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Paper No.

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

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SEP 26 2008

In re Patent No. 7,348,353	:	DECISION ON REQUEST FOR
Gasparini et al.	:	RECONSIDERATION OF
Issue Date: March 25, 2008	:	PATENT TERM ADJUSTMENT
Application No. 10/497,363	:	and
Filed: October 26, 2004	:	NOTICE OF INTENT TO ISSUE
Atty Docket No. PN/4-32141A	:	CERTIFICATE OF CORRECTION

This is a decision on the "PETITION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. §1.705(d)," filed April 18, 2008. Patentees request that the patent term adjustment indicated on the face of the Letters Patent be corrected from one hundred thirteen (113) days to one hundred seventy-six (176) days.

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

On March 25, 2008, the above-identified application matured into U.S. Patent No. 7,348,353, with a revised Patent Term Adjustment of 113 days. The instant request for reconsideration filed April 18, 2008 was timely filed within 2 months of the date the patent issued. See § 1.705(d). Patentees assert entitlement to 176 days of patent term adjustment, considering entry of an additional period of adjustment for Office failure to issue the patent within three years of the date the national stage commenced under 35 U.S.C. §371(b).

Patentees' contention is well taken. A review of the record indicates that the three year failure to issue a patent calculation pursuant to 37 CFR 1.702(b) should have used the 35

U.S.C. 371(b) national stage commencement date of June 3, 2004 which would result in an adjustment of 296 days for examination delay.

However, as acknowledged by patentees, 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. Further, in considering the overlap, 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). See 35 U.S.C. 154(b) (1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f). In this instance, the 233 days accorded pursuant to §1.702(a)(1) for Office delay during the pendency of the application overlaps with 296 days pursuant to §1.703(b). Thus, at issuance, the patent was entitled to an additional period of adjustment of 63 days for Office failure to issue the patent within three years.

In view thereof, the patent term adjustment indicated on the patent should be one hundred seventy-six (176) days.

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

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one hundred seventy-six (176) 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 : 7,348,353 B2

DATED : **March 25, 2008** **DRAFT**

INVENTOR(S) : Gasparini 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 113 days

Delete the phrase "by 113 days" and insert – by 176 days--

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CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA CA 91109-7068

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DEC 15 2006

OFFICE OF PETITIONS

In re Application of
KNIGHT
Application No. 10/497375
Filed: June 3, 2004
Attorney Docket No. 49380/RWJ/N317

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 16, 2006.

The request is **APPROVED**.

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

The request was signed by David A. Plumley on behalf of all attorneys of record. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the sole named inventor Joseph R. Knight at the address indicated below. There is an outstanding Office action mailed August 10, 2006 that requires a reply from the applicant.

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **JOSEPH R. KNIGHT, CEO**
NICO WORLDWIDE LLC
320 IRVING DRIVE
OXNARD, CA 93030

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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
10/497,375	06/03/2004	Joseph R Knight	49380/RWJ/N317

CONFIRMATION NO. 2126

23363
CHRISTIE, PARKER & HALE, LLP
PO BOX 7068
PASADENA, CA 91109-7068

Date Mailed: 12/15/2006

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/16/2006.

- 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.

MONICA A GRAVES
OP (571) 272-7253

FORMER ATTORNEY/AGENT COPY

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

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NOV 19 2007

OFFICE OF PETITIONS

In re Application of :
ARNDT, et al. :
Application No. 10/497,388 : DECISION GRANTING PETITION
Filed: February 1, 2005 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. **5367-103PUS** :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed November 13, 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 October 4, 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 Monica A. Graves at (571) 272-7253.

This application is being referred to Technology Center AU 2814 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

Frances Hicks
Petitions Examiner
Office of Petitions

[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.*

02 NOV 2003

#3

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Ade & Company
1700-360 Main Street
Winnipeg Manitoba
Canada R3C 3ZC

In re Application of :
BURT, Austin :
Application No.: 10/497,390 : DECISION
PCT No.: PCT/GB02/04959 :
Int. Filing Date: 01 November 2002 : ON PETITION UNDER
Priority Date: 01 November 2001 :
Docket No.: 85443-102 : 37 CFR 1.137(b)
For: METHODS FOR GENETICALLY :
MODIFYING A TARGET POPULATION :
OF AN ORGANISM :

Applicants' "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 01 June 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) is required.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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WESTMAN CHAMPLIN & KELLY, P.A.
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55402

Mail Date: 04/21/2010

Applicant	: Ehud Cohen	: DECISION ON REQUEST FOR
Patent Number	: 7613516	: RECALCULATION of PATENT
Issue Date	: 11/03/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/497,397	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 03/23/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1082** 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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PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND, OH 44114-3108

Mail Date: 04/21/2010

Applicant	: Yasuhisa Kimura	: DECISION ON REQUEST FOR
Patent Number	: 7577452	: RECALCULATION of PATENT
Issue Date	: 08/18/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/497,402	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/02/2004	: 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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17 MAR 2009

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William F. Lawrence
Frommer Lawrence & Haug
745 Fifth Avenue
New York NY 10151

In re Application of	:
MERINO, et al.	:
Application No. 10/497,417	: DECISION ON PETITION
Filed: 27 May 2004	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 517427-2002.US	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed 19 August 2008, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed with the petition.

The petition is **DISMISSED**.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

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

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

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

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

The reference to add the prior-filed applications on page one following the first sentence of the specification is not acceptable as drafted since it improperly incorporates by reference the prior-filed applications. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (see 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. See Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). Note MPEP §§ 201.06(c) and 608.04(b).

The reference to U.S. application number 11/129,116 is further improper because the present application was filed prior to application 11/129,116 and thus cannot claim benefit under 35 U.S.C. 120 to application number 11/129,116.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet (37 CFR 1.76(a)(5)) or a proper amendment (complying with the provisions of 37 CFR 1.121) to correct the above matters are required.

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

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

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

By fax:
(571) 273-0459
ATTN: Office of PCT Legal Administration

Any questions concerning this matter may be directed to Derek A. Putonen at (571) 272-3294.

Bryan Lin
Legal Examiner
Office of PCT Legal Administration

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22 JUL 2009

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William F. Lawrence
Frommer Lawrence & Haug
745 Fifth Avenue
New York NY 10151

In re Application of	:
MERINO, et al.	:
Application No. 10/497,417	: DECISION ON PETITION
Filed: 27 May 2004	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 517427-2002.US	:

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed 17 June 2009, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed with the renewed petition.

The renewed petition is **DISMISSED**.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

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

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

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

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

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. The amendment merely indicates that the application is a U.S. National Stage entry of international application PCT/US02/37849, filed November 25, 2002, "which claims benefit of and priority to U.S. Serial No. 09/995,054..." The amendment fails to comply with the provisions of 37 CFR 1.78(a)(2)(i) and is therefore unacceptable.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet (37 CFR 1.76(a)(5)) or a proper amendment (complying with the provisions of 37 CFR 1.121) to correct the above matters are required.

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

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

By fax: (571) 273-0459
ATTN: Office of PCT Legal Administration

Any questions concerning this matter may be directed to Derek A. Putonen at (571) 272-3294.

Bryan Lin
Legal Examiner
Office of PCT Legal Administration

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30 OCT 2009

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

In re Application of	:
MERINO, et al.	:
Application No. 10/497,417	: DECISION ON PETITION
Filed: 27 May 2004	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 517427-2002.US	:

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed 31 July 2009, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed with the petition.

The renewed 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 international application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

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

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

(2) the surcharge set forth in § 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Applicant previously satisfied items (2) and (3).

The renewed petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that a proper reference to the prior-filed international 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).

Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 and 365 (c) to the prior-filed international 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 applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed 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 international application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Derek 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 Technology Center Art Unit 1797 for appropriate action on the amendment filed 31 July 2009, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 and 365 (c) to the prior-filed international application.

Bryan Lin

Bryan Lin
Legal Examiner
Office of PCT Legal Administration

ATTACHMENT: Corrected Filing Receipt

20 MAY 2005

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

In re Application of	:	
BEHRENS et al.	:	
Application No.: 10/497,422	:	DECISION ON PETITION
Filing Date: 28 May 2004	:	UNDER 37 CFR 1.181
Attorney Docket No.: 11336/730	:	
For: BROWSER ENABLED COMMUNICATION SYSTEM	:	

This decision is in response to applicants' "Request for Corrected Filing Receipt and Notice of Acceptance" filed 23 March 2005 and applicants' "37 CFR 1.182 Petition to Process Application under 35 U.S.C. 111(a)" filed on 29 March 2005 in the United States Patent and Trademark Office (USPTO). Applicants are requesting that the application papers submitted on 28 May 2004 be considered a filing under 35 U.S.C. 111. The petition is being treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 02 December 2002, applicants filed international application PCT/EP02/13609 which claimed a priority date of 30 November 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, 30 May 2004.

On 28 May 2004, applicants filed a Transmittal Letter for entry into the national stage accompanied, *inter alia,* by: the requisite basic national fee; an English translation of the international application; and a preliminary amendment.

On 18 October 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 November 2004, applicants filed an executed declaration.

On 22 December 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 of 22 November 2002.

On 23 March 2005, applicant filed "Request for Corrected Filing Receipt and Notice of Acceptance."

On 25 October 2004, applicants filed "37 CFR 1.182 Petition to Process Application under 35 U.S.C. 111(a)" which requests that the application papers submitted on 22 July 2004 be considered a filing under 35 U.S.C. 111.

DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.495(g):

> The documents and fees submitted . . . must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a), page 1800-190 of the MPEP states that:

> If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

On 28 May 2004, applicants submitted a specification which stated "this application is a continuation-in-part and claims the benefit of priority under 35 U.S.C. 120, 365 and 371 to Patent Cooperation Treaty patent Application no. PCT/EP02/13609 . . . " The statement in the specification is inconsistent with an intent to enter the national stage of the PCT under 35 U.S.C. 371. (It is noted that the first line of the specification contains an improper reference to 35 U.S.C.371.) Accordingly, the original papers deposited on 28 May 2004 should have been treated as a filing under 35 U.S.C. 111(a).

Since applicants' application will be treated under 35 U.S.C. 111(a), a corrected Notification of Acceptance of Application under 35 U.S.C. 371 (Form PCT/DO/EO/903) will not be issued.

The title of the invention will be corrected to: Browser Enabled Communication System.

CONCLUSION

The petition to process the application from a national stage application under 35 U.S.C. 371 to a 35 U.S.C. 111(a) filing is **GRANTED**.

The application will be forwarded to the Office of Initial Patent Examination for further processing under 35 U.S.C. 111(a) including: issuing a corrected Filing Receipt and correcting the title of the invention.

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

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

COPY MAILED

FEB 13 2006

OFFICE OF PETITIONS

Applicant: Behrens et al.
Appl. No.: 10/497,422
Filing Date: May 28, 2004
Title: BROWSER ENABLED COMMUNICATION SYSTEM
Attorney Docket No.: 11336/730
Pub. No.: US 2005/0091377 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 June 27, 2005, for the above-identified application.

On May 28, 2004, applicant filed a Transmittal Letter for entry into the national stage accompanied by the fee, an English translation of the international application, a preliminary amendment and another specification, which includes a line in the first sentence that stated this application is a continuation-in-part application to PCT /EP02/13609. In response to a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905), applicant responded with the executed declaration. On December 22, 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), which indicated a date under 35 U.S.C. 371 of November 22, 2002. On March 23, 2005, applicant filed a Request for a Corrected Filing Receipt and Notice of Acceptance. On June 27, 2005, Applicant request a corrected publication because the United State Patent and Trademark Office published the copy of the application provided with the request for entry into the national stage and not the specification provided by applicant, which stated this application is a continuation-in-part of the PCT application.

The request is granted.

The corrected patent application publication will be published in due course, unless the patent issues before the application is republished.

Inquiries relating to this matter may be directed to Mark O. Polutta at (571) 272-7709 (voice).

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

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MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

Mail Date: 04/21/2010

Applicant	: Stephen D. Noble	: DECISION ON REQUEST FOR
Patent Number	: 7607898	: RECALCULATION of PATENT
Issue Date	: 10/27/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/497,429	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 02/07/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1066** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

16 DEC 2004

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Lionel D. Anderson
Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski PC
280 N. Old Woodward Avenue, Suite 400
Birmingham, MI 48009

In re Application of	:	
HÄNSEL, Mathias	:	
Application No.: 10/497,440	:	DECISION
PCT No.: PCT/EP02/12354	:	
Int. Filing Date: 06 November 2002	:	ON PETITION UNDER
Priority Date: 30 November 2001	:	
Docket No.: RAG-15502/08	:	37 CFR 1.137(b)
For: RETAINING OR FIXING ... SUPPORT SURFACE	:	

Applicant's "Petition For Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the above-captioned application on 02 June 2004 is **GRANTED**.

Applicant states "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). 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: 571-272-3292
Facsimile: 571-273-0459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : March 5, 2009

TO SPE OF : ART UNIT 2855
SUBJECT : Request for Certificate of Correction for Appl. No.: 10/497447 / 7445382

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

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

Magdalene Talley
Certificates of Correction Branch
703-308-9390 ext. 120

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: _____

_____

_____

_____

_____

_____ 2855
SPE Art Unit

12 JAN 2005

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PAULA CAMPBELL EVANS
PALMER & DODGE, LLP
111 HUNTINGTON AVENUE
BOSTON, MA 02199-7613

In re Application of MENON et al.	
Application No.: 10/497,449	
PCT Application No.: PCT/EP02/12222	DECISION ON PETITION
Int. Filing Date: 31 October 2002	UNDER 37 CFR 1.137(b)
Priority Date Claimed: 31 October 2001	
Attorney Docket No.: 1529/2042	
For: NOVEL ANTICANCER COMPOUNDS	

Applicants' "Petition For Revival Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office (PTO) on 01 June 2004 is GRANTED.

BACKGROUND

On 31 October 2002, applicants filed international application PCT/EP02/12222. The international application claims a priority date of 31 October 2001 and designates the United States. A copy of the international application was communicated from the International Bureau to the United States Patent and Trademark Office on 08 May 2003. The deadline to pay the basic national fee was thirty months from the priority date, that is 31 April 2004. The application became abandoned at midnight 31 April 2004 for failure to pay the basic national fee.

On 01 June 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, and the petition fee of $665.

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.

Applicant's statement in the petition 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). 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.

The declaration filed 01 June 2004 has not been executed. Accordingly, the provision of 35 USC 371(c)(4) has not been met.

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 Notification of Missing Requirements (PCT/DO/EO/905), requiring an oath or declaration of the inventors in compliance with 37 CFR 1.497 and the surcharge set forth in 37 CFR 1.492(e) are due.

Leonard Smith
PCT Legal Examiner
PCT Legal Administration

Nathan Newhouse
Detailee
PCT Legal Administration
Telephone: 571-272-6095
Facsimile: 571-273-0459

01 MAR 2005
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GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

In re Application of	:	
KJÖRLING, Kristofer et al.	:	
Application No.: 10/497,450	:	DECISION ON
PCT No.: PCT/EP02/13462	:	
Int. Filing Date: 28 November 2002	:	PETITION
Priority Date: 29 November 2001	:	
Attorney's Docket No.: SHO0168	:	UNDER 37 CFR 1.182
For: METHODS FOR IMPROVING HIGH FREQUENCY RECONSTRUCTION	:	

This decision is in response to applicants' "Petition to Convert," filed on 02 November 2004. It has been treated as a petition under 37 CFR 1.182.

BACKGROUND

On 28 November 2002, applicants filed international application PCT/EP02/13462, which claimed a priority date of 29 November 2001. A copy of the international application was transmitted to the Office on 05 June 2003. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 01 June 2004 (29 May 2004 was a Saturday and 31 May 2004 was a holiday).

On 28 May 2004, applicants submitted a transmittal letter for entry into the national stage in the United States, accompanied by the basic national fee and the declaration.

On 02 November 2004, applicants filed the instant petition to convert.

On 07 January 2004, the Office mailed a Notification of Acceptance (Form PCT/DO/EO/903) indicating that the requirements under 35 U.S.C. §371(c)(1), (2) and (4) were satisfied on 28 May 2004.

DISCUSSION

U.S. Statutes and Regulations do not make specific provision for the requested action and as such the Office does not grant such petitions for conversion as a mere matter of course. The Office will only grant such petitions upon a showing by applicant of sufficient cause (e.g., the loss of patent rights) where no other remedy is available.

In the present petition, applicants have not made a showing that a loss of patent rights would occur if the above-captioned application is a filing under 35 U.S.C. §371. Further,

applicants have not explained why the filing of a continuation application under 35 U.S.C. §111 would be inadequate.

CONCLUSION

As discussed above, the petition under 37 CFR 1.182 is **DISMISSED** without prejudice.

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 returned to Group Art Unit 2644 for continued processing.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

29 APR 2005

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GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

In re Application of :
KJÖRLING, Kristofer et al. :
Application No.: 10/497,450 : DECISION ON
PCT No.: PCT/EP02/13462 :
Int. Filing Date: 28 November 2002 : PETITION
Priority Date: 29 November 2001 :
Attorney's Docket No.: SHO0168 : UNDER 37 CFR 1.182
For: METHODS FOR IMPROVING HIGH :
FREQUENCY RECONSTRUCTION :

This decision is in response to applicants' "Request for Reconsideration," filed on 31 March 2005. It has been treated as a renewed petition under 37 CFR 1.182.

BACKGROUND

On 28 November 2002, applicants filed international application PCT/EP02/13462, which claimed a priority date of 29 November 2001. A copy of the international application was transmitted to the Office on 05 June 2003. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 01 June 2004 (29 May 2004 was a Saturday and 31 May 2004 was a holiday).

On 28 May 2004, applicants submitted a transmittal letter for entry into the national stage in the United States, accompanied by the basic national fee and the declaration.

On 02 November 2004, applicants filed a petition to convert.

On 07 January 2005, the Office mailed a Notification of Acceptance (Form PCT/DO/EO/903) indicating that the requirements under 35 U.S.C. §371(c)(1), (2) and (4) were satisfied on 28 May 2004.

On 01 March 2005, the Office mailed Decision On Petition Under 37 CFR 1.182, dismissing applicants' petition without prejudice.

On 31 March 2005, applicants filed a renewed petition.

DISCUSSION

U.S. Statutes and Regulations do not make specific provision for the requested action and as such the Office does not grant such petitions for conversion as a mere matter of course. The Office will only grant such petitions upon a showing by applicant of sufficient cause (e.g., the loss of patent rights) where no other remedy is available.

Applicants have not made a showing that a loss of patent rights would occur if the above-captioned application remains a filing under 35 U.S.C. §371. Further, applicants have not explained why the filing of a continuation application under 35 U.S.C. §111 would be inadequate.

Applicants claim that petitions to convert were granted in similarly situated applications, e.g. 10/481,005, 10/502,622 and 10/490,327. A review of those decisions and applications does not support the assertion. Those applications were improperly processed under 35 U.S.C. §371, as applicants had furnished conflicting instructions upon filing. See MPEP 1893.03(a). Applicants brought that to the attention of the Office and the errors were corrected. Had the Office found the errors on its own, the Office would have vacated the 371 paperwork and directed that the applications be processed under 35 U.S.C. §111(a).

However, conflicting instructions were not present in this application upon filing. Applicants attached 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). The accompanying specification did not contain the conflicting instruction present in the other applications. As such, it was properly processed under 35 U.S.C. §371. Applicants provided a preliminary amendment on 02 November 2004. That amendment claims that the application is a continuation of PCT/EP02/13462. That assertion is not a conflicting instruction as it was submitted subsequent to filing, it is simply incorrect. See MPEP 1893.03(a).

If applicants want a 35 U.S.C. §111(a) application, applicants can file a 35 U.S.C. §111(a) continuation application.

CONCLUSION

As discussed above, the petition under 37 CFR 1.182 is **DISMISSED** without prejudice.

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 returned to Group Art Unit 2644 for continued processing.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

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15 MAY 2006

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MENLO PARK CA 94025

In re Application of	:	
KJÖRLING, Kristofer et al.	:	
Application No.: 10/497,450	:	DECISION
PCT No.: PCT/EP02/13462	:	
Int. Filing Date: 28 November 2002	:	ON PETITION UNDER
Priority Date: 29 November 2001	:	
Attorney's Docket No.: SHO0168	:	37 CFR 1.10(c)
For: METHODS FOR IMPROVING HIGH FREQUENCY RECONSTRUCTION	:	

This decision is in response to applicant's "Request for Corrected Filing Receipt," filed in the United States Patent and Trademark Office on 02 December 2005. It has been treated as a petition under 37 CFR 1.10(c).

BACKGROUND

On 28 November 2002, applicants filed international application PCT/EP02/13462, which claimed a priority date of 29 November 2001. A copy of the international application was transmitted to the Office on 05 June 2003. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 01 June 2004 (29 May 2004 was a Saturday and 31 May 2004 was a holiday).

Applicants submitted a transmittal letter for entry into the national stage in the United States, accompanied by the basic national fee and the declaration. It was accorded a receipt date of 28 May 2004.

On 07 January 2005, the Office mailed Notification of Acceptance (Form PCT/DO/EO/903) indicating that the application satisfied 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) on 28 May 2004.

On 02 December 2005, applicant filed the instant petition under 37 CFR 1.10(c).

DISCUSSION

In the instant petition, applicant requests that the receipt date of application No. 10/497,450 be amended to 02 December 2005. The requirements for a petition to correct a receipt date based on Express Mail records are set forth in 37 CFR 1.10(c). The section states as follows:

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

Items (1), (2) and (3) have been met. The petition was filed promptly. The Express Mail mailing label number was listed on the correspondence. Applicant has provided a copy of the Express Mailing mailing label with the "date-in" listed as 27 May 2004.

CONCLUSION

For the reasons listed above, applicant's petition under 37 CFR 1.10(c) to correct the receipt date of the filing to 27 May 2004 is **GRANTED**.

The Notification of Acceptance (Form PCT/DO/EO/903) mailed 07 January 2005 is **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision, including the mailing of a corrected Notification of Acceptance (Form PCT/DO/EO/903) and Filing Receipt.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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JOHN P. WHITE
COOPER & DUNHAM
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

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SEP 28 2007

OFFICE OF PETITIONS

In re Application of	:	
Arlindo L. Castelhano et al	:	
Application No. 10/497,451	:	ON PETITION
Filed: December 13, 2004	:	
Attorney Docket No. 60390-MA-PCT-US/JPW/KBC	:	

This is a decision on the petition under 37 CFR 1.137(b), filed June 8, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 14, 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 15, 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 1624 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

23 AUG 200

#3

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ELI LILLY AND COMPANY
PATENT DIVISION
P.O. Box 6288
Indianapolis, IN 46206-6288

In re Application of :
HINTON, Paul Robert *et al* :
U.S. Application No.: 10/497,475 : **DECISION**
PCT No.: PCT/US02/11854 : **UNDER**
Int. Filing Date: 26 April 2002 : **37 CFR 1.10(e)**
Priority Date: 30 April 2001 :
Attorney Docket No.: X-14819 :
For: HUMANIZED ANTIBODIES :

This decision is in response to applicants' "Petition for Correspondence Not Received in the USPTO" filed 01 June 2004 which is treated as a petition under 37 CFR 1.10(e). No petition fee is required.

BACKGROUND

On 22 October 2001, applicants purportedly filed a national stage application of PCT/US02/11854 pursuant to 35 U.S.C. 371 using Express Mail. However, there is no record that this application was received in the USPTO.

On 01 June 2004, applicants filed the instant petition which was accompanied by, *inter alia*, a copy of the papers purportedly filed 22 October 2003 and a copy of applicants' "Monthly Statement of Deposit Account."

DISCUSSION

The information provided in the "Monthly Statement of Deposit Account" submitted with the instant petition has led to the discovery of the papers filed 22 October 2003. These papers were received by the USPTO on 22 October 2003 and placed in an inactive U.S. Application (No. 10/476,401).

CONCLUSION

Since the papers filed 22 October 2003 have been located, applicants' petition under 37 CFR 1.10(e) is **DISMISSED** as **MOOT**.

Inactive U.S. Application No. 10/476,401 will be merged into the file of the above-captioned U.S. application No. 10/497,414.

All future correspondence regarding this patent application should be directed to U.S. application No. 10/497,475. The date of receipt of the national stage papers for U.S. application No. 10/497,475 will be changed to 22 October 2003.

A review of the papers filed on 22 October 2003 show that a declaration in compliance with 37 CFR 1.1497(a) and (b) was submitted with the national stage papers.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 26 April 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 22 October 2003.

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

02 NOV 2004

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WILLIAMS MULLEN
FOUNTAIN PLAZA THREE, SUITE 200
721 LAKEFRONT COMMONS
NEWPORT NEWS, VA 23606

In re Application of TAPSCOTT	:	
U.S. Application No.: 10/497,478	:	
PCT Application No.: PCT/US02/31012	:	DECISION
Int. Filing Date: 26 September 2002	:	
Priority Date Claimed: 26 September 2001	:	
Attorney Docket No.: 037580.0001	:	
For: STRIPPER AND FLAIL DELIMBER AND DEBARKER	:	

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 01 June 2004.

BACKGROUND

On 26 September 2002, applicant filed international application PCT/US02/31012, which claimed priority of an earlier United States application filed 26 September 2001. The thirty-month period for paying the basic national fee in the United States expired on 26 March 2004.

International application PCT/US02/31012 became abandoned as to the United States for failure to timely pay the basic national fee.

On 01 June 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 26 September 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 01 June 2004.

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

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JEFFREY M. GREENMAN
BAYER PHARMACEUTICALS CORPORATION
400 MORGAN LANE
WEST HAVEN CT 06516

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MAY 31 2007

OFFICE OF PETITIONS

In re Application of	:	
Luithle et al.	:	
Application No. 10/497,511	:	DECISION ON PETITION
Filed: 12/22/2004	:	
Atty Docket No. LE A 35 819	:	

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

The petition is **DISMISSED AS MOOT**.

A review of the record reveals that on 22 December, 2006, a Notice of Allowance and Fee(s) Due and a Notice of Allowability were mailed, a three (3) month statutory period for reply. The issue and publication fees were required to be paid.

On 22 March, 2007, the issue and publication fees were filed, along with an amendment under 37 CFR 1.312.

On 23 March, 2007, the present petition was filed.

As such, the application was not abandoned, and no petition to revive is necessary.

The petition fee will be credited to counsel's deposit account.

The application will be referred to the Office of Publications for processing into a patent.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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NOV 22 2006

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ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON DC 20005

In re Application of	:
Gerhard Gaedicke et al	:
Serial No.: 10/497,521	: PETITION TO MAKE SPECIAL
Filed: August 11, 2004	:
Attorney Docket No.: 2958-0124	:

This is in response to applicants' petition filed July 20, 2004, to make the above-identified application special under the provisions of 37 CFR 1.102(d). The delay in acting on this petition was due to processing in the DO/EO and initial examination areas of the Office.

Applicant has not satisfied the provisions set forth in M.P.E.P. 708.02, X. Therefor the petition is **DENIED**.

Applicants' petition states in paragraph one that the invention relates to treatment of cancer. A review of the claims shows that they are directed to a compound which is useful for treating any type tumor, not just those associated with cancer. Furthermore, no claim is directed to treatment of cancer. Thus no direct treatment of cancer is shown or claimed and the application does not satisfy the requirements of this section for special status.

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

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SUITE 800
WASHINGTON DC 20005

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APR 27 2010

OFFICE OF PETITIONS

In re Patent No. 7,582,778	:	DECISION ON REQUEST
Gaedicke, et al.	:	FOR
Issue Date: September 1, 2009	:	RECONSIDERATION OF
Application No. 10/497,521	:	PATENT TERM ADJUSTMENT
Filed: August 11, 2004	:	and
Atty Docket No.3603-101	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION

This is a decision on the petition filed on November 2, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand, two hundred and fifteen (1,215) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand, two hundred and forty-seven (1,247) days[1] is **GRANTED to the extent indicated herein.**

[1] The "B" delay period is 821 days. This period is not calculated based on the date this application fulfilled the requirements of 35 U.S.C. 371. 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 December 3, 2001. As the requirements for early commencement were not met, the national stage commenced in this application on June 3, 2004. Thus, "B" delay is 821 days, counting the number of days beginning on June 4, 2007 and ending on September 1, 2009, the date of issuance. See 1.703(b). It is also noted that patentees indicate that the applicant delay is 206 days. The record reflects that the applicant delay is 174 and this

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

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

The application is being forwarded to the Certificates of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand, two hundred and forty-seven (1,247) 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

---

number was used in the calculation of the patent term adjustment of 1,247 days.

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,582,778

DATED : Sep. 1, 2009

INVENTOR(S) : Gaedicke 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 (578) days

Delete the phrase "by 578 days" and insert – by 1,247 days--

13 JAN 2005

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Townsend and Townsend and Crew LLP
Two Embarcadero Center
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San Francisco, CA 94111-3834

In re Application of	:	
ANDERSEN, Soren V. et al.	:	
Application No.: 10/497,530	:	DECISION
PCT No.: PCT/SE02/02226	:	
Int. Filing Date: 03 December 2002	:	ON PETITION UNDER
Priority Date: 04 December 2001	:	
Attorney's Docket No.: 020184-001000US	:	37 CFR 1.181
For: LOW BIT RATE CODEC	:	

This is a decision on applicant's "Petition Under 37 CFR 1.181," filed with the Office on 14 December 2004.

BACKGROUND

On 03 December 2002, applicant filed international application PCT/SE02/02226. A copy of the international application was transmitted to USPTO by 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 04 June 2004.

On 03 June 2004, applicant filed a transmittal letter for entry into the national stage in the United States, accompanied by, *inter alia*, the basic national fee.

On 27 July 2004, applicants submitted a change of address and power of attorney

On 29 September 2004, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905), indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required. The Notification was sent to previous counsel's address.

On 14 December 2004, applicant submitted "Petition Under 37 CFR §1.181," requesting that the Office correct the correspondence address and change the attorney of record.

On 06 January 2005, applicants submitted a copy of a declaration claimed to have been submitted on 30 November 2004 and a postcard receipt. It has been treated as a petition under 37 CFR 1.181.

DISCUSSION

Applicants submitted a change of address and power of attorney on 27 July 2004. They have now been entered. The Notification of Missing Requirements was sent to the old address. The Notification of Missing Requirements is vacated.

Applicants state that the declaration and application data sheet are true copies of the submissions to Office on 30 November 2004. The date stamped postcard receipt listing the items and the application number is adequate evidence of receipt of the listed items. The declaration is treated as having been received 30 November 2004.

The fee for the one month extension of time will be refunded to deposit account no. 20-1430.

CONCLUSION

For the above reasons, applicants' petitions under 37 CFR 1.181 are **GRANTED**.

The Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 29 September 2004 is **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The date under date under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date is 30 November 2004.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

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July 17, 2007

Patent No. : 7211116 B2
Ser. No. : 10/497538
Inventor(s) : Kiyomine, et al.
Issued : May 1, 2007
Title : **HAIR DYE COMPOSITION**
Docket No. : 254418US0PCT

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.

The word "comprises", purported to be in column 34, line 4, cannot be found in the printed patent.

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

Elisha Evans
For Cecelia Newman, Supervisor
Decisions & Certificates
of Correction Branch
(703) 308-9390 ext. 110

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

CBN/eme

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In re Application of FLORENZ et al.	
Application No.: 10/497,543	DECISION ON
PCT No.: PCT/EP02/13537	
Int. Filing: 30 November 2002	PETITION
Priority Date: 12 December 2001	
Attorney Docket No.: FLOR3003/FJD	UNDER 37 CFR 1.47(a)
For: ELECTRONIC FIELD DEVICE WITH A SENSOR UNIT FOR CAPACITIVE LEVEL MEASUREMENT IN A CONTAINER	

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 10 February 2005.

BACKGROUND

On 14 June 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 10 December 2004, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration of the inventors, in compliance 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 10 February 2005, in response to the Notification of Missing Requirements, 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 Hans-Jorg Florenz.

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).

With regard to Item (1), Petitioner submitted $130 for the petition fee. The appropriate fee for a petition under 37 CFR 1.47(a) is $200. The insufficiency of $70 will be charged to applicant's deposit account per his authorization, satisfying Item (1).

Petitioner satisfied Item (4) with the submission of the declaration executed by Clemens Heilig on his behalf and on behalf of the non-signing inventor Hans-Jorg Florenz.

However, with respect to Item (3), Petitioner has not provided a statement of the last known address of the non-signing inventor and is required.

With respect to item (2), Petitioner states that Mr. Florenz is unavailable to sign the declaration, providing a copy of a 17 September 2004 letter from Mrs. Angelika Andres to counsel. Mrs. Andres states that "We have searched his new address, but it was without success."

As indicated in the MPEP Section 409.03(d), where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, diligent efforts made to locate Mr. Florenz were not pursued and documented, such as Internet searches, E-mail contact to obtain a current address, contact with his former employer or joint inventor to obtain a forwarding address or a request from the Postal Service for his forwarding address. 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. Petitioner's statement of facts under 37 CFR 1.47(a) merely states that a search for Mr. Florenz new address was unsuccessful. Since no attempts to locate inventor Florenz have been documented, it can not be concluded that "a diligent effort" was made to locate the non-signing inventor.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. Under these circumstances, it cannot be concluded that Mr. Florenz is unavailable to sign the application. Petitioner has not demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/497,543 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and (2) Mr. Florenz's unavailability after petitioner's diligent effort or Mr. Florenz's refusal to sign, either in writing or orally, these documents. 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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01 JUL 2005

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In re Application of FLORENZ et al. Application No.: 10/497,543 PCT No.: PCT/EP02/13537 Int. Filing: 30 November 2002 Priority Date: 12 December 2001 Attorney Docket No.: FLOR3003/FJD For: ELECTRONIC FIELD DEVICE WITH A SENSOR UNIT FOR CAPACITIVE LEVEL MEASUREMENT IN A CONTAINER	DECISION ON REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.47(a)

This is a decision on applicant's Request for Reconsideration under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 09 May 2005.

BACKGROUND

On 14 June 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 10 December 2004, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration of the inventors, in compliance 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 10 February 2005, in response to the Notification of Missing Requirements, 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 Hans-Jorg Florenz.

On 09 March 2005, a decision dismissing applicant's petition was mailed indicating that Petitioner had not provided a statement of the last known address of the non-signing inventor and did not demonstrate that "a diligent effort" was made to contact the nonsigning inventor.

On 09 May 2005, Petitioner submitted a Request for Reconsideration of the petition under 37 CFR 1.47(a).

DISCUSSION

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

Petitioner has previously satisfied Items (1) and (4) above.

However, with respect to Item (3), Petitioner has not provided a statement of the last known address of the non-signing inventor, which is required.

With respect to item (2), Petitioner is required to make "diligent efforts" to locate Mr. Florenz before it can be concluded that Mr. Florenz is unavailable or refuses to sign the application.

In the petition under 37 CFR 1.47(a) filed on 10 February 2005, the only evidence applicant provided was a copy of a 17 September 2004 letter from Mrs. Angelika Andres to counsel, in which Mrs. Andres states that "We have searched his [nonsiging inventor's] new address, but it was without success."

With the request for reconsideration, petitioner provides a copy of a 22 March 2005 letter to Mr. Florenz from Kathrin Spöri of Endress+Hauser GmbH + Co. KG, along with an English translation. The letter indicates that "a form for the filing of your invention" was enclosed. Furthermore, in a letter from Ms. Spöri to U.S. counsel, Ms. Spöri states that the "letter is returned as undeliverable".

Thus, 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. This one attempt to reach Mr. Florenz is not sufficient to prove that Mr. Florenz is unavailable or refuses to sign the application.

With regard to attempts to locate Inventor Florenz, counsel did not attempt to contact Mr. Florenz himself. Rather, the petition was accompanied by correspondence sent to the nonsigning inventor on 22 March 2005 by Kathrin Spöri. The English translation of the letter was provided but it does 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 the 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 receipt envelope information provided to demonstrate the attempt to deliver a copy of "a form" to Mr. Florenz indicates "Recipient/company not locatable at the given address". It is not clear that the delivery address used is Mr. Florenz's last known address. The evidence does not explain the failed delivery attempt(s) (i.e., wrong address, addresses moved, no answer, etc.)

Moreover, 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 of the "diligent efforts" made 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.

Accordingly, items (2) and (3), above have not been satisfied and the petition under 37 CFR 1.47(a) must be dismissed.

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(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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02 OCT 2006

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In re Application of FLORENZ et al.
Application No.: 10/497,543
PCT No.: PCT/EP02/13537
Int. Filing: 30 November 2002
Priority Date: 12 December 2001
Attorney Docket No.: FLOR3003/FJD
For: ELECTRONIC FIELD DEVICE WITH A SENSOR UNIT FOR CAPACITIVE LEVEL MEASUREMENT IN A CONTAINER

DECISION ON

RENEWED PETITION

UNDER 37 CFR 1.47(a)

This is a decision on applicant's "Further Response", considered as a renewed petition under 37 CFR 1.47(b), filed in the United States Patent and Trademark Office (USPTO) on 28 July 2006. A two month extension of time is required and the response is treated as requesting such extension.

BACKGROUND

On 10 February 2005, in response to the 10 December 2004 Notification of Missing Requirements, 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 Hans-Jorg Florenz.

On 09 March 2005, a decision dismissing applicant's petition was mailed indicating that Petitioner had not provided a statement of the last known address of the non-signing inventor and did not demonstrate that "a diligent effort" was made to contact the nonsigning inventor.

On 09 May 2005, Petitioner submitted a Request for Reconsideration of the petition under 37 CFR 1.47(b). On 01 July 2005, a decision was mailed indicating that Petitioner failed to provide information of the "diligent efforts" made concerning Mr. Florenz's whereabouts or whether diligent efforts to locate Mr. Florenz via E-mail, Internet searches or the like were conducted.

On 12 January 2006, applicant filed a renewed petition.

On 05 April 2006, a decision dismissing the renewed petition was mailed. The decision indicated that Petitioner had not yet provided evidence regarding Mr. Florenz's unavailability or refusal.

On 28 July 2006, Petitioner filed a "Further Response" in reply to the 05 April 2006 decision, accompanied by a newly executed declaration. The 05 April 2006 decision set a two

month time limit for response or by 05 June 2006, with extensions of time available. Applicant's submission was received on 28 July 2006, requiring a two month extension of time. The submission is considered as having requested a two month extension of time. Per applicant's authorization, the fee for a two month extension of time is charged to his deposit account.

DISCUSSION

In response to the decision mailed on 05 April 2006, Petitioner submitted a newly executed declaration from the previously nonsigning inventor Florenz and his joint inventor. A review of the declaration indicates that it is in compliance with 37 CFR 1.497(a) and (b) and is acceptable.

CONCLUSION

The renewed petition under 37 CFR 1.47(a) is Dismissed as Moot. The declaration submitted on 28 July 2006 is in compliance with 37 CFR 1.497(a) and (b) and is acceptable.

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 July 2006.**

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Tel: 571-272-3286
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05 APR 2006

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In re Application of FLORENZ et al.
Application No.: 10/497,543
PCT No.: PCT/EP02/13537
Int. Filing: 30 November 2002
Priority Date: 12 December 2001
Attorney Docket No.: FLOR3003/FJD
For: ELECTRONIC FIELD DEVICE WITH A SENSOR UNIT FOR CAPACITIVE LEVEL MEASUREMENT IN A CONTAINER

DECISION ON

RENEWED PETITION

UNDER 37 CFR 1.47(a)

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) on 12 January 2006. The petition is being treated as a petition under 37 CFR 1.47(a) because the application was made by two joint inventors. Applicant requests a two month extension of time, which is granted.

BACKGROUND

On 10 February 2005, in response to the 10 December 2004 Notification of Missing Requirements, 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 Hans-Jorg Florenz.

On 09 March 2005, a decision dismissing applicant's petition was mailed indicating that Petitioner had not provided a statement of the last known address of the non-signing inventor and did not demonstrate that "a diligent effort" was made to contact the nonsigning inventor.

On 09 May 2005, Petitioner submitted a Request for Reconsideration of the petition under 37 CFR 1.47(b). On 01 July 2005, a decision was mailed indicating that Petitioner failed to provide information of the "diligent efforts" made concerning Mr. Florenz's whereabouts or whether diligent efforts to locate Mr. Florenz via E-mail, Internet searches or the like were conducted.

On 12 January 2006, applicant filed a renewed petition.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application

or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Petitioner satisfied Items (1) and (4) above.

With respect to item (2), Petitioner questions the authority to support the requirement that the petition be accompanied by a first-hand statement of facts and that one attempt to reach Mr. Florenz was insufficient to demonstrate that Mr. Florenz is unavailable.

As explained in MPEP §409.03(d) regarding Proof of Unavailability or Refusal to sign the application papers:

> 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 and 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.

Where the inventor's refusal to join the application is alleged, §409.03(d) further states:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney....It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts **by the person who presented** the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when a 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, 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.

Petitioner has not yet provided evidence regarding Mr. Florenz's unavailability or refusal. Here, the only attempt at delivery to Mr. Florenz was returned as undeliverable. This attempt did

not provide him with a complete copy of the application papers, as required and set forth above. It is unclear whether the delivery to Mr. Florenz did not succeed because he was on vacation, in the hospital or not available at the time of attempted delivery.

Moreover, where the inventor is unavailable, diligent efforts should taken to locate the whereabouts of the nonsigning inventor. As stated above, copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, attempts to locate him through his co-inventor or last known employment or email address that support a finding that the nonsigning inventor could not be found or reached should be made part of the 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.

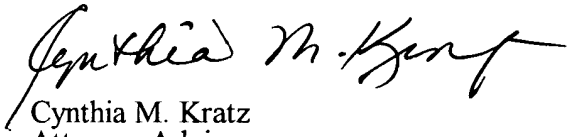
Accordingly, Item (2) has not been satisfied and the petition under 37 CFR 1.47(a) must be dismissed.

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.



Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Tel: 571-272-3286
Fax: 571-273-0459

~~24 MAR 2005~~ 26 MAY 2005 corrected

#5

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

In re Application of	:	
MASI et al.	:	DECISION ON
Application No.: 10/497,549	:	
PCT No.: PCT/EP02/13954	:	PAPERS
Int. Filing Date: 06 December 2002	:	
Priority Date: 20 December 2001	:	UNDER 37 CFR 1.42
Attorney's Docket No.: 254162USOXPCT	:	
For: SUPPORTED CATALYST CONTAINING ACTIVE TITANIUM IN THE HOM, CO, AND TER-POLYMERIZATION OF OLEFIN-UNSATURATED COMPOUNDS	:	

This is a decision on the submission filed by applicants on 25 April 2005, which was accompanied by, *inter alia*, a declaration of the inventors. The indication in this declaration that inventor Roberto Santi is deceased has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 06 December 2002, applicants filed international application PCT/EP02/13954 which claimed a priority date of 20 December 2001 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 June 2004 (20 June 2004 being a Sunday).

On 14 June 2004, applicants filed, *inter alia*, a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date.

On 25 February 2005, 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 25 April 2005, applicants filed the instant submission which was accompanied by,

inter alia, a declaration of inventors. The indication in this declaration that inventor Roberto Santi is deceased has been treated as a request for status under 37 CFR 1.42.

DISCUSSION

The declaration filed 25 April 2005 fails to comply with 37 CFR 1.497(a)-(b). The declaration must include the signature of the legal representative or the signature of all of the heirs (or if there is only one heir, the sole heir). The declaration does not indicate that Maria Rivellini, Stefano Santi, and Laura Santi are all the heirs or are the legal representatives for the deceased inventor. If the declaration is signed by a legal representative, the declaration should state that this person is the legal representative. Alternatively, applicants' attorney may file a statement certifying that the person signing is the legal representative. If the declaration is not signed by a legal representative and does not indicate that the persons signing are all of the heirs (or the sole heir), then it must be accompanied by a statement by either those signing or by the attorney which sets forth (1) that they are in fact all the heirs of the deceased and (2) that no legal representative of the deceased's estate has been appointed or is required by the applicable law to be appointed.

CONCLUSION

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

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.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

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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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 Duke Street
Alexandria, VA 22314

In re Application of :
MASI, Francesco *et al* :
Application No.: 10/497,549 :
PCT No.: PCT/EP02/13954 :
Int. Filing Date: 06 December 2002 :
Priority Date: 20 December 2001 :
Attorney's Docket No.: 254162USOXPCT :
For: SUPPORTED CATALYST CONTAINING ACTIVE TITANIUM IN THE HOM, CO, AND TER-POLYMERIZATION OF OLEFIN-UNSATURATED COMPOUNDS :

DECISION ON PAPERS FILED UNDER 37 CFR 1.42

This is a decision on the "Renewed Submission Under 37 CFR 1.42" filed on 29 June 2005. No fee is required.

BACKGROUND

On 24 May 2005, a decision was mailed indicating that the papers filed under 37 CFR 1.42 on 25 April 2005 were not accepted because applicant did not indicate that a legal representative was not appointed and that there were no more heirs. Applicants were given two months to respond.

On 29 June 2005, applicants submitted the instant response which was accompanied by, *inter alia*, a copy of the declaration previously submitted and an "Attorney Declaration."

DISCUSSION

In the renewed submission, counsel has provided a statement that declares that (1) the heirs listed on the declaration are all of the heirs of the deceased inventor, Mr. Roberto Santi; and (2) no legal representative of the deceased's estate has been appointed or is required by the applicable law to be appointed.

This is sufficient for a grantable petition.

The declaration previously filed was signed by five of the six named joint inventors. The citizenship, residence and address of all the joint inventors (including the deceased inventor) are listed on the declaration pursuant to 37 CFR 1.497(a)(3)

and 37 CFR 1.63(c)(1). In addition, the citizenship, residence and address of the three heirs are recorded on the declaration.

CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 06 December 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 25 April 2005.

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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

Mail Date: 04/21/2010

Applicant	: Michael David Eales	: DECISION ON REQUEST FOR
Patent Number	: 7653389	: RECALCULATION of PATENT
Issue Date	: 01/26/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/497,552	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 11/08/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **418** 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.

24 SEP 2004

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Anthony Handal
Kirkpatrick & Lockhart, LLP
599 Lexington Avenue
31st Floor
New York, New York 10022-6030

In re Application of :
BERTHA et al. :
Application No.: 10/497,582 : DECISION ON
PCT No.: PCT/HU02/00135 : PAPERS UNDER 37 CFR 1.42
Int. Filing Date: 04 December 2002 :
Priority Date: 04 December 2001 :
Attorney Docket No.: BERTHA-3 :
For: METHOD FOR OXYGEN TREATMENT OF UNSATURATED CARBON COMPOUNDS . . .

This decision is in response to the declaration filed 03 June 2004 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 04 December 2002, applicants filed international application PCT/HU02/00135, which claimed a priority date of 04 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 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, 04 June 2004.

On 03 June 2004, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; an information disclosure statement; and an executed declaration. The declaration was executed by: Andras Bertha and Mihaly Lantos as inventors and Peter Kolta and Gergely Kolta, on behalf of deceased inventor, Peter Kolta.

DISCUSSION

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

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

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

The declaration submitted on 03 June 2004 was executed by Peter Kolta and Gergely Kolta as "first and second heirs" to the deceased inventor, Peter Kolta. The declaration asserts that "Peter Kolta and Gergely Kolta are the two sons and only heirs." The declaration submitted appears to have been executed by the proper party under 37 CFR 1.42, however, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

In addition, it is noted that revised 37 CFR 1.497(b)(2) states the following:

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

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide residence, citizenship, and post office address for the signing heir. The declaration filed on 03 June 2004 provides this information with respect to the signing heirs, but not the inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(a)-(b) and 37 CFR 1.63.

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

CONCLUSION

The papers filed under 37 CFR 1.42 are **REFUSED**.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42." Extension of time may be obtained under 37 CFR 1.136.

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

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (703) 308-6314
Fax: (703) 308-6459

22 APR 2005

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New York, New York 10022-6030

In re Application of :
BERTHA et al. :
Application No.: 10/497,582 : DECISION ON
PCT No.: PCT/HU02/00135 : PAPERS UNDER 37 CFR 1.42
Int. Filing Date: 04 December 2002 :
Priority Date: 04 December 2001 :
Attorney Docket No.: BERTHA-3 :
For: METHOD FOR OXYGEN TREATMENT OF UNSATURATED CARBON COMPOUNDS . . .

This decision is in response to the declaration filed 29 November 2004 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 04 December 2002, applicants filed international application PCT/HU02/00135, which claimed a priority date of 04 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 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, 04 June 2004.

On 03 June 2004, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; an information disclosure statement; and an executed declaration. The declaration was executed by: Andras Bertha and Mihaly Lantos as inventors and Peter Kolta and Gergely Kolta, on behalf of deceased inventor, Peter Kolta. In a decision dated 24 September 2004, applicants' request under 37 CFR 1.42 was dismissed without prejudice

On 29 November 2004, applicants filed the present renewed request under 37 CFR 1.42.

DISCUSSION

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

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

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

The declaration submitted on 29 November 2004 was executed by Peter Kolta and Gergely Kolta as "first and second heirs" to the deceased inventor, Peter Kolta. The declaration asserts that "Peter Kolta and Gergely Kolta are the two sons and only heirs." 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 29 November 2004.

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

CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

The application has an international filing date of 04 December 2002, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **29 November 2004**.

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

Anthony Smith
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Roger Pitt
Kirkpatrick & Lockhart Nicholson
Graham LLP
599 Lexington Ave.
New York, NY 10022

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OFFICE OF PETITIONS

In re Application of :
Andras Bertha et al. :
Application No. 10/497,582 : DECISION ON PETITION
Filed: November 29, 2004 : TO WITHDRAW
Attorney Docket No. BERTHA-3 : 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 1, 2006.

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

A review of the file record indicates that the power of attorney to Roger Pitt and the attorney(s) and/or agent(s) of record have been revoked by the applicant of the patent application on May 19, 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.

David Bucci
Petitions Examiner
Office of Petitions

cc: Brown, Rudnick, Berlack & Israels, LLP
Box IP, 18th Floor
One Financial Center
Boston, MA 02111

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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
10/497,582	11/29/2004	Andras Bertha	BERTHA-3

CONFIRMATION NO. 2309

OC000000020321227

OC000000020321227

21710
BROWN, RUDNICK, BERLACK & ISRAELS, LLP.
BOX IP, 18TH FLOOR
ONE FINANCIAL CENTER
BOSTON, MA 02111

Date Mailed: 09/06/2006

NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 05/19/2006.

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.

J. Williams

TERRI S WILLIAMS
OP (571) 272-2991

ATTORNEY/APPLICANT COPY

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OFFICE OF PETITIONS

In re Application of :
Bertha et al. :
Application No. 10/497,582 : DECISION ON PETITION
Filed: November 29, 2004 :
Attorney Docket No. BERTHA-3 :

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 reply in a timely manner to the non-final Office action mailed February 25, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 26, 2008. A Notice of Abandonment was mailed October 23, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Amendment, (2) the petition fee of $810.00, and (3) an adequate 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. It is not apparent whether the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute this patent. In accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts. While, a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

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

This application is being referred to Technology Center AU 1624 for appropriate action by the Examiner in the normal course of business on the reply received.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

cc: Anthony H. Handal
Thompson Hine LLP
335 Madison Avenue
New York NY 100017

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Howard C. Lee
Frommer, Lawrence & Haug, LLP
745 Fifth Avenue
New York, NY 10151

Paper No. 07312007

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FROM DIRECTOR'S OFFICE

AUG 13 2007

TECHNOLOGY CENTER 3600

In re application of
Von Falkenhausen et al.
Application No. 10/497,585
Filed: June 3, 2004
For: DISPENSING DEVICE FOR FLAT DOSAGE FORMS

: **DECISION ON PETITION**
: **REGARDING REQUEST TO**
: **WITHDRAW FINALITY**
: **UNDER 37 CFR 1.181**

This is in response to applicant's petition filed under 37 CFR 1.181 filed April 5, 2007 requesting withdrawal of finality of the Office action mailed February 6, 2007 as being premature.

The Petition is **GRANTED**.

Applicant alleges that the final rejection mailed February 6, 2007 is premature and should be withdrawn because the final rejection included a 35 USC 112, second paragraph rejection that was not made in the first office action and was not necessitated by applicant's amendment.

MPEP 706.07(a) sets forth that the second or any subsequent action on the merits shall be made final except where the examiner introduces a new ground of rejection that is neither necessitated by applicants' amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR .97(c) with the fee set forth in 37 CFR 1.17(p).

A summary of the examiner's Office actions and of applicant's responses is as follows:

1. A first office action was mailed August 14, 2006 rejecting claims 1-12 under 35 USC 112 second paragraph for containing the indefinite recitations in claim 1 of "which is partitioned at least once" and "whose", the examiner noting it was unclear as to what limitations these phrases and terms referred, claims 1-3 and 5-12 were rejected under 35 USC 103 over Adkins in view of Zackheim and further in view of JP 10-2037222, and claim 4 under 35 USC 103 over Adkins in view of Zackheim and JP 10-2037222 and further in view of Kozlow.

2. Applicant's response filed November 14, 2006, amended claim 1 to clarify the limitations that examiner pointed out as indefinite, adding claims 13-20 and argued the propriety of the prior art rejections.

3. A second, final office action was mailed February 6, 2007, rejecting claims 1-20 under 35 USC 112 second paragraph as being written in narrative form and replete with indefinite, functional and operational language, claims 1-3 and 5-12 were rejected under 35 USC 103 over Adkins in view of Zackheim and further in view of JP 10-2037222, and claims 4 and 13-20 under 35 USC 103 over Adkins in view of Zackheim and JP 10-2037222 and further in view of Kozlow.

4. On April 5, 2007 applicant filed a petition requesting withdrawal of the finality of the final rejection mailed February 06, 2007.

5. On May 24, 2007 applicant filed an amendment in response to the final rejection mailed February 6, 2007, canceling claims 1-20 adding claims 21-40 and arguing the propriety of the prior art rejections.

5. On July 5, 2007 an Advisory Action was mailed stating applicant's amendment of May 24, 2007 would not be entered as not placing the claims in better form for appeal by materially reducing or simplifying the issues for appeal.

After careful review of the above facts, the 112 second paragraph rejection of claims 1-20 in the final office action mailed Febraury 6, 2007 was indeed a new rejection not in the first office action and not necessitated by applicant's amendment.

Hence applicant's petition to withdraw the finality of the Office action mailed April 20, 2007 is **GRANTED**.

Accordingly, the finality of the Office action mailed February 6, 2007, but not the action itself, is hereby vacated. The response filed May 24, 2007 will be entered and forwarded to the examiner for consideration of the amendment.

Inquiries related to this decision may be directed to Supervisory Patent Examiner Gene O. Crawford at (571) 272-6911.

Katherine Matecki

Katherine Matecki
Director
Technology Center 3600
[KD/GC: 7/31/07]

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20090416

DATE : April 24, 2009

TO SPE OF : ART UNIT 1637

SUBJECT : Request for Certificate of Correction on Patent No.: 7427673

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 appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

Comments:

SPE: /Gary Benzion/ **Art Unit** 1637

07 APR 2005

#4

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Sughrue Mion PLLC
2100 Pennsylvania Avenue, NW
Suite 800
Washington, DC 20037

In re Application of	:	
Tanaka et al.	:	
Application No. 10/497,596	:	DECISION ON
PCT No.: PCT/JP02/13112	:	
Int. Filing Date: 16 December 2002	:	PETITION UNDER
Priority Date: 19 December 2001	:	
Atty. Docket No.:Q81948	:	37 CFR 1.137(b)
For: Polymer Foam Manufacturing Method, Member For Image Forming Device, And Image Forming Device	:	

This is in response to the petition under 37 CFR 1.137(b) filed on 23 March 2005.

BACKGROUND

This international application was filed on 16 December 2002, claimed an earliest priority date of 19 December 2001, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 26 June 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 19 June 2004.

On 13 September 2004, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant, indicating that this international application had become abandoned with respect to the national stage in the United States for failure to timely pay the required basic national fee.

DISCUSSION

Counsel petitions for revival of this international application with respect to the national stage in the United States, pursuant to 37 CFR 1.137(b). The petition is accompanied by a copy of a return postcard receipt itemizing a petition under 37 CFR 1.137(b) and stamped as received by the USPTO on 30 September 2004, a copy of another return postcard receipt itemizing an executed declaration, an "English translation," $300.00 in fees, and stamped as received by the USPTO on 10 November 2004. Counsel states that copies of the itemized documents, filed on 23 March 2005, are copies of the documents originally filed on 30 September 2004 and 10 November 2004, respectively. MPEP 503 states in part that "A postcard receipt which itemizes and properly identifies the papers which are being filed serves

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as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Pursuant to that practice, the copy of the petition filed on 23 March 2005 is being accepted as a copy of the petition filed on 30 September 2004. Upon inspection of the application file, the original copy of the correspondence filed on 10 November 2004, including the executed declaration of the inventors and an English translation of the international application, have been found to be present.

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 was filed on 30 September 2004.

Regarding requirement (2), the petition fee was filed on 30 September 2004.

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**.

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 November 2004**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

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

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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK NY 10004

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JUN 03 2008

OFFICE OF PETITIONS

In re Application of :
Shoji, et al. :
Application No. 10/497,616 : ON PETITION
Filed: June 2, 2004 :
Attorney Docket No. 52433/752 :
For: METAL MATERIAL COATED WITH METAL OXIDE AND/OR METAL HYDROXIDE COATING FILM AND METHOD FOR PRODUCTION THEREOF

This is a decision on the petition under 37 CFR 1.181, filed February 26, 2008 (certificate of mailing date February 22, 2008), requesting that the Office withdraw the holding of abandonment of the above-identified application.

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

This application was held abandoned for failure to respond in a timely manner to the non-final Office action, mailed July 25, 2007, which set forth an extendable three (3) month period for reply. The Office contended that this application became abandoned on October 26, 2007 for failure to reply to the July 25, 2007 non-final Office action. A Notice of Abandonment was mailed on February 5, 2008.

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 mailed on certificate of mailing date January 24, 2008 and received in the Office on January 28, 2008. The undersigned finds this argument completely convincing, as these documents are present in the application file and a review of Office financial records for the instant application reveals that the required three month extension of time fee and an independent claim in excess of three fee were charged on January 28, 2008. The mailroom date for the payments was January 24, 2008. Therefore, the three month extension of time, excess claim fee, and amendment were timely filed.

The petition under 37 CFR 1.181 is **granted**, the holding of abandonment is withdrawn, and the February 5, 2008 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. 1794 for consideration of the amendment filed on January 28, 2008 (certificate of mailing date January 24, 2008).

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

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

19 MAY 2006

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Darby & Darby, P.C.
P.O. Box 5257
New York, New York 10150-5257

In re Application of
YAMAGUCHI et al.
Application No.: 10/497,622
PCT No.: PCT/JP04/06307
Int. Filing Date: 30 April 2004
Priority Date: 21 May 2003
Atty. Docket No.: 09867/0201423-US0
For: SOUND APPARATUS

DECISION

This decision is issued in response to applicant's "Request for Corrected Filing Receipt and Notice of Acceptance" filed on 13 October 2005, which is being treated as a petition under 37 CFR 1.181.

BACKGROUND

On 01 June 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; an English translation of the international application; and an application data sheet.

In response to the Notification of Missing Requirements dated 27 July 2005, applicants filed an executed declaration of inventors on 08 July 2005.

On 23 September 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification of Acceptance of Application under 35 U.S.C. 371 AND 37 CFR 1.495" (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 08 July 2005 and a 35 U.S.C. 371 completion date of 08 July 2005.

On 13 October 2005, applicant filed "Request for Corrected Filing Receipt and Notice of Acceptance."

DISCUSSION

Applicant requests a corrected filing date (or 371(c) date) from 08 July 2005 to 08 July 2004. The actual filing date of the present application is the international filing date, i.e., 30 April 2004. (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)

Applicant states in their present petition that a declaration and power of attorney was received at the United States Patent and Trademark Office on 08 July 2004. A review of the present application reveals that the declaration and power of attorney filed 08 July 2004 is not located therein. Section 503 of the Manual of Section 503 of the Manual of Patent Examining Procedure under the heading "RETURN POSTCARD" states, in part:

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

The accompanying copy of the post card receipt identifies the application by applicant, application number, and docket number. The receipt itemizes, inter alia, oath; a transmittal letter (PTO-1390); and a certificate of Express Mailing. The receipt is stamped "Rec'd OIPE JUL 08, 2004" across its face and is sufficient to indicate that the combined declaration and power of attorney was in fact received in the Office on 08 July 2004. Therefore, the correction of the "FILING DATE" on the filing receipt to indicate a date of 08 July 2004 is proper since applicant completed the requirements set forth in 35 U.S.C. 371(c) on 08 July 2004. (See MPEP section 1893.03(b)).

CONCLUSION

Applicant's request under 37 CFR 1.181 for issuance of a corrected Notification of Acceptance and Official Filing Receipt 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 September 2005 is hereby **VACATED**.

The application has an international filing date of 30 April 2004 under 35 U.S.C. 363 and a date of 08 July 2004 under 35 U.S.C. 371(c).

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision, that is, for mailing of a NOTIFICATION OF ACCEPTANCE OF APPLICATION (Form PCT/DO/EO/903) which identifies a date of 08 July 2004 under 35 U.S.C. 371(c) and preparation and mailing of a corrected Filing Receipt in accordance with this decision, that is a filing receipt that identifies a filing date of 08 July 2004.

Thereafter, this application will be referred to its appropriate Art Unit.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 571-272-3298
Facsimile: 571-273-0459

14 SEP 2004

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#6

Bryan W. Schaefer
Alston & Bird, LLP
Bank of America Plaza
101 South Tyron Street, Suite 4000
Charlotte, NC 28280-4000

In re Application of :
WILLIAMS et al. :
Application No.: 10/497,625 : DECISION ON PETITION
PCT No.: PCT/US02/37384 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 21 November 2002 :
Priority Date: 21 November 2001 :
Attorney Docket No.: 048777/278402 :
For: DEVICE, SYSTEM, KIT OR METHOD FOR COLLECTING EFFLUENT FROM AN INDIVIDUAL

The petition to revive under 37 CFR 1.137(b) filed 03 June 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

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27 JUL 2009

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LAW OFFICE OF SALVATORE ARRIGO
1050 CONNECTICUT AVE. NW
10TH FLOOR
WASHINGTON DC 20036

In re Application of :
HOWLEY et al. :
Application No.: 10/497,633 :
Filing Date: 03 June 2004 : DECISION
Attorney's Docket No.: BN40PCTSEQ :
For: FLAVIVIRUS NS1 SUBUNIT VACCINE :

This application is before the PCT Legal Office for consideration of matters arising under 35 U.S.C. 371 file in the United States Patent and Trademark Office on 03 June 2004.

BACKGROUND

On 20 November 2002, applicant filed international application PCT/EP02/12991, which claimed priority of an earlier Danish application filed 04 December 2001.

On 03 June 2004, applicant filed a transmittal letter requesting filing under 35 U.S.C. 371 in the United States which was accompanied by, *inter alia*, the basic national fee.

On 06 December 2004, a Notification of Missing Requirements was mailed to applicant. On 20 December 2004, applicant filed a response. On 01 March 2005, a Notification of Defective Response was mailed to applicant. A response was filed on 17 March 2005. On 12 April 2006, a Notification of Acceptance was mailed to applicant.

DISCUSSION

On 03 June 2004, applicant submitted U.S. national application papers including an Application Data Sheet indicating the following : "This application is a continuation of PCT/EP02/12991 2002-11-20."

As explained at Section 1893.03(a) of the Manual of Patent Examining Procedure (MPEP), *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). 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(a).

The Transmittal Letter (Form PTO-1390) filed on 03 June 2004 identified the application as "a filing under 35 U.S.C. 371." However, the Application Data Sheet filed on the same date, indicates the follows: "This application is a continuation of PCT/EP02/12991...".

Applicant's reference to the papers as a continuation application in the Application Data

Sheet is inconsistent with the Transmittal Letter filed 11 May 2001 and contradicts the request in the Transmittal Letter to file under 35 U.S.C. 371. A national application which requests treatment as a continuation of an earlier international application cannot be considered the national stage application of that international application, and under the present circumstances, is an indication of papers filed under 35 U.S.C. 111(a).

In view of the above, it is proper to treat the initial filing as a filing under 35 U.S.C. 111(a). The Notification of Acceptance under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 12 April 2006 is **VACATED**.

CONCLUSION

The papers filed on 03 June 2004 will be treated as a U.S. application filed under 35 U.S.C. 111(a) with filing date of 03 June 2004.

The Notification of Acceptance mailed on 12 April 2006 is hereby **VACATED**.

This application is being referred to the National Stage Processing Branch of the office of PCT Operations for removal of all Article 20 papers and processing of the above referenced application as a U.S. application filed under 35 U.S.C. 111(a) with a filing date of 03 June 2004.

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

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

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APR 25 2006

OFFICE OF PETITIONS

In re Application of :
Toshinori Sugihara et al :
Application No. 10/497,638 : ON PETITION
Filed: June 4, 2004 :
Attorney Docket No. 70404.25 :

This is a decision on the petition, filed April 20, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

Petitioner is advised that the issue fee paid on February 27, 2006, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 2821 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

---

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

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Paper No. _____

Date : April 24, 2006

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) :Toshinori Sugihara et al
Application No. :10/497,638
Filed :June 4, 2004

The above-identified application has been assigned Patent No. 7,042,531 and an issue date of May 9, 2006.

It is hereby directed that this application be withdrawn from issue at the request of the applicant.

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of May 9, 2006:

"All reference to Patent No. 7,042,531 to Toshinori Sugihara et al of Japan for DISPLAY DEVICE USING BIDIRECTIONAL TWO-TERMINAL ELEMENT AND MANUFACTURING METHOD OF DISPLAY DEVIE appearing in the Official Gazette of May 9, 2006 should be deleted since no patent was granted."

Karen Creasy

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

cc: Paul Harrison, MDW-4B03,(FAX-273-5468)
Deneise Boyd, MDE-3D39 (FAX-273-5124)
Mary Louise McAskill, ST-8C15 (FAX 305-4372)
Niomi Farmer, ST-8C14 (FAX-305-4372)
Mary E. Johnson (Cookie), MDE-7C71 (FAX 273-0038
Duane Davis P/OPC MDE-7D89

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McDermott Will & Emery
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Washington DC 20005-3096

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JUN 26 2009

OFFICE OF PETITIONS

Applicant: Shimizu et al.
Appl. No.: 10/497,664
International Filing Date: June 3, 2003
Title: MAGNESIUM ALLOY PLATE AND METHOD FOR PRODUCTION THEREOF
Attorney Docket No.: 52363-021
Pub. No.: US 2005/0067068 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), received on April 11, 2008, for the above-identified application. Applicant requests that the application be republished because the patent application publication contains material error in containing "ratio revalue" rather than "ratio r_0 value in claim 11.

The request is DISMISSED.

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." (emphasis added) 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 of April 11, 2008 was not timely filed. The time allotted by 37 CFR 1.221(b) expired on May 31, 2005, two months from the March 31, 2005 date of the patent application publication. Since the request was made outside the time period set forth in 37 CFR 1.221(b), relief is not available under that section to requester.

The error in the claim of the publication is not a material Office error under 37 CFR 1.221. The patent application publication was published with "ratio revalue" rather than "ratio r_0 value in claim 11. The error is due to the quality of the text, which is not clear due to the size, which makes it difficult to electronically reproduce by digital imaging and optical character recognition. See 37 CFR 1.52 and PCT Rule 11.9(d)(1). Applicant is advised that he may want

[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).

to file application papers that are clearer, as the error is due to the quality of the text. The text is very small, which makes it difficult to read and to electronically reproduce by digital imaging and optical character recognition. Applicants have been advised to file applications having cleaner and larger text with sufficient clarity and contrast to permit reproduction, such as electronic reproduction by digital imaging and optical character recognition, which will avoid errors in the patent application publication process. See 37 CFR 1.52 and PCT Rule 11.9(d)(1).

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 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, as a "Pre-Grant Publication" 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

A guide for filing a request for a Pre-Grant Publication, such as a request for republication, may be found on the link below:

http://www.uspto.gov/ebc/portal/tutorials.htm

Inquiries relating to this matter may be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or the undersigned 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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PTO/SB/83 (04-05)
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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	10/497,666
	Filing Date	(Int'l) November 28, 2002
	First Named Inventor	Frans KOSTER
	Art Unit	1761
	Examiner Name	M. Cano
	Attorney Docket Number	246152022100

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

Approved 2-16-07
Jacqueline M. Stone
Jacqueline M. Stone, Director
Technology Center 1700/2900

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

- [X] all the attorneys/agents of record.
- [ ] the attorneys/agents (with registration numbers) listed on the attached paper(s), or
- [ ] the attorneys/agents associated with Customer Number [ ]

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

The reasons for this request are:
This transfer is being made at the request of the client.

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	Bryan H. Davidson, Esq. Nixon & Vanderhye P.C.				
Address	111th Floor, 901 North Glebe Road				
City	Arlington	State	VA	Zip	22203-1808
Country	US				
Telephone	(703) 816-4026	Email	bhd@nixonvan.com		
Signature	Kate H. Murashige				
Name	Kate H. Murashige		Registration No.	29959	
Date	January 5, 2007		Telephone No.	(858) 720-5112	

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-352564

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 10/1/07

Paper No.: ____

TO SPE OF : ART UNIT 2878

SUBJECT : Request for Certificate of Correction on Patent No.: 10/497,668 7259364

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

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

Valerie Jackson

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9390 ext. 114

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

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

Comments:

Georgia Y. Epps
SPE

2878
Art Unit

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MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

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NOV 23 2007

OFFICE OF PETITIONS

In re Application of :
Heiko Straulino :
Application No. 10/497,681 : DECISION ON PETITION
Filed: November 23, 2004 : TO WITHDRAW
Attorney Docket No. 449122073900 : FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b) filed July 13, 2007.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Morrison & Forester, LLP has been revoked by the assignee of the patent application on August 8, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: KEVIN SPIVAK
BELL, BOYD & LLOYD, LLC
70 WEST MADISON STREET
SUITE 3100
CHICAGO, IL 60602-4207

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Morrison & Foerster LLP
1650 Tysons Boulevard
Suite 300
Mclean, VA 22102

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JAN 31 2008

OFFICE OF PETITIONS

In re Application of
Gerhard Wild
Application No. 10/497,682
Filed: June 4, 2004
Attorney Docket No. 2001P20338

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 **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 November 5, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Lerner Greenberg Stemer LLP**
P. O. Box 2480
Hollywood, FL 33022-2480HoHH

21 SEP 2005

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

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Roger L. Browdy
BROWDY AND NEIMARK, PLLC
624 Ninth Street, N.W., Suite 300
Washington, DC 20001-5303

In re Application of :
HELDMAN, Eliahu *et al* :
U.S. Application No.: 10/497,705 :
PCT No.: PCT/IL02/00997 :
Int. Filing Date: 04 December 2002 : **DECISION**
Priority Date: 04 December 2001 :
Attorney's Docket No.: HELDMAN1A :
For: AMPHILIC COMPOUNDS AND VESICLES . . . :
MOVING MIRROR FOR BAR CODE READING :

This is a decision on the petition filed via facsimile on 06 September 2005 which are treated as a petition to withdraw the holding of abandonment. No fee is required.

BACKGROUND

On 04 January 2005, 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 and surcharge fee was required. A two-month time period for response was set.

On 07 February 2005, applicants purportedly filed a response which included an executed declaration and $65.00 surcharge fee.

On 10 August 2005, a "Request for Official Filing Receipt" was filed.

On 06 September 2005, applicants submitted papers which included a copy of a declaration purportedly filed 07 February 2005 and a copy of a postcard receipt for the documents filed 07 February 2005.

DISCUSSION

A review of the application reveals that the response purportedly filed 07 February 2005 was not located in the file. The time limit to respond to the Form PCT/DO/EO/905 mailed 04 January 2005 expired on 04 August 2005.

As such, the above-captioned application is hereby **ABANDONED**.

In the papers filed 06 September 2005, applicants claim that a proper response was filed 07 February 2005 and provided a copy of the date-stamped postcard receipt for the documents submitted 07 February 2005.

The postcard receipt records that a "Missing Parts Response With Decl" and $65.00 in fees were received in the USPTO. The receipt is stamped "OIPE FEB 07 2005" across its face. The U.S. application number and attorney docket number were listed on the postcard receipt. A review of USPTO financial records show that the $65.00 was received on 07 February 2005. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. *See* MPEP § 503.

But for a grantable petition, counsel must also certify that the papers filed are a true copy of the original papers filed 07 February 2005. In this case, the papers submitted on 06 September 2005 as copies of the documents filed 07 February 2005 were uncertified and unsigned and are not accepted.

DECISION

For the reason discussed above, applicants' petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

The subject application remains **ABANDONED**.

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

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

22 SEP 2005

#9

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Roger L. Browdy
BROWDY AND NEIMARK, PLLC
624 Ninth Street, N.W., Suite 300
Washington, DC 20001-5303

In re Application of :
HELDMAN, Eliahu *et al* :
U.S. Application No.: 10/497,705 :
PCT No.: PCT/IL02/00997 :
Int. Filing Date: 04 December 2002 : **DECISION**
Priority Date: 04 December 2001 :
Attorney's Docket No.: HELDMAN1A :
For: AMPHILIC COMPOUNDS AND VESICLES . . . :
MOVING MIRROR FOR BAR CODE READING :

This is a decision on the "Petition to Vacate Holding of Abandonment" filed via facsimile on 21 September 2005. No fee is required.

BACKGROUND

On 21 September 2005, a decision dismissing applicants' petition to withdraw the holding of abandonment was mailed. At 4:30 pm on 21 September 2005, applicants submitted the subject petition via facsimile.

DISCUSSION

The decision mailed 21 September 2005 noted that the postcard receipt filed 06 September 2005 showed that a response to the Form PCT/DO/EO/905 mailed 04 January 2005 was filed on 07 February 2005. However, counsel failed to sign the petition submitted 06 September 2005 and certify that the copies of the documents provided in the petition were originally submitted on 07 February 2005.

In the subject response, counsel has certified that the papers are "a duplicate copy of the Response . . . dated 07 February 2005."

This is sufficient for a grantable petition.

DECISION

For the reason discussed above, applicants' petition to withdraw the holding of abandonment is hereby **GRANTED**.

10/497,705

The declaration originally filed 07 February 2005 is in compliance with 37 CFR 1.497(a) and (b). As noted in the prior decision, the surcharge fee of $65.00 was received and processed on 07 February 2005.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 04 December 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 07 February 2005.

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

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON DC 20001-5303

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MAR 13 2006

OFFICE OF PETITIONS

In re Application of
Kollet et al.
Application No. 10/497,708
International Filing Date: December 5, 2002
For: MIGRATION OF HEMATOPOIETIC STEM CELLS AND PROGENITOR CELLS TO THE LIVER
Attorney Docket No: KOLLET1
Pub. No.: US 2005/0152871 A1
Pub. Date: July 14, 2005

This is a decision on the request for correction of patent application publication under 37 CFR 1.221 (b), filed on September 14, 2005, for the above-identified application.

The request is DISMISSED.

The instant request is that the application be republished because the front page of the patent application publication includes a material mistaken, as it Tsvee Lapidot, as one of the inventors on the front page.

37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records." 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 error in the omission of Tsvee Lapidot on the front page of the publication is an Office error, but it is not a material error under 37 CFR 1.221(b). The error does not affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.

[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).

On March 24, 2005, a Filing Receipt was mailed by the Office, which improperly listed the inventive entity. To avoid this type of problem in the future, applicant's representative should review the Filing Receipt and make a request for a Corrected Filing Receipt.

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 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), msut 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 (703) 308-8122 (voice).

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

Enclosure: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/497,708	03/09/2005	1633	1356	KOLLET1	1	37	1

CONFIRMATION NO. 6719

CORRECTED FILING RECEIPT

OC000000018268977

1444
BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

Date Mailed: 03/13/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Orit Kollet, Rama Gan, ISRAEL;
Tsvee Lapidot, Ness Ziona, ISRAEL;

Power of Attorney: The patent practitioners associated with Customer Number **1444**.

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/IL02/00988 12/05/2002

Foreign Applications

ISRAEL 146970 12/06/2001

If Required, Foreign Filing License Granted: 03/13/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/497,708

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

Migration of hematopoietic stem cells and progenitor cells to the liver

Preliminary Class

424

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

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

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Jordan and Hamburg
122 East 42nd Street
New York, NY 10168

In re Application of	:	
FRANKE et al.	:	DECISION ON
Application No.: 10/497,713	:	
PCT No.: PCT/DE02/04647	:	PAPERS FILED
Int. Filing Date: 19 December 2002	:	
Priority Date: 21 December 2001	:	UNDER 37 CFR 1.43
Attorney's Docket No.: F-8214	:	
For: METHOD AND SYSTEM FOR PRODUCING A MULTI-LAYER, PRE-FIXED THREAD OF FIBRE ARRANGEMENT	:	

This is a decision on the papers filed on 02 December 2004, which is a request for status under 37 CFR 1.43.

On 04 June 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 02 December 2004, applicant filed an application data sheet, declaration signed by two of the three named inventors and the $130 surcharge for filing the declaration after the thirty month period. The declaration was also signed by Claus Schierz as "legal representative" on behalf of the legally incapacitated co-inventor Markus Schierz. A review of the declaration reveals that it is in compliance with 37 CFR 1.497(a) and (b) and is acceptable.

Accordingly, it is appropriate, at this time, to accord the application status under 37 CFR 1.43

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.43 is presently **GRANTED.**

The application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing. The 35 U.S.C. 371(c)(1), (2) and (4) date is 02 December 2004.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

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DLA PIPER LLP (US)
4365 EXECUTIVE DRIVE
SUITE 1100
SAN DIEGO, CA 92121-2133

Mail Date: 06/01/2010

Applicant	: Neil Russell Foster	: DECISION ON REQUEST FOR
Patent Number	: 7641823	: RECALCULATION of PATENT
Issue Date	: 01/05/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 10/497,715	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 03/23/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1233** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

28 JUL 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Richard J. Sterner
WHITE & CASE, LLP
1155 Avenue of the Americas
Room 1900
New York, NY 10036

In re Application of	:	
Peter BERNSTEIN	:	
Application No.: 10/497,719	:	DECISION ON
PCT Application No.: PCT/SE02/02187	:	
International Filing Date: 27 November 2002	:	PETITION
Priority Date: 28 November 2001	:	
Attorney Docket No.: 2001-1294	:	UNDER 37 CFR 1.137(b)
For: THERAPEUTIC COMPOUNDS	:	

Applicant's "Petition To Revive Unintentionally Abandoned Application Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office on 04 June 2004 is **GRANTED**.

BACKGROUND

On 27 November 2002, applicant filed international application PCT/SE02/02187. The international application claims a priority date of 28 November 2001 and designates the United States. Accordingly the deadline for payment of the basic national for National Stage in the United States was thirty months from the priority date, that is 28 May 2004. A copy of the international application was communicated on 05 June 2003 from the International Bureau to the United States Patent and Trademark Office.

On 04 June 2004, applicant 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) and the payment of the appropriate petition fee.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by 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).

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of this grantable Petition under 37 CFR 1.137(b) was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3). The submission of the national fee 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.

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 and the surcharge set forth in 37 CFR 1.492(e) are due.

Leonard Smith
PCT Legal Examiner
PCT Legal Administration

Jimmy G. Foster
Detailee
PCT Legal Administration

Telephone: (703) 308-1315
Facsimile: (703) 308-6459

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Paper No. 110804

NOV 10 2004

ALAN S. HODES
MORRISON & FOERSTER
755 PAGE MILL ROAD
PALO ALTO, CA 94304-1018

In re Application of:
JOHN WOOD
Serial No.: 10/497,730
Filed: July 19, 2004
Attorney Docket No.: **559652000300**

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request to withdraw as attorney/agent of record under 37 C.F.R. § 1.36, filed July 19, 2004.

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

The request meets all the above stated requirements. The request was signed by Alan S. Hodes, on behalf of himself and all the attorneys/agents of record. There is no outstanding Office action at this time.

The request is **APPROVED**.

All future communications from the Office will be directed to Peter Galloway, at the below address, until otherwise notified by applicant.

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

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

cc: DAVID C. BOHRER (DECHERT LLP)
975 PAGE MILL ROAD
PALO ALTO, CA 94304-1013

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MAR 13 2009

OFFICE OF PETITIONS

ASTRAZENECA R&D BOSTON
35 GATEHOUSE DRIVE
WALTHAM MA 02451-1215

In re Application :
Barlaam, et al. :
Application No. 10/497,744 : PATENT TERM ADJUSTMENT
Filed: November 8, 2004 :
Dkt. No.: 100548-1P US :

This is in response to the "PETITION TO REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT INDICATED IN THE NOTICE OF ALLOWNACE UNDER 35 USC 154(b) AND 37 CFR 1.705." This matter is being properly treated as a timely filed application for patent term adjustment pursuant to 37 CFR 1.705(b). The application for patent term adjustment was timely filed January 26, 2009, at the time of issue fee payment.

The Determination of Patent Term Adjustment under 35 USC 154(b) was mailed October 31, 2008. Applicants contest the adjustment insofar as it relates to the Office's failure to issue the patent within three years of the filing date of the application pursuant to 37 CFR 1.703(b) in view of Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

To the extent that this 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 ordinarily 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 1.703(b). It is noted that at the time of this decision, the patent has not issued.

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment

of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

With respect to the over 3 year calculation, rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term 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 file is being forwarded to the Office of Patent Publication 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 matter should be directed to the undersigned at (571) 272-3205.

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

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MAR 26 2010

OFFICE OF PETITIONS

ASTRAZENECA R&D BOSTON
35 GATEHOUSE DRIVE
WALTHAM MA 02451-1215

In re Patent No. 7,521,453
Issued: April 21, 2009
Application No. 10/497,744
371(c) Date: November 8, 2004
Dkt. No.: 100548-1P US

: DECISION ON APPLICATION FOR
: PATENT TERM ADJUSTMENT and
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION
:

This is a decision on the request filed May 1, 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 1,005 days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.**

The "B" delay period is 367 days, not 544 days. Patentee may have calculated this period based on the date this application fulfilled the requirements of 35 U.S.C. 371. However, in an international application, the "B" delay 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 December 7, 2001. As the requirements for early commencement were not met, the national stage commenced in this application on June 7, 2004. Thus, "B" delay is 367 days, counting the number of days beginning on June 8, 2007 and ending on June 8, 2008, the date of issuance. See, 1.703(b).

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 June 8, 2007, the day after the date that is three years after the date of commencement, and ends on June 8, 2008, the day before the RCE was filed, and not June 9, 2008, the day of filing of the RCE as calculated by patentees. See, 35 U.S.C. 154(b)(1)(B)(i). Thus, the over 3 year period is 367 days and not 544 days.

The periods of "A" and "B" share 77 overlapping days which must be deducted from the total period of adjustment (from June 8, 2007 to August 23, 2007).

Thus, the patent term adjustment is 832 days ("A" delay of 592 + "B" delay of 367 – applicant delay of 50 days – 77 overlapping 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. See, 37 CFR 1.323(a)(4).

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

The application is being forwarded to the Certificates of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 832 days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,521,453 B2

DATED : **April 21, 2009** **DRAFT**

INVENTOR(S) : Barlaam, et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 542 days

Delete the phrase "by 542 days" and insert – by 832 days--

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CORPORATE INTELLECTUAL PROPERTY
MAI B482
FIVE MOORE DR., PO BOX 13398
RESEARCH TRIANGLE PARK, NC 27709-3398

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JUN 26 2008

OFFICE OF PETITIONS

In re Application of :
Robert William Baker et al :
Application No. 10/497,749 : ON PETITION
Filed: September 20, 2004 :
Attorney Docket No. PG4346USW :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 6, 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 August 22, 2007. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is November 23, 2007.

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

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

This application is being referred to Technology Center AU 1612 further processing.

Irvin Dingle
Petition Examiner
Office of Petitions

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United States Patent and Trademark Office
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Robert D. Shedd
Thomson Licensing LLC
PO Box 5312
Princeton, NJ 08543-5312

Mail Date: 04/21/2010

Applicant	: Guillaume Bichot	: DECISION ON REQUEST FOR
Patent Number	: 7630333	: RECALCULATION of PATENT
Issue Date	: 12/08/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/497,750	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/04/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1230** 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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Daniel L Dawes
Myers Dawes Andras & Sherman LLP
19900 MacArthur Blvd, Suite 1150
Irvine CA 92612

In re Application of	:	
KURTH et al.	:	
Application No.: 10/497,763	:	
PCT No.: PCT/US03/37045	:	
Int. Filing Date: 17 November 2003	:	DECISION
Priority Date: 15 November 2002	:	
Attorney Docket No.: KUR1.PAU.08	:	
For: A METHOD AND APPARATUS FOR ANCHORING OF PACING LEADS	:	

This is a decision on applicant's "Preliminary Amendment Petition and Request Pursuant to 37 CFR 1.48(b)" filed in the United States Patent and Trademark Office on 04 June 2004.

Applicant's request to delete inventor Seth Worley is premature and will be held in abeyance until the requirements of 35 U.S.C. 371 are met and entry into the U.S. national stage is complete.

The application will be forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing including issuance of a Notification of Missing Requirements (Form DO/EO/905) indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), and the $65 surcharge for filing the oath or declaration after the thirty month period, is required. To satisfy the requirements of 37 CFR 1.497, an oath or declaration executed by the inventors *as identified in the international application* is required.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

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6-21-2010

Patent No. : 7,153,541
Ser. No. : 10/497769
Inventor(s) : Alicia Elsetinow, et. al.
Issued : December 26, 2006

Re: Request for Certificate of Correction

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

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

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

A. **the processing fee set forth in 37 CFR 1.17(ih) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

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

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

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

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

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

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

Eva James
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) 756-1583 or 1580

The Farrell Law Firm, LLP
290 Broadhollow Road, Suite 210E
Melville, New York 11747

ej

07 JUL 2005

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Dr Mark Friedman Ltd
C/O Bill Polkinghorn
Discovery Dispatch
9003 Florin Way
Upper Marlboro MD 20772

In re Application of
GOLOMB et al.
Application No.: 10/497,783
PCT No.: PCT/IL02/00985
Int. Filing Date: 05 December 2002
Priority Date: 05 December 2001
Attorney Docket No.: 325/89
For: NANOPARTICLES CONTAINING POLYMERIC NUCLEIC ACID PHARMACEUTICAL COMPOSITIONS AND ARTICLES OF MANUFACTURE....

DECISION ON PETITION

UNDER 37 CFR 1.497(d)

This is a decision on applicants' "Response to Notification of Missing Requirements", filed on 08 April 2005 in the United States Patent and Trademark Office (USPTO). Petitioner, in effect, seeks to add Elia Fishbein and Michael Chorny as inventors in the above referenced application. The response is being treated as a petition under 37 CFR 1.497(d).

BACKGROUND

On 05 December 2002, applicant filed international application PCT/IL02/00985 which claimed a priority date of 05 December 2001.

On 07 June 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.

On 14 October 2004, a Notification of Missing Requirements was mailed to applicant indicating that the oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the $65 surcharge for filing the oath or declaration after the thirty month period was required.

On 13 December 2004, applicant filed a Response to the Notification of Missing Requirements, along with Combined Declarations and Powers of Attorney executed by applicant/inventors Gershon Golomb, Hagit Sacks and Yousef Najareh and by Elia Fishbein and Michael Chorny (who were not identified in the published International application).

On 15 March 2005, a Notification of Defective Response was mailed to applicant indicating that the declaration of the inventors submitted was not in compliance with 37 CFR 1.497(a) and (b) as the international application listed three inventors but there are 5 signed inventors on the declaration. Applicant was asked to clarify inventorship.

On 08 April 2005, applicant filed the instant response with a copy of a correction filed with the USPTO on 20 June 2003. The correction requested that "Page 2 of the Request, including the name of inventors Elia Fishbein and Michael Chorny, which were left out in error".

DISCUSSION

There is no indication in the application file or a communication from the International Bureau (Form PCT/IB/306) that either Elia Fishbein or Michael Chorny were added to the international application under PCT Rule 92*bis*[1]. The International Bureau confirmed that it never received a Request under PCT Rule 92*bis* in international application PCT/IL0200985 to correct or change the inventorship from that presented in the Request and published application to add Elia Fishbein or Michael Chorny as applicant/inventors.

If the correction was accepted by the International Bureau, applicant would have received a copy of the Notification of the Recording of a Change (Form PCT/IB/306). Since a correction under PCT Rule 92*bis* was not requested of and accepted by the International Bureau, a petition under 37 CFR 1.182 to correct inventorship may be filed with the USPTO requesting the addition of applicant/inventors Elia Fishbein or Michael Chorny.

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).

CONCLUSION

The request under 37 CFR 1.497(d) to add applicant/inventors Elia Fishbein or Michael Chorny 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.** 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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[1] PCT Rule 92*bis*(a) states that the International Bureau shall, on the request of the applicant or receiving Office, record changes ...in the person, name, residence, nationality or address of the applicant. Here, the USPTO was not the receiving Office and thus, could not request the recording of a change in inventorship.

27 OCT 2005

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Dr Mark Friedman Ltd
C/O Bill Polkinghorn
Discovery Dispatch
9003 Florin Way
Upper Marlboro MD 20772

In re Application of
GOLOMB et al.
Application No.: 10/497,783
PCT No.: PCT/IL02/00985
Int. Filing Date: 05 December 2002
Priority Date: 05 December 2001
Attorney Docket No.: 325/89
For: NANOPARTICLES CONTAINING POLYMERIC NUCLEIC ACID PHARMACEUTICAL COMPOSITIONS AND ARTICLES OF MANUFACTURE....

DECISION ON PETITION

UNDER 37 CFR 1.497

This is a decision on applicants' "Petition", filed on 08 August 2005 in the United States Patent and Trademark Office (USPTO). Petitioner, in effect, seeks to add Elia Fishbein and Michael Chorny as inventors in the above referenced application.

BACKGROUND

On 14 October 2004, a Notification of Missing Requirements was mailed to applicant indicating that the oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the $65 surcharge for filing the oath or declaration after the thirty month period was required.

On 13 December 2004, applicant filed a Response to the Notification of Missing Requirements, along with Combined Declarations and Powers of Attorney executed by applicant/inventors Gershon Golomb, Hagit Sacks and Yousef Najareh and by Elia Fishbein and Michael Chorny (who were not identified in the published International application).

On 15 March 2005, a Notification of Defective Response was mailed to applicant indicating that the declaration of the inventors submitted was not in compliance with 37 CFR 1.497(a) and (b) as the international application listed three inventors but five (5) inventors signed the declaration. Applicant was asked to clarify inventorship.

On 08 April 2005, applicant filed a response with a copy of a correction filed with the USPTO on 20 June 2003. The correction requested that "Page 2 of the Request, including the name of inventors Elia Fishbein and Michael Chorny, which were left out in error".

On 07 July 2005, a decision dismissing the petition was mailed to applicant indicating that there was no indication in the application file or communication from the International Bureau (Form PCT/IB/306) that either Elia Fishbein or Michael Chorny were added to the international

application under PCT Rule 92*bis*[1]. In the alternative, applicant was advised to file a petition to correct inventorship under 37 CFR 1.497(d) with the USPTO requesting the addition of applicant/inventors Elia Fishbein and Michael Chorny.

On 08 August 2005, applicant filed the instant Petition indicating that WIPO (International Bureau) confirmed that the two additional inventors were added under PCT Rule 92*bis*.

DISCUSSION

On 05 August 2005, the International Bureau issued a Notification of the Recording of A Change (Form PCT/IB/306) confirming that Elia Fishbein and Michael Chorny were added to the international application under PCT Rule 92*bis* as applicants/inventors for the United States only.

Since the correction was accepted by the International Bureau under PCT Rule 92*bis* and a copy of the Notification of the Recording of a Change (Form PCT/IB/306) was forwarded to the United States Receiving Office (RO/US) via facsimile on 05 October 2005, the addition of Elia Fishbein and Michael Chorny, as applicant/inventors for the US only, is accepted.

CONCLUSION

In light of the issuance of the Form PCT/IB/306 adding Elia Fishbein and Michael Chorny as applicant/inventors for the US only, the declaration executed by joint inventors Elia Fishbein and Michael Chorny is acceptable and in compliance with 37 CFR 1.497(a) and (b).

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 13 December 2004.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

[1] PCT Rule 92*bis*(a) states that the International Bureau shall, on the request of the applicant or receiving Office, record changes ...in the person, name, residence, nationality or address of the applicant. Here, the USPTO was not the receiving Office and thus, could not request the recording of a change in inventorship.

18 NOV 2005

#6

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Chiron Corporation
Intellectual Property - R440
P.O. Box 8097
Emeryville CA 94662-8097

In re Application of HARDY et al.	
Application No.: 10/497,786	DECISION ON PETITION
PCT No.: PCT/US02/39344	
Int. Filing: 09 December 2002	UNDER 37 CFR 1.47(a)
Priority Date: 07 December 2001	
Attorney Docket No.: PP-18535.003	
For: ENDOGENOUS RETROVIRUS POLYPEPTIDES LINKED TO ONCOGENIC TRANSFORMATION	

This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 23 March 2005, to accept the application without the signature of joint inventor, Lewis T. Williams. Applicant's request for a five month extension of time is granted.

BACKGROUND

On 07 June 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 23 August 2004, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, 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 23 March 2005, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor Lewis T. Williams. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor, Lewis T. Williams alleging that Mr. Lewis refuses to sign the application.

DISCUSSION

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

The petition included the requisite petition fee, satisfying Item (1). Item (3) is satisfied because the last known address of non-signing inventor, Lewis T. Williams, was provided. With

regard to item (4), the declaration executed by the available joint inventors on their behalf and on behalf of the non-signing inventor was submitted and satisfies the requirements of 37 CFR 1.47(a).

With respect to Item (2) above, Petitioner provided the declaration of Nancy L. Swanson, patent assistant for Chiron Corporation, in support of the petition under 37 CFR 1.47(a). Ms. Swanson states that on 7 October 2004, she sent a copy of the patent application along with declaration and assignment forms to Mr. Lewis's business address. However, a review of this letter that accompanied the documents indicates that "[a] copy of the first page, and claims of the application" along with the declaration and assignment were enclosed.. The letter further states: "a copy of [PCT/US02/39344] was forwarded to you on March 19, 2003". Thus, there is no evidence that a complete copy of the application papers, including *specification, claims and drawings* and declaration, were provided to Mr. Lewis. The statement indicates that only the first page of the application, claims, declaration and assignment were sent to the inventor for his signature. What is required is that Mr. Lewis be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for this application.

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

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

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

(Emphasis added.)

In sum, Petitioner has satisfied Items (1), (3) and (4) above. However, Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a *copy of the application papers for U.S. application 10/497,786 (specification, including claims, drawings, and declaration)* to the nonsigning inventor for his signature and (2) Mr. Lewis's refusal to sign, either in writing or by telephone, these documents.

For the reasons set forth above, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application at this time. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

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

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

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

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

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

#10

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

26 JAN 2006

Chiron Corporation
Intellectual Property - R440
P.O. Box 8097
Emeryville CA 94662-8097

In re Application of HARDY et al.	
Application No.: 10/497,786	DECISION ON
PCT No.: PCT/US02/39344	
Int. Filing: 09 December 2002	RENEWED PETITION
Priority Date: 07 December 2001	
Attorney Docket No.: PP-18535.003	UNDER 37 CFR 1.47(a)
For: ENDOGENOUS RETROVIRUS POLYPEPTIDES LINKED TO ONCOGENIC TRANSFORMATION	

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 19 December 2005, to accept the application without the signature of joint inventor, Lewis T. Williams.

On 07 June 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 23 August 2004, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, 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 23 March 2005, applicant filed a petition under 37 CFR 1.47(a), along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor Lewis T. Williams, alleging that Mr. Lewis refused to sign the application. The petition attempted to satisfy the requirements of 35 U.S.C. 371(c)(4) requesting the acceptance of the application without the signature of inventor Williams. On 18 November 2005, a decision was mailed indicating that the requirements of 37 CFR 1.47(a) had not been met.

On 09 December 2005, Petitioner filed a renewed petition along with a declaration executed by Mr. Lewis. The renewed petition under 37 CFR 1.47(a) is considered moot as a declaration executed by the previously unavailable inventor has now been submitted and is acceptable under 37 CFR 1.497(a) and (b).

This application is being forwarded to United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is **09 December 2005.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Office of PCT Legal Administration
Telephone: (571) 272-3286

UNITED STATES PATENT AND TRADEMARK OFFICE

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

27 OCT 2006

NOVARTIS VACCINES AND DIAGNOSTICS INC.
CORPORATE INTELLECTUAL PROPERTY R338
P.O. BOX 8097
Emeryville CA 94662-8097

In re Application of HARDY et al. Serial No.: 10/497,786 PCT App. No.: PCT/US02/39344 Int'l Filing Date: 09 December 2002 Priority Date: 07 December 2001 Attorney Docket No.: 002441.00204 For: ENDOGENOUS RETROVIRUS POLYPEPTIDES LINKED TO ONOGENIC TRANSFORMATION	DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 14 August 2006 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "entire delay in filing this required reply from the due date for the action (July 6, 2006) until the filing of this grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that the proper reply, that is, the sequence listing in response to the 06 June 2006 Notification of Defective Response was provided with the instant petition on 14 August 2006 and is entered. Thus, the requirements of 37 CFR 1.137(b) have been satisfied. The required petition fee of $1500 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 09 December 2005.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

10/26/2006 SBASHEIR 00000004 190733 10497786
Sale Ref: 00000006 DA#: 190733 10497786
01 FC:1453 1500.00 DA

04 FEB 2005

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ALEXANDRIA, VA 22313-1450
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Karl F. Milde, Jr.
Milde & Hoffberg, LLP
10 Bank Street, Suite 460
White Plains, NY 10606

In re Application of
PAN
Application No.: 10/497,792 : DECISION ON REFUND
Filing Date: 07 June 2004
Attorney Docket No.: NTD 209-KFM
For: A METHOD FOR ELIMINATING HIV IN BLOOD AND A DEVICE FOR NON-PHARMACOTHERAPYING AIDS

This decision is in response to applicant's request for refund filed 03 February 2005 in the United States Patent and Trademark Office (USPTO) requesting refund of $80.00 charged to Deposit Account No.: 50-0427 on 02 November 2004.

Apparently applicant was advised that the charge was in error and related to a processing fee for providing an English translation later than thirty months from the earliest claimed priority date. This is not the case. Applicant filed the national stage application on 07 June 2004 and provided payment of $460.00 as the small entity U.S. Basic National Fee for filing with an International Search Report prepared by the EPO or JPO. In fact, the International Search Report and IPER were prepared by the Chinese Patent Office. Therefore, the correct small entity U.S. Basic National fee due was $540.00. As authorized, the $80.00 difference was properly deducted from the deposit account.

Applicant's request for refund is **DISMISSED**.

This application is being returned to the United States Designated/Elected Office (US/DO/EO) for continued processing.

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 : 11/2/2009
Patent No. : 7,377,921 B2
Serial No. : 10/497,794
Inventor(s) : Studer et al.
Issue Date : May 27, 2008
Title : **DAMPING ELEMENT AND DEVICE FOR STABILIZATION OF ADJACENT VERTEBRAL BODIES**
Doc./File No. : **001227.0203**

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.

Respecting the alleged error(s) in your request, there is no information on the SB/44//1050 form indicating any alleged error(s). Pleasee provide the office with a completed SB/44//1050 form.

In view of the foregoing, your request for certificate of correction 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) 756-1590
Mary F. Diggs, *Supervisor* (703) 756-1580
Decisions & Certificates of Correction Branch

SYNTHES
1302 WRIGHTS LANE EAST
WEST CHESTER PA 19380

ecw

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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

OCT 20 2006

OFFICE OF PETITIONS

In re Application of :
Eidesmo and Ellingsrud :
Application No. 10/497,807 : ON PETITION
Filed: June 4, 2004 :
Attorney Docket No. 3062.08US01 :

This is a decision on the papers filed September 14, 2006, and supplemented October 19, 2006, which includes (1) a request under 37 CFR 1.48(a),(2) a petition under 37 CFR 1.183, and (3) a petition under 37 CFR 1.182.

The request under 37 CFR 1.48(a) is **granted**.

The petition under 37 CFR 1.183 is **granted**.

The petition under 37 CFR 1.182 is **granted**.

Facts:

International Application No. PCT/GB02/05355 was filed November 28, 2002.

The International Application entered the national stage under 37 U.S.C. 371 on June 4, 2004.

The inventors of record were Lucy M. MacGregor and Marti C. Sinha.

A Notice of Allowance was mailed on June 9, 2006.

On or about September 8, 2005, a court determined the proper inventors for the instant application are Terje Eidesmo and Svein Ellingsrud.

On September 11, 2006, the issue fee and the instant papers were mailed to the Office in compliance with 37 CFR 1.8.

The request under 37 CFR 1.48(a):

A request to correct inventorship under 37 CFR 1.48(a) must include:

(1) the fee under fee under Rule 17(i) ($130),
(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) a correct executed oath/dec (or oath/dec as permitted by 37 CFR 1.42, 1.43 or 1.47) and
(4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee.

Requirements (1), (3), and (4) above have been met.

Petitioner requests waiver of requirement (2).

The request under 37 CFR 1.183:

Petitioner has not supplied a statement from each person being deleted as an inventor that error in inventorship occurred without deceptive intention on his or her part. However, the petition under 37 CFR 1.183 establishes that justice would be served by waiving the requirement for a statement from each deleted inventor.

Petitioner has not supplied a statement from each person being *added* as an inventor that error in inventorship occurred without deceptive intention on his or her part. However, upon consideration of all the facts and circumstances, including the fact the issue fee has been paid, the Office waives the requirement for a statement from each added inventor.

The inventorship of the application will be changed by the deletion of inventors Lucy M. MacGregor and Marti C. Sinha and by the addition of inventors Terje Eidesmo and Svein Ellingsrud.

The supplemental declaration signed by Eidesmo and Ellingsrud is accepted and has been entered into the record.

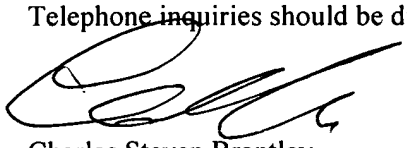
Please find enclosed a corrected filing receipt which reflects the corrected inventorship.

The petition under 37 CFR 1.182:

The petition under 37 CFR 1.182 requests expedited consideration of the request under 37 CFR 1.48(a) and the petition under 37 CFR 1.183. Both the request and petition have been given expedited treatment.

The instant application is scheduled to issue as Patent No. 7,126,338 on October 24, 2006. Therefore, insufficient time exists to take steps to have the correct inventor names appear on the fact of the printed patent. Petitioner may wish to file a Certificate of Correction.

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



Charles Steven Brantley
Petitions Attorney
Office of Petitions

Enclosure: Corrected Filing Receipt

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
10/497,807	06/04/2004	2862	2262	3062.08US01	6	54	8

CONFIRMATION NO. 6505

24113
PATTERSON, THUENTE, SKAAR & CHRISTENSEN, P.A.
4800 IDS CENTER
80 SOUTH 8TH STREET
MINNEAPOLIS, MN 55402-2100

CORRECTED FILING RECEIPT

OC000000020923271

OC000000020923271

Date Mailed: 10/20/2006

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)

Terje Eidesmo, Ranheim, NORWAY;
Svein Ellingsrud, Trondheim, NORWAY;

Power of Attorney: The patent practitioners associated with Customer Number **24113**.

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/GB02/05355 11/28/2002

Foreign Applications

UNITED KINGDOM 0129407.3 12/07/2001

If Required, Foreign Filing License Granted: 10/20/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/497,807

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

ELECTROMAGNETIC SURVEYING FOR HYDROCARBON RESERVOIRS

Preliminary Class

324

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15 (b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

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

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

Mail Date: 04/21/2010

Applicant	: Per Lothe	: DECISION ON REQUEST FOR
Patent Number	: 7597115	: RECALCULATION of PATENT
Issue Date	: 10/06/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/497,818	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/04/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **604** 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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TECHNOLOGY CENTER 2800

March 29, 2007

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

In re application of:	:	
ANGELINI, MARCO et al.	:	NOTICE OF WITHDRAWAL
Application No.: 10/497,819	:	FROM ISSUE
Filed: January 5, 2005	:	UNDER 37 CFR 1.313
Attorney Docket No.: U 015226-3	:	
For: HIGH-HEAT-DISSIPATION	:	
LIGHTING MODULE	:	

The purpose of this communication is to inform you that the above identified application is being withdrawn from issue pursuant to 37 CFR 1.313.

The above identified application is hereby withdrawn from issue. The Notice of Allowance and Issue Fee Due and the Notice of Allowability mailed July 28, 2006 are hereby vacated.

The application is being withdrawn to permit reopening of prosecution. The reasons therefor will be communicated to you by the examiner.

If the issue fee has been submitted, the applicant may request a refund, or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Issue Fee Due, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due. If the application is abandoned, applicant may request either a refund or a credit to a Deposit Account.

Telephone inquiries should be directed to Supervisory Patent Examiner Ricky Mack at (571) 272-2333.

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

Janice A. Falcone, Director
Technology Center 2800
Semiconductor, Electrical, and Optical
Systems, and Components

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19 SEP 2006

KLAUBER & JACKSON
411 HACKENSACK AVENUE
HACKENSACK, NJ 07601

In re Application of ZHANG et al	:	
U.S. Application No.: 10/497,828	:	
PCT Application No.: PCT/US02/38612	:	
Int. Filing Date: 04 December 2002	:	
Priority Date Claimed: 06 December 2001	:	DECISION
Attorney Docket No.: 2570-1-002PCT/US	:	
For: HIGHLY-SENSITIVE GENOMIC ASSAYS	:	
EMPLOYING CHIMERIC	:	
BACTERIOPHAGE STANDARDS	:	

This is in response to applicant's "Request to Withdraw an Erroneous Holding of Abandonment Based on Failure to Respond to Notification of Missing Requirements" filed 31 July 2006, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

BACKGROUND

On 04 December 2002, applicant filed international application PCT/US02/38612, which claimed priority of an earlier United States application filed 06 December 2001. The thirty-month period for paying the basic national fee in the United States expired on 06 June 2004.

On 04 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 23 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 and a sequence listing in computer readable form must be filed.

On 23 November 2004, applicant filed an executed declaration.

On 28 January 2005, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that a sequence listing in computer readable form must be filed.

On 22 February 2005, applicant purportedly filed a sequence listing in computer readable form.

On 11 July 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909).

On 31 July 2006, applicant filed the present petition under 37 CFR 1.181.

DISCUSSION

The evidence of record is sufficient to establish that the sequence listing in computer readable form was originally filed on 22 February 2005. Specifically, the copy of the return postcard, which includes the sequence listing in computer readable form in its itemized contents and which bears a USPTO date stamp of 22 February 2005, serves as *prima facie* evidence that the sequence listing in computer readable form was received by the USPTO on 22 February 2005.

CONCLUSION

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

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 11 July 2006 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 04 December 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 23 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

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03 AUG 2007

KLAUBER & JACKSON
411 HACKENSACK AVENUE
HACKENSACK, NJ 07601

In re Application of ZHANG et al :
U.S. Application No.: 10/497,828 :
PCT Application No.: PCT/US02/38612 :
Int. Filing Date: 04 December 2002 :
Priority Date Claimed: 06 December 2001 : COMMUNICATION
Attorney Docket No.: 2570-1-002PCT/US :
For: HIGHLY-SENSITIVE GENOMIC ASSAYS :
EMPLOYING CHIMERIC :
BACTERIOPHAGE STANDARDS :

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

BACKGROUND

On 04 December 2002, applicant filed international application PCT/US02/38612, which claimed priority of an earlier United States application filed 06 December 2001. The thirty-month period for paying the basic national fee in the United States expired on 06 June 2004.

On 04 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 23 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 and a sequence listing in computer readable form must be filed.

On 23 November 2004, applicant filed an executed declaration.

On 28 January 2005, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that a sequence listing in computer readable form must be filed.

On 22 February 2005, applicant filed a sequence listing in computer readable form.

DISCUSSION

A review of Office records reveals that the disc containing the sequence listing in computer readable form was not properly labeled in accordance with 37 CFR 1.824(a)(6). Therefore, the application became abandoned for failure to timely file a proper reply to the Notification of Defective Response.

CONCLUSION

The application is being forwarded to the DO/EO/US for preparation and mailing of a Notification of Abandonment (Form PCT/DO/EO/909), which should indicate that the present application is abandoned for failure to file a proper reply to the Notification of Defective Response (Form PCT/DO/EO/916) mailed 28 January 2005.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

23 JUL 2008

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KLAUBER & JACKSON
411 HACKENSACK AVENUE
HACKENSACK, NJ 07601

In re Application of ZHANG et al :
U.S. Application No.: 10/497,828 :
PCT Application No.: PCT/US02/38612 :
Int. Filing Date: 04 December 2002 :
Priority Date Claimed: 06 December 2001 : DECISION
Attorney Docket No.: 2570-1-002PCT/US :
For: HIGHLY-SENSITIVE GENOMIC ASSAYS :
EMPLOYING CHIMERIC :
BACTERIOPHAGE STANDARDS :

This is in response to applicant's "Petition to Revive an Abandoned Application and Response to Notification of Missing Parts" filed 30 June 2008, which is being treated as petitions under 37 CFR 1.181 and 37 CFR 1.137(b).

BACKGROUND

On 04 December 2002, applicant filed international application PCT/US02/38612, which claimed priority of an earlier United States application filed 06 December 2001. The thirty-month period for paying the basic national fee in the United States expired on 06 June 2004.

On 04 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 23 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 and a sequence listing in computer readable form must be filed.

On 23 November 2004, applicant filed an executed declaration.

On 28 January 2005, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which indicated that a sequence listing in computer readable form must be filed.

On 22 February 2005, applicant purportedly filed a sequence listing in computer readable form.

On 11 July 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909).

On 31 July 2006, applicant filed a petition under 37 CFR 1.181.

On 19 September 2006, this Office mailed a decision granting the 31 July 2006 petition and vacating the Notification of Abandonment mailed 11 July 2006.

On 13 June 2008, the DO/EO/US, mailed a Notification of Abandonment (Form PCT/DO/EO/909).

On 30 June 2008, applicant filed the present petitions under 37 CFR 1.181 and 37 CFR 1.137(b).

DISCUSSION

I. Petition Under 37 CFR 1.181

The petition request that the Notification of Abandonment mailed 13 June 2008 be withdrawn. However, the petition does not sufficiently explain the grounds upon which such withdrawal should be based. The petition makes reference to a letter accompanying the Notification of Abandonment mailed 13 June 2008. Such letter states that the time period for reply runs from the mail date of the new notice. However, a Notification of Abandonment does not set a time period for reply. Accordingly, there is no time period that is reset by said letter, and the application went abandoned for failure to timely respond to the Notification of Defective Response mailed 28 January 2005.

II. Petition Under 37 CFR 1.137(b)

Applicant requests, alternatively, that the application be revived under 37 CFR 1.137(b).

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), the petition states, "The undersigned hereby attests that the abandonment of this Application 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 set forth in §I above, the petition under 37 CFR 1.181 is DISMISSED without prejudice.

For the reasons set forth in §II 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 04 December 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 23 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 Lin

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PCT Legal Office

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05 APR 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

#5

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Ryan, Kromholz & Manion, SC
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Milwaukee, WI 53226-0618

In re Application of	:	
PALMER *et al*	:	
Application No.: 10/497,851	:	
PCT No.: PCT/GB2002/005093	:	
Int. Filing Date: 11 November 2002	:	DECISION
Priority Date: 07 December 2001	:	
Atty. Docket No.: 9494.18616-PCT US	:	
For: SENSING SOCKET ASSEMBLY	:	

This is a decision on applicants' "PETITION...UNDER 37 C.F.R 1.47(a)" filed in the U.S. Patent and Trademark Office (USPTO) on 28 February 2005.

BACKGROUND

On 11 November 2002, applicants filed international application No. PCT/GB2002/005093 which claimed a priority date of 07 December 2001, and which designated the United States. The deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was set to expire 30 months from the priority date, i.e. 07 June 2004.

On 07 June 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.

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 that an oath or declaration in compliance with 37 CFR 1.497 was required.

On 28 February 2005, applicants filed the present petition requesting that the application be accepted without the signature of one of the joint inventors named in the international application, Norman Palmer, on the grounds that he refuses to execute the application. The petition was accompanied by, *inter alia*,: $130 for the petition fee, a declaration executed by two

of the three named inventors, a "STATEMENT OF PERTINENT FACTS", and a statement of the missing inventor's last known address.

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. Applicants have satisfied items (1), (3) and (4) above.

With regard to item (1), the requisite petition fee is currently $200, and as such the additional $70 has been charged to counsel's deposit account, No. 06-2360, based on the authorization in the originally filed transmittal letter.

Concerning item (2) above, section 409.03(d) of the Manual Of Patent Examining Procedure (MPEP), under the heading "REFUSAL TO JOIN" 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...
>
> 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 application file reveals that item (2) cannot be said to have been satisfied at this time in that the "STATEMENT OF PERTINENT FACTS" is insufficient. Specifically, the statement is not signed and as such it is unclear as to who is making the statement. Such a statement must be made by someone having firsthand knowledge of the facts. Therefore, the petition under 37 CFR 1.47(a) may not be properly granted at this time.

CONCLUSION

For the reasons above, the petition is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

A proper response must include either an acceptable declaration executed by Norman Palmer, or an acceptable showing that he has refused to execute the application as discussed above.

Extensions of time may be obtained under 37 CFR 1.136(a).

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

Richard R. Cole
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Office of PCT Legal Administration

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21 JUL 2005

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In re Application of	:	
PALMER *et al*	:	
Application No.: 10/497,851	:	
PCT No.: PCT/GB2002/005093	:	
Int. Filing Date: 11 November 2002	:	DECISION
Priority Date: 07 December 2001	:	
Atty. Docket No.: 9494.18616-PCT US	:	
For: SENSING SOCKET ASSEMBLY	:	

This is a decision on applicants' "RENEWED PETITION...UNDER 37 C.F.R. 1.47(a)" filed in the U.S. Patent and Trademark Office (USPTO) on 25 April 2005, which requests that the application be accepted without the signature of one of the joint inventors, Norman Palmer, on the grounds that he refuses to execute the application. The petition is **GRANTED** as discussed below.

On 05 April 2005, this Office mailed a decision on applicants' initial petition. The petition was dismissed on the grounds that applicants had not submitted an acceptable statement of facts.

A review of the application file reveals that the present renewed petition was accompanied by, *inter alia*, factual proof that the missing joint inventor refuses to execute the application in the form of a "STATEMENT OF PERTINENT FACTS" by Ray Charig. Therefore the requirements of 37 CFR 1.47(a) have now been satisfied.

A further review of the application file reveals that the requirements for entry into the national stage in the U.S. under 35 U.S.C. 371 have also now been satisfied.

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 the last known address of record as set forth in the present papers, and a notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

The application has an international filing date of **11 November 2002**, under 35 U.S.C. 363 and a date of **28 February 2005**, under 35 U.S.C. 371(c).

This application is being forwarded to the National Stage Processing Branch of the International Division for further processing in accordance with this decision.

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21 JUL 2005

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Norman Palmer
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Progress Works
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Great Britain

In re Application of
PALMER *et al*
Application No.: 10/497,851
PCT No.: PCT/GB2002/005093
Int. Filing Date: 11 November 2002
Priority Date: 07 December 2001
Atty. Docket No.: 9494.18616-PCT US
For: SENSING SOCKET ASSEMBLY

NOTIFICATION

Dear Mr. Palmer:

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

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.497.

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UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/497,852	06/07/2004	Tim Klapka	PIP-93-KLAP-US	7952

31518 7590 07/21/2009

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA, VA 22304

EXAMINER	
KOYAMA, KUMIKO C	
ART UNIT	**PAPER NUMBER**
2887	

NOTIFICATION DATE	DELIVERY MODE
07/21/2009	ELECTRONIC

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

The time period for reply, if any, is set in the attached communication.

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

general@neifeld.com
rneifeld@neifeld.com
rhahl@neifeld.com

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ALEXANDRIA VA 22304

In re Application of	:	
Tim Klapka et al.	:	
Application No.: 10/497,852	:	DECISION ON PETITION
Filed: June 07, 2004	:	UNDER 37 C.F.R. 1.181
Attorney Docket No.: PIP-93-KLAP-US	:	

This is a decision on the petition under 37 CFR 1.181, filed May 28, 2009, requesting review of the decision by the examiner in the Notification of Non-Compliant Appeal Brief dated April 16, 2009, and reinstatement of the Appeal filed December 6, 2008.

The petition is granted to the extent that the application record has been reviewed but is **DENIED** as to reinstating the Appeal.

Petitioner asserts that because the rejections of claims 1 through 12 and 14 through 42 in the non-final Office action of July 25, 2008 are appealable under 35 U.S.C. § 134, the Notice of Appeal and the Appeal Brief filed on December 6, 2008 were proper. As such, the Notification of Non-Compliant Appeal Brief (Notification) mailed April 16, 2009 is incorrect because the application was ripe for appeal. Petitioner requests that the Notification be withdrawn and an Examiner's Answer issued.

The following events occurred during the prosecution of the instant application and are pertinent to the issues raised in the petition:

On July 25, 2008, a non-final Office action in which all pending claims 1 through 12 and 14 through 42 were rejected.

On November 12, 2008, a reply under 37 CFR 1.111 was filed and including: (1) a petition under 37 CFR 1.136(a) (and extension fee) for a one-month extension of time; (2) an amendment to independent claims 1, 17, 21, 42 and new dependent claims 43 through 46; and (3) an affidavits under 37 CFR 1.131 by Timothy Klapka, and Dawn Arnold along with supporting evidence to disqualify US patent publication No. 200310024981 A1 to Narasimhan as prior art under 35 U.S.C. § 102(e) against the claims of the instant application.

On December 6, 2008, a Notice of Appeal, an Appeal Brief (and fees) under 37 CFR 41.31 *et seq.* were filed.

On April 16, 2009, a Notification of Non-Compliant Appeal Brief was mailed April 16, 2009. The examiner also issued a Non-Final Office action on April 21, 2009 rejecting all pending claims 1-12 and 14-46 over the prior art.

The instant petition was filed on May 28, 2009.

35 U.S.C. §§ 1.32 and 134 and 37 CFR 1.111, 112 and 41.31 are relevant to the issues raised in the petition.

35 U.S.C. § 132(a) provides that "[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined."

37 CFR 1.111 provides that an applicant must reply or request for reconsideration in writing in order to be entitled to reconsideration or further examination and 37 CFR 1.112 that an application will be reconsidered and again examined after a reply under 37 CFR 1.111.

35 U.S.C. § 134 provides that "[a]n applicant for patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal."

37 CFR 41.31(a)(1) provides that an applicant for patent, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences."

Under 35 U.S.C. § 132, petitioner was entitled to file an amendment in reply to the Office action July 25, 2008. 35 U.S.C. § 132(a) and 37 CFR 1.112 require the USPTO to reexamine a patent application that whenever a patent applicant persists in his claim for patent, with or without amendment, any of whose claim is rejected. In addition, as petitioner is an applicant for patent, any of whose claims were rejected in the Office action of July 25, 2008, petitioner is an "applicant for patent, any of whose claims has been twice rejected," within the meaning of 35 U.S.C. § 134 and 37 CFR 41.31(a)(1).

Thus, petitioner was entitled to reply to the Office action of July 25, 2008 by filing either 1) a reply under 35 U.S.C. § 132(a) and 37 CFR 1.111 or 2) an appeal under 35 U.S.C. § 134 and 37 CFR 41.31 *et seq*. Petitioner, however, filed a reply under 37

CFR 1.111 on November 12, 2008 and then an appeal under 37 CFR 41.31 *et seq.* on December 6, 2008.

After filing the reply of November 12, 2008, but before the new and amended claims are reexamined pursuant to 35 U.S.C. § 132(a) and 37 CFR 1.112, petitioner appealed by filing a Notice of Appeal and an Appeal Brief on December 6, 2008. In the appeal brief, petitioner indicated that claims 1-12 and 14-46 were rejected and being appealed. Appeal brief, section F., pages 8 and 9 and Appendix I, pages 26-32. The record indicates that, at the time the appeal was filed, amended independent claims 1, 17, 21 and 42 (and the claims that depend therefrom) and new dependent claims 43-46 submitted on November 12, 2008 had not been reexamined and an Office action had not been issued based on the merits of these claims.

A reply under 37 CFR 1.111 (which seeks further prosecution of an application before the examiner) and an appeal under 37 CFR 41.31 *et seq.* (which seeks appellate review of rejections by the examiner) are mutually exclusive replies to a non-final (but appealable) Office action. Petitioner could have filed either a reply or an appeal in response to the Office action of July 25, 2008 but not both. By amending the previously rejected independent claims 1, 17, 21 and 42 (and the claims that depend therefrom), adding new dependent claims 43 through 46, and submitting affidavits under 37 CFR 1.131 and supporting evidence to disqualify US patent publication No. 200310024981 A1 to Narasimhan as prior art under 35 USC 102(e) against the claims in the reply on November 12, 2008, petitioner has elected to further prosecute the application and the USPTO was required to reexamine the application pursuant to 35 USC 132(a). Once the reply was filed on November 12, 2008, the USPTO was required to reexamine the application. 35 U.S.C. § 132(a) and 37 CFR 1.112. Petitioner's right to appeal under 35 U.S.C. § 134(a) was no longer available since the amended claims had not been reexamined and a decision on their patentability required under 35 USC 132(a) had not been made.

Accordingly, at the time the appeal was filed, a "decision of the primary examiner" had not been made such that said decision may be appealed to the Board of Patent Appeals and Interferences pursuant to 35 U.S.C. § 134(a). As such, the appeal filed December 6, 2008 based on claims that had not been reexamined pursuant to 35 U.S.C. § 132(a) was improper as unavailable under 35 U.S.C. § 134(a).

Because an appeal under 35 U.S.C. § 134(a) was not available after the filing of the amendment of November 12, 2008, **the appeal filed December 6, 2008 was inappropriate, the petition seeking its reinstatement must be denied.**

The file record indicates that the examiner properly held the appeal improper and the application was not ripe for appeal. The examiner was correct in refusing to consider the appeal of the amended claims that had not been reviewed and rejected. The examiner also issued an Office action on April 21, 2009 in response to the reply filed November 12, 2008. The Office action sets a shortened but extendable statutory

period of three months for filing a reply thereto. The reply may be a request for reconsideration with or without an amendment or an appeal.

If petitioner elects to pursue an appeal, then a notice of appeal must be filed within the statutory period set in the Office action of April 21, 2009. Petitioner may request that the previously submitted notice of appeal fee and appeal brief fee be reapplied along with the fees to cover the fee differences, if any.

Petitioner may request review of this decision by petitioning to the Deputy Commissioner for Patent Examination Policies.

Any inquiry regarding this decision should be directed to Hien H. Phan, Quality Assurance Specialist, at (571) 272-1606.

Cassandra Spyrou, Acting Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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OFFICE OF PETITIONS

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
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In re Application of	:	
Tim Klapka et al.	:	
Application No. 10/497,852	:	ON PETITION
Filed: June 7, 2004	:	
Attorney Docket No.: PIP-93-KLAP-US	:	

This is a decision on the petition filed August 5, 2009 under 37 CFR 1.181, requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 2800 (Technology Center Director), dated July 21, 2009, which refused to reinstate the Appeal filed December 6, 2008.

BACKGROUND

On July 25, 2008, a non-final Office action was mailed.

On November 12, 2008, applicants filed an amendment under 37 CFR 1.111.

On December 6, 2008, a Notice of Appeal and Appeal Brief were filed.

On April 16, 2009, a Notice of Non-Compliant Brief was mailed.

On April 21, 2009 a non-final Office action was mailed. This action was in response to the amendment filed November 12, 2008.

On May 28, 2009 a petition under 37 CFR 1.181 was filed requesting entry of the Appeal filed December 6, 2008. This petition was dismissed in a decision mailed July 21, 2009.

On July 17, 2009, a Notice of Appeal and Appeal Brief in response to the non-final Office action mailed April 21, 2009 was filed.

The instant petition was filed August 5, 2009.

DECISION

The Appeal Brief filed December 6, 2008 was directed towards the claims as amended in the November 12, 2008 amendment rather than the claims rejected in the July 25, 2008 Office action. Likewise, the arguments presented in the brief were directed to the rejections set forth in the Office action of July 25, 2008 Office action. Therefore, the Appeal Brief of December 6, 2008, was directed to amended claims that had not been reexamined (independent claims 1, 17, 21, 42 and the claims that depended from them). The brief was also directed towards new claims 43-46 that had not been yet examined. Therefore, this brief was not directed to the claims under rejection and was defective.

The later filed Appeal Brief of July 17, 2009 is responsive to the non-final Office action mailed April 21, 2009. This Office action is responsive to the November 12, 2008 amendment and the claims therein. Therefore, the Appeal Brief filed July 17, 2009 is directed to the proper claims and the rejection applied against them.

In view of the filing of the Appeal Brief filed July 17, 2009, which supersedes the defective brief filed December 6, 2008, the petition to overturn the decision of the Technology Center Director and enter the Appeal filed December 6, 2008 is **DISMISSED** as being moot.

Telephone inquires concerning this decision should be directed to Carl Friedman at (571) 272-6842.

Charles Pearson
Director, Office of Petitions

20 MAY 2005
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#9

John P. Deluca
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Washington, DC 20005

In re Application of	:	
GRIFFIN, Neil, et al.	:	
U.S. Application No.: 10/497,854	:	DECISION ON PETITION
PCT No.: PCT/GB02/05636	:	UNDER 37 CFR 1.182
International Filing Date: 12 December 2002	:	
Priority Date: 13 December 2001	:	
Attorney's Docket No.: 66347-109	:	
For: DEVICE FOR CHEMICAL OR BIOCHEMICAL ANALYSIS	:	

This decision is issued in response to applicants' "Response To Notification Of Defective Response" filed on 08 December 2004, which has been treated as a petition under 37 CFR 1.182 to correct the name of the inventor identified in the international application as Sam Christopher William HYDE to Sam Charles William HYDE. Deposit Account No. 04-2223 will be charged the required petition fee.

BACKGROUND

On 12 December 2002, applicants filed international application PCT/GB02/05636 which claimed a priority date of 13 December 2001 and which designated the United States. On 19 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., 13 June 2004.

On 07 June 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 October 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 an oath or declaration in compliance with 37 CFR 1.497 was required.

On 17 November 2004, applicants filed a "Response To Missing Requirements" which was accompanied by an executed declaration. However, the fourth inventor named on the declaration, identified on the published international application as Sam Christopher William HYDE, was identified on the declaration as Sam Charles William HYDE.

On 02 December 2004, the DO/EO/US mailed a Notification Of A Defective Response (Form PCT/DO/EO/916) indicating that the declaration was unacceptable based on the inconsistency in the fourth inventor's name.

On 08 December 2004, applicants filed the "Response To Notification Of Defective Response" considered herein. In this Response, counsel asserts that the fourth inventor's correct name is San Charles William HYDE, as set forth in the declaration, and seeks acceptance of the previously filed declaration. This response has been treated as a petition under 37 CFR 1.182 to correct the discrepancy in the inventor's name.

DISCUSSION

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 second given name of the relevant inventor listed in the published international application is "Christopher" while the second given name for this inventor listed in the declaration (and stated to be correct) is "Charles." This is more than a mere typographical error or a phonetic misspelling of the applicant's name. Accordingly, the present Response has been treated as a petition under 37 CFR 1.182 to correct the name of the fourth inventor. For such a petition to be grantable, it must be accompanied by the requisite petition fee of $400 as well as statements from the inventor and any other persons having firsthand knowledge of the error which resulted in the name "Christopher" being listed on the international application. These statements must set forth the specific circumstances as to how and when the error was made and discovered, and must also state that the mistake was an inadvertent error without deceptive intent, or, in the case where applicant has changed his name, the statement must be signed with both names and set forth the procedure whereby the change of name was effected.

Deposit Account No. 04-2223 has been charged the $400 petition fee, satisfying this requirement. However, applicants have not submitted the statements required for a grantable petition. Accordingly, the petition cannot be granted at this time, and the declaration filed on 17 November 2004 remains defective.

In addition, the declaration filed 17 November 2004 includes John Matthew SOMERVILLE as an inventor. However, the published international application identifies Mr. SOMERVILLE as an applicant/inventor "for all designated states except US." The declaration filed 17 November 2004 therefore does not properly identify the inventors of record herein, as Mr. SOMERVILLE was not identified in the international application as an inventor for purposes

of the United States. If Mr. SOMERVILLE is a proper inventor for purposes of the United States, applicants must correct the inventorship herein pursuant to 37 CFR 1.497(d) so as to add Mr. SOMERVILLE. If Mr. SOMERVILLE is not a proper inventor for purposes of the United States, applicants must submit a clarifying statement and a revised declaration which does not include Mr. SOMERVILLE.

CONCLUSION

Applicants' petition under 37 CFR 1.182 is **DISMISSED** without prejudice. As a result, the declaration of inventors submitted by applicants on 17 November 2004 remains defective. In addition, the filed declaration is defective in that it includes an inventor (John Matthew SOMERVILLE) who is not identified on the international application as an inventor for purposes of the United States.

Applicants' must file a proper response within **TWO (2) MONTHS** from the mail date of this decision. Any such response must include: (1) the statements required for a grantable petition under 37 CFR 1.182 (with respect to the name of inventor HYDE) and, (2) either a grantable request under 37 CFR 1.497(d) to add John Matthew SOMERVILLE as an inventor for purposes of the United States or, in the alternative, a statement clarifying that Mr. SOMERVILLE is not a proper inventor for purposes of the United States, with a revised oath or declaration executed by the proper inventors which does not include Mr. SOMERVILLE.

Failure to file a proper response in a timely manner will result in **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

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26 JUL 2005
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In re Application of:	
GRIFFIN, Neil, et al.	
U.S. Application No.: 10/497,854	DECISION ON RENEWED
PCT No.: PCT/GB02/05636	PETITION UNDER 37 CFR 1.182
International Filing Date: 12 December 2002	AND REQUEST TO CORRECT
Priority Date: 13 December 2001	INVENTORSHIP UNDER
Attorney's Docket No.: 66347-109	37 CFR 1.497(d)
For: DEVICE FOR CHEMICAL OR BIOCHEMICAL ANALYSIS	

In a decision mailed by this Office on 20 May 2005, applicant's petition under 37 CFR 1.182 to correct the name of inventor Sam Christopher William HYDE to Sam Charles William HYDE was dismissed without prejudice. The decision also noted that John Matthew SOMERVILLE, who executed the declaration filed 17 November 2004, was not an applicant of record for the United States, and that a grantable request under 37 CFR 1.497(d) was required to add Mr. SOMERVILLE to the application.

On 25 July 2005, applicants filed the "Request For Reconsideration On Decision On Petition Under 37 CFR 1.182" treated herein as a renewed petition under 37 CFR 1.182 and a request to correct inventorship under 37 CFR 1.497(d). The submission included the authorization to charge Deposit Account No. 04-2223 for the required one month extension fee.

1. Renewed Petition Under 37 CFR 1.182

The renewed petition includes a statement from Sam Charles William HYDE confirming that: (1) Sam Charles William HYDE is this inventor's correct name; (2) that his name has not changed since the filing of the international application; (3) that the listing of his name as Sam Christopher William HYDE in the international application was the result of an error; and (4) that the error occurred without deceptive intent. This statement, in combination with the previously paid petition fee, satisfies the requirements for a grantable petition under 37 CFR 1.182.

Based on the petition under 37 CFR 1.182, the name of record for the inventor listed on the international application as Sam Christopher William HYDE is corrected to Sam Charles William HYDE, as listed on the executed declaration filed 17 November 2004.

2. Request Under 37 CFR 1.497(d)

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).

Applicants have satisfied these requirements by providing: (1) the required statement from John Matthew SOMERVILLE, the applicant being added to the application; (2) the authorization to charge Deposit Account No. 04-2223 the required processing fee; and (3) the assent of assignee "The Technology Partnership PLC." Accordingly, the request to add John Matthew SOMERVILLE as an inventor herein is appropriately granted.

CONCLUSION

Applicants' renewed petition under 37 CFR 1.182 is **GRANTED**. The name of record for the inventor listed on the international application as Sam Christopher William HYDE is hereby corrected to Sam Charles William HYDE.

Applicants' request under 37 CFR 1.497(d) is **GRANTED**. John Matthew SOMERVILLE is hereby added as an inventor herein.

Deposit Account No. 04-2223 will be charged the required extension and processing fees.

Based on the correction of inventor HYDE's name and the addition of inventor SOMERVILLE, the declaration of inventors submitted by applicants on 17 November 2004 is now 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 17 November 2004.

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20 DEC 2004

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In re Application of :
KRAGELUND, Lasse *et al* :
U.S. Application No.: 10/497,855 :
PCT No.: PCT/DK02/00810 :
Int. Filing Date: 02 December 2002 : **DECISION**
Priority Date: 07 December 2001 :
Attorney's Docket No.: 66722-052-7 :
For: METHOD FOR PRODUCING A HEARING AID :

This is a decision on the "Response to Notification of Missing Requirements" filed via facsimile on 13 December 2004 which is treated as a petition under 37 CFR 1.181. No fee is required.

BACKGROUND

On 17 June 2004, applicants purportedly filed an executed declaration and authorized the $130.00 surcharge fee to be charged to Deposit Account No. 04-2223.

On 03 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 an oath/declaration in compliance with 37 CFR 1.497(a) and (b) must be provided. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 13 December 2004, applicants submitted the instant petition which was accompanied by, *inter alia*, a copy of the declaration purportedly filed 17 June 2004 and a copy of the date-stamped postcard receipt for the 17 June 2004 filing.

DISCUSSION

A review of the above-captioned application reveals that the declaration purportedly filed 17 June 2004 was not located in the file. However, USPTO financial records indicate that a surcharge fee of $130.00 was charged from Deposit Account No. 04-2223 in the above-captioned application on 17 June 2004.

MPEP § 503 lists procedures to ensure receipt of any paper filed in the USPTO. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

In this case, applicants provided a copy of the date-stamped postcard receipt for the documents submitted 17 June 2004. The postcard receipt records that a "Submsn of Dec and surcharge fees" were received in the USPTO. The postcard receipt is stamped "OIPE JUN 17 2004" across its face. The U.S. application number, and attorney docket number were listed on the postcard receipt.

Accordingly, applicants have provided *prima facie* evidence that a declaration was originally received by the USPTO on 17 June 2004.

DECISION

Applicants' petition under 37 CFR 1.181 is **GRANTED**.

The Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 03 December 2004 is **VACATED**.

Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 02 December 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 17 June 2004.

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

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SUITE 1100
WASHINGTON, DC 20005-1209

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OFFICE OF PETITIONS

In re Patent No. 6,938,702 :
Issue Date: September 6, 2005 :
Application No. 10/497,860 : DECISION ON PETITION
Filed: October 28, 2004 :
Attorney Docket No. 47121-0099 :

This is a decision on the petition under 37 CFR 3.81(b), filed November 16, 2006, to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **GRANTED**.

The patent file is being referred to the Certificates of Correction Branch for issuance of the requested Certificate of Correction accompanying this petition.

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

Frances Hicks
Petitions Examiner
Office of Petitions

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In re Application of:	:	
MARRA, Johannes, et al.	:	COMMUNICATION REGARDING
U.S. Application No.: 10/497,864	:	SUBMISSION UNDER
PCT No.: PCT/IB02/04885	:	37 CFR 1.42
Int'l Filing Date: 20 November 2002	:	
Priority Date: 10 December 2001	:	
Attorney's Docket No.: NL 010908	:	
For: DISPLAY PANEL COMPRISING A LIGHT GUIDE	:	

This communication is issued in response to applicants' submission on 07 June 2004 of a declaration executed on behalf of the deceased inventor, which has been treated as a submission under 37 CFR 1.42.

BACKGROUND

On 20 November 2002, applicants filed international application PCT/IB02/04885 which claimed a priority date of 10 December 2001 and which designated the United States. On 19 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., 10 June 2004.

On 07 June 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 and the declaration materials considered herein. The declaration materials were executed by four of the inventors, and on behalf of the fifth inventor (deceased) by a legal representative.

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.

	DATE	INITIAL
COMPUTER	OCT	05 2004
SECRETARY	10-22-04	
ATTORNEY		

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 filed declaration does not comply with 37 CFR 1.497(b)(2), above, in that it does not provide the citizenship, mailing address, and residence information for the legal representative (such information is provided with respect to the deceased inventor). Moreover, the declaration, which consists of one copy of page "1 of 2" and four different copies of page "2 of 2" appears to be a compilation of a number of 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.")

Based on the above, the filed declaration is not in a form acceptable under 37 CFR 1.497. In addition, because the declaration does not include all the information required by 37 CFR 1.497(b)(2) with respect to the legal representative of the deceased inventor, the declaration is not acceptable under 37 CFR 1.42.

CONCLUSION

Based on the above, the declaration filed 07 June 2004 is **REJECTED** without prejudice under 37 CFR 1.497 and 37 CFR 1.42.

Applicant have **TWO (2) MONTHS** from the mail date this communication to submit a proper response under 37 CFR 1.42 and 1.497. Failure to file a proper and timely response will result in abandonment. Extensions of time are available under 37 CFR 1.136(a).

A proper response must include copies of the complete declarations executed by the surviving applicants and on behalf of the deceased inventor by the legal representative, such declaration containing all the information required under 37 CFR 1.497, including, as discussed above, the citizenship, residence, and mailing address of both the legal representative and the deceased inventor.

11 JAN 2005

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In re Application of: MARRA, Johannes, et al.	:	
U.S. Application No.: 10/497,864	:	
PCT No.: PCT/IB02/04885	:	COMMUNICATION
International Filing Date: 20 November 2002	:	REGARDING RENEWED
Priority Date: 10 December 2001	:	SUBMISSION UNDER
Attorney's Docket No.: NL 010908	:	37 CFR 1.42
For: DISPLAY PANEL COMPRISING A LIGHT GUIDE	:	

In a communication mailed on 30 September 2004, this Office rejected the declaration filed by applicant on 07 June 2004 for failure to satisfy 37 CFR 1.42 and 1.497. Specifically, the declaration did not provide all the information required by 37 CFR 1.497(b)(2) and was not in an acceptable form. The decision set forth an extendable two-month response period.

On 07 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 file a timely response to the 30 September 2004 decision.

On 20 December 2004, applicants filed a response to the decision which included a revised declaration and the authorization to charge Deposit Account No. 14-1270 for the required one-month extension fee. Based on this extension, the 20 December 2004 submission is considered a timely response to the decision mailed 30 September 2004. The Notification of Abandonment (Form PCT/DO/EO/909) mailed 07 December 2004, based as it was on applicants' purported failure to file a timely response to the 30 September 2004 decision, is therefore appropriately vacated.

The revised declaration filed 20 December 2004 includes the information required under 37 CFR 1.497 and is in an acceptable form. Accordingly, it is appropriate, at this time, to accord the application status under 37 CFR 1.42. Deposit Account No. 14-1270 will be charged the $130 surcharge for filing the declaration later than thirty months after the priority date.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **GRANTED**. The revised declaration filed on 20 December 2004 is accepted as complying with 37 CFR 1.497, with legal representative Henricus Josephus KUNNEN signing on behalf of deceased inventor Gerardus G.P. VAN GORKOM.

The Notification Of Abandonment (Form PCT/DO/EO/909) mailed 07 December 2004 is hereby **VACATED**.

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 20 December 2004.

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In re Application of MONGELLAZ et al.	
Application No.: 10/497,883	
PCT No.: PCT/FR02/04234	DECISION ON
Int. Filing: 09 December 2002	
Priority Date: 10 December 2001	PETITION UNDER
Attorney Docket No.:034299-000589	
For: METHOD FOR PRODUCING AN IMAGING DEVICE	37 CFR §§1.47(a) and 1.42

This is a decision on applicant's petition under 37 CFR §§1.47(a) and 1.42 filed in the United States Patent and Trademark Office (USPTO) on 14 April 2005. Applicant's request for a five month extension of time is granted.

BACKGROUND

On 04 June 2004, within thirty months of the priority date, applicant filed a transmittal letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 16 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), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 14 April 2005, applicant filed a declaration in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) and to comply with 37 CFR 1.497(a) & (b). Petitioner requests status under 37 CFR 1.42 and 1.47(a). The declaration is signed by the legal representatives of deceased inventor. The petition requests the acceptance of the application without the signature of Hélène Hervieu, a legal representatives for deceased inventor François Mongellaz, who allegedly refuses to sign the application.

DISCUSSION

Status under 37 CFR §1.42

37 CFR § 1.42 requires that in the case of the death of the inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent.

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR

1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

The declaration submitted on 14 April 2005 is defective as it directed to a different PCT application (PCT/FR02/04231) rather than PCT/FR02/04234. The declaration is also defective as it does not state the country of citizenship, residency and mailing address for both the deceased inventor and the legal representatives, as required for compliance with 37 CFR 1.497. Thus, the declaration is not in compliance with 37 CFR 1.497(b). A new declaration, which identifies and is executed by the legal representatives of François Mongellaz and by Daniel Lincot and in compliance with 37 CFR 1.497 (a) and (b), is required. The declaration must set forth the citizenship, residency and mailing address for inventor Lincot, deceased inventor Mongellaz and the legal representatives.

Applicant is advised that the declaration submitted appear to contain duplicate signature pages[1]. Each page is signed by different legal representatives and/or inventor and combined into one declaration. The declaration is not properly executed. It appears that either the attorney pieced together separate complete declarations into one composite declaration or the inventors were presented with an incomplete declaration. What is required is one declaration where all inventors have signed or separate complete declarations. Thus, the requirements of 37 CFR 1.497 (a) and (b) have not been met and the declaration is unacceptable as filed.

Request under 37 CFR 1.47(a)

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

Item (1) and (3) are satisfied with the payment of the $400 petition fee per petitioner's authorization to charge his deposit account and with the submission of the nonsigning inventor's last known address. With respect to Item (4), for the reasons set forth above, a new declaration is required.

---

[1]Section 201.03 of the MPEP states, in pertinent part,:

> An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

(Emphasis added.)

With respect to item (2), Petitioner provides the "Statement of Facts in Support of 37 CFR 1.47" of Gérard Poulin, in support of the petition under 37 CFR 1.47(a), who has first hand knowledge of legal representative Hélène Hervieu's refusal to sign the application.

Mr. Poulin states that "On October 22, 2004, a copy of the Oath and Declaration and Power of Attorney for the above-referenced patent application has been [sic] mailed to the attorney for the legal representative of deceased inventor Mr. François Mongellaz: Mrs. Michèle TARDY SEETEN."

Mr. Poulin further states that after several unsuccessful written and telephone attempts, he spoke to Mrs. Seeten, who acknowledged receipt of the declaration and power of attorney. On 29 March 2005, Mrs. Hervieu sent a letter to Mr. Poulin stating: "I acknowledge receipt of your documents. You have not answered the questions put to you by me and my lawyer. I do not understand English. I would ask you to please leave me alone from now on and not to bring back the pain of losing my brother."

The evidence presented[2] is insufficient to conclude that Ms. Hervieu refuses to sign the application because neither Ms. Hervieu or her attorney Mrs. Seeten were provided with a complete copy of the application papers (oath and declaration, specification, including claims and drawings). Thus it cannot be concluded that her conduct constitutes a refusal to sign the application. The evidence submitted does not support a finding that the nonsigning inventor refused to sign the application for the reasons set forth above.

Applicant has not yet satisfied Items (2) and (4) 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 extensions of time remaining under the Notification of Missing Requirements may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No 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

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[2] Item (2) is not yet satisfied. 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).

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In re Application of MONGELLAZ et al.
Application No.: 10/497,883
PCT No.: PCT/FR02/04234
Int. Filing: 09 December 2002
Priority Date: 10 December 2001
Attorney Docket No.:034299-000589
For: METHOD FOR PRODUCING AN IMAGING DEVICE

DECISION ON

PETITION UNDER

37 CFR §§1.47(a) and 1.42

This is a decision on applicant's renewed petition under 37 CFR §§1.47(a) and 1.42 filed in the United States Patent and Trademark Office (USPTO) on 26 August 2005.

BACKGROUND

On 04 June 2004, within thirty months of the priority date, applicant filed a transmittal letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 16 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), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 14 April 2005, applicant filed a declaration in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) and to comply with 37 CFR 1.497(a) & (b). Petitioner requested status under 37 CFR 1.42 and 1.47(a). The declaration was signed by the joint inventor and some of the legal representatives of deceased inventor François Mongellaz. The petition requested the acceptance of the application without the signature of Hélène Hervieu, who allegedly refuses to sign the application as legal representative for deceased inventor François Mongellaz.

On 23 June 2005, a decision dismissing applicant's petition was mailed indicating that a new declaration, identifying the correct PCT international application and signed by the inventor and the legal representatives of the deceased inventor in compliance with 37 CFR 1.497(a) and (b) must be provided. Furthermore, with regard to status under 37 CFR 1.47(a), the evidence presented was insufficient to conclude that Ms. Hervieu refused to sign the application because neither Ms. Hervieu or her attorney Mrs. Seeten were provided with a complete copy of the application papers.

On 26 August 2005, applicant filed a renewed petition along with a statement of facts and a newly executed declaration.

DISCUSSION

Status under 37 CFR §1.42

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

The declaration submitted on 26 August 2005 is defective because on page 3 of the declaration, it misidentifies the legal representatives of François Mongellaz as Inventor three, Inventor four and Inventor five. In compliance with 37 CFR 1.497(b), the legal representatives of the deceased inventor must be identified as such, rather than identified as inventor. Thus, the declaration is not in compliance with 37 CFR 1.497(b).

A new declaration, which identifies and is executed by the legal representatives of deceased inventor François Mongellaz and by joint inventor Daniel Lincot and which is in compliance with 37 CFR 1.497 (a) and (b), is required. The declaration must set forth the citizenship, residency and mailing address for inventor Lincot, deceased inventor Mongellaz and his legal representatives.

Request under 37 CFR 1.47(a)

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

Item (1) and (3) were previously satisfied. With respect to Item (4), for the reasons set forth above, a new declaration is required.

With respect to item (2), Petitioner provides the "Statement of Facts in Support of 37 CFR 1.47" of Gérard Poulin, in support of the petition, who has first hand knowledge of one of the legal representatives' refusal to sign the application.

Mr. Poulin states that "On July 29, 2005, a copy of the Oath and Declaration, Power of Attorney and application papers including claims and figures for the above-referenced patent application was mailed to, Mrs. Michele Tardy Seeten, attorney for legal representative of deceased inventor Francois Mongellaz, Mrs. Hélène Hervieu, Renee Mongellaz and Martin Mongellaz." A copy of the return receipt concerning the letter sent to Mrs. Seeten was attached to his statement and demonstrates that Mrs. Hervieu's attorney received the mailing. Although Mr. Poulin attempted to contact Mrs. Seeten by telephone on 18 August 2005, his attempt proved unsuccessful.

The evidence presented is now sufficient to conclude that Hélène Hervieu, one of the legal representatives of Francois Mongellaz, refuses to sign the application because proof that the application papers were delivered to Ms. Seeten as the attorney for Hélène Hervieu has been provided.. Thus it can be concluded that her conduct constitutes a refusal to sign the application

at this time.

However, applicant has not yet satisfied Item (4) 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 extensions of time remaining under the Notification of Missing Requirements may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No 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.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (571) 272-3286
Fax: (571)272-0459

CMK/LS

Enclosure: FORM/SB/01
FORM/SB/2LR

#15

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

In re Application of MONGELLAZ et al.	
Application No.: 10/497,883	
PCT No.: PCT/FR02/04234	DECISION ON
Int. Filing: 09 December 2002	
Priority Date: 10 December 2001	PETITION UNDER
Attorney Docket No.:034299-000589	
For: METHOD FOR PRODUCING AN IMAGING DEVICE	37 CFR §§1.47(a) and 1.42

This is a decision on applicant's renewed petition under 37 CFR §§1.47(a) and 1.42 filed in the United States Patent and Trademark Office (USPTO) on 17 March 2006.

BACKGROUND

A recitation of the background of this application is found in the Decision on Petition under 37 CFR 1.47(a) and 1.42 mailed on 29 September 2005 and is hereby incorporated by reference.

On 29 September 2005, a decision was mailed to applicant indicating the declaration submitted misidentified the legal representatives of François Mongellaz as inventors. A new declaration, which identifies and is executed by the legal representatives of deceased inventor François Mongellaz and by joint inventor Daniel Lincot and which is in compliance with 37 CFR 1.497 (a) and (b), was required.

On 17 January 2006, a Renewed Petition under 37 CFR 1.47(a) was filed along with a newly executed declaration.

DISCUSSION

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

Item (1), (2) and (3) were previously satisfied. With respect to Item (4), a new declaration, which identifies and is executed by joint inventor Daniel Lincot, on behalf of the non-signing legal representatives of deceased inventor François Mongellaz was submitted on 17 January 2006. The declaration sets forth the citizenship, residency and mailing address for inventor Lincot, deceased inventor Mongellaz and his legal representatives and thus, is in

compliance with 37 CFR 1.497 (a) and (b).

Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) and 1.42 at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) and Status under 37 CFR 1.42 is **GRANTED**.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) and 1.42 application using the declaration filed 17 January 2006. The application has an international filing date of 09 December 2002 under 35 U.S.C. 363, and a date of 17 January 2006 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

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

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

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (571) 272-3286
Fax: (571)272-0459

04 APR 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Helene Hervieu
10 rue de la Farigoulette
34610 Castries, FRANCE

In re Application of MONGELLAZ et al.	
Application No.: 10/497,883	
PCT No.: PCT/FR02/04234	DECISION ON
Int. Filing: 09 December 2002	
Priority Date: 10 December 2001	PETITION UNDER
Attorney Docket No.:034299-000589	
For: METHOD FOR PRODUCING AN IMAGING DEVICE	37 CFR §§1.47(a) and 1.42

Dear Ms. Hervieu :

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

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

04 APR 2006

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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Renee Mongellaz
12 rue Paul Girod
73200 Albertville, FRANCE

In re Application of MONGELLAZ et al.	
Application No.: 10/497,883	
PCT No.: PCT/FR02/04234	DECISION ON
Int. Filing: 09 December 2002	
Priority Date: 10 December 2001	PETITION UNDER
Attorney Docket No.:034299-000589	
For: METHOD FOR PRODUCING AN IMAGING DEVICE	37 CFR §§1.47(a) and 1.42

Dear Ms. Mongellaz:

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

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

Cynthia M. Kratz
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SAN JOSE, CA 95164-0640

04 APR 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Martine Mongellaz
368 av. du 8 mai 1945
Residence les Thermes
83600 FREJUS, FRANCE

In re Application of MONGELLAZ et al.	:	
Application No.: 10/497,883	:	
PCT No.: PCT/FR02/04234	:	DECISION ON
Int. Filing: 09 December 2002	:	
Priority Date: 10 December 2001	:	PETITION UNDER
Attorney Docket No.:034299-000589	:	
For: METHOD FOR PRODUCING AN IMAGING DEVICE	:	37 CFR §§1.47(a) and 1.42

Dear Ms. Mongellaz:

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.

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SAN JOSE, CA 95164-0640

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Attorney's Docket No. AL.US.15 *PATENT*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Joanna L. Duncan, Christopher R. McLarnon, and Francis R. Alix] Examiner: unknown
Serial No.: 10/497888]
Filed: 06/04/2004] Group Art Unit: unknown
For: NOx, Hg, AND SO_2 REMOVAL USING AMMONIA]

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TC 1700

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Alexandria, VA 22313-1450

PETITION TO MAKE SPECIAL UNDER THE ENERGY PROGRAM AND BECAUSE OF ENVIRONMENTAL QUALITY (37 CFR 1.102(c))

Applicants hereby petition to make this application special as being for an application that a) materially contributes to the more efficient utilization and conservation of energy, and b) materially enhances the quality of the environment of mankind, by contributing to the maintenance of the basic life-sustaining elements (air, water, and/or soil).

Accompanying this petition is a declaration by the applicants' attorney explaining how the invention materially contributes to the factors listed above.

PETITION GRANTED

No fee is required with this petition, in accordance with 37 CFR 1.102(c).

Richard Crispino
Special Program Examiner
TC 1700 2/7/05

Date: 9/16/2004

(Signature of Attorney)
Phillip E. Decker
Attorney for Applicants
Decker Law Office
1 New Hampshire Ave., Suite 125
Portsmouth, NH 03801

Reg. No.: 39,163
Tel. No.: (603) 766-1910

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No. 703-872-9310) on September 16, 2004.

Typed or printed name of person signing this certificate: Phillip E. Decker.

Signature:

PAGE 3/5 * RCVD AT 9/16/2004 9:35:27 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-2/0 * DNIS:8729306 * CSID:USPTO * DURATION (mm-ss):00-09

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DUANE MORRIS
100 COLLEGE ROAD WEST
SUITE 100
PRINCETON NJ 08540

MAILED

NOV 05 2009

OFFICE OF PETITIONS

In re Application of :
Lacoste et al. :
Application Number: 10/497894 : DECISION ON PETITION
Filing Date: 11/18/2004 :
Attorney Docket Number: :
Lacoste-1 :

This is a decision on the petition filed on September 10, 2009, under 37 CFR 1.137(b), to revive the above-identified application.

The petition is **DISMISSED**.

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

The application became abandoned on December 23, 2006, for failure to timely reply to the non-final Office action mailed on September 22, 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 April 10, 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 (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 two

and one-half (2 ½) years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on December 22, 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). Likewise, petitioners, registered patent practitioners Arthur L. Plevy, et al., at Duane Morris, LLP, 100 College Road West, Suite 100, Princeton, NJ 08540 (hereinafter "Duane Morris, LLP") were specified as the correspondence address at the time the application was filed and through the time of abandonment, should explain why this application became abandoned while it was under their control and what efforts petitioners made to further reply of itself and with whom this matter was discussed outside of Duane Morris LLP. Copies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from responsible person(s), including the registered patent practitioners at Duane Morris, LLP, and whoever else was involved with this application at the time of abandonment. Statements are required from any and all persons then at Duane Morris, LLP, and the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). *See* MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, over two and one-half (2 ½) years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any and all persons then at Duane Morris, LLP, and the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

> (A) the date that the applicant first became aware of the abandonment of the application; and

(B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also* New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S.District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

Any renewed petition may be addressed as follows:

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

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

The change of correspondence address filed on September 10, 2009, cannot be accepted because the practitioner who signed the paper, Paul A. Schwarz, is not an attorney of record. See 37 CFR 1.33(a)(2). A copy of this decision is being mailed to the address associated with the customer number listed on change of correspondence address. All future correspondence, however, will be mailed solely to the address of record.

To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

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

/D Wood/

Douglas I. Wood

Senior Petitions Attorney

Office of Petitions

Cc: DUANE MORRIS LLP - PRINCETON
PO BOX 5203
PRINCETON, NJ 08543-5203

UNITED STATES PATENT AND TRADEMARK OFFICE

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DUANE MORRIS LLP - Princeton
PO BOX 5203
PRINCETON NJ 08543-5203

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MAY 17 2010

OFFICE OF PETITIONS

In re Application of	:	
Lacoste et al.	:	
Application Number: 10/497894	:	ON PETITION
Filing Date: 11/18/2004	:	
Attorney Docket Number:	:	
Lacoste-1	:	

This is a decision on the renewed petition under 37 CFR 1.137(b) filed on February 5, 2010.

The petition is **GRANTED**.

This application became abandoned on December 23, 2006, for failure to file a timely reply to the non-final Office action mailed on September 22, 2006, which set a three (3) month shortened statutory period for reply. Notice of Abandonment was mailed on April 10, 2007. On September 10, 2009, the initial petition under 37 CFR 1.137(b) was filed. On November 5, 2009, the petition was dismissed. On February 5, 2010, the subject renewed petition was filed, accompanied by a one (1) month extension of time.

Receipt of the amendment filed on September 10, 2009 is acknowledged.

Receipt of the power of attorney and change of correspondence address is acknowledged. The correspondence address has been updated.

The application is forwarded to Technology Center Art Unit 2879 for further processing.

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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KELLEY DRYE & WARREN LLP
400 ALTLANTIC STREET , 13TH FLOOR
STAMFORD CT 06901

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OCT 0 2 2007

OFFICE OF PETITIONS

In re Application of :

STEINBERG, Amiram :
Application No. 10/497,897 : DECISION ON PETITION
Filed: November 15, 2004 : TO WITHDRAW
Attorney Docket No. **ACIM-104(US)** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 28, 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 Marvin Wachs 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 or the assignee 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: **AMIRAM STEINBERG**
P.O. BOX 176
MOSHAV AVIHAIL, ISRAEL 42910

cc: **ANDREW LOWES, ESQ.**
HAYNES AND BOONE LLP
2505 N. PLANO ROAD
SUITE 4000
RICHARDSON, TX 75082-4101

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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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FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

Mail Date: 04/20/2010

Applicant	: Tatsuhiko Kodama	: DECISION ON REQUEST FOR
Patent Number	: 7666998	: RECALCULATION of PATENT
Issue Date	: 02/23/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/497,900	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/30/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **670** 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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AUG 15 2007

OFFICE OF PETITIONS

Dreiss, Fuhlendorf, Steimle & Becker
Postfach 10 37 62
D-70032 Stuttgart De Germany

In re Application of
Ebe Hesterman
Application No. 10/497,918
Filed: June 7, 2004
Attorney Docket No. 5041 009US

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 15, 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 Paul Vincent attorney associated with customer number 29894. Paul Vincent has been withdrawn as attorney of record.

The correspondence address of record remains unchanged.

A non-final rejection was mailed on March 26, 2007. Failure to timely respond will result in the abandonment of this application.

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

Frances Hicks
Petitions Examiner
Office of Petitions

cc: Ebe Hesterman
Curiestraat 7
1171 BG Badhoevedorp
Netherlands NLX

UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/497,918	06/07/2004	Ebe Hesterman	5041 0009US

CONFIRMATION NO. 1001

OC000000025198923

29894
DREISS, FUHLENDORF, STEIMLE & BECKER
POSTFACH 10 37 62
D-70032 STUTTGART,
GERMANY

Date Mailed: 08/06/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/15/2007.

- 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.

Kimberly Gravunit

Office of Initial Patent Examination (571) 272-4000, or 1-800-PTO-9199
FORMER ATTORNEY/AGENT COPY

15 MAR 2005

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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 :
SLOAN, Andrew John *et al* :
U.S. Application No.: 10/497,925 :
PCT No.: PCT/AU02/01648 :
Int. Filing Date: 12 December 2002 :
Priority Date: 12 December 2001 :
Attorney Docket No.: 3170.1005-000 :
For: DIAGNOSTIC TESTING PROCESS :

DECISION ON PETITION UNDER 37 CFR 1.497(d)

This is a decision on applicants' "Transmittal of Declaration and Request for Correction of Inventorship under 37 C.F.R. § 1.497(d)" requesting to add William Samuel Hunter as an inventor and remove Andrew Arthur Gooley as an inventor in the above-captioned national stage application filed 03 February 2005.

BACKGROUND

On 03 November 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to comply with extensions of time available pursuant to 37 CFR 1.136(a).

On 03 February 2005, applicants filed a response which was accompanied by, *inter alia*, a declaration executed by four joint inventors; a $130.00 surcharge fee; a $130.00 petition fee; a "Statement Under 37 C.F.R. § 1.497(d)(1) by Andrew Arthur Gooley"; a "Statement Under 37 C.F.R. § 1.497(d)(1) by William Samuel Hunter"; a "Written Consent of Assignee in Correction of Inventorship under 37 C.F.R. § 1.497(d)(3)" signed by Keith Leslie Williams, CEO of Proteome Systems Intellectual Property, Pty Ltd; a "Statement Under 37 C.F.R. § 3.73(b)"; a one-month extension and $120.00 extension fee; and a copy of an assignment.

DISCUSSION

Applicants request to add William Samuel Hunter and remove Andrew Arthur Gooley as inventors in the above-captioned national stage application of PCT/AU02/01648.

A review of the international publication for PCT/AU02/01648 reveals that there is no record of a change in the inventorship pursuant to PCT Rule 92*bis* in the

international application. 37 CFR 1.497(d) applies when the inventorship in a national stage application filed under 35 U.S.C. 371 differs from that set forth in the international application (see 37 CFR 1.48(f)(1)). 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, or a change to the inventive entity has been effected under PCT Rule 92 bis subsequent to the execution of any declaration which was filed under PCT Rule 4.17(iv), 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 assignee (see § 3.73(b) of this chapter).

Applicants have provided the requisite statements from William Samuel Hunter and Andrew Arthur Gooley. Item (1) is satisfied.

The $130.00 fee has paid. Item (2) is complete.

With regards to item (3), applicants have provided the written consent of the assignee, Proteome Systems Intellectual Property, Pty Ltd. The consent was signed by the CEO, Keith Leslie Williams. The position of CEO is a position recognized as having the authority to sign for a corporation. *See* § 324 MPEP.

In addition, applicants submitted an executed assignment and assignment fee for the above-captioned application granting Proteome Systems Intellectual Property, Pty Ltd all rights, title, and interest for this invention in the United States. A statement Under 37 CFR 3.73(b) signed by Mr. Williams for the assignee was also provided. This is sufficient to satisfy item (3).

Therefore, all the requirements of 37 CFR 1.497(d) are complete.

CONCLUSION

Applicants' request under 37 CFR 1.497(d) to correct the inventorship by adding William Samuel Hunter as an inventor and removing Andrew Arthur Gooley as an

inventor is **GRANTED**.

The declaration filed 03 February 2005 is in compliance with 37 CFR 1.497(a) and (b).

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 12 December 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 03 February 2005.

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

SERIAL NUMBER : 10/497,929

TO: Ram Processing

FROM: PCT LEGAL OFFICE
Crystal Plaza 2 7th Floor

PLEASE PROCESS THE FOLLOWING CORRECTIONS :

FROM			TO		
APPLICATION #	CODE	FEE	APPLICATION#	CODE	FEE
10/497,929	1613	$920	10/497,929	1011	$300
				1111	$500
				1311	$120 (*)

(*) charge balance to Deposit Account 07-1445

OTHER :

☐ CHARGE VOUCHER IS ATTACHED TO CHARGE / REFUND ADDITIONAL FEES

☐ OTHER : _____

THE ORIGINAL METHOD OF PAYMENT WAS :

☐ BY A CHECK

☒ BY A CHARGE TO DEPOSIT ACCOUNT NO. 07-1445

25 MAY 2006

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GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK CA 94025

In re Application of	:	
NEHRIG	:	
Application No.: 10/497,929	:	DECISION
Attorney Docket No.: SCHO0172	:	
For: APPARATUS AND METHOD FOR READING OUT A DIFFERENTIAL CAPACITY WITH A FIRST AND SECOND PARTIAL CAPACITY	:	

This decision is in response to applicant'S "PETITION TO CONVERT" filed on 26 October 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 21 February 2002, applicants filed international application PCT/EP02/01857 which designated the US. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 28 August 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 23 August 2004 (21 August 2004 being a Saturday).

On 04 June 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; authorization to charge any additional fees or credit any overpayment to Deposit Account No. 07-1445; and a purported translation into English of the international application. The purported translation indicates that the "application is a continuation of copending International Application No. PCT/EP02/01857 filed February 21, 2002."

On 26 October 2004, applicants filed the instant "PETITION TO CONVERT", which requests that the application be converted from an application filed under 35 U.S.C. 371 to an application filed under 35 U.S.C. 111(a).

On 08 December 2004, a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) was mailed indicating that the application was accepted under 35 U.S.C. § 371.

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 filed on 04 June 2004 identified the application as "a filing under 35 U.S.C. 371." However, the purported translation reads "[t]his application is a continuation of copending International Application No. PCT/EP02/01857 filed February 21, 2002." Applicant's reference in the disclosure to benefit of the international application under 35 U.S.C. § 120 in the first sentence of the specification is inconsistent with the transmittal letter filed 04 June 2004 and contradicts the request in the transmittal letter to file under 35 U.S.C. 371. See, e.g., 35 U.S.C. 365.[1] The transmittal letter used by applicant is to be used only with submissions under 35 U.S.C. 371. Since applicant 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 04 June 2004 were improperly accepted as a submission under 35 U.S.C. 371. Therefore, 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 08 December 2004 is hereby VACATED. The application is deemed to have been filed under 35 U.S.C. 111(a).

Applicant is reminded that in order to perfect the claim for priority under 35 U.S.C. 119, applicant must submit certified copies of the priority documents. The certified copies of priority documents submitted to the International Bureau cannot be relied upon to perfect the claim for priority. See MPEP § 1896.

---

[1]Attention is also directed to MPEP 1893.03(c), which states in part:

> Note: 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). Stated differently, since the international application is not an earlier application (it has the same filing date as the national stage), a priority claim in the national stage to the international application is inappropriate. 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.

CONCLUSION

For the reasons set forth above, the petition to convert is **DISMISSED** as **MOOT**.

This application will be forwarded to the Office of Initial Patent Examining for processing as an application under 35 U.S.C. 111(a) having a filing date of **04 June 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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AMSTER, ROTHSTEIN & EBENSTEIN
90 PARK AVENUE
NEW YORK, NY 10016

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SEP 2 1 2004

OFFICE OF PETITIONS

In re Application of :
Van Beuningen, Marinus Gerardus Johannes :
Application No. 10/497,934 : ON PETITION
Filed: June 4, 2004 :
Attorney Docket No. 65959/39 :

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

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

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

Inquiries related to *this communication* should be directed to the undersigned at (703) 306-0482. Any telephone inquiries after September 28, 2004 should be directed to (571) 272-3206.

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

07 JUN 2005

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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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Jay S. Paranjpe
Clark Hill PLC
500 Woodward Avenue, Suite 3500
Detroit, MI 48226-3435

In re Application of LEHTOVAARA et al	:	
U.S. Application No.: 10/497,958	:	
PCT Application No.: PCT/CA02/01854	:	
Int. Filing Date: 03 December 2002	:	DECISION
Priority Date Claimed: 05 December 2001	:	
Attorney Docket No.: 19357-097169	:	
For: TIMING BELT TENSIONER WITH STOPS CONTROLLED BY FRICTIONAL BRAKE	:	

This is in response to applicant's "Petition Under 35 C.F.R. § 1.47(a)" filed 08 June 2004 and "Petition Under 37 C.F.R. § 1.181(a) to Withdraw Holding of Abandonment" filed 01 December 2004, which is being treated under 37 CFR 1.10(d).

BACKGROUND

On 03 December 2002, applicant filed international application PCT/CA02/01854, which claimed priority of an earlier United States application filed 05 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 12 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 07 June 2004 (05 June 2004 was a Saturday).

On 07 June 2004, applicant purportedly filed national stage papers in the United States Designated/Elected Office (DO/EO/US) via the Express Mail Post Office to Addressee service of the USPS ("Express Mail"). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and the present petition under 37 CFR 1.47(a). The DO/EO/US accorded the national stage papers a submission date of 08 June 2004.

On 29 October 2004, 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 pay the basic national fee.

On 01 December 2004, applicant filed the present petition under 37 CFR 1.10(d).

DISCUSSION

I. Petition Under 37 CFR 1.10(d)

37 CFR 1.10(d) states,

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and
>
> (3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

With regard to item (1) above, the petition was filed promptly after applicant became aware of the accorded submission date of the national stage papers.

With regard to item (2) above, a review of the "Certificate of Mailing by Express Mail" and the copy of the Express Mail mailing label reveals that the Express Mail mailing label number was placed on the correspondence prior to the original mailing by Express Mail.

With regard to item (3), applicant has made an adequate showing that the correspondence was deposited in Express Mail prior to the last scheduled pickup on 07 June 2004. In particular, applicant has provided a copy of a pickup statement signed by USPS personnel which indicates that the correspondence was deposited on 07 June 2004.

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, 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 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 Mats Lipowski cannot be located. Petitioner unsuccessfully tried to reach Lipowski by registered mail and by searching Internet directories (see affidavit of Jay Paranjpe, ¶¶5-8). However, the petition does not provide evidence of any other attempts to find Lipowski, such as trying to contact Lipowski by telephone, by electronic mail, or through Lipowski's former employer, former co-workers, or family/friends. Thus, it would not be reasonable to conclude at the present time that Lipowski cannot be located.

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 1.10(d) is GRANTED.

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 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). 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

23 SEP 2005

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Jay S. Paranjpe
Clark Hill PLC
500 Woodward Avenue, Suite 3500
Detroit, MI 48226-3435

In re Application of LEHTOVAARA et al :
U.S. Application No.: 10/497,958 :
PCT Application No.: PCT/CA02/01854 :
Int. Filing Date: 03 December 2002 : DECISION
Priority Date Claimed: 05 December 2001 :
Attorney Docket No.: 19357-097169 :
For: TIMING BELT TENSIONER WITH STOPS :
CONTROLLED BY FRICTIONAL BRAKE :

This is in response to applicant's "Revised Petition Under 35 C.F.R. § 1.47(a)" filed 31 August 2005.

BACKGROUND

On 03 December 2002, applicant filed international application PCT/CA02/01854, which claimed priority of an earlier United States application filed 05 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 12 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 07 June 2004 (05 June 2004 was a Saturday).

On 07 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) and a petition under 37 CFR 1.47(a).

On 07 June 2005, this Office mailed a decision dismissing the 07 June 2004 petition.

On 31 August 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 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 Mats Lipowski cannot be located. Petitioner unsuccessfully tried to reach Lipowski by registered mail and by searching Internet directories (see affidavit of Jay Paranjpe, ¶¶5-8). Furthermore, petitioner made numerous other unsuccessful attempts to find Lipowski, such as trying to contact Lipowski through his former employer, former co-workers, or family/friends (see Paranjpe's affidavit ¶¶9-15). Thus, it can be concluded with reasonable certainty that Lipowski cannot be located.

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 03 December 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 07 June 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

21 SEP 2004

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ALEXANDRIA, VA 22313-1450
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Davis & Bujold PLLC
Fourth Floor
500 North Commercial Street
Manchester, NH 03101-1151

In re Application of :
RYERSON, James George et al. :
Application No.: 10/497,960 : DECISION
PCT No.: PCT/CA02/01679 :
Int. Filing Date: 05 November 2002 : ON PETITION UNDER
Priority Date: 05 November 2001 :
Docket No.: THOLAM P234US : 37 CFR 1.137(b)
For: METHOD OF REMOVAL OF :
HYDROCARBONS FROM SOILS USING :
SOLIDS LOADED POLYMER FOAMS :

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 07 June 2004 is **GRANTED**.

Applicant states that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, as required by 37 CFR 1.137(b)(3). The appropriate national fee and the petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

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 07 June 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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JAN 22 2008

OFFICE OF PETITIONS

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD, SUITE 400
MCLEAN, CA 22102

In re Application of :
HOFMANN, et al. :
Application No. 10/497,964 : DECISION ON PETITION
Filed: June 9, 2004 : TO WITHDRAW
Attorney Docket No. **118744-112** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 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 8, 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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 7/15/2008

TO SPE OF : ART UNIT **1600 (1664)**

SUBJECT : Request for Certificate of Correction on Patent No.: **7,354,577**

Attn: Maher Haddad

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

Please complete this form and forward within **7** days to: **Scanning customer Support**

Send copy also via PTO mail to:
Certificates of Correction Branch – 2900 South Tower 9A39A
Palm location **7580** - Tel. No. 308-8309

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

***Ok to enter item (60) as requested in the C of C?**

Ernest C. White, LIE - 308-9390x122
Certificates of Correction Branch

Thank You For Your Assistance

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

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

Comments:

_____

_____

_____

_____

_____

Eileen B. O'Hara 1644

SPE Art

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 7/15/2008

TO SPE OF : ART UNIT 1600 (1664)

SUBJECT : Request for Certificate of Correction on Patent No.: 7,354,577

Attn: Maher Haddad

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

Please complete this form and forward within 7 days to: **Scanning customer Support**

Send copy also via PTO mail to:
Certificates of Correction Branch – 2900 South Tower 9A39A
Palm location **7580** - Tel. No. 308-8309

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

***Ok to enter item (60) as requested in the C of C?**

Ernest C. White, LIE - 308-9390x122
Certificates of Correction Branch

Thank You For Your Assistance

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

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

Comments:

Eileen B. O'Hara 1644

SPE Art

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 5/18/10 Paper No.: —

TO SPE OF : ART UNIT 1644

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/497991 Patent No.: 7354577 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 – 9D10-A
Palm Location 7580

Virginia Tolbert
Certificates of Correction Branch
571-272-0460

Thank You For Your Assistance

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

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

Comments: _____

J Tucker 1649

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OFFICE OF PETITIONS

OGILVY RENAULT LLP
1981 MCGILL COLLEGE AVENUE
SUITE 1600
MONTREAL, CANADA H3A2Y-3

In re Application of :
Isabelle Boucher, et al. :
Application No. 10/498,001 : DECISION ON PETITION
Filed: June 14, 2004 : TO WITHDRAW
Attorney Docket No. 14957-2US : 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 19, 2008.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Ogilvy Renault, LLP has been revoked by the assignee of the patent application on September 18, 2008. 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: ROBIC
1001, SQUARE – VICTORIA
BLOC E – 8EME ETAGE
MONTREAL, QUEBEC H2Z 2B7

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JAN 25 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

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

In re Application of :
Michiaki TAKANO :
Application No. 10/498,009 :
Filed: June 15, 2004 :
For: **INFORMATION NOTIFICATION METHOD, MOBILE COMMUNICATIONS SYSTEM, BASE STATION, AND MOBILE STATION** :

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition filed October 6, 2004 under Manual of Patent Examination Procedure §708.02, VIII requesting accelerated examination.

The petition under Manual of Patent Examination Procedure §708.02, VIII, must:
(1) be filed prior to receiving any examination by the examiner,
(2) be accompanied by the required fee- $130,
(3) the claims should be directed to a single invention (if it is determined that the claims pertain to more than one invention, then applicant will have to make an election without traverse or forfeit accelerated examination status),
(4) state that a pre-examination search was made, and fully discuss the search method employed, such as classes and subclasses searched, publications, Chemical abstracts, patents, etc. A search made by a foreign patent office satisfies this requirement,
(5) be accompanied by a copy of each of the references most closely related to the subject matter encompassed by the claims if said references are not already of record,
(6) fully discuss the references, pointing out with the particularity required by 37 C.F.R. §1.111 (b) and (c), how the claimed subject matter is patentable over the references.

The petitioner meets all the above-listed requirements. Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant. The application file is being forwarded to the examiner for appropriate action in due course.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

08 APR 2005

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William G. Kratz
Armstrong, Kratz, Quintos, Hanson & Brooks, LLP
1725 K Street, N.W.
Suite 1000
Washington, D.C. 20006

In re Application of	:	
KITAMURA et al.	:	
Application No. 10/498,012	:	
PCT No.: PCT/JP02/01963	:	DECISION
Int. Filing Date: 04 March 2002	:	
Priority Date: 19 December 2001	:	
Attorney Docket No.: 040251	:	
For: FOLDING COMMUNICATION TERMINAL APPARATUS	:	

This decision is in response to "Petition under 37 CFR 1.181" filed via facsimile on 23 March 2005. No petition fee is due.

BACKGROUND

On 15 June 2004, applicants timely filed a request to enter into the national stage under 35 U.S.C. 371 along with the appropriate basic national filing fee, a copy of the international application, a translation of the international application; and a preliminary amendment.

On 27 December 2004, the United States Designated/Elected Office mailed a Notification of Missing Requirements (PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge under 37 CFR 1.492(e).

On 25 February 2005, applicants submitted an executed declaration. The declaration was incorrectly date stamped 28 February 2005.

On 16 March 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) which set forth a 35 U.S.C. 371 completion date of 28 February 2005.

On 23 March 2005, applicants filed "Petition under 37 CFR 1.181" which included, inter alia: a copy of the declaration and power of attorney and a postcard receipt dated 25 February 2005.

DISCUSSION

Applicant states in their present petition that a declaration and power of attorney was received at the United States Patent and Trademark Office on 25 February 2005. Section 503 of the Manual of Section 503 of the Manual of Patent Examining Procedure under the heading "RETURN POSTCARD" states, in part:

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

The accompanying copy of the post card receipt identifies the application by applicant, application number, and docket number. The receipt itemizes, inter alia: Response to Notification with Declaration and Notification. The receipt is stamped "Rec'd OIPE 25 February 2005" across its face and is sufficient to indicate that the combined declaration and power of attorney was in fact received in the Office on 25 February 2005.

A review of the application papers reveals that applicant has completed all the requirements of 35 U.S.C. 371 for entry into the national stage on 25 February 2005.

CONCLUSION

Applicants' petition under 37 CFR 1.181 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 16 March 2005 is hereby **VACATED**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision, that is, for mailing of a NOTIFICATION OF ACCEPTANCE OF APPLICATION (Form PCT/DO/EO/903) and Official Filing Receipt which identifies a date of 25 February 2005 under 35 U.S.C. 371(c).

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

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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK NY 10004

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OFFICE OF PETITIONS

In re Application of :
Guido Mueller :
Application No. 10/498,031 : ON PETITION
Filed: January 11, 2005 :
Attorney Docket No. 10191/3750 :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed April 20, 2009.

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

The holding of abandonment is **WITHDRAWN**.

The application was held abandoned due to failure to timely file a reply to the non-final Office action mailed July 2, 2008. This Office action set a statutory period for reply of three (3) months. No reply having been received, the application became abandoned on October 3, 2008. The Office mailed a Notice of Abandonment on January 23, 2009.

To establish nonreceipt of an Office action, a petitioner must: 1) include a statement that the Office action was not received; 2) attest to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and 3) include a copy of the docket record where the nonreceived Office action would have been entered had it been received and

docketed.[1] A proper docket report consists of a "docket record where the nonreceived Office action would have been entered had it been received and docketed."[2] "For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket record showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted..."[3]

With the instant petition, petitioner has submitted, *inter alia*, a copy of a master docket report, showing all of the firm's replies docketed for the due date of October 2, 2008. An entry for the instant application is absent, supporting the conclusion that the July 2, 2008 Office action was not received.

In view thereof, the petition is granted.

The application is being forwarded to Group Art Unit 2176 for re-mailing of the July 2, 2008 Office action, setting a new period for reply.

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

Cliff Congo
Petitions Attorney
Office of Petitions

---

[1] See MPEP 711.03(c)(II).

[2] MPEP 711.03(c)(II).

[3] Id.

14 NOV 2005

#8

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Chiron Corporation
Intellectual Property - R440
P.O. Box 8097
Emeryville CA 94662-8097

In re Application of HARDY et al.	
Application No.: 10/498,033	DECISION ON PETITION
PCT No.: PCT/US02/39136	
Int. Filing: 09 December 2002	UNDER 37 CFR 1.47(a)
Priority Date: 07 December 2001	
Attorney Docket No.: PP-20077.003	
For: ENDOGENOUS RETROVIRUS UP-REGULATED IN PROSTATE CANCER	

This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 23 March 2005, to accept the application without the signature of joint inventor, Lewis T. Williams. Applicant's request for a five month extension of time is granted.

BACKGROUND

On 07 June 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 23 August 2004, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, 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 23 March 2005, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor Lewis T. Williams. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor, Lewis T. Williams alleging that Mr. Lewis refuses to sign the application.

DISCUSSION

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

The petition included the requisite petition fee, satisfying Item (1). Item (3) is satisfied because the last known address of non-signing inventor, Lewis T. Williams, was provided. With regard to item (4), the declaration executed by the available joint inventors on their behalf and on

behalf of the non-signing inventor was submitted and satisfies the requirements of 37 CFR 1.47(a).

With respect to Item (2) above, Petitioner provided the declaration of Nancy L. Swanson, patent assistant for Chiron Corporation, in support of the petition under 37 CFR 1.47(a). Ms. Swanson states that she sent a copy of the patent application along with declaration and assignment forms to Mr. Lewis's business address. However, a review of this letter that accompanied the documents indicates that "[a] copy of the first page, and claims of the application" along with the declaration and assignment were enclosed.. The letter further states: "a copy of [PCT/US02/39136] was forwarded to you on June 26, 2003". Thus, there is no evidence that a complete copy of the application papers, including *specification, claims and drawings* and declaration, were provided to Mr. Lewis. The statement indicates that only the first page of the application, claims, declaration and assignment were sent to the inventor for his signature. What is required is that Mr. Lewis be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for this application.

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

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

a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

(Emphasis added.)

In sum, Petitioner has satisfied Items (1), (3) and (4) above. However, Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a *copy of the application papers for U.S. application 10/498,033 (specification, including claims, drawings, and declaration)* to the nonsigning inventor for his signature and (2) Mr. Lewis's refusal to sign, either in writing or by telephone, these documents.

For the reasons set forth above, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application at this time. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

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

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

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

Cynthia M. Kratz

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

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

28 DEC 2005

#10

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Chiron Corporation
Intellectual Property - R440
P.O. Box 8097
Emeryville CA 94662-8097

In re Application of HARDY et al.	
Application No.: 10/498,033	DECISION ON
PCT No.: PCT/US02/39136	
Int. Filing: 09 December 2002	RENEWED PETITION
Priority Date: 07 December 2001	
Attorney Docket No.: PP-20077.003	UNDER 37 CFR 1.47(a)
For: ENDOGENOUS RETROVIRUS UP-REGULATED IN PROSTATE CANCER	

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 22 December 2005, to accept the application without the signature of joint inventor, Lewis T. Williams.

On 07 June 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 23 August 2004, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, 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 23 March 2005, applicant filed a petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor Lewis T. Williams. Applicant requested the acceptance of the application under 37 CFR 1.47(a) without the signature of inventor, Lewis T. Williams alleging that Mr. Lewis refuses to sign the application.

On 14 November 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 10/498,033 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and Mr. Lewis's refusal to sign, either in writing or by telephone, these documents.

On 22 December 2005, Petitioner filed a renewed petition along with a declaration executed by Mr. Lewis. The renewed petition under 37 CFR 1.47(a) is considered moot as a declaration executed by the previously unavailable inventor has now been submitted and is acceptable under 37 CFR 1.497(a) and (b).

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

The declaration executed by the joint inventor and submitted on 22 December 2005 is in compliance with 37 CFR 1.497(a) and (b) and is acceptable.

This application is being forwarded to United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is **22 December 2005.**

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

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

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

MAILED

JUN 17 2010

OFFICE OF PETITIONS

In re Application of :

Lawrence Hofmann :

Application No. 10/498,035 : DECISION ON PETITION

Filed: June 7, 2004 :

Attorney Docket No. 56381 (71699)

This is a decision on the petition under 37 CFR 1.137(b), filed March 12, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 11, 2009, which set a shortened statutory period for reply of three (3) months. No extension of time pursuant to 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on December 12, 2009.

Examiner Kathleen Sonnett has determined that the amendment filed March 12, 2010, does not place the application in condition for allowance. Accordingly, the Notice of Appeal, filed March 12, 2010, will be treated as the response required to accompany the petition under 37 CFR 1.137(b).

The Notice of Appeal, filed March 12, 2010, has been entered and made of record. Accordingly, the two-month period for filing an appeal brief (accompanied by the fee required by 37 CFR 1.17(c)) runs from the date of this decision.

The request for an extension of time within the third month requested March 12, 2010, is noted, but cannot be granted as the request was made outside the maximum statutory period for reply to the non-final Office action. The amount of $555.00 will be refunded to deposit account 04-1105 in due course.

The application is being forwarded to Technology Center 3700, GAU 3731 for further processing.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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STEVENS DAVIS LLP
1615 L STREET NW
SUITE 850
WASHINGTON, DC 20036

COPY MAILED

AUG 13 2008

OFFICE OF PETITIONS

In re Application of :
Kenichi Miyoshi :
Application No. 10/498,052 : ON PETITION
Filed: June 9, 2004 :
Attorney Docket No. L9289.04141 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 31, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 26, 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 December 27, 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 2616 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

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07 SEP 2007

BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

In re Application of MAY	:	
U.S. Application No.: 10/498,058	:	
PCT Application No.: PCT/EP02/13952	:	
Int. Filing Date: 09 December 2002	:	DECISION
Priority Date Claimed: 10 December 2001	:	
Attorney Docket No.: 119508-00256	:	
For: MAGNETIC TORQUE/FORCE TRANSDUCER	:	

This is in response to applicant's "Fourth Renewed Petition Under 37 C.F.R. § 1.47(b)" and "Petition Under 37 C.F.R. § 1.103(a) for Suspension of Action" filed 11 July 2007.

BACKGROUND

On 09 December 2002, applicant filed international application PCT/EP02/13952, which claimed priority of an earlier United Kingdom application filed 10 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 19 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 10 June 2004.

On 09 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 06 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 25 January 2005, applicant filed a petition under 37 CFR 1.47(b).

On 12 April 2005, this Office mailed a decision dismissing the 25 January 2005 petition.

On 12 October 2005, applicant filed a renewed petition under 37 CFR 1.47(b).

On 22 November 2005, this Office mailed a decision dismissing the 12 October 2005 renewed petition.

On 22 May 2006, applicant filed a second renewed petition under 37 CFR 1.47(b).

On 13 June 2006, this Office mailed a decision dismissing the 22 May 2006 renewed petition.

On 13 December 2006, applicant filed a third renewed petition under 37 CFR 1.47(b).

On 12 January 2007, this Office mailed a decision dismissing the 13 December 2006 renewed petition.

On 11 July 2007, applicant filed the present fourth renewed petition under 37 CFR 1.47(b).

DISCUSSION

I. Petition Under 37 CFR 1.47(b)

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Applicant has previously satisfied items (1), (2), (3), and (6) above.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has been provided. However, ownership of the application has not been sufficiently established. The petition states that Abas, Inc. ("Abas") has ownership of the application. Therefore, applicant must demonstrate a chain of title of the invention from Lutz May to Abas. Petitioner has previously established that Fast Technology AG ("Fast") assigned the present invention to Abas in June 2004. However, as discussed below, applicant has not established that Fast obtained rights to the invention from inventor May.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

The renewed petition includes an English language translation of a German court decision which involves the present invention. Such court decision indicates that Fast did not obtain rights to the invention from the inventor May. Because petitioner has not shown that

ownership of the invention passed from May to Abas via Fast, it cannot be concluded at the present time that Abas has sufficient proprietary interest in the application.

II. Petition Under 37 CFR 1.103(a)

MPEP 709 specifies that "a suspension of action applies to an impending Office action by the examiner. . . . It is only the action by the examiner which can be suspended under 37 CFR 1.103." See also MPEP 1003 and 1004, which indicate that a suspension of action is applicable only when an application is before the examiner.

A review of Office records reveals that the present application has not yet been docketed for examination. Therefore, an Office action by an examiner is not impending, and the present request for a suspension of action is premature.

CONCLUSION

For the reasons set forth in §I above, the fourth renewed petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

For the reasons set forth in §II above, the petition under 37 CFR 1.103(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. 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

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18 APR 2008

BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

In re Application of MAY	:	
U.S. Application No.: 10/498,058	:	
PCT Application No.: PCT/EP02/13952	:	
Int. Filing Date: 09 December 2002	:	DECISION
Priority Date Claimed: 10 December 2001	:	
Attorney Docket No.: 119508-00256	:	
For: MAGNETIC TORQUE/FORCE TRANSDUCER	:	

This is in response to applicant's "Fifth Renewed Petition Under 37 C.F.R. § 1.47(b)" filed 07 March 2008.

BACKGROUND

On 09 December 2002, applicant filed international application PCT/EP02/13952, which claimed priority of an earlier United Kingdom application filed 10 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 19 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 10 June 2004.

On 09 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 06 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 25 January 2005, applicant filed a petition under 37 CFR 1.47(b).

On 12 April 2005, this Office mailed a decision dismissing the 25 January 2005 petition.

On 12 October 2005, applicant filed a renewed petition under 37 CFR 1.47(b).

On 22 November 2005, this Office mailed a decision dismissing the 12 October 2005 renewed petition.

On 22 May 2006, applicant filed a second renewed petition under 37 CFR 1.47(b).

On 13 June 2006, this Office mailed a decision dismissing the 22 May 2006 renewed petition.

On 13 December 2006, applicant filed a third renewed petition under 37 CFR 1.47(b).

On 12 January 2007, this Office mailed a decision dismissing the 13 December 2006 renewed petition.

On 11 July 2007, applicant filed a fourth renewed petition under 37 CFR 1.47(b).

On 07 September 2007, this Office mailed a decision dismissing the 11 July 2007 renewed petition.

On 07 March 2008, applicant filed the present fifth 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(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Applicant has previously satisfied items (1), (2), (3), and (6) above.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has been provided. The Office previously held that this item was not satisfied because ownership of the application has not been sufficiently established. Although ownership of the application remains at issue, petitioner's argument that this item is nevertheless satisfied is deemed persuasive.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

The petition states that Abas, Inc. ("Abas") has ownership of the application. Therefore, applicant must demonstrate a chain of title of the invention from Lutz May to Abas. Petitioner has previously established that Fast Technology AG ("Fast") assigned the present invention to

Abas in June 2004. However, petitioner has not established that Fast obtained rights to the invention from inventor May. The renewed petition includes a supplemental affidavit of Stephen Harders and a copy of an employment agreement purportedly signed by May. However, the newly presented evidence is insufficient to overcome the German court decision which held that Fast did not obtain rights to the invention from the inventor May. Because petitioner has not shown that ownership of the invention passed from May to Abas via Fast, it cannot be concluded at the present time that Abas has sufficient proprietary interest in the application.

CONCLUSION

For the reasons above, the fifth renewed petition under 37 CFR 1.47(b) 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. 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

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12 APR 2005

#1

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WASHINGTON, DC 20037

In re Application of MAY	:	
U.S. Application No.: 10/498,058	:	
PCT Application No.: PCT/EP02/13952	:	
Int. Filing Date: 09 December 2002	:	DECISION
Priority Date Claimed: 10 December 2001	:	
Attorney Docket No.: 119508-00256	:	
For: MAGNETIC TORQUE/FORCE TRANSDUCER	:	

This is in response to applicant's "Petition Under Rule 1.47(b)" filed 25 January 2005.

BACKGROUND

On 09 December 2002, applicant filed international application PCT/EP02/13952, which claimed priority of an earlier United Kingdom application filed 10 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 19 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 10 June 2004.

On 09 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 06 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 25 January 2005, applicant filed the present 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(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached

after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that sole inventor Lutz May refuses to sign the application papers. However, petitioner has not adequately established that a bona fide attempt was made to present a copy of the application papers to May for signature. Although the affidavit of Stephen Harders states that "on information and belief" a copy of the application papers was sent to May, the affidavit does not establish that Mr. Harders was the person who personally sent the application papers to May or otherwise had firsthand knowledge of the mailing. Furthermore, the petition does not sufficiently establish that May refuses to sign. Even though Mr. Harders' affidavit states that May has orally refused to sign, the affidavit does not establish that Mr. Harders was the person to whom the alleged oral refusal was made and does not indicate the time and date of the purported refusal. Thus, it would not be reasonable to conclude at the present time that May refuses to join in the application.

It is also noted that pages 1-3 of Mr. Harders' affidavit appear to be original sheets whereas page 4 of the affidavit appears to have been transmitted by facsimile. This raises doubt as to whether the signature page was associated with the other pages at the time of execution. Thus, a newly executed affidavit is required.

With regard to item (3) above, the petition states the last known address of the nonsigning inventor.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has been provided. However, this declaration is unacceptable. Specifically, the declaration fails to state the citizenship of the inventor. Furthermore, page 1 of the declaration appears to be an original copy whereas page 2 of the declaration appears to have been transmitted by facsimile, which raises doubt as to whether the signature page was associated with page 1 at the time of execution. Petitioner must submit a complete declaration which is presented to and signed by the 37 CFR 1.47(b) applicant.

In addition, MPEP 324 states that when an assignee files an application under 37 CFR 1.47(b), ownership of the application must be established. Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO. In the present case, petitioner has not provided any documentary evidence that Abas, Inc. has ownership of the present application.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, petitioner has not presented any documentary evidence that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

With regard to item (6) above, the petition contains a sufficient statement regarding preservation of rights in the present application.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

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

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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22 NOV 2005

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In re Application of MAY	:	
U.S. Application No.: 10/498,058	:	
PCT Application No.: PCT/EP02/13952	:	
Int. Filing Date: 09 December 2002	:	DECISION
Priority Date Claimed: 10 December 2001	:	
Attorney Docket No.: 119508-00256	:	
For: MAGNETIC TORQUE/FORCE TRANSDUCER	:	

This is in response to applicant's "Renewed Petition Under 37 C.F.R. § 1.47(b)" filed 12 October 2005.

BACKGROUND

On 09 December 2002, applicant filed international application PCT/EP02/13952, which claimed priority of an earlier United Kingdom application filed 10 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 19 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 10 June 2004.

On 09 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 06 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 25 January 2005, applicant filed a petition under 37 CFR 1.47(b).

On 12 April 2005, this Office mailed a decision dismissing the 25 January 2005 petition.

On 12 October 2005, applicant filed the present renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Applicant has previously satisfied items (1), (3), and (6) 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 sole inventor Lutz May refuses to sign the application papers. Petitioner has adequately established that a bona fide attempt was made to present a copy of the application papers to May for signature (see affidavit of Alexander Straus, ¶13). However, the petition does not sufficiently establish that May refuses to sign. Specifically, an English translation of the letter dated 30 August 2005 (Annex VII) has not been provided. Furthermore, inventor May purportedly indicated in the 30 August 2005 letter that more time was needed to review the situation before responding (see Straus affidavit, ¶14), which is not an express refusal to sign.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has been provided. However, ownership of the application has not been sufficiently established. The petition states that Abas, Inc. ("Abas") has ownership of the application. Therefore, applicant must demonstrate a chain of title of the invention from Lutz May to Abas. Applicant has shown that in August 2003, Fast

Technology AG ("Fast") sold the present invention to Magna-lastic Device, Inc. ("Magna-lastic"). However, applicant has also presented evidence that Fast assigned the invention to Abas in June 2004. Applicant has not presented documentary evidence which explains how Fast could have assigned the invention in June 2004 when Fast had already sold the rights to the invention in August 2003. Additionally, applicant has not established that Fast obtained rights to the invention from the inventor May, either through an assignment, a written agreement to assign the invention, or by operation of law as discussed below.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, petitioner has not presented any documentary evidence (e.g. an assignment agreement, employment agreement, or the like) that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application. In the absence of a written agreement, an appropriate legal memorandum to the effect that a court of competent jurisdiction would by the weight of authority in that jurisdiction award title of the invention to Abas must be submitted. The facts in support of any legal conclusion made by the memorandum must be made of record in an affidavit of the person having firsthand knowledge of such facts. See MPEP 409.03(f).

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

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

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 JUN 2006

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WASHINGTON, DC 20037

In re Application of MAY	:	
U.S. Application No.: 10/498,058	:	
PCT Application No.: PCT/EP02/13952	:	
Int. Filing Date: 09 December 2002	:	DECISION
Priority Date Claimed: 10 December 2001	:	
Attorney Docket No.: 119508-00256	:	
For: MAGNETIC TORQUE/FORCE TRANSDUCER	:	

This is in response to applicant's "Second Renewed Petition Under 37 C.F.R. § 1.47(b)" filed 22 May 2006.

BACKGROUND

On 09 December 2002, applicant filed international application PCT/EP02/13952, which claimed priority of an earlier United Kingdom application filed 10 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 19 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 10 June 2004.

On 09 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 06 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 25 January 2005, applicant filed a petition under 37 CFR 1.47(b).

On 12 April 2005, this Office mailed a decision dismissing the 25 January 2005 petition.

On 12 October 2005, applicant filed a renewed petition under 37 CFR 1.47(b).

On 22 November 2005, this Office mailed a decision dismissing the 12 October 2005 renewed petition.

On 22 May 2006, applicant filed the present second 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(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Applicant has previously satisfied items (1), (3), and (6) 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 sole inventor Lutz May refuses to sign the application papers. Petitioner has adequately established that a bona fide attempt was made to present a copy of the application papers to May for signature (see affidavit of Alexander Straus, ¶13). Furthermore, the petition sufficiently establishes that May refuses to sign. Specifically, May's failure to supply an executed declaration in response to the letter dated 24 August 2005 constitutes a constructive refusal to cooperate (see translation of 24 August 2005 letter and May's response

dated 30 August 2005). Thus, it can be concluded with reasonable certainty that May refuses to sign the application papers.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has been provided. However, ownership of the application has not been sufficiently established. The petition states that Abas, Inc. ("Abas") has ownership of the application. Therefore, applicant must demonstrate a chain of title of the invention from Lutz May to Abas. Petitioner has shown that on 22 August 2003, Fast Technology AG ("Fast") sold the present invention to Magna-lastic Device, Inc. ("Magna-lastic") (see affidavit of Hans von Gleichenstein, ¶10, and Exhibit C). The respective affidavits of Stephen Harders, Alexander Strauss, and Klaus Gennen state that Magna-lastic assigned the rights to the present invention to Abas (see Harders' affidavit, ¶4; Strauss' affidavit, ¶5; and Gennen's affidavit, ¶25). However, petitioner has not supplied any documentary evidence which confirms that rights in the present invention were transferred from Magna-lastic to Abas. Although the copy of the assignment agreement submitted with the 12 October 2005 petition states that Fast assigned the present invention to Abas in June 2004, Fast had already sold the entire right, title, and interest in the present invention to Magna-lastic on 22 August 2003. Petitioner has not adequately explained and documented how Fast could have assigned an invention that it had previously sold to another entity. Additionally, applicant has not established that Fast obtained rights to the invention from May as discussed below.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, the legal memorandum of Klaus Gennen states that Magna-lastic or Abas would be awarded title of the present invention by a court of competent jurisdiction but does not unequivocally state that the petitioner Abas would be awarded title (see Gennen's memorandum, ¶36). Additionally, the memorandum's conclusion is based on the alleged fact that May made the present invention during the time and scope of his employment by Fast (see Gennen's memorandum, ¶¶11-14). However, it is apparent by the language in the memorandum "I was told that. . ." that Mr. Gennen does not have personal knowledge of how and by whom the present invention was made. MPEP 409.03(f) requires that the facts in support of any legal conclusion made by the memorandum be made of record in an affidavit of the person having firsthand knowledge of such facts.

CONCLUSION

For the reasons above, the second renewed petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

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

response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)."

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

3 0 DEC 2008

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BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

In re Application of MAY	:	
U.S. Application No.: 10/498,058	:	
PCT Application No.: PCT/EP02/13952	:	
Int. Filing Date: 09 December 2002	:	DECISION
Priority Date Claimed: 10 December 2001	:	
Attorney Docket No.: 119508-00256	:	
For: MAGNETIC TORQUE/FORCE TRANSDUCER	:	

This is in response to applicant's "Sixth Renewed Petition Under 37 C.F.R. § 1.47(b)" filed 29 October 2008.

BACKGROUND

On 09 December 2002, applicant filed international application PCT/EP02/13952, which claimed priority of an earlier United Kingdom application filed 10 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 19 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 10 June 2004.

On 09 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 06 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 25 January 2005, applicant filed a petition under 37 CFR 1.47(b).

On 12 April 2005, this Office mailed a decision dismissing the 25 January 2005 petition.

On 12 October 2005, applicant filed a renewed petition under 37 CFR 1.47(b).

On 22 November 2005, this Office mailed a decision dismissing the 12 October 2005 renewed petition.

On 22 May 2006, applicant filed a second renewed petition under 37 CFR 1.47(b).

On 13 June 2006, this Office mailed a decision dismissing the 22 May 2006 renewed petition.

On 13 December 2006, applicant filed a third renewed petition under 37 CFR 1.47(b).

On 12 January 2007, this Office mailed a decision dismissing the 13 December 2006 renewed petition.

On 11 July 2007, applicant filed a fourth renewed petition under 37 CFR 1.47(b).

On 07 September 2007, this Office mailed a decision dismissing the 11 July 2007 renewed petition.

On 07 March 2008, applicant filed a fifth renewed petition under 37 CFR 1.47(b).

On 18 April 2008, this Office mailed a decision dismissing the 07 March 2008 renewed petition.

On 29 October 2008, applicant filed the present sixth 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(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Applicant has previously satisfied items (1), (2), (3), (4), and (6) above.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

The petition states that Abas, Inc. ("Abas") has ownership of the application. Therefore, applicant must demonstrate a chain of title of the invention from Lutz May to Abas. Petitioner has previously established that Fast Technology AG ("Fast") assigned the present invention to

Abas in June 2004. The present renewed petition adequately demonstrates that that Fast obtained rights to the invention from inventor May. In particular, the new affidavit of Klaus Gennen discusses the German court decision which held that Fast did not obtain rights to the invention from the inventor May. Mr. Gennen states that such court decision has been appealed and provides reasons as to why Mr. Gennen believes the court decision will be overturned on appeal. Thus, Abas is deemed to have sufficient proprietary interest in the application.

CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 09 December 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 12 October 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 Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

30 DEC 2008

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Lutz Axel May
3 The Grange
Newbury, Berkshire
RG14 6RJ
UNITED KINGDOM

In re Application of MAY
U.S. Application No.: 10/498,058
PCT Application No.: PCT/EP02/13952
Int. Filing Date: 09 December 2002
Priority Date Claimed: 10 December 2001
For: MAGNETIC TORQUE/FORCE TRANSDUCER

Dear Lutz Axel May:

You are named as the 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 the inventor.

As the named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost 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

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

BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037
Attorney Docket No.: 119508-00256

#13

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12 JAN 2007

BLANK ROME LLP
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

In re Application of MAY :
U.S. Application No.: 10/498,058 :
PCT Application No.: PCT/EP02/13952 :
Int. Filing Date: 09 December 2002 : DECISION
Priority Date Claimed: 10 December 2001 :
Attorney Docket No.: 119508-00256 :
For: MAGNETIC TORQUE/FORCE :
TRANSDUCER :

This is in response to applicant's "Third Renewed Petition Under 37 C.F.R. § 1.47(b)" filed 13 December 2006.

BACKGROUND

On 09 December 2002, applicant filed international application PCT/EP02/13952, which claimed priority of an earlier United Kingdom application filed 10 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 19 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 10 June 2004.

On 09 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 06 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 25 January 2005, applicant filed a petition under 37 CFR 1.47(b).

On 12 April 2005, this Office mailed a decision dismissing the 25 January 2005 petition.

On 12 October 2005, applicant filed a renewed petition under 37 CFR 1.47(b).

On 22 November 2005, this Office mailed a decision dismissing the 12 October 2005 renewed petition.

On 22 May 2006, applicant filed a second renewed petition under 37 CFR 1.47(b).

On 13 June 2006, this Office mailed a decision dismissing the 22 May 2006 renewed petition.

On 13 December 2006, applicant filed the present third 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(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Applicant has previously satisfied items (1), (2), (3), and (6) above.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has been provided. However, ownership of the application has not been sufficiently established. The petition states that Abas, Inc. ("Abas") has ownership of the application. Therefore, applicant must demonstrate a chain of title of the invention from Lutz May to Abas. Petitioner has shown that on 22 August 2003, Fast Technology AG ("Fast") sold the present invention to Magna-lastic Devices, Inc. ("Magna-lastic") (see affidavit of Hans von Gleichenstein, ¶10, and Exhibit C). The respective affidavits of Stephen Harders, Alexander Strauss, and Klaus Gennen state that Magna-lastic assigned the rights to the present invention to Abas (see Harders' affidavit, ¶4; Strauss' affidavit, ¶5; and Gennen's affidavit, ¶25). Petitioner has supplied a copy of an assignment agreement which indicates that Fast assigned the present invention to Abas in June 2004. Petitioner's explanation as to how the assignment from Fast to Abas was executed after rights to the invention were sold to Magna-lastic is accepted. However, as discussed below, applicant has not established that Fast obtained rights to the invention from inventor May.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, the legal memorandum of Klaus Gennen states that Magna-lastic or Abas would be awarded title of the present invention by a court of competent jurisdiction. However, the memorandum's conclusion is based on the alleged fact that May made the present invention during the time and scope of his employment by Fast (see Gennen's memorandum, ¶¶11-14). However, it is apparent by the language in the memorandum "I was told that. . ." that Mr. Gennen does not have personal knowledge of how and by whom the present invention was made. MPEP 409.03(f) requires that the facts in support of any legal conclusion made by the memorandum be made of record in an affidavit of the person having firsthand knowledge of such facts. Petitioner must submit a legal memorandum to the effect that a court of competent jurisdiction would be the weight of authority in that jurisdiction award title of the invention to Abas. The facts in support of any legal conclusion in such legal memorandum must be made of record in an affidavit of the person having firsthand knowledge of such facts. Additionally, the petition states that a German court has recently decided that the present invention did not belong to Fast and thus Fast could not have transferred ownership of the invention to Abas. Any legal memorandum must address such German court decision in drawing any legal conclusion.

CONCLUSION

For the reasons above, the third renewed petition under 37 CFR 1.47(b) is DISMISSED without prejudice.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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BLANK ROME LLP
WATERGATE
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

COPY MAILED

DEC 31 2009

OFFICE OF PETITIONS

In re Application of
Lutz A. May
Application No. 10/498,058
Filed: October 12, 2005
Attorney Docket No. 119508-00256

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Requests to Withdraw as Attorney or Agent of Record under 37 C.F.R. § 1.36(b), filed November 11, 2009.

The request is **NOT APPROVED**.

The Office strongly encourages practitioner(s) requesting withdrawal from representation as practitioner of record in an application to review the record to determine whether he or she is, in fact, of record and how he or she was made of record. For example, the practitioner(s) should determine whether he or she was appointed by naming each practitioner individually or through the use of a Customer Number. If the practitioner(s) was appointed by a specific designation, then the Request should ask that each specified practitioner be withdrawn and should list each practitioner(s) in the Request.

The request herein, fails to indicate who is to be withdrawn.

Further, the Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71,* or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

As there is no Statement under 37 CFR 3.73(b) in the instant application, the request cannot be granted. All future communications from the Office will be directed to above-listed address until otherwise properly notified by the applicant or a proper change of correspondence address have been submitted.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-6059. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Alicia Kelley
Petitions Examiner
Office of Petitions

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WATERGATE
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

MAILED

MAY 24 2010

OFFICE OF PETITIONS

In re Application of	:	
Lutz A. May	:	DECISION ON PETITION
Application No. 10/498,058	:	TO WITHDRAW
Filed: October 12, 2005	:	FROM RECORD
Attorney Docket No. 119508-00256	:	

This is a decision on the renewed Requests to Withdraw as Attorney or Agent of Record under 37 C.F.R. § 1.36(b), filed April 22, 2010.

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 will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which 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 replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40 (c).

The request was signed by Brian W. Higgins on behalf of all the practitioners of record.

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

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

There is an outstanding Office action mailed March 29, 2010 that requires a reply.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-6059. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Alicia Kelley
Petitions Examiner
Office of Petitions

cc: LUTZ A. MAY C/O
PETERS, SCHONBERGER & PARTER GBR
SCHACKSTRASSE 2
MUNICH 80539 GERMANY

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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
10/498,058	10/12/2005	Lutz A. May	119508-00256

CONFIRMATION NO. 9619

POWER OF ATTORNEY NOTICE

27557
BLANK ROME LLP
WATERGATE
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON, DC 20037

Date Mailed: 05/24/2010

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 04/22/2010.

- 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.

/atkelley/

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

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/498,066	10/06/2004	Gael Depres	042465	9702

38834 7590 03/04/2008

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER
JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
03/04/2008	PAPER

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

The time period for reply, if any, is set in the attached communication.

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

Mailed: 3-4-08

In re Application of Gael DEPRES Serial No. 10/498,066 Filed: October 6, 2004 For: COATED PAPER POSESSING A SILKY FEEL	:	DECISION ON PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 FOR REVIEW OF REQUIREMENT FOR RESTRICTION UNDER 37 CFR 1.144 AND FOR WITHDRAWL OF FINALITY OF THE OFFICE ACTION dated August 22, 2007.

On May 18, 2007 newly presented claims 21-28 were withdrawn from consideration as being directed to a non-elected invention. The examiner took the position that these claims were independent and distinct from the originally presented invention. Applicants traversed the restriction requirement in a response filed September 13, 2006. The examiner failed to respond to the traversal of the restriction requirement in the office actions dated December 1, 2006 and August 22, 2007. In addition the examiner withdrew claim 29 from consideration in the Office action dated August 22, 2007 as being directed to a non-elected invention.

On November 9, 2007, the instant petition under 37 CFR 1.144 was filed to formally request the withdrawal of the restriction requirement.

Applicant's position for the withdrawal of the restriction requirement is that the examiner has not shown that a lack of unity exists between the groups of claims.

DECISION

The examiner has withdrawn the restriction requirement and the finality of the office action in the non-final rejection mailed January 22, 2008. Accordingly, the petition is **DISMISSED** as moot.

JMStone

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

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON DC 20036

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ALEXANDRIA, VA 22313-1450
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JENKENS & GILCHRIST, PC
1445 ROSS AVENUE
SUITE 3200
DALLAS TX 75202

In re Application of	:	
BEVEC et al.	:	
Application No.: 10/498,079	:	DECISION
PCT No.: PCT/CH02/00691	:	
Int. Filing Date: 12 December 2002	:	
Priority Date: 18 December 2001	:	
Attorney Docket No.: 27793-00089USPX	:	
For: NOVEL PHARMACEUTICAL COMPOSITION	:	
OF INTERFERON GAMMA OR PIRFENIDONE WITH	:	
MOLECULAR DIAGNOSTICS FOR THE IMPROVED	:	
TREATMENT OF INTERSTITIAL LUNG DISEASES	:	

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 05 May 2005 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 12 December 2002, applicants filed international application PCT/CH02/00691, which designated the United States and claimed a priority date of 18 December 2001. A copy of the international application was communicated from the International Bureau to the USPTO on 1726 June 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 18 June 2004.

On 08 June 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 assertion of small entity status.

On 08 March 2005, 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 05 May 2005, 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 in support of the 37 CFR 1.47(a) petition by Dr. R. C. Salgo.

DISCUSSION

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

As to item (1), the petition fee under 37 CFR 1.17(g) as of 22 November 2004 is $200. Applicants have paid $130. The balance of $70 has been charged to Deposit Account 10-0447.

Item (3) has been satisfied.

Item (2) has not been satisfied. 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. Here, it is not clear that Dr. Salgo has *firsthand* knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Additionally, it is not clear whether it is being alleged that non-signing inventor Rolf Ziesche refuses to execute the application or that he cannot be reached after diligent effort. A communication was purportedly sent to Mr. Ziesche's last known address on 18 June 2004, on 27 August 2004, and on 27 September 2004. It is not clear whether Mr. Ziesche 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. To establish a refusal to execute, *inter alia*, the non-signing inventor must be presented with a copy of the application papers including the specification, claims and drawings. Here, it is not clear that a copy of the application papers including the specification, claims and drawings was sent to Mr. Ziesche. See MPEP § 409.03(d). If it is being alleged that the inventor cannot be reached or found, copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, and telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration.

Item (4) has not been satisfied. The declaration of inventors filed 05 May 2005 is not in compliance with 37 CFR 1.497(a)-(b) because it fails to identify all of the inventors. Rather, it identifies only one of the two joint inventors.

CONCLUSION

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

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

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

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

08 AUG 2006

#16

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

JENKENS & GILCHRIST, PC
1445 ROSS AVENUE
SUITE 3200
DALLAS TX 75202

In re Application of	:	
BEVEC et al.	:	
Application No.: 10/498,079	:	DECISION
PCT No.: PCT/CH02/00691	:	
Int. Filing Date: 12 December 2002	:	
Priority Date: 18 December 2001	:	
Attorney Docket No.: 27793-00089USPX	:	
For: NOVEL PHARMACEUTICAL COMPOSITION	:	
OF INTERFERON GAMMA OR PIRFENIDONE WITH	:	
MOLECULAR DIAGNOSTICS FOR THE IMPROVED	:	
TREATMENT OF INTERSTITIAL LUNG DISEASES	:	

This is a decision on applicants' submission filed 05 May 2006 in the United States Patent and Trademark Office (USPTO). The submission included a petition under 37 CFR 1.137(b) and a renewed petition under 37 CFR 1.47(a).

BACKGROUND

On 12 December 2002, applicants filed international application PCT/CH02/00691, which designated the United States and claimed a priority date of 18 December 2001. A copy of the international application was communicated from the International Bureau to the USPTO on 1726 June 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 18 June 2004.

On 08 June 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 assertion of small entity status.

On 08 March 2005, 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 05 May 2005, applicants filed 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 in support of the 37 CFR 1.47(a) petition by Dr. R. C. Salgo.

On 02 June 2005, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a) because applicants had failed to provide factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort and failed to provide a declaration of inventors in compliance with 37 CFR 1.497(a)-(b).

On 10 April 2006, a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) was mailed indicating that the application was abandoned as to the United States of America for failure to respond to the decision mailed 02 June 2005.

On 05 May 2006, applicants filed the instant submission which included a petition to revive the application under 37 CFR 1.137(b) and a renewed petition under 37 CFR 1.47(a). The petition under 37 CFR 1.47(a) was accompanied by, *inter alia*, a declaration of facts by Martha Overstreet, a declaration of inventors, a copy of a letter from Michael Maddox to non-signing inventor Rolf Ziesche, and copies of two Federal Express tracking updates.

DISCUSSION

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), applicant submitted the renewed petition under 37 CFR 1.47(a) on 05 May 2006.

As to item (2), applicant submitted the petition fee on 05 May 2006.

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.

Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or

cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As noted in the decision mailed 02 June 2005, items (1) and (3) have been satisfied.

Items (2) and (4) have now been met as well. The declaration of inventors filed 05 May 2006 is in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.137(b) is **GRANTED**.

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 **05 May 2006**.

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

08 AUG 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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ROLF ZIESCHE
KARL-LOTHRINGERSTR. 81/36
A1210 WEIN
AUSTRIA

In re Application of
BEVEC et al.
Application No.: 10/498,079
PCT No.: PCT/CH02/00691
Int. Filing Date: 12 December 2002
Priority Date: 18 December 2001
Attorney Docket No.: 27793-00089USPX
For: NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES

Dear Mr. Ziesche:

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

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

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

JENKENS & GILCHRIST, PC
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DALLAS TX 75202

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69137-4USPX

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JENKENS & GILCHRIST, PC
1445 ROSS AVENUE
SUITE 3200
DALLAS TX 75202

INTELLECTUAL PROPERTY
AUG 10 2006
JENKENS & GILCHRIST

In re Application of
BEVEC et al.
Application No.: 10/498,079
PCT No.: PCT/CH02/00691
Int. Filing Date: 12 December 2002
Priority Date: 18 December 2001
Attorney Docket No.: ~~27793-00089USPX~~
For: NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES

DECISION

This is a decision on applicants' submission, filed 05 May 2006 in the United States Patent and Trademark Office (USPTO). The submission included a petition under 37 CFR 1.137(b) and a renewed petition under 37 CFR 1.47(a).

BACKGROUND

On 12 December 2002, applicants filed international application PCT/CH02/00691, which designated the United States and claimed a priority date of 18 December 2001. A copy of the international application was communicated from the International Bureau to the USPTO on 1726 June 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 18 June 2004.

On 08 June 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 assertion of small entity status.

On 08 March 2005, 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.

* DOCKETED
Int: DT: 8/11/06
Decision on Petition
Action Copy Date: 8/8/06

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On 05 May 2005, applicants filed 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 in support of the 37 CFR 1.47(a) petition by Dr. R. C. Salgo.

On 02 June 2005, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a) because applicants had failed to provide factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort and failed to provide a declaration of inventors in compliance with 37 CFR 1.497(a)-(b).

On 10 April 2006, a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) was mailed indicating that the application was abandoned as to the United States of America for failure to respond to the decision mailed 02 June 2005.

On 05 May 2006, applicants filed the instant submission which included a petition to revive the application under 37 CFR 1.137(b) and a renewed petition under 37 CFR 1.47(a). The petition under 37 CFR 1.47(a) was accompanied by, *inter alia*, a declaration of facts by Martha Overstreet, a declaration of inventors, a copy of a letter from Michael Maddox to non-signing inventor Rolf Ziesche, and copies of two Federal Express tracking updates.

DISCUSSION

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), applicant submitted the renewed petition under 37 CFR 1.47(a) on 05 May 2006.

As to item (2), applicant submitted the petition fee on 05 May 2006.

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.

Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or

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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 02 June 2005, items (1) and (3) have been satisfied.

Items (2) and (4) have now been met as well. The declaration of inventors filed 05 May 2006 is in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.137(b) is **GRANTED**.

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 **05 May 2006**.

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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RECEIVED IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Via: First Class Mail	**Dkt No:** 69137-00004USPX
Mailed: May 3, 2006	
Inventor(s): Dorian Bevec et al.	
Application No.: 10/498079	**Filing Date:** December 12, 2002
Title: NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES	

Documents Filed:

Transmittal Letter (2 pages)
Petition Fee Transmittal (1 page)
Petition to Revive Unintentionally Abandoned Application (2 pages)
Renewed Petition under 37 CFR 1.47(a) (3 pages)
Declaration of Facts of Martha Overstreet (2 pages)
Exhibits A-C
Copy of Declaration and Power of Attorney Executed by Dorian Bevec (5 pages)
Charge $750.00 to deposit account 10-0447
Postcard Acknowledgment

* DOCKETED
Int: Dt: 5/4/06
Action: Date: 5/3/06

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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: May 3, 2006 Signature: Martha Overstreet (Martha Overstreet)

Docket No.: 69137-00004USPX (PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Dorian Bevec et al.

Application No.: 10/498079 Group Art Unit: N/A

Filed: December 12, 2002 Examiner: Not Yet Assigned

For: NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES

TRANSMITTAL LETTER

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

Dear Sir:

Enclosed are the following items for filing in connection with the above-referenced Patent Application:

1. Petition Fee Transmittal (1 page);
2. Petition to Revive Unintentionally Abandoned Application (2 pages);
3. Renewed Petition under 37 CFR 1.47(a) (3 pages);
4. Declaration of Facts of Martha Overstreet (2 pages);
5. Exhibits A-C;
6. Copy of Declaration and Power of Attorney Executed by Dorian Bevec (5 pages); and
7. Postcard Acknowledgment.

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Please charge our Deposit Account No. 10-0447 in the amount of $750.00 covering the required fees.. The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 10-0447, under Order No. 69137-00004USPX. A duplicate copy of this paper is enclosed.

Dated: May 3, 2006

Respectfully submitted,

By Michael W. Maddox

Michael W. Maddox
Registration No.: 47,764
JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION
1445 Ross Avenue, Suite 3700
Dallas, Texas 75202
(214) 855-4500
Attorneys For Applicant

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PTO/SB/17p (11-05)
Approved for use through 7/31/2007. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FEE
Under 37 CFR 1.17(f), (g) & (h)
TRANSMITTAL

(Fees are subject to annual revision)

Send completed form to:
MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Application Number	10/498079-Conf. #3091
Filing Date	December 12, 2002
First Named Inventor	Dorian Bevec
Art Unit	N/A
Examiner Name	Not Yet Assigned
Attorney Docket Number	69137-00004USPX

Enclosed is a petition filed under 37 CFR _____ that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of $ _____ is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. *For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.*

Payment of Fees (small entity amounts are NOT available for the petition fees).

[X] The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 10-0447 :
[X] petition fee under 37 CFR 1.17(f), (g) or (h) [X] any deficiency of fees and credit of any overpayments
Enclose a duplicative copy of this form for fee processing.

[ ] Check in the amount of $ _____ is enclosed.

[ ] Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

Petition Fees under 37 CFR 1.17(f): Fee $400 Fee Code 1462

For petitions filed under:
§ 1.36(a) – for revocation of a power of attorney by fewer than all applicants.
§ 1.53(e) – to accord a filing date.
§ 1.57(a) – to accord a filing date.
§ 1.182 – for decision on a question not specifically provided for.
§ 1.183 – to suspend the rules.
§ 1.378(e) – for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
§ 1.741(b) – to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee $200 Fee Code 1463

For petitions filed under:
§ 1.12 – for access to an assignment record.
§ 1.14 – for access to an application.
§ 1.47 – for filing by other than all the inventors or a person not the inventor.
§ 1.59 – for expungement of information.
§ 1.103(a) – to suspend action in an application.
§ 1.136(b) – for review of a request for extension of time when the provisions of section 1.136(a) are not available.
§ 1.295 – for review of refusal to publish a statutory invention registration.
§ 1.296 – to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
§ 1.377 – for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
§ 1.550(c) – for patent owner requests for extension of time in ex parte reexamination proceedings.
§ 1.956 – for patent owner requests for extension of time in inter partes reexamination proceedings.
§ 5.12 – for expedited handling of a foreign filing license.
§ 5.15 – for changing the scope of a license.
§ 5.25 – for retroactive license.

Petition Fees under 37 CFR 1.17(h): Fee $130 Fee Code 1464

For petitions filed under:
§ 1.19(g) – to request documents in a form other than that provided in this part.
§ 1.84 – for accepting color drawings or photographs.
§ 1.91 – for entry of a model or exhibit.
§ 1.102(d) – to make an application special.
§ 1.138(c) – to expressly abandon an application to avoid publication.
§ 1.313 – to withdraw an application from issue.
§ 1.314 – to defer issuance of a patent.

Michael W. Maddox	May 3, 2006
Signature	Date
Michael W. Maddox	47,764
Typed or printed name	Registration No., if applicable

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: May 3, 2006 Signature: Martha Overstreet (Martha Overstreet)

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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: May 3, 2006 Signature: Martha Overstreet
(Martha Overstreet)

Docket No.: 69137-00004USPX
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Dorian Bevec et al.

Application No.: 10/498079 Confirmation No.: 3091

Filed: December 12, 2002 Art Unit: N/A

For: NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES

Examiner: Not Yet Assigned

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

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

Dear Sir:

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extensions of time actually obtained.

Accompanied herewith is a renewed petition under 37 CFR 1.47(a) submitted in response to the Decision mailed June 2, 2005.

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. It is submitted, therefore, that on the basis described above the abandonment should be held to be unintentional, the enclosed renewed Petition should be entered and the case revived.

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Please charge our Deposit Account No. 10-0447 in the amount of $750.00 covering the fee set forth in 37 CFR 1.17(m). The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 10-0447, under Order No. 69137-00004USPX. A duplicate copy of this paper is enclosed.

Dated: May 3, 2006

Respectfully submitted,

By Michael W. Maddox

Michael W. Maddox
Registration No.: 47,764
JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION
1445 Ross Avenue, Suite 3700
Dallas, Texas 75202
(214) 855-4500
Attorneys For Applicant

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I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: MS Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: May 3, 2006 Signature: Martha Overstreet
(Martha Overstreet)

Docket No.: 69137-00004USPX
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Dorian Bevec et al.

Application No.: 10/498079 Confirmation No.: 3091

Filed: December 12, 2002 Art Unit: N/A

For: NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES

Examiner: Not Yet Assigned

RENEWED PETITION UNDER 37 CFR 1.47(a)

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

Dear Sir:

Applicants hereby submit a renewed petition under 37 CFR 1.47(a) to the Commissioner for reconsideration of the Decision, mailed June 2, 2005, to accept the filing of the above-identified U.S. Patent Application by other than all of the inventors. A Declaration of Facts of Marcy Overstreet is enclosed under separate title. The facts therein establish that inventor Rolf Ziesche refuses to execute the Declaration and Assignment ("Filing Documents") for the above-identified U.S. Patent Application.

The Decision indicates that 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 join inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known

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address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding item (1) of the Decision, it was indicated on page 2 that as of 22 November 2004, the petition fee under 37 CFR 1.17(g) is $200. Applicants have paid $130 and the balance of $70 was charged to Deposit Account 10-0447. Accordingly item (1) of the Decision has been satisfied. The Decision further indicates that item (3) has been satisfied.

The Decision indicates that item (2) and item (4) have not been satisfied.

In response to item (2) of the Decision, Martha Overstreet, an employee of Jenkens & Gilchrist, sent a package containing a cover letter addressed to Mr. Rolf Ziesche, a copy of the application papers including the specification, claims and drawings, a Preliminary Amendment as originally filed in the U.S. Patent and Trademark Office, an Information Disclosure Statement, a Declaration and Power Of Attorney and Assignment documents via FedEx on April 11, 2006 to the last known address of Mr. Rolf Ziesche.

The last known address of Rolf Ziesche is Karl-Lothringerstr. 18/36, A-1210 Wien, Austria.

Also enclosed with the package was a prepaid FedEx envelope addressed to Jenkens & Gilchrist. The cover letter addressed to Mr. Rolf Ziesche requested that he review the patent application, the Preliminary Amendment, the Declaration and Power of Attorney document, and the Assignment document, and return the executed Declaration and Power of Attorney document and Assignment document to Jenkens & Gilchrist in the aforementioned prepaid FedEx envelope. The cover letter indicated that failure to reply within a time period of ten (10) days of receipt of the letter indicates a refusal on Mr. Ziesche's part to execute the enclosed documents. Copies of the contents of the package sent to Mr. Ziesche are attached as Exhibit A.

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FedEx tracking records for the package indicate that the package was delivered and signed for at the aforementioned address on April 13, 2006. Copies of the FedEx tracking records are attached as Exhibit B. As of May 3, 2006, no response has been received from Rolf Ziesche regarding the request to execute the Filing Documents. Moreover, FedEx tracking records for the prepaid FedEx envelope addressed to Jenkens & Gilchrist indicate that the prepaid FedEx envelope has not been sent. Copies of the FedEx tracking records for the prepaid envelope are attached as Exhibit C. In view of the foregoing, Applicant respectfully submits that item (2) of the Decision has been satisfied.

Enclosed herewith is a Declaration and Power of Attorney document that identifies all of the inventors of the application. The enclosed Declaration and Power of Attorney has been executed by inventor Dorian Bevec, but has not been executed by inventor Rolf Ziesche. In view of the foregoing, Applicant respectfully submits that item (4) of the Decision has been satisfied.

In view of the foregoing discussion, Applicants respectfully request granting of the renewed petition under 37 CFR 1.47(a).

Dated: May 3, 2006

Respectfully submitted,

By Michael W. Maddox

Michael W. Maddox
Registration No.: 47,764
JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION
1445 Ross Avenue, Suite 3700
Dallas, Texas 75202
(214) 855-4500
Attorneys For Applicant

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PATENT & TRADEMARK OFFICE

Docket No.: 69137-00004USPX
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Dorian Bevec et al.

Application No.: 10/498079 | Confirmation No.: 3091

Filed: December 12, 2002 | Art Unit: N/A

For: NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES | Examiner: Not Yet Assigned

DECLARATION OF FACTS OF MARTHA OVERSTREET

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

Dear Sir:

I, Martha Overstreet, hereby declare as follows:

1. I am an employee of Jenkens & Gilchrist, and have personal knowledge of the facts described below.

2. On April 11, 2006, I sent a package containing a cover letter addressed to Mr. Rolf Ziesche, a copy of the application papers including the specification, claims and drawings, a Preliminary Amendment as originally filed in the U.S. Patent and Trademark Office, an Information Disclosure Statement, a Declaration and Power Of Attorney document and Assignment document ("Filing Documents") via FedEx to the address of Mr. Rolf Ziesche, Karl-Lothringerstr. 18/36, A-1210 Wien, Austria. A copy of the contents of the package are attached to the renewed petition as Exhibit A.

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3. FedEx tracking records indicate that the package was delivered and signed for at the aforementioned address on April 13, 2006. Copies of the FedEx tracking records are attached to the renewed petition as Exhibit B.

4. As of May 3, 2006, no response has been received from Rolf Ziesche regarding the request to execute the Filing Documents. Moreover, FedEx tracking records for the prepaid FedEx envelope addressed to Jenkens & Gilchrist indicate that the prepaid FedEx envelope has not been sent. Copies of the FedEx tracking records for the prepaid envelope are attached to the renewed petition as Exhibit C.

I hereby declare further that all statements made herein of my own knowledge are true, and that all statements made on information and belief are to be true; and further that these statements are made with the knowledge that false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States code, and that such false statements may jeopardize the validity of the application or any patent issuing thereon.

This affidavit and declaration is executed on this 3rd day of May, 2006.

Martha Overstreet

Martha Overstreet

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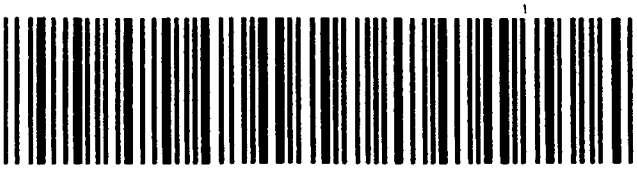

From
MARTHA OVERSTREET
JENKENS & GILCHRIST PC
1445 ROSS AVE FL 29
DALLAS, TX 752022812
United States
214-855-4500

To
Mr. Rolf Ziesche
Karl-Lothringerstr. 81/36
A1210 Wein, A1210
Austria
011-214-855-4806

Shipment Information
Service: International Priority
Packaging: FedEx Pak
Handling:
Dimmed:
Weight: 2
Bill Shipment To:
Bill Duty/Tax/Fees:
Reference: 69137-00004USPX
Declared Value:

History | Ship to new recipient | Ship to same recipient

1. Fold the printed page along the horizontal line.
2. Place label in shipping label pouch and affix it to your shipment so that the barcode portion of the label can be read and scanned.
3. To print a receipt of your shipment, please click on "Shipping History."

EXHIBIT
A

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DALLAS, TX 752022812

DALLAS

FedEx

Ship | Track | History | Address Book | Preferences | Reports | Admin

<< Logout | Options

Quick

Special services

- [ ] Saturday pick up
- [ ] Saturday delivery
- [ ] Hold at FedEx location Edit
- [ ] Dry Ice Edit

Billing details

Bill shipment to Sender (Prepaid)

Optional information

Ship date Today

Total declared value U.S. Dollar

Shipment notification

	Email address	Shipment notification	Deli notific
Sender	MOverstreet@jenkens.com	☑	☑
Recipient		☐	☐
Other 1		☐	☐
Other 2		☐	☐

FedEx InSight℠

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DECLARATION FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled:

NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES

the specification of which was filed on December 12, 2002 as Application No. PCT/CH02/00691.

In the event that the filing date and/or Application No. are not entered above at the time I execute this document, and if such information is deemed necessary, I hereby authorize and request my attorneys/agent(s) at **Jenkens & Gilchrist, a Professional Corporation,** 1445 Ross Avenue, Suite 3200, Dallas, Texas 75202, to insert above the filing date and/or Application No. of said application.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by an amendment, if any, specifically referred to herein.

I acknowledge the duty to disclose all information known to me that is material to patentability in accordance with Title 37, Code of Federal Regulations, § 1.56.

FOREIGN PRIORITY CLAIM

I hereby claim foreign priority benefits under Title 35, United States Code § 119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

☐ no such foreign applications have been filed

☒ such foreign application have been filed as follows:

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EARLIEST FOREIGN APPLICATION(S), IF ANY FILED WITHIN 12 MONTHS (6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION

Application Number	Country	Date of Filing	Priority Claimed Under 35 USC 119
01130011.8	Europe	December 18, 2001	X Yes No ___
			___ Yes No ___
			___ Yes No ___

ALL FOREIGN APPLICATION(S), IF ANY FILED MORE THAN 12 MONTHS (6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION

Application Number	Country	Date of Filing

CLAIM FOR BENEFIT OF EARLIER U.S. PROVISIONAL APPLICATIONS

I hereby claim priority benefits under Title 35, United States Code §119(e), of any United States provisional patent application(s) listed below:

[x] no such U.S. provisional applications have been filed.

[ ] such U.S. provisional application have been filed as follows:

Application Number	Date of Filing	Priority Claimed Under 35 USC 119
		___ Yes No ___
		___ Yes No ___
		___ Yes No ___

CLAIM FOR BENEFIT OF EARLIER U.S./PCT APPLICATION(S)

I hereby claim the benefit under Title 35, United States Code, §120 of the United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose all information that is material to patentability in accordance with Title 37, Code of Federal Regulations, §1.56 which became available to me between the filing date of the prior application and the national or PCT international filing date of this application:

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☐ no such U.S./PCT applications have been filed.

☐ such U.S./PCT application have been filed as follows:

Application Number	Relationship	Parent Application	Date of Filing

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint:

All practitioners at Customer Number 23932

all of **Jenkens & Gilchrist, a Professional Corporation**, 1445 Ross Avenue, Suite 3200, Dallas, Texas 75202, jointly, and each of them severally, my attorneys at law/patent agent(s), with full power of substitution, delegation and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the U. S. Patent and Trademark Office connected therewith.

Please mail all correspondence to Stanley R. Moore, whose address is:

Jenkens & Gilchrist, a Professional Corporation
1445 Ross Avenue, Suite 3200
Dallas, Texas 75202

Please direct telephone calls to: Stanley R. Moore at (214) 855-4713.

Please direct facsimiles to: (214) 855-4300

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Full name of sole or first inventor Dorian Bevec	
Sole or first inventor's signature Dorian Bevec	Date Sept. 16, 2004
Residence Gentilino, Switzerland	
Citizenship ~~Switzerland~~ German	
Mailing Address Via Pasquée 23 CH-6925 Gentilino SWITZERLAND	

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Full name of second inventor, if any Rolf Ziesche	
Second inventor's signature	Date
Residence Wein, Austria	
Citizenship Germany	
Mailing Address Karl-Lothringerstr. 81/36 A-1210 Wein AUSTRIA	

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Jenkens & Gilchrist

A PROFESSIONAL CORPORATION

1445 Ross Avenue, Suite 3700
Dallas, Texas 75202

(214) 855-4500
FACSIMILE (214) 855-4300

AUSTIN, TEXAS
(512) 499-3800
CHICAGO, ILLINOIS
(312) 425-3900
HOUSTON, TEXAS
(713) 951-3300
LOS ANGELES, CALIFORNIA
(310) 820-8800
PASADENA, CALIFORNIA
(626) 578-7400
SAN ANTONIO, TEXAS
(210) 246-5000
WASHINGTON, D.C.
(202) 326-1500

Michael W. Maddox
Patent Agent
(214) 855-4614
mmaddox@jenkens.com

April 11, 2006

Mr. Rolf Ziesche
Karl-Lothringerstr. 81/36
A-1210 Wein
AUSTRIA

Re: U.S. Patent Application
Application No.: 10/498079
U.S. National Stage of International Patent Application No. PCT/CH02/00691
Title: NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES
Filed: December 12, 2002
Inventors: Rolf Ziesche and Dorian Bevec
Our Reference: 69137-00004USPX

URGENT: PLEASE READ AND ADVISE IF YOU DO NOT INTEND TO EXECUTE THESE DOCUMENTS

Dear Mr. Ziesche:

Enclosed herewith is a copy of the above-identified patent application in which you are shown to be an inventor. These documents include the specification, claims and drawings, and a Preliminary Amendment as originally filed in the U.S. Patent and Trademark Office for which you are named as a joint inventor. Also enclosed herewith is the IDS that was filed and a Declaration and Power of Attorney document and an Assignment document for your execution.

After you've had an opportunity to review the patent application, the Preliminary Amendment, the Declaration and Power of Attorney document and the Assignment document, we ask that you please return the executed Declaration and Power of Attorney document and Assignment document to us as soon as possible for filing in the U. S. Patent and Trademark Office.

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We ask that you return an executed copy of the Declaration and Power of Attorney document and Assignment document to us within ten (10) days of your receipt of this letter. Failure to reply within this time period will indicate a refusal on your part to execute the enclosed documents. For your convenience, a self-addressed prepaid FedEx envelope is enclosed for returning the executed documents to us. If you refuse to review and execute these documents, then please advise us in the above referenced self-addressed prepaid FedEx envelope.

Please do not hesitate to contact us if you have any questions regarding this matter.

Best regards,

Michael W. Maddox
Patent Agent

MWM/cam

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ASSIGNMENT BY INVENTORS

THIS ASSIGNMENT, made by Dorian Bevec and Rolf Ziesche (hereinafter referred to as Assignors), residing at Via Pasquée 23, CH-6925 Gentilino, SWITZERLAND; and Karl-Lothringerstr. 81/36, A-1210 Wein, AUSTRIA, respectively;

WHEREAS, Assignors have invented certain new and useful improvements in NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES, set forth in a Patent application for Letters Patent of the United States, already filed on _____ as U.S. application No. _____; and

WHEREAS, Mondobiotech Laboratories Anstalt, a corporation organized under and pursuant to the laws of Liechtenstein having its principal place of business at Austrasse 79, FL-9490 Vaduz, Liechtenstein (hereinafter referred to as Assignee), is desirous of acquiring the entire right, title and interest in and to said inventions and said Application for Letters Patent of the United States, and in and to any Letters Patent of the United States to be obtained therefore and thereon.

NOW, THEREFORE, in consideration of One Dollar ($1.00) and other good and sufficient consideration, the receipt of which is hereby acknowledged, Assignors have sold, assigned, transferred and set over, and by these presents do sell, assign, transfer and set over, unto Assignee, its successors, legal representatives and assigns, the entire right, title and interest in and to the above-mentioned inventions and application for Letters Patent, and in and to any and all direct and indirect divisions, continuations and continuations-in-part of said application, and any and all Letters Patent in the United States and all foreign countries which may be granted therefore and thereon, and reissues, reexaminations and extensions of said Letters Patent, and all rights under the International Convention for the Protection of Industrial Property, the same to be held and enjoyed by Assignee, for its own use and benefit and the use and benefit of its successors, legal representatives and assigns, to the full end of the term or

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terms for which Letters Patent may be granted and/or extended, as fully and entirely as the same would have been held and enjoyed by Assignors, had this sale and assignment not been made.

AND for the same consideration, Assignors hereby represent and warrant to Assignee, its successors, legal representatives and assigns, that, at the time of execution and delivery of these presents, except for any rights, titles and/or interests that have arisen to Assignee under law or that have already been transferred to Assignee, Assignors are the sole and lawful owners of the entire right, title and interest in and to the said inventions and application for Letters Patent above-mentioned, and that the same are unencumbered and that Assignors have good and full right and lawful authority to sell and convey the same in the manner herein set forth.

AND for the same consideration, Assignors hereby covenant and agree to and with Assignee, its successors, legal representatives and assigns, that Assignors will sign all papers and documents, take all lawful oaths and do all acts necessary or required to be done for the procurement, maintenance, enforcement and defense of any Letters Patent and applications for Letters Patent for said inventions, without charge to Assignee, its successors, legal representatives and assigns, whenever counsel of Assignee, or counsel of its successors, legal representatives and assigns, shall advise: that any proceeding in connection with said inventions, or said Patent application for Letters Patent, or any proceeding in connection with any Letters Patent or applications for Letters Patent for said inventions in any country, including but not limited to interference proceedings, is lawful and desirable; or, that any division, continuation or continuation-in-part of any application for Letters Patent, or any reissue, reexamination or extension of any Letters Patent, to be obtained thereon, is lawful and desirable.

AND Assignors hereby request the Commissioner of Patent and Trademarks to issue said Letters Patent of the United States to Assignee, as Assignee of said inventions and the Letters Patent to be issued thereon, for the sole use and benefit of Assignee, its successors, legal representatives and assigns.

AND Assignors hereby grant the following individuals the power to insert on this Assignment any further identification which may be necessary or desirable in order to comply

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with the rules of the United States Patent and Trademark Office for recordation of this document:

JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION

Robert L. Abdon, Ph.D., 50,996; Timothy G. Ackermann, 44,493; Mark R. Anderson, 54,656; J. Benjamin Bai, 43,481; Joseph M. Beauchamp, 46,544; Norma Bennett, 51,229; Michael D. Berger, 52,616; Diane Bergin, 51,101; Mary Jo Boldingh, 34,713; Margaret A. Boulware, 28,708; Daniel J. Burnham, 39,618; Sorinel Cimpoes, 48,311; Andrew G. DiNovo, 40,115; Mario J. Donato, Jr., 37,816; R David Donoghue, 42,493; Samuel H. Dworetsky, 27,873; Stuart D. Dwork, 31,103; Valerie K. Friedrich, 39,676; Janet M. Garetto, 42,568; Mark Gatschet, 42,569; John C. Gatz, 41,774; Russell J. Genet, 42,571; Anil V. Gollahalli, 48,996; Lekha Gopalakrishnan, 46,733; Steven R. Greenfield, 38,166; J. Pat Heptig, 40,643; Gary Hood, 51,818; Sharon A. Israel, 41,867; Lisa K. Jorgenson, 34,845; John R. Kirk, Jr., 24,477; Paul R. Kitch, 38,206; Timothy M. Kowalski, 44,192; Michael W. Maddox, 47,764; W. Jackson Matney, Jr., 39,292; Roger L. Maxwell, 31,855; Lisa H. Meyerhoff, 36,869; Ashley N. Moore, 51,667; Stanley R. Moore, 26,958; Daniel G. Nguyen, 42,933; Constance M. Pielech, 46,991; Gregory Porter, 40,131; Ross T. Robinson, 47,031; Stephen G. Rudisill, 20,087; Jerry R. Selinger, 26,582; Amy L. Sierocki, 54,447; Zachary J. Smolinski, 47,100; Justin A. Swindells, 48,733; Steve Z. Szczepanski, 27,957; Andre M. Szuwalski, 35,701; Katherine L. Tabor, 36,026; Alan R. Thiele, 30,694; Cynthia K. Thompson, 48,655; Tamsen Valoir, Ph.D., 41,417; Andrew Warnecke, 43,238; Harold N. Wells, 26,044; and William D. Wiese, 45,217

AND Assignors acknowledge an obligation of assignment of this invention to Assignee at the time the invention was made.

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Date

Dorian Bevec

Witness:

Date

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Date	Rolf Ziesche

Witness:

Date	

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JENKENS & GILCHRIST PC
1445 ROSS AVE FL 29

DALLAS, TX 75202
UNITED STATES US

Ship Date: 20APR06
Actual Wgt: 2 LB
System#: 409981/FXRS0723
Account: S 317708840

Jenkens & Gilchrist
Michael W. Maddox
1445 Ross Avenue
Suite 3700
Dallas, TX 75202

(214) 855 4614 FedEx Express

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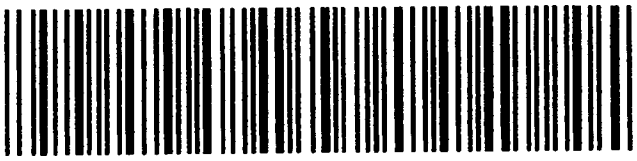

From
MARTHA OVERSTREET
JENKENS & GILCHRIST PC
1445 ROSS AVE FL 29

DALLAS, TX 752022812
US
214-855-4500

To
Michael W. Maddox
Jenkens & Gilchrist
1445 Ross Avenue
Suite 3700
Dallas, TX 75202
United States
214-855-4614

Shipment Information
Service: Priority Overnight
Packaging: FedEx Pak
Handling:
Dimmed:
Weight: 2
Bill Shipment To:
Bill Duty/Tax/Fees:
Reference: 69137-00004USPX
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1. Fold the printed page along the horizontal line.
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MARTHA OVERSTREET
1445 ROSS AVE FL 29
DALLAS, TX 752022812
DALLAS

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- [ ] Signature required
- [ ] Saturday pick up
- [ ] Saturday delivery
- [ ] COD (Collect on delivery) Edit
- [ ] Hold at FedEx location Edit
- [ ] Dry Ice Edit

Billing details

Bill shipment to Sender (Prepaid)

Optional information

Ship date Thu-Apr 20

Declared value 0.00 USD

Shipment notification

	Email address	Shipment notification	De noti
Sender	MOverstreet@jenkens.com	☑	
Recipient		☐	
Other 1		☐	
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ORIGIN (POSTAL USE ONLY)			
PO ZIP Code: 75222	Day of Delivery: ☐ Next ☐ Second	Flat Rate Envelope: ☐	
Date In: Mo. 6 Day 8 Year 04	Time: ☐ 12 Noon ☐ 3 PM	Postage: $	
Time In: ☐ AM ☐ PM 1681	Military: ☐ 2nd Day ☐ 3rd Day	Return Receipt Fee	
Weight: 4 lbs. 12 ozs.	Int'l Alpha Country Code	COD Fee	Insurance Fee
No Delivery: ☐ Weekend ☐ Holiday	Acceptance Clerk Initials: JBA	Total Postage & Fees: $ 27.30	

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Delivery Date: Mo. Day	Time: ☐ AM ☐ PM	Employee Signature

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R. Butler - 5566
EL 987027896 US

TO: (PLEASE PRINT) PHONE ( )

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

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Atty Docket No.: 27793-00089USPX

Applicant: Dorian Bevec et al.

Application No.: Not Yet Assigned **Filing Date:** Concurrently Herewith

Title: NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES

Documents Filed:

Transmittal Letter to the United States Designated-Elected Office (2 pages) — Check in the amount of $661.00

Copy of the International application

Copy of International Search Report

Preliminary Amendment

Declaration and POA for Patent Application (Un-Executed)

Information Disclosure Statement

Information Disclosure Statement by Applicant

Via: Express Mail: Airbill No. EL987027896US

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FORM PTO 1390 (REV 10-2003) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE		ATTORNEY'S DOCKET NUMBER
TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371		27793-00089USPX
		U.S. APPLICATION NO. (If known, see 37 CFR 1.5)
INTERNATIONAL APPLICATION NO. PCT/CH02/00691	INTERNATIONAL FILING DATE 12 December 2002	PRIORITY DATE CLAIMED 18 December 2001
TITLE OF INVENTION	NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES	
APPLICANT(S) FOR DO/EO/US	Dorian Bevec et al.	

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. [x] This is a **FIRST** submission of items concerning a filing under 35 U.S.C. 371.
2. [ ] This is a **SECOND** or **SUBSEQUENT** submission of items concerning a filing 35 U.S.C. 371.
3. [x] This is an express request to begin national examination procedures (35 U.S.C. 371 (f)). The submission must include items (5), (6), (9) and (21) indicated below.
4. [x] The US has been elected (Article 31).
5. [x] A copy of the International Application as filed (35 U.S.C. 371 (c)(2))
   a. [x] is attached hereto (required only if not communicated by the International Bureau).
   b. [ ] has been communicated by the International Bureau.
   c. [ ] is not required, as the application was filed in the United States Receiving Office (RO/US).
6. [ ] An English language translation of the International Application as filed (35 U.S.C. 371 (c)(2)).
   a. [ ] is attached hereto.
   b. [ ] has been previously submitted under 35 U.S.C. 154(d)(4).
7. [ ] Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371 (c)(3))
   a. [ ] are attached hereto (required only if not communicated by the International Bureau).
   b. [ ] have been communicated by the International Bureau.
   c. [ ] have not been made; however, the time limit for making such amendments has NOT expired.
   d. [ ] have not been made and will not be made.
8. [ ] An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371 (c)(3)).
9. [x] An oath or declaration of the inventor(s) (35 U.S.C. 371 (c)(4)). (Un-Executed)
10. [ ] An English language translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371 (c)(5)).

Items 11 to 20 below concern document(s) or information included:

11. [x] An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
12. [ ] An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
13. [x] A preliminary amendment.
14. [ ] An Application Data Sheet under 37 CFR 1.76.
15. [ ] A substitute specification.
16. [ ] A power of attorney and/or change of address letter.
17. [ ] A computer-readable form of the sequence listing in accordance with PCT Rule 13*ter*.2 and 37 CFR 1.821 - 1.825.
18. [ ] A second copy of the published international application under 35 U.S.C. 154(d)(4).
19. [ ] A second copy of the English language translation of the international application under 35 U.S.C. 154(d)(4).
20. [x] Other items or information: Copy of the International Search Report; Postcard Acknowledgment

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U.S. APPLICATION NO. (if known, see 37 CFR 1.5)	INTERNATIONAL APPLICATION NO.	ATTORNEY'S DOCKET NUMBER
	PCT/CH02/00691	27793-00089USPX

21. [x] The following fees are submitted:

BASIC NATIONAL FEE (37 CFR 1.492 (a) (1) – (5)):

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[ ]	Neither international preliminary examination fee (37 CFR 1.482) nor international search fee (37 CFR 1.445(a)(2)) paid to USPTO and International Search Report not prepared by the EPO or JPO $1080.00	
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[x] Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above are reduced by ½.				$ 661.00	
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(54) Title: NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES

(57) Abstract: The present invention relates to a novel pharmaceutical composition comprising interferon-γ or pirfenidone and a diagnostic array of candidate polynucleotides for the improved treatment of lung diseases, especially for all forms of interstitial lung diseases. This invention describes the combination of molecular diagnosis and clinical therapy as a novel medication principle for reduction of mortality and improvement of disease management in interstitial lung diseases.

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NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES

The present invention relates to a novel pharmaceutical composition of compounds having the biological activity of interferon gamma (IFN-γ) or pirfenidone in combination with a diagnostic array of candidate polynucleotides for the improved treatment of all forms of interstitial lung diseases, in particular of idiopathic pulmonary fibrosis (IPF).

BACKGROUND OF THE INVENTION

Interstitial lung diseases

Reliable diagnosis of is of critical importance for disease management, research, epidemiology and development of specific therapies.

Interstitial lung diseases (ILD) are a heterogeneic group of chronic inflammatory reactions of the lung. Different forms of ILD are known which comprise, for example, of idiopathic pulmonary fibrosis (IPF), hypersensivity pneumonitis, scleroderma, Systemic Lupus Erythematosus, Rheumatoid Arthritis, Churg-Strauss syndrome, Wegener's granulomatosis, and Goodpasture Syndrome. This process is characterized by a combination of injury and exaggerated but futile attempts of tissue repair that transforms the regular maintenance of cellular growth into progressive development of scars. Characteristic features of this reaction are: repeated damage; intensified proteolytic activity and change in the composition of extracellular matrix (ECM) components. This combination leads to a shifted cellular immune response and a relentless induction of mesenchymal growth.

Cytokines, such as tumor necrosis factor-α, and mediators of growth, such as transforming growth factor β_1 ($TGF\beta_1$), have long been implicated in this process. Of these mediators, $TGF\beta_1$ has probably become the most important one, due to its strong activity to stimulate mesenchymal growth and its abil-

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ity to modulate cellular immune functions. TGF-β_1 is known to cause severe pulmonary fibrosis when overexpressed in animal models *(Sime PJ, Xing Z, Graham FL, Csaky KG, Gauldie J. Adenovector-mediated gene transfer of active transforming growth factor β1 induces prolonged severe fibrosis in rat lung. J Clin Invest 1997;100:768-76.)*, and a significant overexpression of this mediator is found in human pulmonary fibrosis *(Broekelmann TJ, Limper AH, Colby TV, McDonald JA. Transforming growth factor beta 1 is present at sites of extracellular matrix gene expression in human pulmonary fibrosis. Proc Natl Acad Sci USA 1991;88:6642-6.)*. The immunomodulatory action of TGF-β_1 is well-known *(Qin L, Ding Y, Bromberg JS. Gene transfer of transforming growth factor-beta 1 prolongs murine cardiac allograft survival by inhibiting cell-mediated immunity. Hum Gene Ther 1996;7:1981-8; Gilbert KM, Thoman M, Bauche K, Pham T, Weigle WO. Transforming growth factor-beta 1 induces antigen-specific unresponsiveness in naive T cells. Immunol Invest 1997;26:459-72; Lawrence DA. Transforming growth factor-beta: a general review. Eur Cytokine Netw 1996;7:363-74.)*. It includes the inhibition of interferon gamma release *(Naganuma H, Sasaki A, Satoh E, Nagasaka M, Nakano S, Isoe S, et al. Transforming growth factor-beta inhibits interferon gamma secretion by lymphokine-activated killer cells stimulated with tumor cells. Neurol Med Chir Tokyo 1996;36:789-95.)*, the suppression of interferon gamma-dependent immune reactions *(Lee YJ, Han Y, Lu HT, Nguyen V, Qin H, Howe PH, et al. TGF-beta suppresses interferon gamma induction of class II MHC gene expression by inhibiting class II transactivator messenger RNA expression. J Immunol 1997;158:2065-75.)*, and the induction of immunosuppressive CD8+ lymphocytes *(Gray JD, Hirokawa M, Horwitz DA, J Exp Med 180, 1937-1942, 1994.)*. Indeed, modulation of cellular immunity in patients with progressive fibrosis has been observed for years, even in forms, which clearly represent *different* mechanisms of initial damage. Recent investigations have demonstrated that progressive scarring in idiopathic pulmonary fibrosis is accompanied by a shift of the cytokine balance in T lymphocytes that favors the formation of the so-called T helper type 2 (Th2) reaction

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(Prior C, Haslam PL. In vivo levels and in vitro production of interferon gamma in fibrosing interstitial lung diseases. Clin Exp Immunol 1992;88:280-7.; Ziesche R, Kink E, Herold C, Podolsky A, Block LH. Therapy of chronic interstitial lung disease with a combination of Interferon gamma and low-dose prednisolone. Chest 1996;110:25S.). This reaction is characterized by an increase of 'Th2' cytokines, such as interleukin (IL)-4, IL-10 and IL-13, and a reduction or even a complete loss of interferon gamma, the main mediator of the T helper type 1 reaction *(Majumdar S, Li D, Ansari T, et al. Tissue cytokine profiles of cryptogenic fibrosing alveolitis (CFA) and fibrosing alveolitis associated with systemic sclerosis (FASSc) are distinct: a quantitative in situ study of open lung biopsies. Eur Respir J 1999; 14: 251-7.)*. In bleomycin-induced lung fibrosis, transcription of the interferon gamma gene decreases from day 7 onwards and is no longer detectable on day 28. Reciprocally, transcription of IL-13, which also has fibrogenic activity, *(Romagnani S. Th1/Th2 cells. Inflamm Bowel Dis. 1999; 5: 285-94.; Fallon PG, Richardson EJ, McKenzie GJ, McKenzie AN. Schistosome infection of transgenic mice defines distinct and contrasting pathogenic roles for IL-4 and IL-13: IL-13 is a profibrotic agent. J Immunol. 2000; 164 :2585-91.)*, begins to increase on day 7.

In contrast to the chronic inflammatory reaction in fibrosis, acute inflammation of the pulmonary interstitium as a result of infection with *M. pneumoniae* is characterized by a simultaneous transcription of both Th1 and Th2 cytokine genes, i.e. IL-12 and interferon gamma, and IL-4. In addition, this reaction includes an increased transcription of TGF-β_1, probably as a sign of activated tissue repair.

Unfortunately, as a result of the usually late recognition of IPF, the early cellular events in this disease are virtually impossible to assess. However, analysis of mRNA accumulation for IL-4, interferon gamma, and TGF-β_1 in an individual with familial idiopathic pulmonary fibrosis, with symptoms of breathlessness on maximum exertion of less than a year, already demonstrates the shift of the immune balance and the

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intense activation of transcription of TGF-β_1. In the group of individuals with idiopathic pulmonary fibrosis, we found that the amount of mRNA accumulation of the TGF-β_1 gene was seven fold higher than that in normal lungs. In conclusion, our observations clearly demonstrate features of pathologically intensified repair mechanisms.

The intensity of repair is directly influenced by mechanisms of inflammation causing intensified turnover of both ECM and cellular components. As a result, chronic inflammation, usually induced by various infective agents, aggravates pathologic tissue repair.

Even if the causative agents were known, at present organ fibrosis cannot be sufficiently treated with any medication. Millions of people are dying from slow destruction of vital organ systems owing to pathological restructuring of functional organ tissue. This relentless process is known as fibrosis or tissue remodeling that is primarily due to fibroproliferative mechanisms. The only remedy is organ transplantation, which is associated with numerous costly complications.

The fibroproliferative reaction concerns all organs of the body. In the gas-exchanging lung tissue it is known as lung fibrosis, in the bronchi it is known as bronchial asthma, in the liver as cirrhosis, in the kidney as glomerulosclerosis, in the general circulation as arteriosclerosis and coronary artery sclerosis, and in the pulmonary circulation as pulmonary hypertension.

These conditions are collectively known as fibroproliferative diseases. In fibrosis, healthy tissue is progressively replaced by components of the connective and supporting tissue of the human body. This process is based on the pathologically accelerated growth rate of tissue cells, which would normally accomplish regular wound healing. Thus, fibroproliferative diseases may be defined as uncontrollably accelerated wound healing. In fibrosis, the replacement of functional organ tissue continues until complete loss of organ function occurs. The currently available modes of diagnosis and treatment for all fibroproliferative diseases are inadequate.

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Pirfenidone

Pirfenidone is an orally active small molecule drug that appears to inhibit collagen synthesis, down regulates production of multiple cytokines and blocks fibroblast proliferation and stimulation in response to cytokines. Pirfenidone, which has demonstrated activity in multiple fibrotic indications, is currently in Phase II clinical development for fibrotic diseases of the lung, kidney and liver.

Interferon gamma (IFN-γ)

IFN-γ is a naturally glycoprotein cytokine, acting synergistically with other cytokines to exert its wide ranging effects. IFN-γ is a naturally occurring glycoprotein having a molecular weight of about 17.000 which can be commercially produced today also by recombinant techniques.

For improvement of the pharmacokinetic features, IFN-γ can be modified by pegylation to obtain PEG-IFN-γ. In addition to injection techniques, IFN-γ can be administered by inhalation to the lungs to diminish undesirable side effects. IFN-γ exhibits antiviral activity and together with other cytokines it plays an pivotal immunoregulatory role within the human immune system (an immunostimulating or an immunosuppressive effect, dependent on cell activation and location). Effects of IFN-γ include the induction of MHC class II antigens, macrophage activation, increased immunoglobulin production from B lymphocytes and enhanced NK cell activity.

The general antifibrotic properties of IFN-γ are well-documented *(Lortat-Jacob H, Kleinman HK, Grimaud JA. High-affinity binding of interferon-gamma to a basement membrane complex (matrigel). J Clin Invest. 1991; 87: 878-83.; Narayanan AS, Whithey J, Souza A, Raghu G. Effect of gamma-interferon on collagen synthesis by normal and fibrotic human lung fibroblasts. Chest. 1992 May;101(5):1326-31; Hjelmeland LM, Li JW, Toth CA, Landers MB 3d. Antifibrotic and uveitogenic properties of gamma interferon in the rabbit eye. Grae-*

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fes Arch Clin Exp Ophthalmol. 1992;230(1):84-90; Hyde DM, Henderson TS, Giri SN, Tyler NK, Stovall MY. Effect of murine gamma interferon on the cellular responses to bleomycin in mice. Exp Lung Res. 1988;14(5):687-704.). It has already been demonstrated that IFN-γ causes a reduced expression of TGF-β_1 together with a reduction in the amount of fibrosis *(Giri SN, Hyde DM, Marafino BJ Jr. Ameliorating effect of murine interferon gamma on bleomycin-induced lung collagen fibrosis in mice. Biochem Med Metab Biol. 1986 Oct;36(2):194-7.)*. When using IFN-γ under clinical conditions, the transcription of TGF-β_1 and that of CTGF are significantly diminished after six months of therapy *(Ulloa L, Doody J, Massague J. Inhibition of transforming growth factor-beta/SMAD signalling by the interferon-gamma/STAT pathway. Nature 1999; 397: 710-3.)*. The simultaneous improvement of lung function in individuals suffering from IPF receiving IFN-γ provides additional support for the hypothesis that the mesenchymal activation in individuals with lung fibrosis depends, at least in part, on the continuous overexpression of TGF-β_1 and CTGF *(Ziesche R, Hofbauer E, Wittmann K, Petkov V, Block LH. A preliminary study of long-term treatment with interferon gamma-1b and low-dose prednisolone in individuals with idiopathic pulmonary fibrosis. N Engl J Med. 1999; 341: 1264-9; EP0795332A2.)*. Moreover, these results suggest that an acquired deficiency of IFN-γ may be one reason for the exaggerated wound healing process characteristic of progressive organ fibrosis.

IFN-γ was shown to be the first clinically applicable anti-fibrotic drug. As any endogenous substance, IFN-γ has pleiotropic effects dependent on the existing conditions within the body. In case of an exaggerated, yet non- or low-inflammatory wound healing, such as in IPF, the drug exerts powerful highly beneficial anti-fibrotic properties. However, in the presence of accompanying infections, such as chronic bacterial, viral or fungal infections, the drug will add to the inflammatory process and even reinforce, by intensifying tissue repair, the fibrotic process.

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Thus, for a safe and effective use of the drug, it is necessary to molecularly measure the state of tissue response prior to application of the drug. The absence of the mRNA transcription of the gene for IFN-γ in the presence of intensified transcription of factors of wound healing may serve as the first vague discriminator between fibrosis as a result of deregulated wound healing itself, versus fibrosis as a result of intensified inflammation. The first attempts to analyze gene expression patterns in pulmonary fibrosis in animal models demonstrate the power of this tool to discriminate between the fibrotic process itself and accompanying mechanisms *(Kaminski et al., Proc Natl Acad Sci U S A 2000 Feb 15;97(4):1778-83 Global analysis of gene expression in pulmonary fibrosis reveals distinct programs regulating lung inflammation and fibrosis; Katsuma et al., Biochem Biophys Res Commun 2001 Nov 9;288(4):747-51 Molecular monitoring of bleomycin-induced pulmonary fibrosis by cDNA microarray-based gene expression profiling)*. A medication which combines the molecular diagnosis (transcription analysis in diseased ILD patients compared to control populations - healthy individuals or patients suffering from different lung diseases - with a distinct quantitative, specific expression difference to those) with proven effectiveness of a antifibrotic drug like IFN-γ or pirfenidone under clinical conditions provides the essential step for the first bio-medical based treatment of these multifunctional diseases.

To sum up, the real effectiveness of IFN-γ therapy mainly depends on four conditions:

(a) the proof of IFN-γ deficiency in pulmonary tissue;

(b) the control of infections or other inflammatory conditions, either pre-existing or acquired during therapy;

(c) the gene expression profiling of the patients suspected to have an interstitial lung disease;

(d) the duration of disease-related symptoms, reflecting the extent of completed scarring.

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Clinical experience suggests that repeated phases of increased inflammation due to a large variety of infectious agents are the most common reason for a failure of IFN-γ in the treatment of ILD. Thus, clinical and molecular control of inflammation and infections, especially in the peripheral bronchi is crucial for a success of an anti-fibrotic treatment with IFN-γ.

Thus it is goal of the work of the present invention to improve the treatment of lung diseases, especially ILD and its various subforms with novel pharmaceuticals using either pirfenidone or IFN-γ in pharmaceutical composition with a diagnostic array of candidate polynucleotides (genechip).

Disease-related gene expression profiles

With the completion of the Human Genome Project sequencing, biomedical research will be revolutionised by the ability to carry out investigations on a genome wide scale:

Arch Ophthalmol 2001 Nov;119(11):1629-34
Microarray analysis of gene expression in human **donor corneas**.

Jun AS et al.
Ann Surg 2001 Dec;234(6):769-78; discussion 778-9
Identification of disease-specific genes in **chronic pancreatitis** using DNA array technology.
Friess H et al.

DNA Cell Biol 2001 Nov;20(11):683-95
A gene expression profile of **Alzheimer's disease**.
Loring JF et al.

Pharmacogenomics J 2001;1(4):272-87
Molecular classification of **psoriasis** disease-associated genes through pharmacogenomic expression profiling.

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Oestreicher JL et al.

Gene expression technology is gaining increasingly widespread use as a means to determine the expression of potentially all human genes at the level of messenger RNA. Gene specific sequences (oligo-, polynucleotides or cDNAs) are immobilised on arrays, hybridised with complex probes represented by a mixture of cDNAs of respective samples from human biopsies and other human materials (reversely transcribed from messenger RNA), and labelled with different dyes. Hybridised slides are analysed with sensitive scanning methodologies. Genechips containing gene sequences deliver fast and excellent overview of the expression pattern of the biological samples. Thus, the genome-wide gene expression analysis provides new insights into causes of disease, and elucidates the as yet unknown biological gene expression variations between seemingly similar diseases in defined detection ranges, leading to a new classification system valuable in accurate diagnosis.

Important applications include:

(a) development of a more global understanding of the qualitative and quantitative gene expression profiles that contribute to disease processes;

(b) discovery of new diagnostic and prognostic indicators and biomarkers of therapeutic response;

(c) identification and validation of new molecular targets for drug development;

(d) provision of an improved understanding of the molecular mode of action during lead identification and optimisation;

(e) designing more specific and efficient treatment strategies;

(f) prediction of potential side-effects during development and toxicology studies;

(g) confirmation of molecular modes of action during hypothesis-testing clinical trials;

(h) identification of genes involved in conferring drug sensitivity and resistance;

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(i) prediction of patients most likely to benefit from the drug and use in general pharmacogenomic studies.

As a result of further technological improvements, array-based genechips will become essential part for clinical interventions in identifying and quantifiying individual gene-expression patterns for purposes of patient-oriented therapy, and in establishing a method for predicting efficacy of drugs for individual patients, given the functional complexity of most diseases, especially those involving fibroproliferative processes. Considering the fact that inflammatory diseases reflect qualitative and quantitative changes in the activity of certain genes and/or gene clusters, the molecular assessment will allow for a higher specificity and efficacy of medical treatments and will be considered integral part of the therapeutic composition.

To achieve this goal, new molecular markers and markers of progression are needed for improved staging and for better assessment of diagnosis and treatment of complex diseases. Gene expression profiling techniques in combination with therapeutics offer the opportunity to discover such pathophysiologically relevant markers of disease.

In the context of this disclosure, a number of terms shall be utilized.

The term "polynucleotide" refers to a polymer of RNA or DNA that is single-stranded, optionally containing synthetic, non-natural or altered nucleotide bases. A polynucleotide in the form of a polymer of DNA may be comprised of one or more segments of cDNA, genomic DNA or synthetic DNA.

The term "subsequence" refers to a sequence of nucleic acids that comprises a part of a longer sequence of nucleic acids.

The term "immobilized on a support" means bound directly or indirectly thereto including attachment by covalent binding,

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hydrogen bonding, ionic interaction, hydrophobic interaction or otherwise.

An aspect of the invention relates to polynucleotide arrays, which allows to qualitatively and quantitatively study mRNA expression levels of selected candidate genes in human materials.

Polynucleotide or DNA arrays consist of large numbers of DNA molecules spotted in a systematic order on a solid support or substrate such as a nylon membrane, glass slide, glass beads or a silicon chip. Depending on the size of each DNA spot on the array, DNA arrays can be categorized as microarrays (each DNA spot has a diameter less than 250 microns) and macroarrays (spot diameter is grater than 300 microns). When the solid substrate used is small in size, arrays are also referred to as DNA chips. Depending on the spotting technique used, the number of spots on a glass microarray can range from hundreds to tens of thousands.

DNA microarrays serve a variety of purposes, including gene expression profiling, de novo gene sequencing, gene mutation analysis, gene mapping and genotyping. cDNA microarrays are printed with distinct cDNA clones isolated from cDNA libraries. Therefore, each spot represents an expressed gene, since it is derived from a distinct mRNA.
Typically, a method of monitoring gene expression involves providing

(1) a pool of sample polynucleotides comprising RNA transcripts of target genes or nucleic acids derived from the RNA transcripts;

(2) hybridizing the sample polynucleotides or nucleic acids derived from the RNA transcripts to an array of probes (for example, polynucleotides obtained from a polynucleotide library including control probes, and

(3) detecting the hybridized double-stranded polynucleotides/nucleic acids. The label used to mark polynucleotide samples is selected from the group consisting

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of radioactive, colorimetric, enzymatic, molecular amplification, bioluminescent or fluorescent label.

The invention relates also to any polynucleotide library as previously described wherein said polynucleotides are immobilized on a solid support in order to form a polynucleotide array.

Preferably the support is selected from the group consisting of a nylon membrane, glass slide, glass beads, or a silicon chip.

The invention relates to a polynucleotide library useful in the molecular characterization of a fibrotic interstitial lung disease like Idiopathic Pulmonary Fibrosis (IPF), the library including a pool of polynucleotide sequences or subsequences thereof wherein the sequences or subsequences are either underexpressed or overexpressed in IPF diseased cells.

Preferably, a set of sequences is selected from oligo- or polynucleotide probes having a sequence defined by, or correlated to, or derived from the group of genes consisting of candidate genes indicated in the following list, representing increased gene expression levels of IPF cells versus cells from patients with a different lung disorder:

PTH-responsive osteosarcoma B1 protein, AF095771.1

matrix associated, actin dependent regulator of chromatin, subfamily f, member 1, AF231056.1

deleted in lung and esophageal cancer 1 (DLEC1), NM_007337.1

major histocompatibility complex, class II, DQ beta 1, AW276186

SB classII histocompatibility antigen alpha-chain, AI128225

mucin 4, tracheobronchial, AJ242547.1

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forkhead box J1 (FOXJ1), U69537.1

hypothetical protein FLJ21616, NM_024567.1

neuronal specific transcription factor DAT1, AF258348.1

hematopoietic PBX-interacting protein, BF344265

proline oxidase homolog, AA074145

mucin 5, subtype B, tracheobronchial, AI697108

golgi membrane protein GP73, AF236056.1

ATP citrate lyase, U18197.1

NG22 protein, NM_025257.1

cDNA DKFZp434A2322, AL137706.1

hepatocyte nuclear factor 3, alpha, U39840.1

major histocompatibility complex, class II, DQ alpha 1, X00452.1

myosin regulatory light chain 2, smooth muscle isoform, J02854.1

plexin B1, AV693216

pyruvate kinase, muscle, BC000481.1

tetraspanin TM4-C, AF133425.1

insulin-like growth factor binding protein 2 (36kD), BC004312.1

FLJ13945 fis, clone Y79AA1000969, AU160041

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hypothetical protein DKFZp586M1120, NM_031294.1

CD24 signal transducer, L33930

hypothetical protein FLJ23571, NM_025111.1

glutathione S-transferase M2 (muscle), M63509.1

cadherin 1, type 1, E-cadherin (epithelial), L08599.1

NTT5 protein, AF265578.1

lipocalin 2 (oncogene 24p3), NM_005564.1

myotonic dystrophy kinase (DM kinase), L08835

uncoupling protein 2 (mitochondrial, proton carrier), U76367.1

dynein intermediate chain 2, NM_023036.1

discoidin receptor tyrosine kinase isoform b, discoidin domain receptor family, member 1, NM_001954.2

sperm associated antigen 6, AF079363.1

hypothetical protein FLJ23049, NM_024687.1

nasopharyngeal epithelium specific protein 1, AF094758.1

nuclear receptor subfamily 4, group A, member 2, NM_006186.1

hypothetical protein FLJ22215, BC003543.1

non-specific cross reacting antigen, M18728.1

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amylase, alpha 1A; salivary (AMY1A), NM_004038.1

carcinoembryonic antigen-related cell adhesion molecule 6 (non-specific cross reacting antigen), BC005008.1

glutathione S-transferase subunit 4 (EC 2.5.1.18), X08020.1

SH3-containing protein SH3GLB2, AF257319.1

KDEL (Lys-Asp-Glu-Leu) endoplasmic reticulum protein retention receptor 1, NM_006801.1

anterior gradient 2 (Xenepus laevis) homolog, AF038451.1

sv7-MUC4 apomucin, mucin 4, tracheobronchial, AJ242547.1

stratifin, BC000329.1

connective tissue growth factor, M92934.1

cytochrome P450-IIB (hIIB3), M29873.1

filamin A, alpha (actin-binding protein-280), AW051856

membrane glycoprotein LIG-1, AB050468.1

E74-like factor 3 (ets domain transcription factor, epithelial-specific), U73844.1

elastin (supravalvular aortic stenosis, Williams-Beuren syndrome), M36860.1

ephrin receptor EPHA3, AF213459.1

fibrillin 1 (Marfan syndrome), L13923.1

discs, large (Drosophila) homolog 1, U13896.1

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lysyl oxidase-like 1 (LOXL1), L21186.1

calumenin, U67280.1

male germ cell-associated kinase, NM_005906.2

plectin 1, intermediate filament binding protein, 500kD, Z54367

peroxisome biogenesis factor 1, AF026086.1

mast cell tryptase beta III, AF099143

ataxia-telangiectasia group D-associated protein, AF230388.1

hypothetical protein FLJ10921, NM_018272.1

biglycan, BC002416.1

BLu protein, AC002481

CGI-92 protein, AF151850.1

adaptor-related protein complex 1, mu 2 subunit, BC003387.1

keratin 15, BC002641.1

B7 protein, U72508.1

S100 calcium-binding protein A2, BC002829.1

MUF1 protein, BC004953.1

cholesterol 25-hydroxylase, AF059214.1

cytidine monophosphate-N-acetylneuraminic acid hydroxylase (CMP-N-acetylneuraminate monooxygenase), AF074480.1

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neuropilin 2, AF022859.1

Fas-interacting serinethreonine kinase 3, homeodomain-interacting protein kinase 3, AF305239.1

a disintegrin and metalloproteinase domain 28 (ADAM28), transcript variant 2, AF137334.1

cDNA DKFZp434A119 , AW663632

complement component 6, J05064.1

cytokeratin 17, Z19574

wingless-type MMTV integration site family, member 5A, AI968085

matrix metalloproteinase 7 (matrilysin, uterine), BC003635.1

leiomodin 1 (smooth muscle), NM_012134.1

Cip1-interacting zinc finger protein, AB030835.1

cyclin-dependent kinase inhibitor 1A (p21, Cip1), BC000275.1

integrin, alpha 7, AF032108.1

DKFZP586G011 protein, BG289527

fatty acid binding protein 6, ileal (gastrotropin), U19869.1

glutathione S-transferase M4, M96234.1

Ras-related associated with diabetes, L24564.1

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claudin 3, AB000714.1

matrix metalloproteinase 10 (stromelysin 2), BC002591.1

fibulin 2, NM_001998.1

serine threonine kinase 11 (STK11), AF035625

eukaryotic translation initiation factor 1A: AF000987.1

DEADH (Asp-Glu-Ala-AspHis) box polypeptide: AF000985.1

ribosomal protein S4: AF116711.1

ubiquitin specific protease 9: AF000986.2

SMC (mouse) homolog: U52191.1

myelin basic protein: L18865.1

S100 calcium-binding protein: NM_005980.1

Jagged2 (JAG2): AF003521.1

latent transforming growth factor beta binding protein 4: NM_003573.1

microtubule-associated protein, RPEB family, member 3: AB025186.1

Unknown (protein for MGC:2854): BC003629.1

clone=IMAGE-2406340: AI830563

AQP3 gene for aquaporine 3 (water channel): AB001325

cDNA DKFZp434A119

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fenestrated-endothelial linked structure protein (FELS), PV1 protein (PLVAP): AF326591.1

LUNX protein; PLUNC (palate lung and nasal epithelium clone); tracheal epithelium enriched protein (LOC51297): AB024937.1

RAB, member of RAS oncogene family-like 2A: AF095350.1

chromosome 11 open reading frame 16: NM_020643.1

hypothetical protein FLJ23049: NM_024687.1

hypothetical protein FLJ11767: NM_024593.1

dynein, axonemal, intermediate polypeptide: AF091619.1

brain specific protein (LOC51673): AF132972.1

MUC4 apomucin, mucin 4, tracheobronchial: AJ242547.1

myotonin protein kinase (DM): M87313.1

cytokeratin 4: X07695.1

KIAA0362 gene, MCF.2 cell line derived transforming sequence-like: AB002360.1

cytokeratin 17: Z19574

LIM domain protein: BC003096.1

E74-like factor 3 (ets domain transcription factor, epithelial-specific) : U73844.1

fatty acid binding protein 6, ileal (gastrotropin): U19869.1

sperm associated antigen 6: AF079363.1

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eyes absent (Drosophila) homolog 2: U71207.1

phosphatidic acid phosphatase type 2C: BC002806.1

epoxide hydrolase 2, cytoplasmic: AF233334.1

tubulin, beta, 2: BC002783.1

heat shock 105kD: D86956.1

villin 2 (ezrin): J05021.1

a disintegrin and metalloproteinase domain 28 (ADAM28), transcript variant 3: AF137335.1

deleted in lung and esophageal cancer 1: NM_007337.1

arachidonate 15-lipoxygenase: NM_001140.1

UDP glycosyltransferase 1 family, polypeptide A1: M57899.1

hypothetical protein PRO2834: AF119903.1

lectin, galactoside-binding, soluble, 7 (galectin 7): L07769.1

B7 protein: U72508.1

ephrin receptor EPHA3: AF213459.1

forkhead box J1: U69537.1

BLu protein: U70824.1

aldehyde dehydrogenase 3 family, member A1: BC004370.1

NG22 protein: NM_025257.1

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small inducible cytokine subfamily A (Cys-Cys), member 14: NM_004166.1

cysteine-rich protein 1 (intestinal): BC002738.1

putative GTP-binding protein similar to RAYRAB1C: BC000566.1

integrin, beta 4: NM_000213.1

serine (or cysteine) proteinase inhibitor, clade B (ovalbumin), member 5 (SERPINB5): U04313.1

Ras-related associated with diabetes: L24564.1

hepatic leukemia factor: M95585.1

keratin 15: BC002641.1

nuclear receptor subfamily 4, group A, member 2: NM_006186.1

sialyltransferase: U14550.1

glutathione S-transferase M2 (muscle): M63509.1

hypothetical protein FLJ13110: NM_022912.1

S100 calcium-binding protein A2: NM_005978.2

collagen, type VII, alpha 1 (epidermolysis bullosa, dystrophic, dominant and recessive) : L02870.1

claudin 3: AB000714.1

insulin-like growth factor binding protein 6: BC003507.1

fibroblast growth factor receptor 2 (bacteria-expressed kinase, keratinocyte growth factor receptor, craniofacial dys-

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ostosis 1, Crouzon syndrome, Pfeiffer syndrome, Jackson-Weiss syndrome): M80634.1

insulin-like growth factor 1 receptor: NM_000875.2

insulin-like growth factor binding protein 2 (36kD): M35410.1

ataxia-telangiectasia group D-associated protein: AF230388.1

keratin 5 (epidermolysis bullosa simplex, Dowling-MearaKobnerWeber-Cockayne types): M21389.1

Duffy blood group: U01839.1

transforming growth factor β_1: NM_000660

wherein each oligo- or polynucleotide probe is obtainable on the basis of structural information mediated by the sequence data provided by the respective accession number set out for each candidate gene.

Yet another set of sequences is selected from oligo- or polynucleotide probes having a sequence defined by, or correlated to, or derived from the group of genes consisting of candidate genes indicated in the following list, representing decreased gene expression levels of IPF cells versus cells from patients with different lung disorder:

sorting nexin 10 (SNX10), AF121860.1

phospholipase A2, group IIA (platelets, synovial fluid), M22430.1

hemoglobin alpha-1 globin chain (HBA1), AF349571.1

macrophage scavenger receptor 1, AI299239

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surfactant, pulmonary-associated protein C, BC005913.1

disintegrin protease (M12.219), NM_014479.1

retinol-binding protein 4, interstitial, AF119868.1

major histocompatibility complex, class II, DR beta 3, M27635.1

adipose differentiation-related protein, BC005127.1

hemoglobin, delta, NM_000519.2

beta-2-microglobulin, AW188940

hemoglobin, alpha 2, BC005931.1

protein C receptor, endothelial (EPCR), L35545.1

thymosin, beta 10, M92381.1

apolipoprotein C-I, W79394

hypothetical protein, AL133067.1

proteoglycan 4, (megakaryocyte stimulating factor, articular superficial zone protein), U70136.1

tetranectin (plasminogen-binding protein), NM_003278.1

platelet factor 4, M25897.1

tissue factor pathway inhibitor 2, BC005330.1

fatty acid binding protein 4, adipocyte, BC003672.1

cathepsin B (CTSB), M14221.1

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transmembrane 4 superfamily member 1, M90657.1

MHC class I HLA-B51 major histocompatibility complex, class I, E, M31183.1

endothelial PAS domain protein 1, U51626.1

Apo-2 ligand tumor necrosis factor (ligand) superfamily, member 10, U37518.1

haptoglobin-related protein, NM_020995.1

Rho guanine exchange factor (GEF) 12, AF119898.1

major histocompatibility complex, class II, DR beta 5, M11867.1

interferon, gamma-inducible protein 30, AF097362.1

ferritin, light polypeptide, BG537190

prosaposin (variant Gaucher disease and variant metachromatic leukodystrophy), BC004275.1

calcium-binding protein A4 (calvasculin, metastasin,), NM_002961.2

hemoglobin, beta, M25079.1

CDW52 antigen (CAMPATH-1 antigen), BC000644.1

aldehyde dehydrogenase 1 family, member A2, AB015226.1

cathepsin Z, AF032906.1

MHC HLA-B39 major histocompatibility complex, class I, B, L37880.1

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major histocompatibility complex, class II, DQ alpha 1, M33906.1

fibroblast growth factor 9 (glia-activating factor), D14838.1

hemoglobin, alpha 2, AF097635.1

transferrin receptor (p90, CD71), BC001188.1

complement component 3 (C3), K02765.1

cDNA DKFZp564D066, AL050025.1

complement component 1, q subcomponent, beta polypeptide, NM_000491.2

small inducible cytokine subfamily A (Cys-Cys), member 18, pulmonary and activation-regulated, AB000221.1

reticulon 1, L10333.1

major histocompatibility complex, class II, DR beta 1, M33600.1

haptoglobin, L29394.1

acid phosphatase 5, tartrate resistant, J04430.1

cytochrome P450, subfamily XXVIIA (steroid 27-hydroxylase, cerebrotendinous xanthomatosis), polypeptide 1, M62401.1

CD36 antigen (collagen type I receptor, thrombospondin receptor), M24795.1

calbindin 2, (29kD, calretinin), NM_001740.2

alpha-2-HS-glycoprotein, BG538564

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cDNA DKFZp564A132, AL049963.1

fibronectin 1, AF130095.1

phosphodiesterase 4C, cAMP-specific, NM_000923.1

transcription factor 7 (T-cell specific, HMG-box), NM_003202.1

found in inflammatory zone 3 (FIZZ3), AF323081.1

claudin 15, NM_014343.1

carboxypeptidase B1 (tissue), M81057.1

hypothetical protein FLJ14054, NM_024563.1

bone marrow stromal cell antigen 1, D21878.1

interleukin 7 receptor, M29696.1

procollagen C-endopeptidase enhancer 2, AF098269.1

calcium-binding protein A8 (calgranulin A), AW238654

cDNA DKFZp564D193, AL049252.1

major histocompatibility complex, class II, DP beta 1, J03041.1

human leukocyte antigen C alpha chain, major histocompatibility complex, class I, C, AK024836.1

BCM-like membrane protein precursor, AF144235.1

CD14 antigen, M86511.1

pulmonary surfactant protein (SP5), J03553

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signal transducer and activator of transcription 1, 91kD, BC002704.1

Wilms tumor 1 (WT1), transcript variant D, NM_024424.1

annexin A8, BC004376.1

macrophage receptor with collagenous structure, MARCO, AF035819.1

surfactant, pulmonary-associated protein A2, NM_006926.1

solute carrier family 6 (neurotransmitter transporter, serotonin), member 4, L05568.1

chitinase 1 (chitotriosidase), U29615.1

lung type-I cell membrane-associated glycoprotein, AU154455

fibronectin leucine rich transmembrane protein 2, AB007865.1

gamma-aminobutyric acid (GABA) A receptor, alpha 5, BF966183

hypothetical protein FLJ12983, NM_024856.1

sialophorin (gpL115, leukosialin, CD43), J04536.1

cerebellar degeneration-related protein (34kD), M16965.1

hydroxyacid oxidase 2 (long chain), hydroxy-delta-5-steroid dehydrogenase (3 beta-and steroid delta-isomerase 2), AL359553

CLONE=IMAGE:1032795=Hs.83623 nuclear receptor subfamily 1, group I, member 3

small inducible cytokine subfamily C, member 2: NM_003175.1

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hypothetical protein similar to swine acylneuraminate lyase: NM_030769.1

fibrinogen, gamma polypeptide: AF118092.1

thrombospondin 1: NM_003246.1

SAM domain, SH3 domain and nuclear localisation signals, 1: AF222927.1

chitinase 3-like 1 (cartilage glycoprotein-39): M80927.1

cathepsin Z: AF032906.1

CLONE=IMAGE:3579023 collagen, type XIV, alpha 1 (undulin)

chloride intracellular channel 2: NM_001289.2

monokine induced by gamma interferon: NM_002416.1

KIAA0433 protein: NM_015216.1

tumor necrosis factor, alpha-induced protein 6: NM_007115.1

signal transducer and activator of transcription 1, 91kD: BC002704.1

thrombospondin 2: L12350.1

collagen, type IV, alpha 3 (Goodpasture antigen): NM_000091.1

integrin, beta-like 1 (with EGF-like repeat domains): AF072752.1

diubiquitin: NM_006398.1

protease, cysteine, 1 (legumain): D55696.1

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cytochrome P450, subfamily I (dioxin-inducible), polypeptide 1 (glaucoma 3, primary infantile): U03688.1

integrin, alpha 1: X68742.1

GABA-B receptor, G protein-coupled receptor 51: AF056085.1

KIAA1199 protein: AB033025.1

collagen, type V, alpha 2: NM_000393.1

interleukin 13 receptor, alpha 2: U70981.1

translocase of inner mitochondrial membrane 8 (yeast) homolog A: BC005236.1

steroid sulfatase (microsomal), arylsulfatase C, isozyme S: M16505.1

CLONE=IMAGE:1982571 ATPase, H+ transporting, lysosomal (vacuolar proton pump) 9kD

proteoglycan 4, (megakaryocyte stimulating factor, articular superficial zone protein): U70136.1

nidogen (enactin): M30269.1

KIAA1598 protein: AU157109

vascular cell adhesion molecule 1: M60335.1

guanylate binding protein 1, interferon-inducible, 67kD: BC002666.1

cDNA DKFZp586E1124

apolipoprotein H (beta-2-glycoprotein I): M62839.1

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ribosomal protein L37a: BE857772

cDNA DKFZp564A132

cathepsin S: M86553.1

a disintegrin and metalloproteinase domain 9 (meltrin gamma) (ADAM9): U41766.1

zinc finger protein 331: AF272148.1

lysosomal-associated membrane protein 2: J04183.1

carboxypeptidase M: NM_001874.1

collagen, type I, alpha 2: NM_000089.1

P311 protein: U36189.1

KIAA0372 gene product: AB002370.1

Human T cell-specific protein RANTES: M21121

interferon-gamma-inducible indoleamine 2,3-dioxygenase (IDO): M34455.1

hypothetical protein FLJ10430: NM_018092.1

transcription factor ISGF-3: M97935

interleukin 1 receptor-like 1 (IL1RL1): NM_003856.1

putative alpha chemokine (H174), small inducible cytokine subfamily B (Cys-X-Cys), member 11: AF002985.1

small inducible cytokine subfamily B (Cys-X-Cys), member 10: NM_001565.1

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mesoderm specific transcript (mouse) homolog: BC002413.1

carboxypeptidase B-like protein: AB011969.1

CD2 antigen (p50), sheep red blood cell receptor: M16445.

interferon, alpha-inducible protein (clone IFI-6-16): NM_022872.1

RAS guanyl releasing protein 1 (calcium and DAG-regulated): AF081195.1

lipase, endothelial: AF118767.1

fatty-acid-Coenzyme A ligase, long-chain 4: NM_022977.1

klotho: AB005142.1

chondroitin sulfate proteoglycan 2 (versican): NM_004385.1

hypothetical protein, expressed in osteoblast: AB000115.1

CD14 antigen: M86511.1

CGI-83 protein: BC000878.1

leucine aminopeptidase: AF061738.1

UDP-Gal:betaGlcNAc beta 1,3-galactosyltransferase, polypeptide 3: AB050855.1

protocadherin alpha 12: AF152308.1

neuroglycan C: AF059274

neuroligin: AI338338

HSPC156 protein: AF161505.1

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hypothetical protein FLJ13310: NM_025118.1

eosinophil chemotactic cytokine (TSA1902): AB025008.1

aminopeptidase: AF191545.1

semaphorin sem2: AB029496.1

protocadherin 12: AF231025.1

X transporter protein 3: NM_020208.1

transmembrane 4 superfamily member (tetraspan NET-2): AF124522.1

hypothetical protein FLJ10970: NM_018286.1

perforin 1 (pore forming protein): M28393.1

natural killer cell group 7 sequence: NM_005601.1

hypothetical protein DKFZp761N09121: BF435376

integrin, alpha 4 (antigen CD49D, alpha 4 subunit of VLA-4 receptor): BG532690

chitinase 3-like 2: U58515.1

FYN oncogene: N20923

relaxin 1 (H1): BC005956.1

hydroxyprostaglandin dehydrogenase 15-(NAD): U63296.1

sulfotransferase family, cytosolic, 1C, member 1: AF186254.1

TGF-b superfamily receptor type I: L17075.1

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granzyme B (granzyme 2, cytotoxic T-lymphocyte-associated serine esterase 1): M36118.1

cystatin F (leukocystatin): AF031824.1

regulator of G protein signaling-Z (RGSZ1): AF060877.2

clone MGC:12387: M16942.1

zinc-alpha2-glycoprotein: D90427.1

BCG induced integral membrane protein BIGMo-103: AB040120.1

nectin-like protein 2 (NECL2): AF132811.1

CD209 antigen-like: AB015629.1

solute carrier family 6 (neurotransmitter transporter, serotonin), member 4: L05568.1

MAD (mothers against decapentaplegic, Drosophila) homolog 6: U59914.1

latrophilin: AF104939.1

platelet factor 4: M25897.1

calcitonin receptor-like: L76380.1

matrilin 3: NM_002381.2

solute carrier family 14 (urea transporter), member 1 (Kidd blood group): U35735.1

interleukin 7 receptor: M29696.1

MAP kinase kinase 6 (MKK6), mitogen-activated protein kinase kinase 6: U39656.1

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protocadherin 17: AF029343.1

granulysin: NM_006433.2

interferon-stimulated protein, 15 kDa (ISG15): M13755.1

cadherin 5, type 2, VE-cadherin (vascularepithelium): U84722.1

thrombomodulin: M16552.1

interferon, alpha-inducible protein 27: NM_005532.1

interferon-gamma: X87308

wherein each oligo- or polynucleotide probe is obtainable on the basis of structural information mediated by the sequence data provided by the respective accession number set out for each candidate gene.

For example, suitable sequences which may be used for oligonucleotide design may be downloaded from the NCBI GenBank (http://www.ncbi.nlm.gov/GenBank/index.html) using the Accession number listed behind the gene name.

All accession numbers give access to mRNA sequences; since the cDNA of the patients is reverse transcribed, the oligonucleotide have to sense strand and are therefore identical with the mRNA sequence.

Preferably the pool of polynucleotide sequences or subsequences correspond substantially to the polynucleotide sequences useful in qualitative and quantitative differentiating a normal cell, or a cell from a patient suffering from non-fibrosing lung disease, from a cell of an patient with interstitial lung disease, most preferably with Idiopathic Pulmonary Fibrosis (IPF).

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The invention concerns the part of pharmaceutical composition for detecting differentially expressed polynucleotide sequences which are correlated with IPF, said part comprising: a) obtaining a polynucleotide sample from a patient; and b) reacting the sample polynucleotide obtained in step (a) with a probe immobilized on a solid support wherein said probe comprises any of the polynucleotide sequences of the libraries previously described or an expression product encoded by any of the polynucleotide sequences of said libraries and c) detecting the reaction product of step (b) as a prerequisite for a subsequent administration of suitable drug.

The invention relates also to the part of pharmaceutical composition detecting differentially expressed polynucleotide sequences of the invention wherein the amount of reaction product of step (c) is compared to control samples.

The detection of differentially expressed polynucleotide sequences is used for detecting, diagnosing, staging, monitoring, prognosticating, preventing or treating conditions associated with ILD, and namelly idiopathic pulmonary fibrosis IPF, hypersensivity pneumonitis, scleroderma, Systemic Lupus Erythematosus, Rheumatoid Arthritis, Churg-Strauss syndrome, Wegener's granulomatosis, and Goodpasture Syndrome.

The detection of differentially expressed polynucleotide sequences is particular useful wherein the product encoded by any of the polynucleotide sequences or subsequences is involved in a receptor-ligand reaction on which detection is based.

The invention relates also to detecting differentially expressed polynucleotide sequences previously described wherein the sample has been treated with the anti-ILD drug to be screened.

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The invention also relates to a library of polynucleotides comprising a population of polynucleotide sequences overexpressed or underexpressed in cells derived from ILD patients. A particular embodiment of the invention relates to a polynucleotide library of corresponding substantially to any combination of at least one polynucleotide sequence selected among those included in each one of predefined polynucleotide sequences sets mentioned above.

The invention relates to polynucleotide libraries comprising at least one polynucleotide selected among those included in at least 50%, preferably 75% and more preferably 100% of said predefined sets, allowing to obtain a discriminating gene pattern, namely to distinguish between normal individuals and patients suffering from ILD, particularly from IPF.

Polynucleotide sequences library useful for the realization of the invention can comprise also any sequence comprised between 3'-end and 5'-end of each polynucleotide sequence sets as defined above, allowing the complete detection of the implicated genes.

The invention relates also to a polynucleotide library useful to differentiate a normal cell from a cell of ILD patients wherein the pool of polynucleotide sequences or subsequences correspond substantially to any combination of at least one polynucleotide sequence selected among those included in each one of predefined polynucleotide sequences sets indicated above, useful in differentiating a normal cell from a cell from ILD patients.

Differences in gene expression are accepted as different when the signals from patient material are at least two fold lower or higher than those from comparative material, be it from

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healthy volunteers material or from other diseased material. This threshold is commonly accepted for the evaluation of expression arrays.

The invention additionally provides a method for identifying gene expression or genomic DNA of infective agents including bacteria (Mycobacterium spec., Mycoplasma spec., Staphyllococcus aureus, treptococcus spec., Borrelia, Treponema pallidum, Leptospira interrogans, Campylobacter jejuni, fetus; Escherichia coli, EPEC, ETEC, EIEC, EHEC Salmonella enterica, Yersinia enterocolitica, Aeromonas spec., Campylobacter fetus, Moraxella catarrhalis, Moraxella catarrhalis, Brucella spec., Toxoplasma, Salmonella enterica, Shigella spec., Yersinia enterocolitica, Vibrio cholerae, Pseudomonas aeruginosa, Burkholderia cepacia, Stenotrophomonas maltophilia, Acinetobacter baumanii, Acitenobacter calcoaceticus, Klebsiella, Enterobacter, Citrobacter, Proteus, Serratia, Morganella, Providencia, Cardiobacterium hominis, Eikenella corrodens, Gardnerella vaginalis, Calymmatobacterium granulomatis, Bacteriodes, Porphyromonas, Prevotella, Fusobacterium, Rickettsia prowazekii, Bartonella bacilliformis, Bartonella henselae and Chlamydia spec.), yeasts, fungi, or viruses (retroviruses, adenoviruses, hepadnaviruses, herpesviruses, influenza viruses, paramyxoviruses) as cellular parasites in cells from patients with ILD.

SUMMARY OF THE INVENTION

It was surprisingly found that a pharmaceutical composition of interferon gamma together with a gene expression analysis of the patients with lung diseases results in a faster and more successful treatment of lung diseases, preferably ILD and ILD related lung diseases. Thus, the invention relates to

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new pharmaceutical compositions and pharmaceutical kits comprising interferon gamma or pirfenidone and a disease-oriented gene expression analysis.

To sum up and in more detail, the invention relates to the following topics:

- A pharmaceutical composition comprising (i) interferon gamma (IFN-γ), pegylated (PEG) IFN-γ), or pirfenidone, optionally together with a pharmaceutically acceptable carrier, diluent or excipient, (ii) a gene expression analysis of patients with interstitial lung disease (genechip);
- a corresponding pharmaceutical composition, comprising additionally a glucocorticoid compound;
- a corresponding pharmaceutical composition, wherein the medication is selected from the following group:
- a pharmaceutical kit comprising

(i) a package comprising IFN-γ, PEG-IFN-γ, or pirfenidone,

(ii) a package comprising a gene expression analysis (genechip) of the patient with lung disease;

- a corresponding pharmaceutical kit further comprising a package comprising a glucocorticoid compound;
- a method or a use of a combination of a pharmaceutical composition or a pharmaceutical kit according as specified for the manufacture of a medicament for the treatment of interstitial lung diseases (ILD);
- a corresponding method or use, wherein IFN-γ is administered to the individual in a single dose amount varying from 2.0 to 3.0 µg / kg body weight;
- a corresponding method or use, wherein the glucocorticoid compound is administered to the individual in a

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single dose amount varying from 100 to 150 µg / kg body weight;

- a corresponding method or use, wherein IFN-γ is administered to the individual by inhalation after a gene expression analysis.

DETAILED DESCRIPTION

Suitable compounds which have the therapeutic effect within the combination according to the invention, are, besides interferon gamma, pegylated interferon gamma, perfinidone, compounds which have the same, but also enhanced, biological activity of interferon gamma, pegylated interferon gamma, or pirfenidone in combination with the gene expression analysis of diseased patients.

The invention includes also derivatives, analogues, homologues, fusion proteins, stabilized forms, etc., of the disclosed drugs, as more specified above, which have the same biological activity as interferon gamma, or pirfenidone.

The term "**same biological activity**" means herein the same substantial biological, physiological or therapeutic activity or functionality, which however can be quantitatively enhanced or reduced compared with the relevant properties of said drugs.

The term "**stabilized form**" means a derivative or analogue wherein the parent drug was altered in order get more stability and increased half-life in blood and serum. Polypeptides and proteins may be protected against proteolysis by the attachment of chemical moieties. Such attachment may effectively block the proteolytic enzyme from physical contact with the protein backbone itself, and thus prevent degradation. Polyethylene glycol is one such chemical moiety which has been shown to protect against proteolysis (Sada, et al.,

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J. Fermentation Bioengineering 71: 137-139, 1991). In addition to protection against proteolytic cleavage, chemical modification of biologically active proteins has been found to provide additional advantages under certain circumstances, such as increasing the stability and circulation time of the therapeutic protein and decreasing immunogenicity. (US. 4,179,337; Abuchowski et al., Enzymes as Drugs.; J.S. Holcerberg and J. Roberts, eds. pp. 367-383, 1981; Francis, *Focus on Growth Factors* 3: 4-10; EP 0 401 384). The addition of polyethylene glycol increases stability of the peptides and polypeptides of this invention at physiological pH as compared to non-pegylated compounds. The pegylated polypeptide /protein is also stabilized with regard to salts.

The term "**fusion protein**" means a compound, especially a stabilized form, consisting of a polypeptide according to the invention, preferably interferon gamma, which is fused to another peptide or protein.

The term "**pharmaceutical kit**" means a package comprising two or more packages or containers containing one or more, preferably one pharmaceutically active compound or agent and a gene expression analysis device, wherein the agent or compound in said packages or containers are administered to an individual after gene expression analysis is performed.

The pharmaceutical compositions according to the invention comprising interferon gamma or pirfenidone and a gene expression analysis as defined above and below can be used as medicament for the treatment of an individual.

The term "**individual**" preferably refers to mammals, especially humans.

The compound according to this invention, IFN-γ or pirfenidone, is used in a pharmaceutical formulations, comprising, as a rule, a pharmaceutically acceptable carrier, excipient or diluents. Techniques for the formulation and administra-

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tion of the compounds of the present invention may be found in "Remington's Pharmaceutical Sciences" Mack Publishing Co., Easton PA.

As used herein, the term **"pharmaceutically acceptable carrier"** means an inert, non toxic solid or liquid filler, diluent or encapsulating material, not reacting adversely with the active compound or with the individual, or any other formulation such as tablets, pills, dragees, capsules, gels, syrups, slurries, suspensions and the like. Suitable, preferably liquid carriers are well known in the art such as sterile water, saline, aqueous dextrose, sugar solutions, ethanol, glycols and oils, including those of petroleum, animal, vegetable, or synthetic origin, for example, peanut oil, soybean oil and mineral oil. Tablets and capsules for oral administration contain conventional excipients such as binding agents, fillers, diluents, tableting agents, lubricants, disintegrants, and wetting agents. The tablets may be coated according to methods well known in the art.

The formulations according to the invention may be administered as unit doses containing conventional non-toxic pharmaceutically acceptable carriers, diluents, adjuvants and vehicles which are typical for parenteral administration.

The term **"parenteral"** includes herein subcutaneous, intravenous, intra-articular and intratracheal injection and infusion techniques. Parenteral compositions and combinations are most preferably administered intravenously either in a bolus form or as a constant fusion according to known procedures.

Also other administrations such as oral administration or administration by inhalation or nasal spray are also object of the invention. Inhalation of vapors containing interferon gamma as specified is also a preferred way of administration. For inhalations the compound according to the invention is preferably brought in an aerosol form. Aerosols and tech-

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niques to make them are well known in the art. Aerosols applicable by inhalers containing a polypeptide of the invention, for example, interferon gamma are preferred if direct pulmonary symptoms have to be treated.

Unit doses according to the invention may contain daily required amounts of the compound according to the invention, or sub-multiples thereof to make up the desired dose. The optimum therapeutically acceptable dosage and dose rate for a given individual (mammals, including humans) depends on a variety of factors, such as the activity of the specific active material employed, the age, body weight, general health, sex, diet, time and route of administration, rate of clearance, enzyme activity, the object of the treatment, i. e., therapy or prophylaxis and the nature of the disease to be treated. Therefore, in the pharmaceutical compositions according to the invention for the therapy of an individual, a pharmaceutical effective daily dose of the respective compound in said composition is:

Interferon gamma (IFN-γ): It could be shown that interferon-γ is effective in the combination therapy according to the invention in a dose of 1.0 - 5.0 µg / kg body weight, preferably 2.0 - 3.0 µg / kg body weight, 1- 5 times per week. The above-indicated single dosages of interferon-γ are administered parenteral, preferably subcutaneously to the patient.

The doses of glucocorticoids which can be administered optionally together with IFN-γ to an individual vary according to the invention from 10 - 100 mg / single dose and more preferably from 15 - 80 mg, which corresponds to approximately 100 - 350 µg /kg body weight, preferably 100-150 µg /kg body weight.

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SHORT DESCRIPTION OF THE FIGURES

Fig. 1: Figure 1 depicts the total lung capacity (TLC), the partial pressure of arterial oxygen (PaO2), and the forced vital capacity (FVC) of a patient with histologically proven UIP (open lung biopsy) and failure of immunosuppressive treatment (f, 59 yr) treated with interferon gamma.

EXAMPLES

Biopsies were taken from patients suffering from severe interstitial lung disease (ILD), after informal consent was given, using the surgical method of bronchoscopy. Obtained tissue probes were stored and processed for isolation of total RNA in RNA*later*™ (patent pending), an aqueous, non-toxic tissue storage reagent that stabilizes and protects cellular RNA in intact, unfrozen tissue samples.

The dissected tissue (less than 0.5 cm in any one dimension) is submerged in approximately 5 volumes of RNA*later* (e.g., a 0.5 g sample requires about 2.5 ml of RNA*later*) at room temperature. The solution permeates the cells, stabilizing the RNA. Then, RNA is isolated using the one-step RNA isolation methods, such as TRIzol® Reagent (Life Technologies), following the instructions of the supplier and finally eluted in H_2O.

Preparation of Labeled cRNA and Hybridization to Microarrays. Double-stranded cDNA was synthesized out of the isolated patients RNA samples using a cDNA synthesis kit (Superscript; Life Technologies) employing oligo(dT) priming. The resulting cDNA was used for *in vitro* transcription (Ambion T7 Megascript system) in the presence of biotin-11-CTP and biotin-16-UTP (Enzo Diagnostics). A total of 25-50 µg of the cRNA product in buffer [40 mM Tris·acetate (pH 8.1)/100 mM potassium acetate/30 mM magnesium acetate] was fragmented at 94°C for 35 min. It was then used as a hybridization probe from each

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patient for hybridization as recommended (Affymetrix, Santa Clara, CA).

Aliquots of the hybridization patients cRNA mixtures (10 µg cRNA in 200 µl hybridization mix) were hybridized to a Human Genome U133A Array. Each array was washed and scanned (Hewlett Packard, GeneArray scanner G2500A) according to procedures developed by manufacturer (Affymetrix).

Analysis of GENECHIP Data. Scanned output files were visually inspected for hybridization artifacts and then analyzed with GENECHIP 3.1 software (Affymetrix).

The expression analysis files created by GENECHIP 3.1 software were transferred to a database (Microsoft Access) and linked to Internet genome databases (e.g., NHLBI, or Swiss Prot).

Analysis of Infectious agents in biopsies. As patients with ILD repeatedly suffer from inflammations, biopsied material was tested for the presence of infectious agents. Most dominant was the observation of underlying Herpes virus infections (treated with Ganciclovir) and various bacterial infections (treated with various antibiotics), or few fungal infections.

Therapy. Therapy with interferon gamma was only started after successful pretreatment of the underlying infections and the assessment of the gene expression of the endogenous disease signiture genes. Application of molecular gene expression analysis followed by interferon gamma, led to a surprising, statistically highly significant increase of total lung capacity that was accompanied by a substantial increase of physical exertion capacity, statistically significant increased partial pressure of arterial oxygen at rest and a strong decrease of disease symptoms. This indicates that the

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pharmaceutical composition of gene expression analysis followed by interferon gamma is able to counterbalance fibrosing reactions in interstitial lung diseases and provides significant survival benefit to the patients with IPF.

Fig. 1a) depicts start data #1 of the treatment.

Levels of Gene transcription during long-term treatment

#	IFN g	IL-13	TGF-beta,	CTGF
1	1.7	1.8	13.1	2.9
2				
3				
4				

t

Immune response Wound healing

Fig. 1b) depicts the total lung capacity (TLC), the partial pressure of arterial oxygen (PaO2), and the forced vital capacity (FVC) of the same patient with histologically proven UIP (open lung biopsy) and failure of immunosuppressive treatment (f, 59 yr) between time #1 and time #2.

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Levels of Gene transcription during long-term treatment

#	IFN g	IL-13	TGF-beta$_1$	CTGF
1	1.7	1.8	13.1	2.9
2	0	0	5.4	2.1
3				
4				

t ▼

Immune response Wound healing

Fig. 1c) depicts the same data for the same patient between time #1 and time #4.

Levels of Gene transcription during long-term treatment

#	IFN g	IL-13	TGF-beta$_1$	CTGF
1	1.7	1.8	13.1	2.9
2	0	0	5.4	2.1
3	0	0.2	3.1	1.3
4	0	0	1.2	0.4

t ▼

Immune response Wound healing

5

Pretreatment of CMV followed by selected gene transcription analysis and subsequent interferon gamma treatment lead to stabilization of the patient with a deadly disease.

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Claims

1. A pharmaceutical composition comprising

2. (i) interferon gamma (IFN-γ), optionally together with a pharmaceutically acceptable carrier, diluent or excipient

(ii) a polynucleotide library for the molecular characterization of an interstitial lung disease (ILD), said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are either underexpressed or overexpressed in ILD cells

(iii) a polynucleotide library for the molecular characterization of infectious agents, said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for bacteria, mycoplasma, viruses, fungi, or yeasts.

3. A pharmaceutical composition according to claim 1, comprising additionally a glucocorticoid compound.

4. A pharmaceutical composition comprising

(i) pegylated interferon gamma (PEG-IFN-γ), optionally together with a pharmaceutically acceptable carrier, diluent or excipient

(ii) a polynucleotide library for the molecular characterization of an interstitial lung disease (ILD), said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are either underexpressed or overexpressed in ILD cells

(iii) a polynucleotide library for the molecular characterization of infectious agents, said library com-

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prising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for bacteria, mycoplasma, viruses, fungi, or yeasts.

5. A pharmaceutical composition according to claim 3, comprising additionally a glucocorticoid compound.

6. A pharmaceutical composition comprising

(i) pirfenidone, optionally together with a pharmaceutically acceptable carrier, diluent or excipient

(ii) a polynucleotide library for the molecular characterization of an interstitial lung disease (ILD), said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are either underexpressed or overexpressed in ILD cells

(iii) a polynucleotide library for the molecular characterization of infectious agents, said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for bacteria, mycoplasma, viruses, fungi, or yeasts.

7. A pharmaceutical composition according to claim 5, comprising additionally a glucocorticoid compound.

8. A pharmaceutical composition according to claims 1-6 for the treatment of idiopathic pulmonary fibrosis (IPF).

9. A pharmaceutical composition according to claims 1-6 for the treatment of hypersensivity pneumonitis.

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10. A pharmaceutical composition according to claims 1-6 for the treatment of scleroderma.

11. A pharmaceutical composition according to claims 1-6 for the treatment of Systemic Lupus Erythematosus.

12. A pharmaceutical composition according to claims 1-6 for the treatment of Rheumatoid Arthritis.

13. A pharmaceutical composition according to claims 1-6 for the treatment of Churg-Strauss syndrome, Wegener's granulomatosis, and Goodpasture Syndrome.

14. A polynucleotide library according to claims 1-6 wherein said sequences are useful in classifying good and poor prognosis in ILD patients.

15. A polynucleotide library according to claims 1-6 wherein said polynucleotide sequences or subsequences correspond to any combination of at least one polynucleotide selected among those included in at least 50%, preferably 75% and more preferably 100% of the predefined sets.

16. A polynucleotide library according to claims 1-6 wherein said polynucleotides are immobilized on a solid support in order to form a polynucleotide array.

17. A polynucleotide library according to claims 1-6 wherein the support is selected from the group comprising a nylon membrane, nitrocellulose membrane, glass slide,

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glass beads, membranes on glass support or a silicon chip.

18. A polynucleotide library according to claims 1-6 wherein the presence of or predisposition for ILD using expression profiling images comprises the steps of:
(a) isolation of material from an individual clinically diagnosed for a lung disease, or of familiar predisposition for an ILD,
(b) providing molecular probes as ligands selected from the group consisting of mRNA, polynucleotides, oligonucleotides, cDNAs, proteins or functional fragments thereof, isolated or generated from said individuals
(c) contacting said molecular probes as ligands with a set of immobilized receptors selected from the group consisting of polynucleotides, oligonucleotide or cDNA probes and antibodies or functional fragments thereof, specifically representing a respective set of genes involved with the presence of or predisposition for ILD, or an infection to be molecularly diagnosed, and qualitatively and quantitatively detecting the presence of bound ligand/receptor complexes to obtain an expression profiling image being representative for the current status of the individual to be diagnosed,
(d) comparing the expression profiling image obtained in step (c) with the expression profiling image(s) of normal individuals, expression profiling image(s) of individuals with clinically similar diseases, and/or with the expression profiling images(s) of individuals having a predisposition for or suffering from ILD to be diagnosed, and
(e) therefore on the basis of the results of the comparison obtained in step (d).

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19. A pharmaceutical composition according to claims 1-6 wherein said polynucleotide library for the molecular characterization of an interstitial lung disease (ILD) comprises a pool of polynucleotide sequences or subsequences selected from a set of sequences defined by, or correlated to, or derived from the group of genes consisting of candidate genes indicated in the following list:

PTH-responsive osteosarcoma B1 protein, AF095771.1

matrix associated, actin dependent regulator of chromatin, subfamily f, member 1, AF231056.1

deleted in lung and esophageal cancer 1 (DLEC1), NM_007337.1

major histocompatibility complex, class II, DQ beta 1, AW276186

SB classII histocompatibility antigen alpha-chain, AI128225

mucin 4, tracheobronchial, AJ242547.1

forkhead box J1 (FOXJ1), U69537.1

hypothetical protein FLJ21616, NM_024567.1

neuronal specific transcription factor DAT1, AF258348.1

hematopoietic PBX-interacting protein, BF344265

proline oxidase homolog, AA074145

mucin 5, subtype B, tracheobronchial, AI697108

golgi membrane protein GP73, AF236056.1

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ATP citrate lyase, U18197.1

NG22 protein, NM_025257.1

cDNA DKFZp434A2322, AL137706.1

hepatocyte nuclear factor 3, alpha, U39840.1

major histocompatibility complex, class II, DQ alpha 1, X00452.1

myosin regulatory light chain 2, smooth muscle isoform, J02854.1

plexin B1, AV693216

pyruvate kinase, muscle, BC000481.1

tetraspanin TM4-C, AF133425.1

insulin-like growth factor binding protein 2 (36kD), BC004312.1

FLJ13945 fis, clone Y79AA1000969, AU160041

hypothetical protein DKFZp586M1120, NM_031294.1

CD24 signal transducer, L33930

hypothetical protein FLJ23571, NM_025111.1

glutathione S-transferase M2 (muscle), M63509.1

cadherin 1, type 1, E-cadherin (epithelial), L08599.1

NTT5 protein, AF265578.1

lipocalin 2 (oncogene 24p3), NM_005564.1

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myotonic dystrophy kinase (DM kinase), L08835

uncoupling protein 2 (mitochondrial, proton carrier), U76367.1

dynein intermediate chain 2, NM_023036.1

discoidin receptor tyrosine kinase isoform b, discoidin domain receptor family, member 1, NM_001954.2

sperm associated antigen 6, AF079363.1

hypothetical protein FLJ23049, NM_024687.1

nasopharyngeal epithelium specific protein 1, AF094758.1

nuclear receptor subfamily 4, group A, member 2, NM_006186.1

hypothetical protein FLJ22215, BC003543.1

non-specific cross reacting antigen, M18728.1

amylase, alpha 1A; salivary (AMY1A), NM_004038.1

carcinoembryonic antigen-related cell adhesion molecule 6 (non-specific cross reacting antigen), BC005008.1

glutathione S-transferase subunit 4 (EC 2.5.1.18), X08020.1

SH3-containing protein SH3GLB2, AF257319.1

KDEL (Lys-Asp-Glu-Leu) endoplasmic reticulum protein retention receptor 1, NM_006801.1

anterior gradient 2 (Xenepus laevis) homolog, AF038451.1

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sv7-MUC4 apomucin, mucin 4, tracheobronchial, AJ242547.1

stratifin, BC000329.1

connective tissue growth factor, M92934.1

cytochrome P450-IIB (hIIB3), M29873.1

filamin A, alpha (actin-binding protein-280), AW051856

membrane glycoprotein LIG-1, AB050468.1

E74-like factor 3 (ets domain transcription factor, epithelial-specific), U73844.1

elastin (supravalvular aortic stenosis, Williams-Beuren syndrome), M36860.1

ephrin receptor EPHA3, AF213459.1

fibrillin 1 (Marfan syndrome), L13923.1

discs, large (Drosophila) homolog 1, U13896.1

lysyl oxidase-like 1 (LOXL1), L21186.1

calumenin, U67280.1

male germ cell-associated kinase, NM_005906.2

plectin 1, intermediate filament binding protein, 500kD, Z54367

peroxisome biogenesis factor 1, AF026086.1

mast cell tryptase beta III, AF099143

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ataxia-telangiectasia group D-associated protein, AF230388.1

hypothetical protein FLJ10921, NM_018272.1

biglycan, BC002416.1

BLu protein, AC002481

CGI-92 protein, AF151850.1

adaptor-related protein complex 1, mu 2 subunit, BC003387.1

keratin 15, BC002641.1

B7 protein, U72508.1

S100 calcium-binding protein A2, BC002829.1

MUF1 protein, BC004953.1
cholesterol 25-hydroxylase, AF059214.1

cytidine monophosphate-N-acetylneuraminic acid hydroxylase (CMP-N-acetylneuraminate monooxygenase), AF074480.1

neuropilin 2, AF022859.1

Fas-interacting serinethreonine kinase 3, homeodomain-interacting protein kinase 3, AF305239.1

a disintegrin and metalloproteinase domain 28 (ADAM28), transcript variant 2, AF137334.1

cDNA DKFZp434A119 , AW663632

complement component 6, J05064.1

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cytokeratin 17, Z19574

wingless-type MMTV integration site family, member 5A, AI968085

matrix metalloproteinase 7 (matrilysin, uterine), BC003635.1

leiomodin 1 (smooth muscle), NM_012134.1

Cip1-interacting zinc finger protein, AB030835.1

cyclin-dependent kinase inhibitor 1A (p21, Cip1), BC000275.1

integrin, alpha 7, AF032108.1

DKFZP586G011 protein, BG289527

fatty acid binding protein 6, ileal (gastrotropin), U19869.1

glutathione S-transferase M4, M96234.1

Ras-related associated with diabetes, L24564.1

claudin 3, AB000714.1

matrix metalloproteinase 10 (stromelysin 2), BC002591.1

fibulin 2, NM_001998.1

serine threonine kinase 11 (STK11), AF035625

eukaryotic translation initiation factor 1A: AF000987.1

DEADH (Asp-Glu-Ala-AspHis) box polypeptide: AF000985.1

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ribosomal protein S4: AF116711.1

ubiquitin specific protease 9: AF000986.2

SMC (mouse) homolog: U52191.1

myelin basic protein: L18865.1

S100 calcium-binding protein: NM_005980.1

Jagged2 (JAG2): AF003521.1

latent transforming growth factor beta binding protein 4: NM_003573.1

microtubule-associated protein, RPEB family, member 3: AB025186.1

Unknown (protein for MGC:2854): BC003629.1

clone=IMAGE-2406340: AI830563

AQP3 gene for aquaporine 3 (water channel): AB001325

cDNA DKFZp434A119

fenestrated-endothelial linked structure protein (FELS), PV1 protein (PLVAP): AF326591.1

LUNX protein; PLUNC (palate lung and nasal epithelium clone); tracheal epithelium enriched protein (LOC51297): AB024937.1

RAB, member of RAS oncogene family-like 2A: AF095350.1

chromosome 11 open reading frame 16: NM_020643.1

hypothetical protein FLJ23049: NM_024687.1

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hypothetical protein FLJ11767: NM_024593.1

dynein, axonemal, intermediate polypeptide: AF091619.1

brain specific protein (LOC51673): AF132972.1

MUC4 apomucin, mucin 4, tracheobronchial: AJ242547.1

myotonin protein kinase (DM): M87313.1

cytokeratin 4: X07695.1

KIAA0362 gene, MCF.2 cell line derived transforming sequence-like: AB002360.1

cytokeratin 17: Z19574

LIM domain protein: BC003096.1

E74-like factor 3 (ets domain transcription factor, epithelial-specific) : U73844.1

fatty acid binding protein 6, ileal (gastrotropin): U19869.1

sperm associated antigen 6: AF079363.1

eyes absent (Drosophila) homolog 2: U71207.1

phosphatidic acid phosphatase type 2C: BC002806.1

epoxide hydrolase 2, cytoplasmic: AF233334.1

tubulin, beta, 2: BC002783.1

heat shock 105kD: D86956.1

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villin 2 (ezrin): J05021.1

a disintegrin and metalloproteinase domain 28 (ADAM28), transcript variant 3: AF137335.1

deleted in lung and esophageal cancer 1: NM_007337.1

arachidonate 15-lipoxygenase: NM_001140.1

UDP glycosyltransferase 1 family, polypeptide A1: M57899.1

hypothetical protein PRO2834: AF119903.1

lectin, galactoside-binding, soluble, 7 (galectin 7): L07769.1

B7 protein: U72508.1

ephrin receptor EPHA3: AF213459.1

forkhead box J1: U69537.1

BLu protein: U70824.1

aldehyde dehydrogenase 3 family, member A1: BC004370.1

NG22 protein: NM_025257.1

small inducible cytokine subfamily A (Cys-Cys), member 14: NM_004166.1

cysteine-rich protein 1 (intestinal): BC002738.1

putative GTP-binding protein similar to RAYRAB1C: BC000566.1

integrin, beta 4: NM_000213.1

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serine (or cysteine) proteinase inhibitor, clade B (ovalbumin), member 5 (SERPINB5): U04313.1

Ras-related associated with diabetes: L24564.1

hepatic leukemia factor: M95585.1

keratin 15: BC002641.1

nuclear receptor subfamily 4, group A, member 2: NM_006186.1

sialyltransferase: U14550.1

glutathione S-transferase M2 (muscle): M63509.1

hypothetical protein FLJ13110: NM_022912.1

S100 calcium-binding protein A2: NM_005978.2

collagen, type VII, alpha 1 (epidermolysis bullosa, dystrophic, dominant and recessive) : L02870.1

claudin 3: AB000714.1

insulin-like growth factor binding protein 6: BC003507.1

fibroblast growth factor receptor 2 (bacteria-expressed kinase, keratinocyte growth factor receptor, craniofacial dysostosis 1, Crouzon syndrome, Pfeiffer syndrome, Jackson-Weiss syndrome): M80634.1

insulin-like growth factor 1 receptor: NM_000875.2

insulin-like growth factor binding protein 2 (36kD): M35410.1

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ataxia-telangiectasia group D-associated protein: AF230388.1

keratin 5 (epidermolysis bullosa simplex, Dowling-MearaKobnerWeber-Cockayne types): M21389.1

Duffy blood group: U01839.1

transforming growth factor β_1, NM_000660

sorting nexin 10 (SNX10), AF121860.1

phospholipase A2, group IIA (platelets, synovial fluid), M22430.1

hemoglobin alpha-1 globin chain (HBA1), AF349571.1

macrophage scavenger receptor 1, AI299239

surfactant, pulmonary-associated protein C, BC005913.1

disintegrin protease (M12.219), NM_014479.1

retinol-binding protein 4, interstitial, AF119868.1

major histocompatibility complex, class II, DR beta 3, M27635.1

adipose differentiation-related protein, BC005127.1

hemoglobin, delta, NM_000519.2

beta-2-microglobulin, AW188940

hemoglobin, alpha 2, BC005931.1

protein C receptor, endothelial (EPCR), L35545.1

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thymosin, beta 10, M92381.1

apolipoprotein C-I, W79394

hypothetical protein, AL133067.1

proteoglycan 4, (megakaryocyte stimulating factor, articular superficial zone protein), U70136.1

tetranectin (plasminogen-binding protein), NM_003278.1

platelet factor 4, M25897.1

tissue factor pathway inhibitor 2, BC005330.1

fatty acid binding protein 4, adipocyte, BC003672.1

cathepsin B (CTSB), M14221.1

transmembrane 4 superfamily member 1, M90657.1

MHC class I HLA-B51 major histocompatibility complex, class I, E, M31183.1

endothelial PAS domain protein 1, U51626.1

Apo-2 ligand tumor necrosis factor (ligand) superfamily, member 10, U37518.1

haptoglobin-related protein, NM_020995.1

Rho guanine exchange factor (GEF) 12, AF119898.1

major histocompatibility complex, class II, DR beta 5, M11867.1

interferon, gamma-inducible protein 30, AF097362.1

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ferritin, light polypeptide, BG537190

prosaposin (variant Gaucher disease and variant metachromatic leukodystrophy), BC004275.1

calcium-binding protein A4 (calvasculin, metastasin,), NM_002961.2

hemoglobin, beta, M25079.1

CDW52 antigen (CAMPATH-1 antigen), BC000644.1

aldehyde dehydrogenase 1 family, member A2, AB015226.1

cathepsin Z, AF032906.1

MHC HLA-B39 major histocompatibility complex, class I, B, L37880.1

major histocompatibility complex, class II, DQ alpha 1, M33906.1

fibroblast growth factor 9 (glia-activating factor), D14838.1

hemoglobin, alpha 2, AF097635.1

transferrin receptor (p90, CD71), BC001188.1

complement component 3 (C3), K02765.1

cDNA DKFZp564D066, AL050025.1

complement component 1, q subcomponent, beta polypeptide, NM_000491.2

small inducible cytokine subfamily A (Cys-Cys), member 18, pulmonary and activation-regulated, AB000221.1

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reticulon 1, L10333.1

major histocompatibility complex, class II, DR beta 1, M33600.1

haptoglobin, L29394.1

acid phosphatase 5, tartrate resistant, J04430.1

cytochrome P450, subfamily XXVIIA (steroid 27-hydroxylase, cerebrotendinous xanthomatosis), polypeptide 1, M62401.1

CD36 antigen (collagen type I receptor, thrombospondin receptor), M24795.1

calbindin 2, (29kD, calretinin), NM_001740.2

alpha-2-HS-glycoprotein, BG538564

cDNA DKFZp564A132, AL049963.1

fibronectin 1, AF130095.1

phosphodiesterase 4C, cAMP-specific, NM_000923.1

transcription factor 7 (T-cell specific, HMG-box), NM_003202.1

found in inflammatory zone 3 (FIZZ3), AF323081.1

claudin 15, NM_014343.1

carboxypeptidase B1 (tissue), M81057.1

hypothetical protein FLJ14054, NM_024563.1

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bone marrow stromal cell antigen 1, D21878.1

interleukin 7 receptor, M29696.1

procollagen C-endopeptidase enhancer 2, AF098269.1

calcium-binding protein A8 (calgranulin A), AW238654

cDNA DKFZp564D193, AL049252.1

major histocompatibility complex, class II, DP beta 1, J03041.1

human leukocyte antigen C alpha chain, major histocompatibility complex, class I, C, AK024836.1

BCM-like membrane protein precursor, AF144235.1

CD14 antigen, M86511.1

pulmonary surfactant protein (SP5), J03553

signal transducer and activator of transcription 1, 91kD, BC002704.1

Wilms tumor 1 (WT1), transcript variant D, NM_024424.1

annexin A8, BC004376.1

macrophage receptor with collagenous structure, MARCO, AF035819.1

surfactant, pulmonary-associated protein A2, NM_006926.1

solute carrier family 6 (neurotransmitter transporter, serotonin), member 4, L05568.1

chitinase 1 (chitotriosidase), U29615.1

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lung type-I cell membrane-associated glycoprotein, AU154455

fibronectin leucine rich transmembrane protein 2, AB007865.1

gamma-aminobutyric acid (GABA) A receptor, alpha 5, BF966183

hypothetical protein FLJ12983, NM_024856.1

sialophorin (gpL115, leukosialin, CD43), J04536.1

cerebellar degeneration-related protein (34kD), M16965.1

hydroxyacid oxidase 2 (long chain), hydroxy-delta-5-steroid dehydrogenase (3 beta-and steroid delta-isomerase 2), AL359553

CLONE=IMAGE:1032795=Hs.83623 nuclear receptor subfamily 1, group I, member 3

small inducible cytokine subfamily C, member 2: NM_003175.1

hypothetical protein similar to swine acylneuraminate lyase: NM_030769.1

fibrinogen, gamma polypeptide: AF118092.1

thrombospondin 1: NM_003246.1

SAM domain, SH3 domain and nuclear localisation signals, 1: AF222927.1

chitinase 3-like 1 (cartilage glycoprotein-39): M80927.1

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cathepsin Z: AF032906.1

CLONE=IMAGE:3579023 collagen, type XIV, alpha 1 (undulin)

chloride intracellular channel 2: NM_001289.2

monokine induced by gamma interferon: NM_002416.1

KIAA0433 protein: NM_015216.1

tumor necrosis factor, alpha-induced protein 6: NM_007115.1

signal transducer and activator of transcription 1, 91kD: BC002704.1

thrombospondin 2: L12350.1

collagen, type IV, alpha 3 (Goodpasture antigen): NM_000091.1

integrin, beta-like 1 (with EGF-like repeat domains): AF072752.1

diubiquitin: NM_006398.1

protease, cysteine, 1 (legumain): D55696.1

cytochrome P450, subfamily I (dioxin-inducible), polypeptide 1 (glaucoma 3, primary infantile): U03688.1

integrin, alpha 1: X68742.1

GABA-B receptor, G protein-coupled receptor 51: AF056085.1

KIAA1199 protein: AB033025.1

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collagen, type V, alpha 2: NM_000393.1

interleukin 13 receptor, alpha 2: U70981.1

translocase of inner mitochondrial membrane 8 (yeast) homolog A: BC005236.1

steroid sulfatase (microsomal), arylsulfatase C, isozyme S: M16505.1

CLONE=IMAGE:1982571 ATPase, H+ transporting, lysosomal (vacuolar proton pump) 9kD

proteoglycan 4, (megakaryocyte stimulating factor, articular superficial zone protein): U70136.1

nidogen (enactin): M30269.1

KIAA1598 protein: AU157109

vascular cell adhesion molecule 1: M60335.1

guanylate binding protein 1, interferon-inducible, 67kD: BC002666.1

cDNA DKFZp586E1124

apolipoprotein H (beta-2-glycoprotein I): M62839.1

ribosomal protein L37a: BE857772

cDNA DKFZp564A132

cathepsin S: M86553.1

a disintegrin and metalloproteinase domain 9 (meltrin gamma) (ADAM9): U41766.1

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zinc finger protein 331: AF272148.1

lysosomal-associated membrane protein 2: J04183.1

carboxypeptidase M: NM_001874.1

collagen, type I, alpha 2: NM_000089.1

P311 protein: U36189.1

KIAA0372 gene product: AB002370.1

Human T cell-specific protein RANTES: M21121

interferon-gamma-inducible indoleamine 2,3-dioxygenase (IDO): M34455.1

hypothetical protein FLJ10430: NM_018092.1

transcription factor ISGF-3: M97935

interleukin 1 receptor-like 1 (IL1RL1): NM_003856.1

putative alpha chemokine (H174), small inducible cytokine subfamily B (Cys-X-Cys), member 11: AF002985.1

small inducible cytokine subfamily B (Cys-X-Cys), member 10: NM_001565.1

mesoderm specific transcript (mouse) homolog: BC002413.1

carboxypeptidase B-like protein: AB011969.1

CD2 antigen (p50), sheep red blood cell receptor: M16445.

interferon, alpha-inducible protein (clone IFI-6-16): NM_022872.1

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RAS guanyl releasing protein 1 (calcium and DAG-regulated): AF081195.1

lipase, endothelial: AF118767.1

fatty-acid-Coenzyme A ligase, long-chain 4: NM_022977.1

klotho: AB005142.1

chondroitin sulfate proteoglycan 2 (versican): NM_004385.1

hypothetical protein, expressed in osteoblast: AB000115.1

CD14 antigen: M86511.1

CGI-83 protein: BC000878.1

leucine aminopeptidase: AF061738.1

UDP-Gal:betaGlcNAc beta 1,3-galactosyltransferase, poly-peptide 3: AB050855.1

protocadherin alpha 12: AF152308.1

neuroglycan C: AF059274

neuroligin: AI338338

HSPC156 protein: AF161505.1

hypothetical protein FLJ13310: NM_025118.1

eosinophil chemotactic cytokine (TSA1902): AB025008.1

aminopeptidase: AF191545.1

semaphorin sem2: AB029496.1

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protocadherin 12: AF231025.1

X transporter protein 3: NM_020208.1

transmembrane 4 superfamily member (tetraspan NET-2): AF124522.1

hypothetical protein FLJ10970: NM_018286.1

perforin 1 (pore forming protein): M28393.1

natural killer cell group 7 sequence: NM_005601.1

hypothetical protein DKFZp761N09121: BF435376

integrin, alpha 4 (antigen CD49D, alpha 4 subunit of VLA-4 receptor): BG532690

chitinase 3-like 2: U58515.1

FYN oncogene: N20923

relaxin 1 (H1): BC005956.1

hydroxyprostaglandin dehydrogenase 15-(NAD): U63296.1

sulfotransferase family, cytosolic, 1C, member 1: AF186254.1

TGF-b superfamily receptor type I: L17075.1

granzyme B (granzyme 2, cytotoxic T-lymphocyte-associated serine esterase 1): M36118.1

cystatin F (leukocystatin): AF031824.1

regulator of G protein signaling-Z (RGSZ1): AF060877.2

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clone MGC:12387: M16942.1

zinc-alpha2-glycoprotein: D90427.1

BCG induced integral membrane protein BIGMo-103: AB040120.1

nectin-like protein 2 (NECL2): AF132811.1

CD209 antigen-like: AB015629.1

solute carrier family 6 (neurotransmitter transporter, serotonin), member 4: L05568.1

MAD (mothers against decapentaplegic, Drosophila) homolog 6: U59914.1

latrophilin: AF104939.1

platelet factor 4: M25897.1

calcitonin receptor-like: L76380.1

matrilin 3: NM_002381.2

solute carrier family 14 (urea transporter), member 1 (Kidd blood group): U35735.1

interleukin 7 receptor: M29696.1

MAP kinase kinase 6 (MKK6), mitogen-activated protein kinase kinase 6: U39656.1

protocadherin 17: AF029343.1

granulysin: NM_006433.2

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interferon-stimulated protein, 15 kDa (ISG15): M13755.1

cadherin 5, type 2, VE-cadherin (vascularepithelium): U84722.1

thrombomodulin: M16552.1

interferon, alpha-inducible protein 27: NM_005532.1

interferon-gamma, X87308

and allelic variants or mutants thereof

and sequences specific for infectious agents, comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for Mycobacterium spec., Mycoplasma spec., Staphyllococcus aureus, Streptococcus spec., Borrelia, Treponema pallidum, Leptospira interrogans, Campylobacter jejuni, Escherichia coli, EPEC, ETEC, EIEC, EHEC Salmonella enterica, Yersinia enterocolitica, Aeromonas spec., Campylobacter fetus, Moraxella catarrhalis, Moraxella catarrhalis, Brucella spec., Toxoplasma, Salmonella enterica, Shigella spec., Yersinia enterocolitica, Vibrio cholerae, Pseudomonas aeruginosa, Burkholderia cepacia, Stenotrophomonas maltophilia, Acinetobacter baumanii, Acitenobacter calcoaceticus, Klebsiella, Enterobacter, Citrobacter, Proteus, Serratia, Morganella, Providencia, Cardiobacterium hominis, Eikenella corrodens, Gardnerella vaginalis, Calymmatobacterium granulomatis, Bacteriodes, Porphyromonas, Prevotella, Fusobacterium, Rickettsia prowazekii, Bartonella bacilliformis, Bartonella henselae, Chlamydia spec., yeasts, fungi, retroviruses, adenoviruses, hepadnaviruses, herpesviruses, influenza viruses, paramyxoviruses.

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20. Use of a pharmaceutical kit comprising

(i) a package comprising IFN-γ,

(ii) a package comprising a polynucleotide library for the molecular characterization of an interstitial lung disease (ILD), said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are either underexpressed or overexpressed in ILD cells

(iii)a package comprising a polynucleotide library for the molecular characterization of infectious agents, said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for bacteria, mycoplasma, viruses, fungi, or yeasts.

21. Use of pharmaceutical kit according to claim 19 further comprising a package comprising a glucocorticoid compound.

22. Use of a pharmaceutical kit comprising

(i) a package comprising pegylated IFN-γ,

(ii) a package comprising a polynucleotide library for the molecular characterization of an interstitial lung disease (ILD), said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are either underexpressed or overexpressed in ILD cells

(iii)a package comprising a polynucleotide library for the molecular characterization of infectious agents, said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subse-

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quences are characteristic for bacteria, mycoplasma, viruses, fungi, or yeasts.

23. Use of pharmaceutical kit according to claim 21 further comprising a package comprising a glucocorticoid compound.

24. Use of a pharmaceutical kit comprising
(i) a package comprising pirfenidone,
(ii) a package comprising a polynucleotide library for the molecular characterization of an interstitial lung disease (ILD), said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are either underexpressed or overexpressed in ILD cells
(iii)a package comprising a polynucleotide library for the molecular characterization of infectious agents, said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for bacteria, mycoplasma, viruses, fungi, or yeasts.

25. Use of pharmaceutical kit according to claim 23 further comprising a package comprising a glucocorticoid compound.

26. Use of pharmaceutical kit according to claims 19-24 for the manufacture of a medicament for the treatment of interstitial lung diseases (ILD).

27. Use of pharmaceutical kit according to claims 19-25, wherein IFN-γ is administered to the individual in a sin-

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gle dose amount varying from 2.0 to 3.0 µg / kg body weight.

28. Use of pharmaceutical kit according to claims 19-26, wherein the glucocorticoid compound is administered to the individual in a single dose amount varying from 100 to 150 µg / kg body weight.

29. Use of pharmaceutical kit according to claims 19-27, wherein interferon gamma or pegylated interferon gamma is administered to the individual by inhalation.

30. Method for treatment of interstitial lung diseases (ILD) or related forms thereof comprising administering to a individual a pharmaceutical composition according to any of the claims 1 - 6 or a pharmaceutical kit according to any of the claims 19 - 28.

31. Method according to claim 29, wherein IFN-γ is administered to the individual in a single dose amount varying from 2.0 to 3.0 µg / kg body weight.

32. Method according to claims 29 or 30, wherein the glucocorticoid compound is administered to the individual in a single dose amount varying from 100 to 150 µg / kg body weight.

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Fig. 1a)

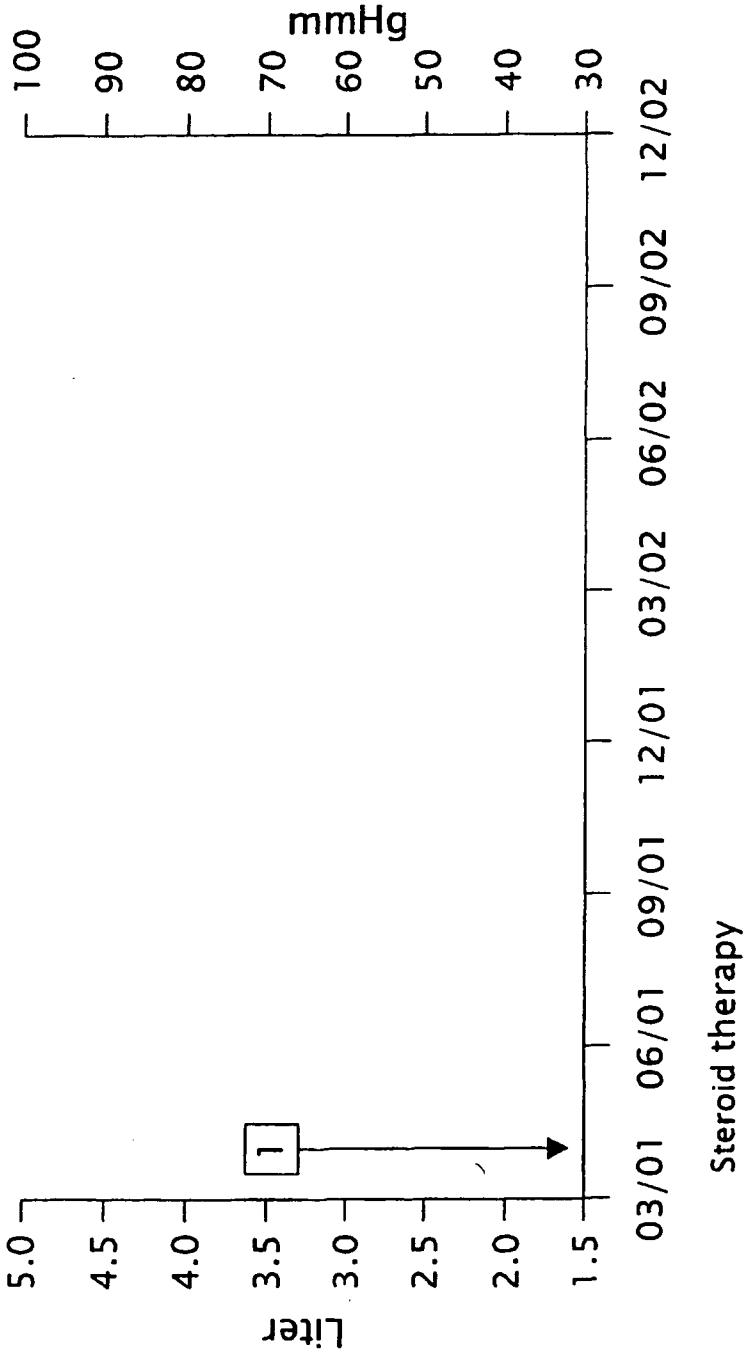

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Fig. 1b)

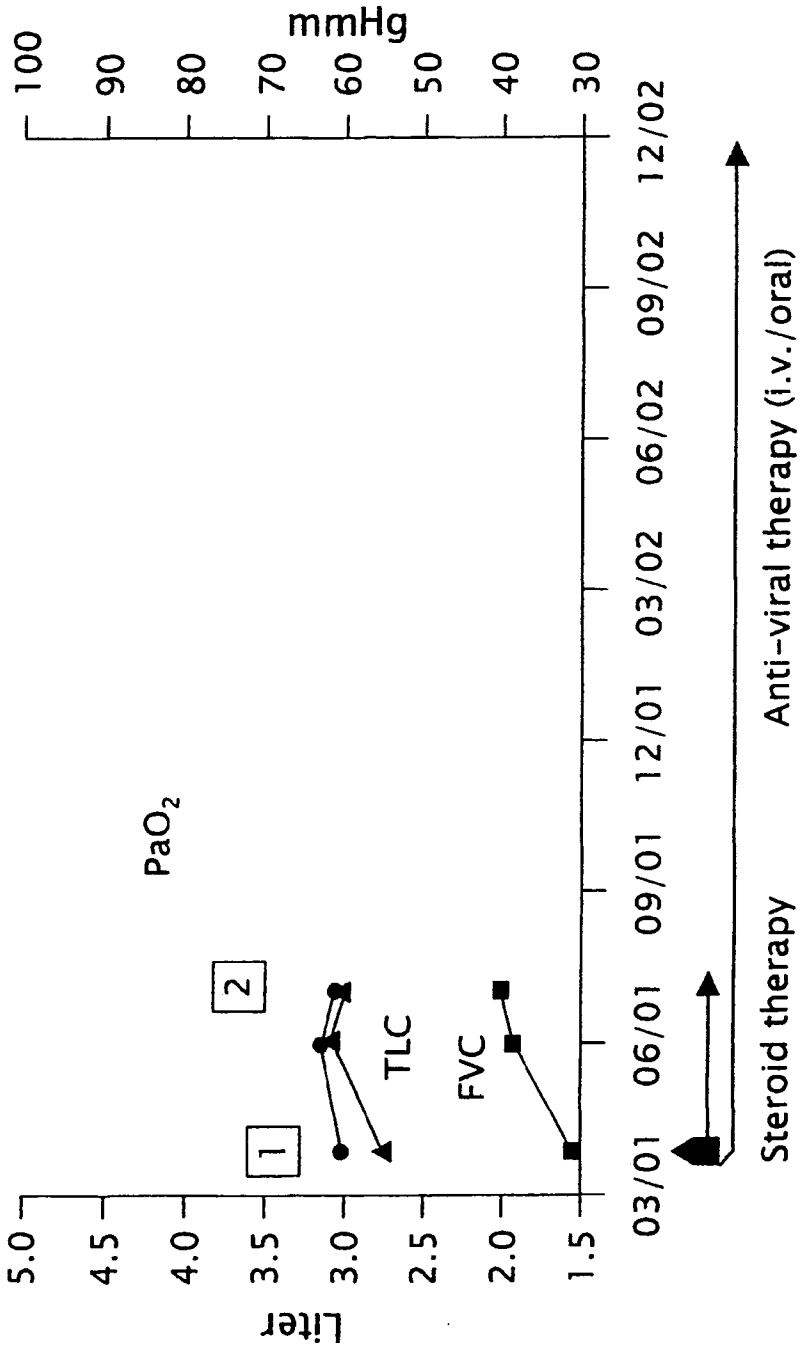

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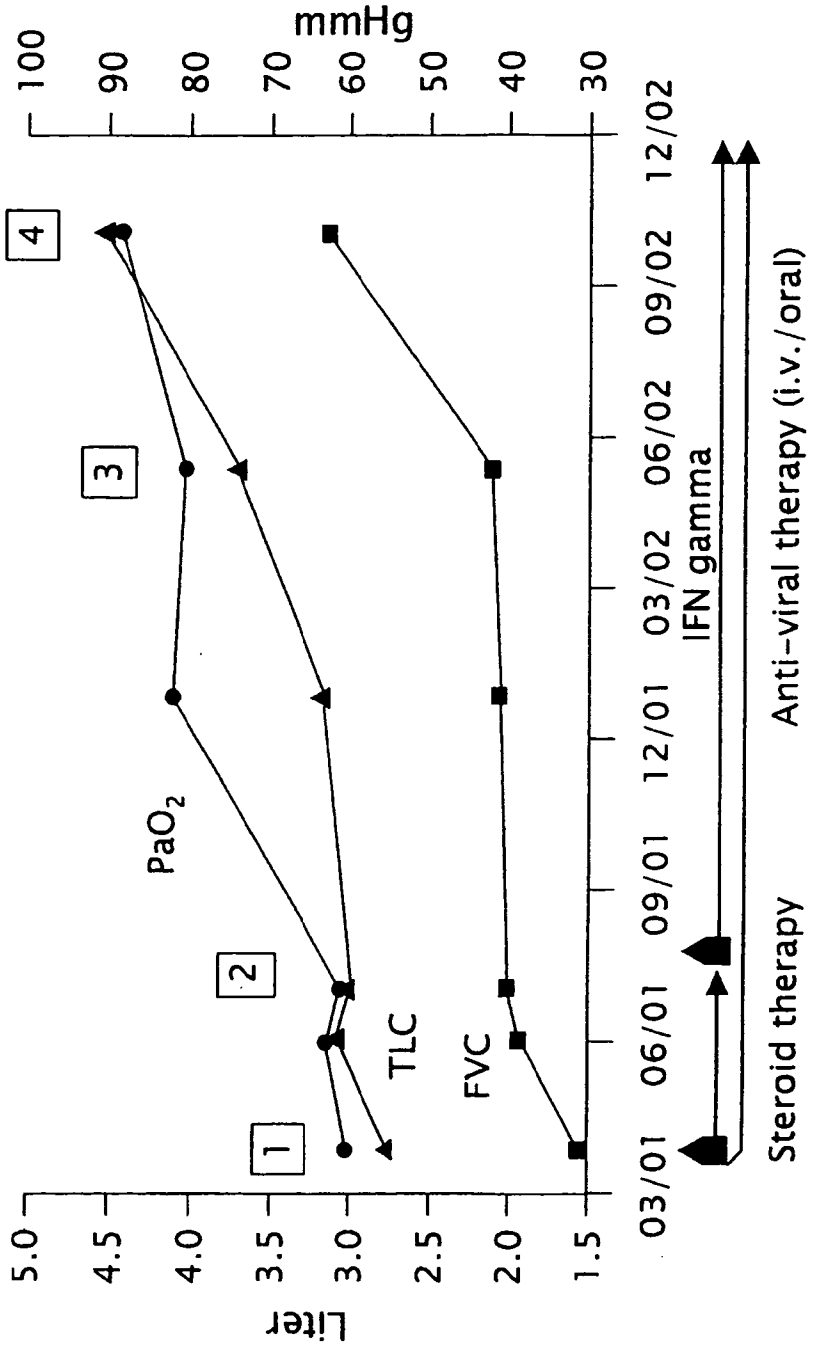
Fig. 1c)



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INTERNATIONAL SEARCH REPORT

Internation pplication No
PCT/CH 02/00691

A. CLASSIFICATION OF SUBJECT MATTER
IPC 7 A61K38/21 C12Q1/68 C12N15/10 A61P11/00 //(A61K38/21, 31:57)

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)
IPC 7 A61K C12Q C12N

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)
EPO-Internal, WPI Data, PAJ, EMBASE, BIOSIS, MEDLINE

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	EP 0 795 332 A (ZIESCHE ROLF DR ;BLOCK LUTZ HENNING PROF DR (AT)) 17 September 1997 (1997-09-17)	1-3,8-13
Y	the whole document	20-23, 26-32
X	WO 01 34180 A (ZIESCHE ROLF ;BLOCK LUTZ HENNING (DE)) 17 May 2001 (2001-05-17) the whole document	1-3,8-13
X	EP 0 789 081 A (INST DE SALUD CARLOS III) 13 August 1997 (1997-08-13)	1,4
Y	claims	20-23
X	EP 0 316 170 A (GENE GALWAY LIMITED G) 17 May 1989 (1989-05-17)	1,4
Y	claims 1-4	20-23

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[X] Further documents are listed in the continuation of box C.

[X] Patent family members are listed in annex.

* Special categories of cited documents :

"A" document defining the general state of the art which is not considered to be of particular relevance

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"O" document referring to an oral disclosure, use, exhibition or other means

"P" document published prior to the international filing date but later than the priority date claimed

"T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

"X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

"Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

"&" document member of the same patent family

Date of the actual completion of the international search	Date of mailing of the international search report
12 August 2003	16.09.03

Name and mailing address of the ISA	Authorized officer
European Patent Office, P.B. 5818 Patentlaan 2 NL - 2280 HV Rijswijk Tel. (+31-70) 340-2040, Tx. 31 651 epo nl, Fax: (+31-70) 340-3016	Deck, A

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C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	AFFYMETRIX: "GeneChip Human Genome U133 Set" INTERNET ARTICLE, 'Online! XP002232760 Retrieved from the Internet: <URL:http://www.affymetrix.com/support/technical/datasheets/hgu133_datasheet.pdf> 'retrieved on 2003-02-26! the whole document	1,4,19
X	AFFYMETRIX: "GeneChip E.coli antisense genome array" INTERNET ARTICLE, 'Online! XP002232761 Retrieved from the Internet: <URL:http://www.affymetrix.com/support/technical/datasheets/ecoli_antisense_datasheet.pdf> 'retrieved on 2003-02-26! the whole document	1,4
X	AFFYMETRIX: "GeneChip Pseudomonas aeruginosa genome array" INTERNET ARTICLE, 'Online! XP002232762 Retrieved from the Internet: <URL:http://www.affymetrix.com/support/technical/datasheets/pseudomonas_datasheet.pdf> 'retrieved on 2003-02-26! the whole document	1,4
X	AFFYMETRIX: "GenGhip Yeast genome S98 array" INTERNET ARTICLE, 'Online! XP002232763 Retrieved from the Internet: <URL:http://www.affymetrix.com/support/technical/datasheets/yeast_datasheet.pdf> 'retrieved on 2003-02-26! the whole document	1,4
X	ZIESCHE ROLF ET AL: "A preliminary study of long-term treatment with interferon gamma-1b and low-dose prednisolone in patients with idiopathic pulmonary fibrosis." NEW ENGLAND JOURNAL OF MEDICINE, vol. 341, no. 17, 21 October 1999 (1999-10-21), pages 1264-1269, XP001145933 ISSN: 0028-4793	1-3,8
Y	the whole document	20-23, 26-32

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C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	ZIESCHE ROLF ET AL: "Mechanisms of antifibrotic action of interferon gamma-1b in pulmonary fibrosis." WIENER KLINISCHE WOCHENSCHRIFT, vol. 112, no. 18, 2000, pages 785-790, XP009005957 ISSN: 0043-5325	1-3,8
Y	the whole document	20-23, 26-32
X	ZIESCHE R ET AL: "'New therapeutic approaches in pulmonary fibrosis!" PNEUMOLOGIE (STUTTGART, GERMANY) GERMANY OCT 2000, vol. 54, no. 10, October 2000 (2000-10), pages 431-433, XP009005956 ISSN: 0934-8387	1-3,8
Y	the whole document page 432, left-hand column, line 8 -right-hand column, line 1	20-23, 26-32
X	WO 01 36001 A (MAXYGEN APS ;JENSEN ANNE DAM (DK); ANDERSEN KIM VILBOUR (DK); HANS) 25 May 2001 (2001-05-25)	1,4,8
Y	claims	4,20-23, 26-32
Y	KITA Y ET AL: "CHARACTERIZATION OF A POLYETHYLENE GLYCOL CONJUGATE OF RECOMBINANT HUMAN INTERFERON-GAMMA" DRUG DESIGN AND DELIVERY, HARWOOD ACADEMIC PUBLISHERS GMBH, XX, vol. 6, no. 3, 1990, pages 157-167, XP001042224 the whole document	4,22
X	WO 94 26249 A (MARGOLIN SOLOMON B) 24 November 1994 (1994-11-24) page 4, line 33 -page 19, line 10	6-13,30
X	RAGHU G ET AL: "TREATMENT OF IDIOPATHIC PULMONARY FIBROSIS WITH A NEW ANTIFIBROTIC AGENT, PIRFENIDONE. RESULTS OF A PROSPECTIVE, OPEN-LABEL PHASE II STUDY" AMERICAN JOURNAL OF RESPIRATORY AND CRITICAL CARE MEDICINE, AMERICAN LUNG ASSOCIATION, NEW YORK, NY, US, vol. 159, no. 4, April 1999 (1999-04), pages 1061-1069, XP000878900 ISSN: 1073-449X the whole document	6-13,30

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C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	MARGOLIN S ET AL: "REMOVAL OF INTERSTITIAL PULMONARY FIBROSIS (ASBESTOS-INDUCED) BY ORAL CHEMOTHERAPY WITH PIRFENIDONE" FASEB JOURNAL (FEDERATION OF AMERICAN SOCIETIES FOR EXPERIMENTAL BIOLOGY), BETHESDA, US, vol. 41, no. 5, 1982, page 1550 XP008000826 ISSN: 0892-6638 the whole document	6-13,30
X	NICOD L P: "Pirfenidone in idiopathic pulmonary fibrosis" LANCET, XX, XX, vol. 354, no. 9175, 24 July 1999 (1999-07-24), pages 268-269, XP004266626 ISSN: 0140-6736 the whole document	6-13,30
X	WO 00 17391 A (INNOGENETICS NV ;JANNES GEERT (BE); SCHMITT HEINZ JOSEF (DE)) 30 March 2000 (2000-03-30) the whole document	1,4,6
X	WO 00 60117 A (DUFF GORDON W ;GIOVINE FRANCESCO SAVERIO DI (GB); WHYTE MORIA (US)) 12 October 2000 (2000-10-12) page 22, paragraphs 2,3; claim 1	14-18
X	KATSUMA SUSUMU ET AL: "Molecular monitoring of bleomycin-induced pulmonary fibrosis by cDNA microarray-based gene expression profiling" BIOCHEMICAL AND BIOPHYSICAL RESEARCH COMMUNICATIONS, ACADEMIC PRESS, SAN DIEGO, CA, US, vol. 288, no. 4, 9 November 2001 (2001-11-09), pages 747-751, XP002237871 ISSN: 0006-291X the whole document	14-18

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INTERNATIONAL SEARCH REPORT

Internation pplication No
PCT/CH 02/00691

C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	KAMINSKI N ET AL: "Global analysis of gene expression in pulmonary fibrosis reveals distinct programs regulating lung inflammation and fibrosis" PROCEEDINGS OF THE NATIONAL ACADEMY OF SCIENCES OF USA, NATIONAL ACADEMY OF SCIENCE. WASHINGTON, US, vol. 97, no. 4, 15 February 2000 (2000-02-15), pages 1778-1783, XP002237872 ISSN: 0027-8424 the whole document	14-18

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INTERNATIONAL SEARCH REPORT

Intern... d application No.
PCT/CH 02/00691

Box I Observations where certain claims were found unsearchable (Continuation of item 1 of first sheet)

This International Search Report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

1. [X] Claims Nos.:
because they relate to subject matter not required to be searched by this Authority, namely:

Although claims 30-32 are directed to a method of treatment of the human/animal body, the search has been carried out and based on the alleged effects of the compound/composition.

2. [X] Claims Nos.: 1-5, 8-13, 19-23, 26-32 (partially)
because they relate to parts of the International Application that do not comply with the prescribed requirements to such an extent that no meaningful International Search can be carried out, specifically:

see FURTHER INFORMATION sheet PCT/ISA/210

3. [ ] Claims Nos.:
because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

Box II Observations where unity of invention is lacking (Continuation of item 2 of first sheet)

This International Searching Authority found multiple inventions in this international application, as follows:

see additional sheet

As a result of the prior review under R. 40.2(e) PCT, no additional fees are to be refunded.

1. [X] As all required additional search fees were timely paid by the applicant, this International Search Report covers all searchable claims.

2. [ ] As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee.

3. [ ] As only some of the required additional search fees were timely paid by the applicant, this International Search Report covers only those claims for which fees were paid, specifically claims Nos.:

4. [ ] No required additional search fees were timely paid by the applicant. Consequently, this International Search Report is restricted to the invention first mentioned in the claims; it is covered by claims Nos.:

Remark on Protest

[X] The additional search fees were accompanied by the applicant's protest.

[ ] No protest accompanied the payment of additional search fees.

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FURTHER INFORMATION CONTINUED FROM PCT/ISA/ 210

This International Searching Authority found multiple (groups of) inventions in this international application, as follows:

1. Claims: 1-5, 8-13, 19-23, 26-32 (partially)

   Pharmaceutical composition comprising Interferon gamma or pegylated interferon gamma, a polynucleotide library for the diagnosis of an interstitial lung disease (ILD), and a polynucleotide library for the characterisation of infectious agents; uses thereof in the treatment of an ILD.

2. Claims: 6-13, 19, 24-26, 28-30, 32 (partially)

   Pharmaceutical composition comprising pirfenidone, a polynucleotide library for the diagnosis of an interstitial lung disease (ILD), and a polynucleotide library for the characterisation of infectious agents; uses thereof in the treatment of an ILD.

3. Claims: 14-18

   A polynucleotide library for the diagnosis of an ILD.

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FURTHER INFORMATION CONTINUED FROM PCT/ISA/ 210

Continuation of Box I.2

Claims Nos.: 1-5, 8-13, 19-23, 26-32 (partially)

Present claims 1, 4, 20, 22 relate to products (polynucleotide libraries) defined by reference to a desirable characteristic or property, namely that they comprise polynucleotides (ii) which are either underexpressed or overexpressed in ILD cells, and (iii) which are characteristic for infectious agents respectively.

The claims cover all products having this characteristic or property, whereas the application provides support within the meaning of Article 6 PCT and disclosure within the meaning of Article 5 PCT for only a very limited number of such products, namely the Genome U133A array in the example p. 43. The application gives no indication as to how such libraries are obtained, which is the minimum of information required in the case of claims pertaining to libraries. In the present case, the claims so lack support, and the application so lacks disclosure, that a meaningful search over the whole of the claimed scope is impossible. Independent of the above reasoning, the claims also lack clarity (Article 6 PCT). An attempt is made to define the product by reference to a result to be achieved. Again, this lack of clarity in the present case is such as to render a meaningful search over the whole of the claimed scope impossible.

In addition, present claims 1, 20, 22 taken together with claim 19 relate to an extremely large number of possible compounds. In fact, the claims contain so many possible permutations that a lack of clarity and conciseness within the meaning of Article 6 PCT arises to such an extent as to render a meaningful search of the claims impossible.

Consequently, the search has been carried out for those parts of the application which do appear to be clear and concise, namely to the example pages 43-44, and to the general concept underlying the invention.

The applicant's attention is drawn to the fact that claims, or parts of claims, relating to inventions in respect of which no international search report has been established need not be the subject of an international preliminary examination (Rule 66.1(e) PCT). The applicant is advised that the EPO policy when acting as an International Preliminary Examining Authority is normally not to carry out a preliminary examination on matter which has not been searched. This is the case irrespective of whether or not the claims are amended following receipt of the search report or during any Chapter II procedure.

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INTERNATIONAL SEARCH REPORT

Information on patent family members

International application No
PCT/CH 02/00691

Patent document cited in search report	Publication date	Patent family member(s)	Publication date
EP 0795332 A	17-09-1997	EP 0795332 A2	17-09-1997
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DECLARATION FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and joint inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled:

NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES

the specification of which was filed on December 12, 2002 as Application No. PCT/CH02/00691.

In the event that the filing date and/or Application No. are not entered above at the time I execute this document, and if such information is deemed necessary, I hereby authorize and request my attorneys/agent(s) at **Jenkens & Gilchrist, a Professional Corporation**, 1445 Ross Avenue, Suite 3200, Dallas, Texas 75202, to insert above the filing date and/or Application No. of said application.

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by an amendment, if any, specifically referred to herein.

I acknowledge the duty to disclose all information known to me that is material to patentability in accordance with Title 37, Code of Federal Regulations, § 1.56.

FOREIGN PRIORITY CLAIM

I hereby claim foreign priority benefits under Title 35, United States Code § 119(a)-(d) of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

☐ no such foreign applications have been filed

☒ such foreign application have been filed as follows:

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EARLIEST FOREIGN APPLICATION(S), IF ANY FILED WITHIN 12 MONTHS (6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION

Application Number	Country	Date of Filing	Priority Claimed Under 35 USC 119
01130011.8	Europe	December 18, 2001	X Yes No ___
			___ Yes No ___
			___ Yes No ___

ALL FOREIGN APPLICATION(S), IF ANY FILED MORE THAN 12 MONTHS (6 MONTHS FOR DESIGN) PRIOR TO THIS U.S. APPLICATION

Application Number	Country	Date of Filing

CLAIM FOR BENEFIT OF EARLIER U.S. PROVISIONAL APPLICATIONS

I hereby claim priority benefits under Title 35, United States Code §119(e), of any United States provisional patent application(s) listed below:

[x] no such U.S. provisional applications have been filed.

[ ] such U.S. provisional application have been filed as follows:

Application Number	Date of Filing	Priority Claimed Under 35 USC 119
		___ Yes No ___
		___ Yes No ___
		___ Yes No ___

CLAIM FOR BENEFIT OF EARLIER U.S./PCT APPLICATION(S)

I hereby claim the benefit under Title 35, United States Code, §120 of the United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose all information that is material to patentability in accordance with Title 37, Code of Federal Regulations, §1.56 which became available to me between the filing date of the prior application and the national or PCT international filing date of this application:

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☐ no such U.S./PCT applications have been filed.

☐ such U.S./PCT application have been filed as follows:

Application Number	Relationship	Parent Application	Date of Filing

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

I hereby appoint:

All practitioners at Customer Number 23932

all of **Jenkens & Gilchrist, a Professional Corporation**, 1445 Ross Avenue, Suite 3200, Dallas, Texas 75202, jointly, and each of them severally, my attorneys at law/patent agent(s), with full power of substitution, delegation and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, and to transact all business in the U. S. Patent and Trademark Office connected therewith.

Please mail all correspondence to Stanley R. Moore, whose address is:

Jenkens & Gilchrist, a Professional Corporation
1445 Ross Avenue, Suite 3200
Dallas, Texas 75202

Please direct telephone calls to: Stanley R. Moore at (214) 855-4713.

Please direct facsimiles to: (214) 855-4300

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Full name of sole or first inventor Dorian Bevec	
Sole or first inventor's signature	Date
Residence Gentilino, Switzerland	
Citizenship Switzerland	
Mailing Address Via Pasquée 23 CH-6925 Gentilino SWITZERLAND	

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Full name of second inventor, if any Rolf Ziesche	
Second inventor's signature	Date
Residence Wein, Austria	
Citizenship Germany	
Mailing Address Karl-Lothringerstr. 81/36 A-1210 Wein AUSTRIA	

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AUG 11 2008
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PATENT & TRADEMARK OFFICE

Docket No.: 27793-00089USPX
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Dorian Bevec et al.

Application No.: Not Yet Assigned

Confirmation No.: N/A

Filed: Concurrently Herewith

Art Unit: N/A

For: NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES

Examiner: Not Yet Assigned

INFORMATION DISCLOSURE STATEMENT (IDS)

MS DO/EO/US
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to 37 CFR 1.56, 1.97 and 1.98, the attention of the Patent and Trademark Office is hereby directed to the references listed on the attached PTO/SB/08. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the references be made of record therein and appear among the "References Cited" on any patent to issue therefrom.

This Information Disclosure Statement accompanies the new patent application submitted herewith.

A copy of each reference on the PTO/SB/08 is attached.

In accordance with 37 CFR 1.97(g), the filing of this Information Disclosure Statement shall not be construed to mean that a search has been made or that no other material information as defined in 37 CFR 1.56(a) exists. In accordance with 37 CFR 1.97(h), the filing

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of this Information Disclosure statement shall not be construed to be an admission that any patent, publication or other information referred to therein is "prior art" for this invention unless specifically designated as such.

It is submitted that the Information Disclosure Statement is in compliance with 37 CFR 1.98 and the Examiner is respectfully requested to consider the listed references.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 10-0447, under Order No. 27793-00089USPX. A duplicate copy of this paper is enclosed.

Dated: June 7, 2004

Respectfully submitted,

By Stanley R. Moore

Stanley R. Moore
Registration No.: 26,958
JENKENS & GILCHRIST, A PROFESSIONAL CORPORATION
1445 Ross Avenue, Suite 3200
Dallas, Texas 75202
(214) 855-4500
Attorneys For Applicant

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ALTERNATIVE TO PTO/SB/08a/b (06-03)

Substitute for form 1449/PTO				Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT				Application Number	Not Yet Assigned
				Filing Date	Concurrently Herewith
				First Named Inventor	Dorian Bevec
				Art Unit	N/A
(Use as many sheets as necessary)				Examiner Name	Not Yet Assigned
Sheet	1	of	1	Attorney Docket Number	27793-00089USPX

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No.[1]	Document Number Number-Kind Code[2] *(if known)*	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
	AA**	US-4179337	12-18-1979	Davis et al.	

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No.[1]	Foreign Patent Document Country Code[3]-Number[4]-Kind Code[5] *(if known)*	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T[6]
	BA	WO 00/60117	10-12-2000	Interleukin Genetics, Inc.		
	BB	WO 01/36001 A2	05-25-2001	Maxygen APS		
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	BG	WO 01/34180 A2	05-17-2001	Block, Lutz Henning et al.		
	BH	EP 0316170	05-17-1989	G Gene Galway Limited		

*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. [1] Applicant's unique citation designation number (optional). [2] See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. [3] Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). [4] For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. [5] Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. [6] Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No.[1]	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T[2]

*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

[1]Applicant's unique citation designation number (optional). [2]Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	

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OIPE
AUG 11 2008
IAP3
PATENT & TRADEMARK OFFICE

Docket No.: 27793-00089USPX
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Dorian Bevec et al.

Application No.: Not Yet Assigned

Art Unit: N/A

Filed: Concurrently Herewith

Examiner: Not Yet Assigned

For: NOVEL PHARMACEUTICAL COMPOSITION OF INTERFERON GAMMA OR PIRFENIDONE WITH MOLECULAR DIAGNOSTICS FOR THE IMPROVED TREATMENT OF INTERSTITIAL LUNG DISEASES

FIRST PRELIMINARY AMENDMENT

MS DO/EO/US
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

INTRODUCTORY COMMENTS

Prior to examination on the merits, please amend the above-identified U.S. patent application as follows:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 20 of this paper.

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AMENDMENTS TO THE CLAIMS

1. (Currently Amended) A pharmaceutical composition comprising:

(i) interferon gamma (IFN-γ), optionally together with a pharmaceutically acceptable carrier, diluent or excipient;

(ii) a polynucleotide library for the molecular characterization of an interstitial lung disease (ILD), said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are either underexpressed or overexpressed in ILD cells; and

(iii) a polynucleotide library for the molecular characterization of infectious agents, said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for bacteria, mycoplasma, viruses, fungi, or yeasts.

2. (Canceled)

3. (Original) A pharmaceutical composition according to claim 1, comprising additionally a glucocorticoid compound.

4. (Currently Amended) A pharmaceutical composition comprising:

(i) pegylated interferon gamma (PEG-IFN-γ), optionally together with a pharmaceutically acceptable carrier, diluent or excipient;

(ii) a polynucleotide library for the molecular characterization of an interstitial lung disease (ILD), said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are either underexpressed or overexpressed in ILD cells; and

(iii) a polynucleotide library for the molecular characterization of infectious agents, said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for bacteria, mycoplasma, viruses, fungi, or yeasts.

5. (Currently Amended) A pharmaceutical composition according to claim 3 4, comprising additionally a glucocorticoid compound.

6. (Currently Amended) A pharmaceutical composition comprising:

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(i) pirfenidone, optionally together with a pharmaceutically acceptable carrier, diluent or excipient;

(ii) a polynucleotide library for the molecular characterization of an interstitial lung disease (ILD), said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are either underexpressed or overexpressed in ILD cells; and

(iii) a polynucleotide library for the molecular characterization of infectious agents, said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for bacteria, mycoplasma, viruses, fungi, or yeasts.

7. (Currently Amended) A pharmaceutical composition according to claim ~~5~~ 6, comprising additionally a glucocorticoid compound.

8. (Currently Amended) A pharmaceutical composition according to ~~claims~~ claim 1[[-6]] for the treatment of idiopathic pulmonary fibrosis (IPF).

9. (Currently Amended) A pharmaceutical composition according to ~~claims~~ claim 1[[-6]] for the treatment of hypersensivity pneumonitis.

10. (Currently Amended) A pharmaceutical composition according to ~~claims~~ claim 1[[-6]] for the treatment of scleroderma.

11. (Currently Amended) A pharmaceutical composition according to ~~claims~~ claim 1[[-6]] for the treatment of Systemic Lupus Erythematosus.

12. (Currently Amended) A pharmaceutical composition according to ~~claims~~ claim 1[[-6]] for the treatment of Rheumatoid Arthritis.

13. (Currently Amended) A pharmaceutical composition according to ~~claims~~ claim 1[[-6]] for the treatment of Churg-Strauss syndrome, Wegener's granulomatosis, and Goodpasture Syndrome.

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14. (Currently Amended) A polynucleotide library according to ~~claims~~ claim 1[[-6]] wherein said sequences are useful in classifying good and poor prognosis in ILD patients.

15. (Currently Amended) A polynucleotide library according to ~~claims~~ claim 1[[-6]] wherein said polynucleotide sequences or subsequences correspond to any combination of at least one polynucleotide selected among those included in at least 50%, preferably 75% and more preferably 100% of the predefined sets.

16. (Currently Amended) A polynucleotide library according to ~~claims~~ claim 1[[-6]] wherein said polynucleotides are immobilized on a solid support in order to form a polynucleotide array.

17. (Currently Amended) A polynucleotide library according to ~~claims~~ claim 1[[-6]] wherein the support is selected from the group comprising a nylon membrane, nitrocellulose membrane, glass slide, glass beads, membranes on glass support or a silicon chip.

18. (Currently Amended) A polynucleotide library according to ~~claims~~ claim 1[[-6]] wherein the presence of or predisposition for ILD using expression profiling images comprises the steps of:

(a) isolation of material from an individual clinically diagnosed for a lung disease, or of familiar predisposition for an ILD[[,]];

(b) providing molecular probes as ligands selected from the group consisting of mRNA, polynucleotides, oligonucleotides, cDNAs, proteins or functional fragments thereof, isolated or generated from said individuals;

(c) contacting said molecular probes as ligands with a set of immobilized receptors selected from the group consisting of polynucleotides, oligonucleotide or cDNA probes and antibodies or functional fragments thereof, specifically representing a respective set of genes involved with the presence of or predisposition for ILD, or an infection to be molecularly diagnosed, and qualitatively and quantitatively detecting the presence of bound ligand/receptor complexes to obtain an expression profiling image being representative for the current status of the individual to be diagnosed[[,]];

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(d) comparing the expression profiling image obtained in step (c) with the expression profiling image(s) of normal individuals, expression profiling image(s) of individuals with clinically similar diseases, and/or with the expression profiling images(s) of individuals having a predisposition for or suffering from ILD to be diagnosed[[,]]; and

(e) therefore on the basis of the results of the comparison obtained in step (d).

19. (Currently Amended) A pharmaceutical composition according to ~~claims~~ claim 1[[-6]] wherein said polynucleotide library for the molecular characterization of an interstitial lung disease (ILD) comprises a pool of polynucleotide sequences or subsequences selected from a set of sequences defined by, or correlated to, or derived from the group of genes consisting of candidate genes indicated in the following list:

PTH-responsive osteosarcoma B1 protein, AF095771.1

matrix associated, actin dependent regulator of chromatin, subfamily f, member 1, AF231056.1

deleted in lung and esophageal cancer 1 (DLEC1), NM_007337.1

major histocompatibility complex, class II, DQ beta 1, AW276186

SB classII histocompatibility antigen alpha-chain, AI128225

mucin 4, tracheobronchial, AJ242547.1

forkhead box J1 (FOXJ1), U69537.1

hypothetical protein FLJ21616, NM_024567.1

neuronal specific transcription factor DAT1, AF258348.1

hematopoietic PBX-interacting protein, BF344265

proline oxidase homolog, AA074145

mucin 5, subtype B, tracheobronchial, AI697108

golgi membrane protein GP73, AF236056.1

ATP citrate lyase, U18197.1

NG22 protein, NM_025257.1

cDNA DKFZp434A2322, AL137706.1

hepatocyte nuclear factor 3, alpha, U39840.1

major histocompatibility complex, class II, DQ alpha 1, X00452.1

myosin regulatory light chain 2, smooth muscle isoform, J02854.1

plexin B1, AV693216

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pyruvate kinase, muscle, BC000481.1

tetraspanin TM4-C, AF133425.1

insulin-like growth factor binding protein 2 (36kD), BC004312.1

FLJ13945 fis, clone Y79AA1000969, AU160041

hypothetical protein DKFZp586M1120, NM_031294.1

CD24 signal transducer, L33930

hypothetical protein FLJ23571, NM_025111.1

glutathione S-transferase M2 (muscle), M63509.1

cadherin 1, type 1, E-cadherin (epithelial), L08599.1

NTT5 protein, AF265578.1

lipocalin 2 (oncogene 24p3), NM_005564.1

myotonic dystrophy kinase (DM kinase), L08835

uncoupling protein 2 (mitochondrial, proton carrier), U76367.1

dynein intermediate chain 2, NM_023036.1

discoidin receptor tyrosine kinase isoform b, discoidin domain receptor family, member 1, NM_001954.2

sperm associated antigen 6, AF079363.1

hypothetical protein FLJ23049, NM_024687.1

nasopharyngeal epithelium specific protein 1, AF094758.1

nuclear receptor subfamily 4, group A, member 2, NM_006186.1

hypothetical protein FLJ22215, BC003543.1

non-specific cross reacting antigen, M18728.1

amylase, alpha 1A; salivary (AMY1A), NM_004038.1

carcinoembryonic antigen-related cell adhesion molecule 6 (non-specific cross reacting antigen), BC005008.1

glutathione S-transferase subunit 4 (EC 2.5.1.18), X08020.1

SH3-containing protein SH3GLB2, AF257319.1

KDEL (Lys-Asp-Glu-Leu) endoplasmic reticulum protein retention receptor 1, NM_006801.1

anterior gradient 2 (Xenepus laevis) homolog, AF038451.1

sv7-MUC4 apomucin, mucin 4, tracheobronchial, AJ242547.1

stratifin, BC000329.1

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connective tissue growth factor, M92934.1

cytochrome P450-IIB (hIIB3), M29873.1

filamin A, alpha (actin-binding protein-280), AW051856

membrane glycoprotein LIG-1, AB050468.1

E74-like factor 3 (ets domain transcription factor, epithelial-specific), U73844.1

elastin (supravalvular aortic stenosis, Williams-Beuren syndrome), M36860.1

ephrin receptor EPHA3, AF213459.1

fibrillin 1 (Marfan syndrome), L13923.1

discs, large (Drosophila) homolog 1, U13896.1

lysyl oxidase-like 1 (LOXL1), L21186.1

calumenin, U67280.1

male germ cell-associated kinase, NM_005906.2

plectin 1, intermediate filament binding protein, 500kD, Z54367

peroxisome biogenesis factor 1, AF026086.1

mast cell tryptase beta III, AF099143

ataxia-telangiectasia group D-associated protein, AF230388.1

hypothetical protein FLJ10921, NM_018272.1

biglycan, BC002416.1

BLu protein, AC002481

CGI-92 protein, AF151850.1

adaptor-related protein complex 1, mu 2 subunit, BC003387.1

keratin 15, BC002641.1

B7 protein, U72508.1

S100 calcium-binding protein A2, BC002829.1

MUF1 protein, BC004953.1

cholesterol 25-hydroxylase, AF059214.1

cytidine monophosphate-N-acetylneuraminic acid hydroxylase (CMP-N-acetylneuraminate monooxygenase), AF074480.1

neuropilin 2, AF022859.1

Fas-interacting serinethreonine kinase 3, homeodomain-interacting protein kinase 3, AF305239.1

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a disintegrin and metalloproteinase domain 28 (ADAM28), transcript variant 2, AF137334.1

cDNA DKFZp434A119 , AW663632

complement component 6, J05064.1

cytokeratin 17, Z19574

wingless-type MMTV integration site family, member 5A, AI968085

matrix metalloproteinase 7 (matrilysin, uterine), BC003635.1

leiomodin 1 (smooth muscle), NM_012134.1

Cip1-interacting zinc finger protein, AB030835.1

cyclin-dependent kinase inhibitor 1A (p21, Cip1), BC000275.1

integrin, alpha 7, AF032108.1

DKFZP586G011 protein, BG289527

fatty acid binding protein 6, ileal (gastrotropin), U19869.1

glutathione S-transferase M4, M96234.1

Ras-related associated with diabetes, L24564.1

claudin 3, AB000714.1

matrix metalloproteinase 10 (stromelysin 2), BC002591.1

fibulin 2, NM_001998.1

serine threonine kinase 11 (STK11), AF035625

eukaryotic translation initiation factor 1A: AF000987.1

DEADH (Asp-Glu-Ala-AspHis) box polypeptide: AF000985.1

ribosomal protein S4: AF116711.1

ubiquitin specific protease 9: AF000986.2

SMC (mouse) homolog: U52191.1

myelin basic protein: L18865.1

S100 calcium-binding protein: NM_005980.1

Jagged2 (JAG2): AF003521.1

latent transforming growth factor beta binding protein 4: NM_003573.1

microtubule-associated protein, RPEB family, member 3: AB025186.1

Unknown (protein for MGC:2854): BC003629.1

clone=IMAGE-2406340: AI830563

AQP3 gene for aquaporine 3 (water channel): AB001325

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cDNA DKFZp434A119

fenestrated-endothelial linked structure protein (FELS), PV1 protein (PLVAP): AF326591.1

LUNX protein; PLUNC (palate lung and nasal epithelium clone); tracheal epithelium enriched protein (LOC51297): AB024937.1

RAB, member of RAS oncogene family-like 2A: AF095350.1

chromosome 11 open reading frame 16: NM_020643.1

hypothetical protein FLJ23049: NM_024687.1

hypothetical protein FLJ11767: NM_024593.1

dynein, axonemal, intermediate polypeptide: AF091619.1

brain specific protein (LOC51673): AF132972.1

MUC4 apomucin, mucin 4, tracheobronchial: AJ242547.1

myotonin protein kinase (DM): M87313.1

cytokeratin 4: X07695.1

KIAA0362 gene, MCF.2 cell line derived transforming sequence-like: AB002360.1

cytokeratin 17: Z19574

LIM domain protein: BC003096.1

E74-like factor 3 (ets domain transcription factor, epithelial-specific) : U73844.1

fatty acid binding protein 6, ileal (gastrotropin): U19869.1

sperm associated antigen 6: AF079363.1

eyes absent (Drosophila) homolog 2: U71207.1

phosphatidic acid phosphatase type 2C: BC002806.1

epoxide hydrolase 2, cytoplasmic: AF233334.1

tubulin, beta, 2: BC002783.1

heat shock 105kD: D86956.1

villin 2 (ezrin): J05021.1

a disintegrin and metalloproteinase domain 28 (ADAM28), transcript variant 3: AF137335.1

deleted in lung and esophageal cancer 1: NM_007337.1

arachidonate 15-lipoxygenase: NM_001140.1

UDP glycosyltransferase 1 family, polypeptide A1: M57899.1

hypothetical protein PRO2834: AF119903.1

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lectin, galactoside-binding, soluble, 7 (galectin 7): L07769.1

B7 protein: U72508.1

ephrin receptor EPHA3: AF213459.1

forkhead box J1: U69537.1

BLu protein: U70824.1

aldehyde dehydrogenase 3 family, member A1: BC004370.1

NG22 protein: NM_025257.1

small inducible cytokine subfamily A (Cys-Cys), member 14: NM_004166.1

cysteine-rich protein 1 (intestinal): BC002738.1

putative GTP-binding protein similar to RAYRAB1C: BC000566.1

integrin, beta 4: NM_000213.1

serine (or cysteine) proteinase inhibitor, clade B (ovalbumin), member 5 (SERPINB5): U04313.1

Ras-related associated with diabetes: L24564.1

hepatic leukemia factor: M95585.1

keratin 15: BC002641.1

nuclear receptor subfamily 4, group A, member 2: NM_006186.1

sialyltransferase: U14550.1

glutathione S-transferase M2 (muscle): M63509.1

hypothetical protein FLJ13110: NM_022912.1

S100 calcium-binding protein A2: NM_005978.2

collagen, type VII, alpha 1 (epidermolysis bullosa, dystrophic, dominant and recessive) : L02870.1

claudin 3: AB000714.1

insulin-like growth factor binding protein 6: BC003507.1

fibroblast growth factor receptor 2 (bacteria-expressed kinase, keratinocyte growth factor receptor, craniofacial dysostosis 1, Crouzon syndrome, Pfeiffer syndrome, Jackson-Weiss syndrome): M80634.1

insulin-like growth factor 1 receptor: NM_000875.2

insulin-like growth factor binding protein 2 (36kD): M35410.1

ataxia-telangiectasia group D-associated protein: AF230388.1

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keratin 5 (epidermolysis bullosa simplex, Dowling-MearaKobnerWeber-Cockayne types): M21389.1

Duffy blood group: U01839.1

transforming growth factor β_1, NM_000660

sorting nexin 10 (SNX10), AF121860.1

phospholipase A2, group IIA (platelets, synovial fluid), M22430.1

hemoglobin alpha-1 globin chain (HBA1), AF349571.1

macrophage scavenger receptor 1, AI299239

surfactant, pulmonary-associated protein C, BC005913.1

disintegrin protease (M12.219), NM_014479.1

retinol-binding protein 4, interstitial, AF119868.1

major histocompatibility complex, class II, DR beta 3, M27635.1

adipose differentiation-related protein, BC005127.1

hemoglobin, delta, NM_000519.2

beta-2-microglobulin, AW188940

hemoglobin, alpha 2, BC005931.1

protein C receptor, endothelial (EPCR), L35545.1

thymosin, beta 10, M92381.1

apolipoprotein C-I, W79394

hypothetical protein, AL133067.1

proteoglycan 4, (megakaryocyte stimulating factor, articular superficial zone protein), U70136.1

tetranectin (plasminogen-binding protein), NM_003278.1

platelet factor 4, M25897.1

tissue factor pathway inhibitor 2, BC005330.1

fatty acid binding protein 4, adipocyte, BC003672.1

cathepsin B (CTSB), M14221.1

transmembrane 4 superfamily member 1, M90657.1

MHC class I HLA-B51 major histocompatibility complex, class I, E, M31183.1

endothelial PAS domain protein 1, U51626.1

Apo-2 ligand tumor necrosis factor (ligand) superfamily, member 10, U37518.1

haptoglobin-related protein, NM_020995.1

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Rho guanine exchange factor (GEF) 12, AF119898.1

major histocompatibility complex, class II, DR beta 5, M11867.1

interferon, gamma-inducible protein 30, AF097362.1

ferritin, light polypeptide, BG537190

prosaposin (variant Gaucher disease and variant metachromatic leukodystrophy), BC004275.1

calcium-binding protein A4 (calvasculin, metastasin,), NM_002961.2

hemoglobin, beta, M25079.1

CDW52 antigen (CAMPATH-1 antigen), BC000644.1

aldehyde dehydrogenase 1 family, member A2, AB015226.1

cathepsin Z, AF032906.1

MHC HLA-B39 major histocompatibility complex, class I, B, L37880.1

major histocompatibility complex, class II, DQ alpha 1, M33906.1

fibroblast growth factor 9 (glia-activating factor), D14838.1

hemoglobin, alpha 2, AF097635.1

transferrin receptor (p90, CD71), BC001188.1

complement component 3 (C3), K02765.1

cDNA DKFZp564D066, AL050025.1

complement component 1, q subcomponent, beta polypeptide, NM_000491.2

small inducible cytokine subfamily A (Cys-Cys), member 18, pulmonary and activation-regulated, AB000221.1

reticulon 1, L10333.1

major histocompatibility complex, class II, DR beta 1, M33600.1

haptoglobin, L29394.1

acid phosphatase 5, tartrate resistant, J04430.1

cytochrome P450, subfamily XXVIIA (steroid 27-hydroxylase, cerebrotendinous xanthomatosis), polypeptide 1, M62401.1

CD36 antigen (collagen type I receptor, thrombospondin receptor), M24795.1

calbindin 2, (29kD, calretinin), NM_001740.2

alpha-2-HS-glycoprotein, BG538564

cDNA DKFZp564A132, AL049963.1

fibronectin 1, AF130095:1

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phosphodiesterase 4C, cAMP-specific, NM_000923.1

transcription factor 7 (T-cell specific, HMG-box), NM_003202.1

found in inflammatory zone 3 (FIZZ3), AF323081.1

claudin 15, NM_014343.1

carboxypeptidase B1 (tissue), M81057.1

hypothetical protein FLJ14054, NM_024563.1

bone marrow stromal cell antigen 1, D21878.1

interleukin 7 receptor, M29696.1

procollagen C-endopeptidase enhancer 2, AF098269.1

calcium-binding protein A8 (calgranulin A), AW238654

cDNA DKFZp564D193, AL049252.1

major histocompatibility complex, class II, DP beta 1, J03041.1

human leukocyte antigen C alpha chain, major histocompatibility complex, class I, C, AK024836.1

BCM-like membrane protein precursor, AF144235.1

CD14 antigen, M86511.1

pulmonary surfactant protein (SP5), J03553

signal transducer and activator of transcription 1, 91kD, BC002704.1

Wilms tumor 1 (WT1), transcript variant D, NM_024424.1

annexin A8, BC004376.1

macrophage receptor with collagenous structure, MARCO, AF035819.1

surfactant, pulmonary-associated protein A2, NM_006926.1

solute carrier family 6 (neurotransmitter transporter, serotonin), member 4, L05568.1

chitinase 1 (chitotriosidase), U29615.1

lung type-I cell membrane-associated glycoprotein, AU154455

fibronectin leucine rich transmembrane protein 2, AB007865.1

gamma-aminobutyric acid (GABA) A receptor, alpha 5, BF966183

hypothetical protein FLJ12983, NM_024856.1

sialophorin (gpL115, leukosialin, CD43), J04536.1

cerebellar degeneration-related protein (34kD), M16965.1

hydroxyacid oxidase 2 (long chain), hydroxy-delta-5-steroid dehydrogenase (3 beta-and steroid delta-isomerase 2), AL359553

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CLONE=IMAGE:1032795=Hs.83623 nuclear receptor subfamily 1, group I, member 3

small inducible cytokine subfamily C, member 2: NM_003175.1

hypothetical protein similar to swine acylneuraminate lyase: NM_030769.1

fibrinogen, gamma polypeptide: AF118092.1

thrombospondin 1: NM_003246.1

SAM domain, SH3 domain and nuclear localisation signals, 1: AF222927.1

chitinase 3-like 1 (cartilage glycoprotein-39): M80927.1

cathepsin Z: AF032906.1

CLONE=IMAGE:3579023 collagen, type XIV, alpha 1 (undulin)

chloride intracellular channel 2: NM_001289.2

monokine induced by gamma interferon: NM_002416.1

KIAA0433 protein: NM_015216.1

tumor necrosis factor, alpha-induced protein 6: NM_007115.1

signal transducer and activator of transcription 1, 91kD: BC002704.1

thrombospondin 2: L12350.1

collagen, type IV, alpha 3 (Goodpasture antigen): NM_000091.1

integrin, beta-like 1 (with EGF-like repeat domains): AF072752.1

diubiquitin: NM_006398.1

protease, cysteine, 1 (legumain): D55696.1

cytochrome P450, subfamily I (dioxin-inducible), polypeptide 1 (glaucoma 3, primary infantile): U03688.1

integrin, alpha 1: X68742.1

GABA-B receptor, G protein-coupled receptor 51: AF056085.1

KIAA1199 protein: AB033025.1

collagen, type V, alpha 2: NM_000393.1

interleukin 13 receptor, alpha 2: U70981.1

translocase of inner mitochondrial membrane 8 (yeast) homolog A: BC005236.1

steroid sulfatase (microsomal), arylsulfatase C, isozyme S: M16505.1

CLONE=IMAGE:1982571 ATPase, H+ transporting, lysosomal (vacuolar proton pump) 9kD

proteoglycan 4, (megakaryocyte stimulating factor, articular superficial zone protein): U70136.1

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nidogen (enactin): M30269.1

KIAA1598 protein: AU157109

vascular cell adhesion molecule 1: M60335.1

guanylate binding protein 1, interferon-inducible, 67kD: BC002666.1

cDNA DKFZp586E1124

apolipoprotein H (beta-2-glycoprotein I): M62839.1

ribosomal protein L37a: BE857772

cDNA DKFZp564A132

cathepsin S: M86553.1

a disintegrin and metalloproteinase domain 9 (meltrin gamma) (ADAM9): U41766.1

zinc finger protein 331: AF272148.1

lysosomal-associated membrane protein 2: J04183.1

carboxypeptidase M: NM_001874.1

collagen, type I, alpha 2: NM_000089.1

P311 protein: U36189.1

KIAA0372 gene product: AB002370.1

Human T cell-specific protein RANTES: M21121

interferon-gamma-inducible indoleamine 2,3-dioxygenase (IDO): M34455.1

hypothetical protein FLJ10430: NM_018092.1

transcription factor ISGF-3: M97935

interleukin 1 receptor-like 1 (IL1RL1): NM_003856.1

putative alpha chemokine (H174), small inducible cytokine subfamily B (Cys-X-Cys), member 11: AF002985.1

small inducible cytokine subfamily B (Cys-X-Cys), member 10: NM_001565.1

mesoderm specific transcript (mouse) homolog: BC002413.1

carboxypeptidase B-like protein: AB011969.1

CD2 antigen (p50), sheep red blood cell receptor: M16445.

interferon, alpha-inducible protein (clone IFI-6-16): NM_022872.1

RAS guanyl releasing protein 1 (calcium and DAG-regulated): AF081195.1

lipase, endothelial: AF118767.1

fatty-acid-Coenzyme A ligase, long-chain 4: NM_022977.1

klotho: AB005142.1

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chondroitin sulfate proteoglycan 2 (versican): NM_004385.1

hypothetical protein, expressed in osteoblast: AB000115.1

CD14 antigen: M86511.1

CGI-83 protein: BC000878.1

leucine aminopeptidase: AF061738.1

UDP-Gal:betaGlcNAc beta 1,3-galactosyltransferase, polypeptide 3: AB050855.1

protocadherin alpha 12: AF152308.1

neuroglycan C: AF059274

neuroligin: AI338338

HSPC156 protein: AF161505.1

hypothetical protein FLJ13310: NM_025118.1

eosinophil chemotactic cytokine (TSA1902): AB025008.1

aminopeptidase: AF191545.1

semaphorin sem2: AB029496.1

protocadherin 12: AF231025.1

X transporter protein 3: NM_020208.1

transmembrane 4 superfamily member (tetraspan NET-2): AF124522.1

hypothetical protein FLJ10970: NM_018286.1

perforin 1 (pore forming protein): M28393.1

natural killer cell group 7 sequence: NM_005601.1

hypothetical protein DKFZp761N09121: BF435376

integrin, alpha 4 (antigen CD49D, alpha 4 subunit of VLA-4 receptor): BG532690

chitinase 3-like 2: U58515.1

FYN oncogene: N20923

relaxin 1 (H1): BC005956.1

hydroxyprostaglandin dehydrogenase 15-(NAD): U63296.1

sulfotransferase family, cytosolic, 1C, member 1: AF186254.1

TGF-b superfamily receptor type I: L17075.1

granzyme B (granzyme 2, cytotoxic T-lymphocyte-associated serine esterase 1): M36118.1

cystatin F (leukocystatin): AF031824.1

regulator of G protein signaling-Z (RGSZ1): AF060877.2

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clone MGC:12387: M16942.1

zinc-alpha2-glycoprotein: D90427.1

BCG induced integral membrane protein BIGMo-103: AB040120.1

nectin-like protein 2 (NECL2): AF132811.1

CD209 antigen-like: AB015629.1

solute carrier family 6 (neurotransmitter transporter, serotonin), member 4: L05568.1

MAD (mothers against decapentaplegic, Drosophila) homolog 6: U59914.1

latrophilin: AF104939.1

platelet factor 4: M25897.1

calcitonin receptor-like: L76380.1

matrilin 3: NM_002381.2

solute carrier family 14 (urea transporter), member 1 (Kidd blood group): U35735.1

interleukin 7 receptor: M29696.1

MAP kinase kinase 6 (MKK6), mitogen-activated protein kinase kinase 6: U39656.1

protocadherin 17: AF029343.1

granulysin: NM_006433.2

interferon-stimulated protein, 15 kDa (ISG15): M13755.1

cadherin 5, type 2, VE-cadherin (vascularepithelium): U84722.1

thrombomodulin: M16552.1

interferon, alpha-inducible protein 27: NM_005532.1

interferon-gamma, X87308

and allelic variants or mutants thereof

and sequences specific for infectious agents, comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for Mycobacterium spec., Mycoplasma spec., Staphyllococcus aureus, Streptococcus spec., Borrelia, Treponema pallidum, Leptospira interrogans, Campylobacter jejuni, Escherichia coli, EPEC, ETEC, EIEC, EHEC Salmonella enterica, Yersinia enterocolitica, Aeromonas spec., Campylobacter fetus, Moraxella catarrhalis, Moraxella catarrhalis, Brucella spec., Toxoplasma, Salmonella enterica, Shigella spec., Yersinia enterocolitica, Vibrio cholerae, Pseudomonas aeruginosa, Burkholderia cepacia, Stenotrophomonas maltophilia, Acinetobacter baumanii, Acitenobacter calcoaceticus, Klebsiella, Enterobacter, Citrobacter, Proteus, Serratia, Morganella, Providencia, Cardiobacterium hominis, Eikenella corrodens, Gardnerella vaginalis,

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Calymmatobacterium granulomatis, Bacteriodes, Porphyromonas, Prevotella, Fusobacterium, Rickettsia prowazekii, Bartonella bacilliformis, Bartonella henselae, Chlamydia spec., yeasts, fungi, retroviruses, adenoviruses, hepadnaviruses, herpesviruses, influenza viruses, paramyxoviruses.

20. (Currently Amended) ~~Use of a~~ A pharmaceutical kit comprising:

(i) a package comprising IFN-γ[[,]];

(ii) a package comprising a polynucleotide library for the molecular characterization of an interstitial lung disease (ILD), said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are either underexpressed or overexpressed in ILD cells; and

(iii)a package comprising a polynucleotide library for the molecular characterization of infectious agents, said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for bacteria, mycoplasma, viruses, fungi, or yeasts.

21. (Currently Amended) ~~Use of~~ The pharmaceutical kit according to claim 19 further comprising a package comprising a glucocorticoid compound.

22. (Currently Amended) ~~Use of a~~ A pharmaceutical kit comprising:

(i) a package comprising pegylated IFN-γ[[,]];

(ii) a package comprising a polynucleotide library for the molecular characterization of an interstitial lung disease (ILD), said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are either underexpressed or overexpressed in ILD cells; and

(iii)a package comprising a polynucleotide library for the molecular characterization of infectious agents, said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for bacteria, mycoplasma, viruses, fungi, or yeasts.

23. (Currently Amended) ~~Use of~~ The pharmaceutical kit according to claim 21 further comprising a package comprising a glucocorticoid compound.

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24. (Currently Amended) ~~Use of a~~ A pharmaceutical kit comprising:

(i) a package comprising pirfenidone[[,]];

(ii) a package comprising a polynucleotide library for the molecular characterization of an interstitial lung disease (ILD), said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are either underexpressed or overexpressed in ILD cells; and

(iii) a package comprising a polynucleotide library for the molecular characterization of infectious agents, said library comprising a pool of polynucleotide sequences or subsequences thereof wherein said sequences or subsequences are characteristic for bacteria, mycoplasma, viruses, fungi, or yeasts.

25. (Currently Amended) ~~Use of~~ The pharmaceutical kit according to claim 23 further comprising a package comprising a glucocorticoid compound.

26. (Currently Amended) ~~Use of~~ The pharmaceutical kit according to ~~claims~~ claim 19[[-24]] for the manufacture of a medicament for the treatment of interstitial lung diseases (ILD).

27. (Currently Amended) ~~Use of~~ The pharmaceutical kit according to ~~claims~~ claim 19[[-25]], wherein IFN-γ is administered to the individual in a single dose amount varying from 2.0 to 3.0 μg / kg body weight.

28. (Currently Amended) ~~Use of~~ The pharmaceutical kit according to ~~claims~~ claim 19[[-26]], wherein the glucocorticoid compound is administered to the individual in a single dose amount varying from 100 to 150 μg / kg body weight.

29. (Currently Amended) ~~Use of~~ The pharmaceutical kit according to ~~claims~~ claim 19[[-27]], wherein interferon gamma or pegylated interferon gamma is administered to the individual by inhalation.

30-32. (Canceled)

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REMARKS

It is respectfully submitted that the amendments made to the claims herein are neither being presented nor made in response to the citation of any prior art known to the Applicants or the Applicants' attorneys. This amendment is further not made for any reason related to any statutory requirements for patentability. This amendment is made solely to more precisely claim the subject matter to which Applicants are entitled. It is submitted that no new matter has been added.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: June 7, 2004

Respectfully submitted,

By _____
Ashley N. Moore
Registration No.: 51,667
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Overstreet, Marcy

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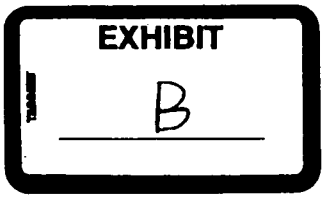

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Overstreet, Marcy

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Tracking number:	727165506659	**Ship date:**	Apr 11, 2006
		Weight:	1.5 lbs.
Recipient:		**Shipper:**	
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Reference		69137-00004USPX04189	

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Subject: FedEx Shipment Notification

This tracking update has been requested by:

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E-mail:

MARTHA OVERSTREET of JENKENS & GILCHRIST PC sent Michael W. Maddox of Jenkens & Gilchrist 1
package(s).

This shipment is scheduled to be sent on 04/20/2006.

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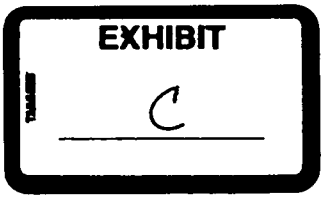

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		Destination	Dallas, TX
		Service type	Priority Pak
		Weight	2.0 lbs.
Status	Package data transmitted to FedEx		

Date/Time		Activity	Location	Details
Apr 20, 2006	4:02 AM	**Package data transmitted to FedEx**		

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

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JUL 05 2007

OFFICE OF PETITIONS

In re Application of :

PILZ, Georg et al. :
Application No. 10/498,098 : DECISION ON PETITION
Filed: June 10, 2004 : TO WITHDRAW
Attorney Docket No. **449122073000** : 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 11, 2007.

The request is **APPROVED**.

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

The request was signed by 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: **GEORG PILZ**
BUENAUSTR. 54
DRESDEN, GERMANY 01159

cc: **LERNER, GREENBERG, STEMER LLP**
2445 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020

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OFFICE OF PETITIONS

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

In re Application of

PILZ, Georg et al.
Application No. 10/498,098
Filed: June 10, 2004
Attorney Docket No. **449122073000**

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 11, 2007.

The request is **APPROVED**.

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

The request was signed by 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.

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Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **GEORG PILZ**
BUENAUSTR. 54
DRESDEN, GERMANY 01159

cc: **LERNER, GREENBERG, STEMER LLP**
2445 HOLLYWOOD BOULEVARD
HOLLYWOOD, FL 33020

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Nicht abgeholt	☐	Non réclamé
Nicht zulässig	☐	Non admis

Rücksendung am/Retour le: 13. JUL 2007

1/GroCom 01.03 915-025-000

GEORG PILZ
~~BUENAUSTR. 54~~
~~DRESDEN, GERMANY 01159~~

04 NOV 2004

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BOSTON MA 02110

In re Application of REITNAUER et al.	:
Application No.: 10/498,103	: DECISION ON PETITION
PCT No.: PCT/US02/37446	:
Int. Filing: 21 November 2002	:UNDER 37 CFR 1.47(a)
Priority Date: 04 December 2001	:
Attorney Docket No.: 06155-074US1	:
For: HOT MELT INKS	:

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 03 September 2004, to accept the application without the signature of joint inventor, DeAva Lambert.

BACKGROUND

On 03 June 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 23 August 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 03 September 2004, 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, DeAva Lambert, alleging that Ms. Lambert cannot be found or refuses to execute the application.

DISCUSSION

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

The petition included the requisite petition fee, satisfying Item (1).

Item (3) is not satisfied because the last known address of non-signing inventor, DeAva Lambert, was not provided. With regard to item (4), the declaration submitted did not identify the correct international application number, PCT/US02/37446 but rather identified

PCT/US02/37445. Thus, the declaration does not satisfy the requirements of 37 CFR 1.497(a) & (b), or the requirements of 37 CFR 1.47(a).

Refusal to Sign

Petitioner is alleging that Ms. Lambert is both unavailable and refuses to sign the declaration. In attempting to satisfy Item (2) above, Petitioner submits the declaration under 37 CFR 1.47(a) from Robert E. Hume, administrator of Product Development and Engineering, Markem Corporation. Mr. Hume states that on 14 June 2004, a cover letter, a Declaration and Power of Attorney, and an Assignment was sent to DeAva Lambert asking her to sign the Declaration and Power of Attorney and Assignment and return the documents. The package was mailed to her residence in Coventry, Connecticut. Mr. Hume further states that on 07 July 2004, after learning that Ms. Lambert moved, a second package was mailed to her "new address"; however, this package was returned by the USPS with the notation "Moved, left no address, Unable to forward". A copy of the letter and postal receipt was attached to the declaration. Mr. Hume does not indicate that a copy of the application (including specification, claims and drawings) was sent to Ms. Lambert. Mr. Hume does not state that he made any further attempts to contact Ms. Lambert at her home in Coventry, Connecticut or that the package mailed to that address was returned. Nor has an attempt to reach Ms. Lambert at her place of employment been documented.

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in 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 statement of facts. It is important that the statement contain facts as opposed to conclusions.
>
> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or , if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
> ....
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which 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.

First, in his declaration under 37 CFR 1.47(a), Mr. Hume indicates that only the declaration/power of attorney and assignment were sent to the inventor for her signature with no mention or proof that a copy of application papers (specification, including claims, and drawings) were also sent to the nonsigning inventor for her signature. Indeed, the copy of a letter to Ms. Lambert indicates that only the declaration and assignment were enclosed.

Since there is no indication that a complete copy of the application papers including specification, claims and drawings, were mailed to Ms. Lambert, what is required is that Ms. Lambert be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for this application.

Second, if petitioner is alleging that Ms. Lambert refuses to cooperate in signing the application, the circumstances of Ms. Lambert's refusal must be provided. As outlined above, Mr. Hume's statement does not provide any details of the non-signing inventor's refusal. Where a refusal to sign the application papers is alleged, the circumstances of the presentation of the papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts by the person having firsthand knowledge of the facts recited therein. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. Thus, at this time it cannot be concluded that Ms. Lambert refuses to sign the application.

Unavailable or Unable to Locate

Mr. Hume indicates that on 07 July 2004, a copy of the declaration and power of attorney was sent to Ms. Lambert but delivery was not successful because Ms. Lambert's had moved. Without describing any further attempts to locate inventor Lambert, counsel concludes that Ms. Lambert is unavailable or refuses to sign the Declaration.

As indicated in the MPEP Section 409.03(d), 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.

Further attempts to locate Ms. Lambert have not been pursued and documented, such as Internet searches, E-mail contact to obtain a current address, or contact with her former employer or joint inventor to obtain a forwarding address. No attempt to further contact Ms. Lambert at the Coventry, Connecticut address was made or telephone her. 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. Petitioner's statement of facts under 37 CFR 1.47(a) merely states that Ms. Lambert is unavailable or refuses to sign the Declaration and Power of Attorney. Since no further attempts to locate inventor Lambert have been documented, it can not be concluded that "a diligent effort" was made to locate the non-signing inventor.

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 10/498,103 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and (2) Ms. Lambert's unavailability or refusal to sign, either in writing or by telephone, these documents.

The evidence submitted does not support a finding that the nonsigning inventor is unavailable or refuses to sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

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

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

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

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

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In re Application of REITNAUER et al.	:
Application No.: 10/498,103	: DECISION
PCT No.: PCT/US02/37446	:
Int. Filing: 21 November 2002	:
Priority Date: 04 December 2001	:
Attorney Docket No.: 06155-074US1	:
For: HOT MELT INKS	:

This is a decision on applicant's Response to Notification of Missing Requirements, filed in the United States Patent and Trademark Office (USPTO) on 27 December 2004.

On 03 June 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 23 August 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 03 September 2004, applicant filed a Petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, DeAva Lambert, alleging that Ms. Lambert cannot be found or refuses to execute the application.

On 27 November 2004, a decision dismissing applicant's petition under 37 CFR 1.47(a) was mailed indicating that the evidence submitted did not support a finding that the nonsigning inventor was unavailable or refused to sign the application.

On 27 December 2004, applicant filed the instant response along with two executed declarations. A review of the declarations reveal that they are in compliance with 37 CFR 1.497(a) and (b) and are acceptable.

The application will be forwarded to United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (2) and (4) date is **27 December 2004.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

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OFFICE OF PETITIONS

In re Application of :
Reitnauer et al. :
Application No. 10/498,103 : LETTER REGARDING
Filed: December 27, 2004 : PATENT TERM ADJUSTMENT
Atty Docket No. 06155-074US1 :

This letter is in response to the "LETTER REGARDING PATENT TERM ADJUSTMENT" filed February 20, 2009. Pursuant to their duty of good faith and candor to the Office, applicants disclose that the initial determination of patent term adjustment of three hundred three (303) days may be longer than appropriate.

The request for review of the initial determination of patent term adjustment (PTA) is **GRANTED.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one hundred eighty-eight **(188)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On December 31, 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 303 days. Applicants do not state a basis for their disclosure that the patent term adjustment may be longer than appropriate.

Nonetheless, a review of the record confirms that entry of an additional period of reduction for applicant delay is warranted.

37 CFR 1.704(c)(7) establishes submission of a reply having an omission (37 CFR 1.135(c)) as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. 37 CFR 1.704(c)(7) provides that in such a case the period of adjustment set forth in 37 CFR 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed. The reference to 37 CFR 1.135(c) is parenthetical because 37 CFR 1.704(c)(7) is not limited to Office actions under 37 CFR 1.135(c) but applies when the Office issues any action or notice indicating that a reply has an omission which must be corrected: e.g., (1) a decision on a petition under 37 CFR 1.47 dismissing the petition as lacking an item necessary to grant the petition; or (2) a notice indicating that the computer readable format sequence listing filed in reply to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661) does not comply with 37 CFR 1.821 et seq.

In this instance, a reply to the Notification of Missing Requirements mailed August 23, 2004 was filed on September 3, 2004[1]. This reply included *inter alia* a declaration and a petition under 1.47. A decision dismissing the petition and noting the deficiencies in the reply was mailed on November 4, 2004. A renewed petition correcting the deficiencies was filed on December 27, 2004 (See decision granting petition mailed March 2, 2005). Accordingly, a period of reduction of 115 days is being entered for the period beginning on the day after the date the reply having an omission was filed, September 4, 2004 and ending on the date that the reply correcting the omission was filed, December 27, 2004.

In view thereof, it is concluded that the determination of PTA at the time of the mailing of the notice of allowance is ONE HUNDRED EIGHTY-EIGHT (188) days (416 (413 + 3) days of Office delay reduced by 24 + 89 + 115 days of applicant delay).

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

---

[1] As this reply was filed within three months, there was properly no reduction pursuant to 37 CFR 1.704(b).

for their good faith and candor in bringing this to the attention of the Office.

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 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

PTA Calculations for Application: 10/498103			
Application Filing Date:	12/27/2004	PTO Delay (PTO):	416
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	113
Post-Issue Petitions:	0	Total PTA (days):	188
PTO Delay Adjustment:	-115		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
82	06/21/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		115	
73	12/31/2008	MAIL NOTICE OF ALLOWANCE	3		59
72	12/22/2008	ISSUE REVISION COMPLETED			
71	12/22/2008	DOCUMENT VERIFICATION			
70	12/22/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
69	12/22/2008	CASE DOCKETED TO EXAMINER IN GAU			
68	12/22/2008	NOTICE OF ALLOWABILITY			
62	05/22/2008	REFERENCE CAPTURE ON IDS			
61	05/22/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
60	09/30/2008	DATE FORWARDED TO EXAMINER			
59	08/28/2008	RESPONSE AFTER NON-FINAL ACTION			
58	07/22/2008	MAIL NON-FINAL REJECTION			
57	07/21/2008	NON-FINAL REJECTION			
56	05/22/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
55	05/22/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
54	04/15/2008	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
53	04/22/2008	DATE FORWARDED TO EXAMINER			
52	04/15/2008	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
51	04/22/2008	DATE FORWARDED TO EXAMINER			
50	04/15/2008	REQUEST FOR CONTINUED EXAMINATION (RCE)		89	46
		DISPOSAL FOR A RCE/CPA/129 (EXPRESS			

49	04/22/2008	ABANDONMENT IF CPA)			
48	04/15/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
47	04/15/2008	WORKFLOW - REQUEST FOR RCE - BEGIN			
46	10/17/2007	MAIL FINAL REJECTION (PTOL - 326)			
45	10/15/2007	FINAL REJECTION			
44	08/09/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
43	10/04/2007	CASE DOCKETED TO EXAMINER IN GAU			
42	08/11/2007	DATE FORWARDED TO EXAMINER			
41	08/09/2007	RESPONSE AFTER NON-FINAL ACTION		24	37
40	08/09/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
39	08/09/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
38	08/09/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
37	04/16/2007	MAIL NON-FINAL REJECTION	413		-1
34	03/22/2007	NON-FINAL REJECTION			
33	03/11/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
32	03/11/2005	REFERENCE CAPTURE ON IDS			
31.7	03/11/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
31	03/11/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
30	10/03/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
29	12/05/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
28	12/15/2006	CASE DOCKETED TO EXAMINER IN GAU			
27	09/13/2006	CORRESPONDENCE ADDRESS CHANGE			
26	04/27/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
24	12/05/2005	REFERENCE CAPTURE ON IDS			
23.7	12/05/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
23	12/05/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
22.7	10/03/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

22	10/03/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
21	04/15/2005	CLEARED BY OIPE CSR			
20	04/15/2005	CLEARED BY OIPE CSR			
19	04/15/2005	CLEARED BY OIPE CSR			
18	04/15/2005	CLEARED BY OIPE CSR			
17	04/15/2005	CLEARED BY OIPE CSR			
16	04/15/2005	CLEARED BY OIPE CSR			
15	04/15/2005	CLEARED BY OIPE CSR			
14	04/08/2005	CLEARED BY OIPE CSR			
13	12/27/2004	371 COMPLETION DATE			
12	03/31/2005	APPLICATION DISPATCHED FROM OIPE			
11	03/31/2005	NOTICE OF DO/EO ACCEPTANCE MAILED			
10	12/27/2004	ADDITIONAL APPLICATION FILING FEES			
9	03/11/2005	INFORMATION DISCLOSURE STATEMENTS			
8	03/11/2005	COPY OF REFERENCES CITED IN INTERNATIONAL SEARCH REPORT			
7	12/27/2004	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
6	03/03/2005	MAIL-PETITION DECISION - GRANTED			
5	12/27/2004	PETITION ENTERED			

Search Another: Application# Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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Paper No.

FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

MAILED

MAR 01 2010

OFFICE OF PETITIONS

In re Patent No. 7,578,874	:	
Benjamin et al.	:	DECISION ON REQUEST
Issue Date: August 25, 2009	:	FOR
Application No. 10/498,103	:	RECONSIDERATION OF
Filed: December 27, 2004	:	PATENT TERM ADJUSTMENT
Atty Docket No. 06155-074US1	:	and
	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION

This is a decision on the petition filed on October 15, 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 (500) days. This calculation includes patentee's correct disclosure that additional period of reduction of 37 days should have been entered pursuant to 37 CFR 1.78(c)(8) for applicant's filing of an IDS on May 22, 2008.

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 four hundred ninety-nine (499) days is **GRANTED to the extent indicated herein.**

Patentee incorrectly calculates the excluded period for the request for continued examination (RCE) as 497 days, when it should be 498 days. Patentee acknowledges that the RCE was filed on April 15, 2008, but fails to begin counting on April 15, 2008. The period beginning on April 15, 2008 and ending on August 25, 2009 is 498 days. Thus, the patent term adjustment is 499, not 500 days as calculated by patentee.

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

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

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **four hundred ninety-nine (499)** 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 : 7,578,874 B2

DATED : **August 25, 2009** **DRAFT**

INVENTOR(S) : Benjamin 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 221 days

Delete the phrase "by 221 days" and insert – by 499 days--

22 SEP 2004
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#3

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William P. Berridge
OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320

In re Application of Yann GUILMARD, et al. Application No.: 10/498,115 PCT No.: PCT/FR02/04093 Int. Filing Date: 28 November 2002 Priority Date: 07 December 2001 Attorney Docket No.: 120025 For: PROCESS TO DEPOSIT A PROTECTIVE COATING ON THE INNER WALL OF A TUBE, AND NOTABLY A GUN BARREL PRODUCED ACCORDING TO THIS PROCESS	DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 09 June 2004 in the above-captioned application is hereby **GRANTED** as follows:

On 28 November 2002, applicants filed international application PCT/FR02/04093, which claimed priority of an earlier French application filed 07 December 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 07 June 2004.

On 09 June 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 09 June 2004 reveals that all of the requirements of 37 CFR 1.137(b) for revival have been submitted. Applicants' statement that "the delay causing the abandonment of the application was unintentional" has been interpreted as meaning 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) at the time of filing this petition. If this is an incorrect interpretation in view of the rules, petitioners are required to provide a statement to that effect.

A review of the declaration of the inventors filed 09 June 2004 reveals that it is in compliance with 37 CFR 1.497. Since the translation of the international application and the declaration of the inventors were submitted after 30 months from the priority date claimed of 07 December 2001, an amount of $260, including $130.00 processing fee (fee code 1618) for submitting a translation after 30 months and $130.00 surcharge (fee code 1617) for filing an oath or declaration after 30 months, will be charged to Counsel's Deposit Account No. 15-0461, as authorized in the Transmittal Letter accompanying this petition.

Applicants' claim for priority is acknowledged. The application has an international filing date of **28 November 2002** under 35 U.S.C. 363 and a date of **09 June 2004** under 35 U.S.C. 371.

The request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

The application is being forwarded to the United States Designated/Elected Office for processing in accordance with this decision, that is, for issuance of a Notification of Acceptance of Application under 35 U.S.C. 371(1), (c)(2) and (c)(4) and 37 CFR 1.495 (Form PCT/DO/ EO/903) and for preparation and mailing of a filing receipt.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Office

NNH/LES:hn

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

Tel: (703) 308-6508

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : May 8 2007

TO SPE OF : ART UNIT 3632

SUBJECT : Request for Certificate of Correction for Appl. No. 10/498123patent no. 7104512

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: _____

Carl D. Friedman
Supervisory Patent Examiner
Group 3600

SPE

3632

Art Unit

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OFFICE OF PETITIONS

In re Application of :
Donald E. Murray, et al. :
Application No. 10/498,130 : DECISION ON PETITION
Filed: October 18, 2004 :
Attorney Docket No. 7865-145 MIS:jb :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 22, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.

This application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of May 1, 2006. This decision precedes the mailing of a Notice of Abandonment. 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).

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; (2) the petition fee of 1,500; and (3) a proper statement of unintentional delay.

This application is being referred to Technology Center AU 1656 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 7/23/06

TO SPE OF : ART UNIT 3721

SUBJECT : Request for Certificate of Correction on Patent No.: 7021032

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

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

Valerie Jackson

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9390 ext. 114

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

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

Comments:

7/30/06

SPE

3721
Art Unit

02 NOV 2003

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02 NOV 2004

David Silverstein
Andover-IP-Law
44 Park Street, Suite 300
Andover, MA 01810

In re Application of	
GODEC, Richard D.	
Application No.: 10/498,180	DECISION
PCT No.: PCT/US02/38250	
Int. Filing Date: 02 December 2002	ON PETITION UNDER
Priority Date: 03 December 2001	
Docket No.: IOSL-416 PCT/US	37 CFR 1.137(b)
For: SENSITIVE DETECTION OF UREA AND RELATED COMPOUNDS IN WATER	

Applicants' "Petition For Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the above-captioned application on 12 June 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

Telephone: (571) 272-3292
Facsimile: (571) 273-0459

16 FEB 2005

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Dann Dorfman Herrell & Skillman
A Professional Corporation
1601 Market Street
Suite 720
Philadelphia, PA 19103

In re Application of	:	
LUO et al.	:	
Application No.: 10/498,182	:	
PCT No.: PCT/US02/38553	:	DECISION ON PETITION
Int. Filing Date: 05 December 2002	:	UNDER 37 CFR 1.47(a)
Priority Date: 05 December 2001	:	
Attorney Docket No.: R&H04-13	:	
For: OPTICAL WAVEGUIDE TERMINATION WITH VERTICAL AND HORIZONTAL MODE SHAPING	:	

This decision is in response to applicants' "Petition under 37 CFR 1.47(a)" filed 03 December 2004 to accept the application without the signature of joint-inventor, Mindaugas F. Dautartas. The required petition fee of $200.00 has been submitted.

BACKGROUND

On 05 December 2002, applicants filed international application PCT/US02/38553 which claimed a priority date of 05 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, 05 June 2004.

On 04 June 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; a preliminary amendment; and an information disclosure statement.

On 30 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 03 December 2004, applicants filed the present petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1), (3) and(4) have been satisfied.

A review of the present petition and the accompanying papers reveal that applicants have satisfied item (2), in that the applicants have shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Mindaugas F. Dautartas. The steps taken by Niels Haun are sufficient to show that Mindaugas F. Dautartas 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**.

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
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

16 FEB 2005

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Dann Dorfman Herrell & Skillman
A Professional Corporation
1601 Market Street
Suite 720
Philadelphia, PA 19103

In re Application of :
LUO et al. :
Application No.: 10/498,182 :
PCT No.: PCT/US02/38553 : DECISION ON PETITION
Int. Filing Date: 05 December 2002 : UNDER 37 CFR 1.47(a)
Priority Date: 05 December 2001 :
Attorney Docket No.: R&H04-13 :
For: OPTICAL WAVEGUIDE TERMINATION WITH VERTICAL AND HORIZONTAL MODE SHAPING :

This decision is in response to applicants' "Petition under 37 CFR 1.47(a)" filed 03 December 2004 to accept the application without the signature of joint-inventor, Mindaugas F. Dautartas. The required petition fee of $200.00 has been submitted.

BACKGROUND

On 05 December 2002, applicants filed international application PCT/US02/38553 which claimed a priority date of 05 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, 05 June 2004.

On 04 June 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; a preliminary amendment; and an information disclosure statement.

On 30 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 03 December 2004, applicants filed the present petition under 37 CFR 1.47(a).

Petition Decision noted
Mr. Dautartas is a NON-signing INVENTOR.
His signature is not on the oath or declaration
RMH 3/9/07

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1), (3) and(4) have been satisfied.

A review of the present petition and the accompanying papers reveal that applicants have satisfied item (2), in that the applicants have shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Mindaugas F. Dautartas. The steps taken by Niels Haun are sufficient to show that Mindaugas F. Dautartas 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**.

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
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Mail Date: 04/21/2010

Applicant	: Juergen Loeffler	: DECISION ON REQUEST FOR
Patent Number	: 7590477	: RECALCULATION of PATENT
Issue Date	: 09/15/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/498,189	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/25/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1270** 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.

03 MAY 2005

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John J. Gresens
Merchant & Gould
P.O. Box 2903
Minneapolis, Minnesota 55402-0903

In re Application of :
KOLLAARD et al. :
Application No.: 10/498,202 :
PCT No.: PCT/IB02/05367 : DECISION ON
Int. Filing Date: 10 December 2002 : PAPERS UNDER 37 CFR 1.42
Priority Date: 13 December 2001 :
Attorney Docket No.: 09728.0311USWO :
For: SCREW ACTUATOR WITH LOCKING MECHANISM

This decision is in response to the "Communication" filed 09 March 2005, which is being treated as a request under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 10 December 2002, applicants filed international application PCT/IB02/05367, which claimed a priority date of 13 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 19 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, 13 June 2004.

On 29 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 09 March 2005, applicants filed a declaration executed by: Carl Vissers; Henk Kapaan; Koos Zwarts; and Bernie Van Leeuwen as inventors and Simone Eckhard on behalf of deceased inventor, Nico Kollaard.

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 09 March 2005 is executed by Simone Eckhard on behalf of the deceased inventor, Nico Kòllaard. The declaration submitted appears to have been executed by the proper party under 37 CFR 1.42, but fails to identify the person signing the declaration and his relationship to the deceased co-inventor, Nico Kollaard. Further, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

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

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

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(b)(2), the declaration must also provide residence, citizenship, and post office address for the administrator. The declaration filed on 09 March 2005 provides the residence, citizenship, and post office address for only one individual and it is unclear whether this information is for the administrator or the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

CONCLUSION

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

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

Any further correspondence with respect to this matter should 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

06 JUL 2005

#7

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John J. Gresens
Merchant & Gould
P.O. Box 2903
Minneapolis, Minnesota 55402-0903

In re Application of :
KOLLAARD et al. :
Application No.: 10/498,202 :
PCT No.: PCT/IB02/05367 : DECISION ON
Int. Filing Date: 10 December 2002 : PAPERS UNDER 37 CFR 1.42
Priority Date: 13 December 2001 :
Attorney Docket No.: 09728.0311USWO :
For: SCREW ACTUATOR WITH LOCKING MECHANISM

This decision is in response to the "Renewed Submission under 37 CFR 1.42" filed 31 May 2005. No petition fee is required.

BACKGROUND

On 10 December 2002, applicants filed international application PCT/IB02/05367, which claimed a priority date of 13 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 19 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, 13 June 2004.

On 29 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 09 March 2005, applicants filed a declaration executed by: Carl Vissers; Henk Kapaan; Koos Zwarts; and Bernie Van Leeuwen as inventors and Simone Eckhart on behalf of deceased inventor, Nico Kollaard. In a decision dated 03 May 2005, applicants' request under 37 CFR 1.42 was refused under 37 CFR 1.497(a)-(b).

On 31 May 2005, applicants filed the present renewed request under 37 CFR 1.42.

DISCUSSION

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

In case of the death of the inventor, the legal representative (executor,

administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

As stated in previous decision, the declaration filed 09 March 2005 is executed by Simone Eckhart on behalf of the deceased inventor, Nico Kollaard. Counsel avers that "the citizenship and former residence and post office address of the deceased inventor, Mr. Kollaard, is accurate as stated on the Combined Declaration and Power of Attorney. Ms. Simone Eckhart, wife of the deceased, is a citizen of Netherlands and also resides at the post office address listed on the Combined Declaration and Power of Attorney."

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.

In this case, the declaration does not identify Simone Eckhart's relationship (legal representative, executor, administrator, etc.) to the deceased co-inventor, Nico Kollaard. Therefore, a newly executed declaration which identifies Ms. Eckhart's citizenship, residence/post office address, and relationship to the deceased inventor is required.

CONCLUSION

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

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

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

Anthony Smith
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23 SEP 2005
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John J. Gresens
Merchant & Gould
P.O. Box 2903
Minneapolis, Minnesota 55402-0903

In re Application of :
KOLLAARD et al. :
Application No.: 10/498,202 :
PCT No.: PCT/IB02/05367 : DECISION ON
Int. Filing Date: 10 December 2002 : PAPERS UNDER 37 CFR 1.42
Priority Date: 13 December 2001 :
Attorney Docket No.: 09728.0311USWO :
For: SCREW ACTUATOR WITH LOCKING MECHANISM

This decision is in response to the "Renewed Submission under 37 CFR 1.42" filed 06 September 2005. No petition fee is required.

BACKGROUND

On 10 December 2002, applicants filed international application PCT/IB02/05367, which claimed a priority date of 13 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 19 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, 13 June 2004.

On 29 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 09 March 2005, applicants filed a declaration executed by: Carl Vissers; Henk Kapaan; Koos Zwarts; and Bernie Van Leeuwen as inventors and Simone Eckhart on behalf of deceased inventor, Nico Kollaard. In a decision dated 03 May 2005, applicants' request under 37 CFR 1.42 was refused under 37 CFR 1.497(a)-(b).

On 31 May 2005, applicants filed a renewed request under 37 CFR 1.42. In a decision dated 06 July 2005, applicants' request under 37 CFR 1.42 was refused under 37 CFR 1.497(a)-(b).

On 06 September 2005, applicants filed the present renewed request under 37 CFR 1.42.

DISCUSSION

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

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

The declaration filed 06 September 2005 is executed by Simone Eckhart as the "administrator" of the deceased inventor, Nico Kollaard. 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 06 September 2005.

CONCLUSION

The papers filed under 37 CFR 1.42 are ACCEPTED.

The application has an international filing date of 10 December 2002, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **06 September 2005**.

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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30 SEP 2004

#3

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Gary M. Nath
NATH & ASSOCIATES PLLC
1030 15th Street, N.W., Sixth Floor
Washington, DC 20005

In re Application of :
SPECTOR, Yuval *et al* :
U.S. Application No.: 10/498,235 :
PCT No.: PCT/IL02/00807 :
Int. Filing Date: 10 February 2002 :
Priority Date: 03 October 2001 :
Attorney Docket No.: 26193 :
For: ADAPTABLE TRACTION SYSTEM OF A VEHICLE :

DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)

Applicants' "Petition to Revive Under 37 C.F.R. 1.137(b)" filed with the national stage papers on 10 June 2004 is hereby **GRANTED** as follows:

The appropriate petition fee of $665.00 has been paid. Applicants state that "[t]he entire delay in filing this entry into the national phase due 3 April 2004, until the filing of this statement and the attached petition under 37 CFR 1.137(b), is unintentional." This 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, applicants should notify the office. A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

The declaration filed with the national stage papers incorrectly lists the filing date of the international application. The declaration indicates that PCT/IL02/00807 was filed on "02/10/2002." The international filing date for PCT/IL02/00807 is 03 October 2002. While this declaration complies with 37 CFR 1.497, it does not comply with 37 CFR 1.63.

Applicants have **TWO (2) MONTHS** from the mail date of this decision to provide an executed supplemental declaration containing the proper reference date. 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.

James Thomson
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22 JUN 2004

#3

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Richard M. Mescher
Porter Wright Morris & Arthur LLP
41 South High Street
Columbus, Ohio 43215

In re Application of	:	
LENEGHAN, Damian	:	
Application No.: 10/498,246	:	DECISION ON PETITION
PCT No.: PCT/EP02/11333	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 08 October 2002	:	
Priority Date: 08 October 2001	:	
Attorney Docket No.: 3998264-151839	:	
For: RECTIFYING VIEWER		

The petition to revive under 37 CFR 1.137(b) filed 07 June 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.

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16 OCT 2006

Jean-Louis Seugnet
RHODIA INC.
Intellectual Property Dept.
259 Prospect Plain Road
CN 7500
Cranbury, NJ 08512

In re Application of :
VARLET *et al* :
Application No.: 10/498,255 :
PCT No.: PCT/FR02/04367 :
Int. Filing Date: 16 December 2002 :
Priority Date: 17 December 2001 : **DECISION**
Attorney's Docket No.: RN01171G1 :
For: THERMOPLASTIC POLYMER COMPOSITION COMPRISING A HYPERBRANCHED POLYMER, AND ARTICLES MADE USING SAID COMPOSITION :

This decision is in response to applicants' "Petition to Withdraw the Holding of Abandonment and Statement" filed 05 June 2006 which is treated as a petition under 37 CFR 1.182.

BACKGROUND

On 20 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 a declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee must be provided. A two-month time period for response was set with extensions of time available.

On 12 October 2004, applicant filed a "Submission of Missing Requirements" ("Submission") and an executed declaration. However, the U.S. application number was misidentified on the Submission and these papers were placed in U.S. application No. 10/408,255.

On 11 May, 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) for failing to respond to the Form PCT/DO/EO/905 mailed 20 September 2004.

On 17 May 2006, applicant filed via facsimile a copy of the documents filed 12

October 2004 and a date-stamped postcard receipt for those documents.

On 05 June 2006, applicant filed the subject petition to withdraw the holding of abandonment.

On 13 June 2006, the DO/EO/US mailed a Withdrawal of Previously Sent Notice and a Notification of Acceptance of Application Under 35 U.S.C. 371 and 1.495 (Form PCT/DO/EO/903) indicating the date of completion of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements of 12 October 2004.

DISCUSSION

Applicants claim that a timely response to the Form PCT/DO/EO/905 was mailed in the above-captioned application on 12 October 2004. However, the U.S. application number was misidentified as 10/408,255 on the Submission. No application number was recorded on the declaration. As a result, these documents were placed in the wrong U.S. application.

Accordingly, this is treated as a petition to correct the papers filed 12 October 2004 pursuant to 37 CFR 1.182. The $400.00 petition fee has been charged to Deposit Account No. 18-1171 as authorized.

A review of the above-captioned application and U.S. application No. 10/408,255 show that the declaration and Submission listed the international application number, title, names of applicants and attorney docket number which correspond to the above-identified national stage application. Applicants also provided a copy of the date-stamped postcard receipt for the 12 October 2004 filing which recorded the U.S. application number as 10/498,255. Moreover, the docket number, title and name of applicants on the postcard receipt also correspond to the subject application.

This is sufficient to verify that the documents filed 12 October 2004 were misidentified and placed in the wrong U.S. application number.

DECISION

Applicants' petition under 37 CFR 1.182 is hereby **GRANTED**.

The papers filed 12 October 2004 have been removed from U.S. application No. 10/408,255 and placed in the subject application. Applicants are advised to use only U.S. application No. **10/498,255** for all future correspondence.

The surcharge fee of $130.00 charged in U.S. application No. 10/408,255

improperly has been credited back to applicants' Deposit Account.

This application is being forwarded to the appropriate Technology Center for continued processing.

James Thomson
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Office of PCT Legal Administration

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03 MAY 2005

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Michael K. Mutter
Birch, Stewart, Kolasch & Birch, LLP
P.O. Box 747
Falls Church, VA 22040-0747

In re Application of	:	
HIRANO, et al.	:	
Application No.: 10/498,267	:	DECISION
PCT No.: PCT/JP02/12281	:	
Int. Filing Date: 26 November 2002	:	
Priority Date: 10 December 2001	:	
For: MOBILE-TERMINAL-TYPE IMAGE PROCESSING SYSTEM, MOBILE TERMINAL, AND SERVER	:	

This decision is in response to applicant's "Request For Reconsideration of Notification of Missing Requirements" filed 14 March 2005 in the United States Patent and Trademark Office (USPTO). The request is being treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 26 November 2002, applicant filed international application PCT/JP02/12281, which claimed priority of an earlier application filed 10 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 19 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, 10 June 2004.

On 08 June 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 English translation of the international application, an executed declaration of the inventors and an assignment document for recording.

On 13 December 2004, applicant was mailed a "Notification of Missing Requirements Under 35 U.S.C. 371"(Form PCT/DO/EO/905) informing applicant that an additional English translation of the international application was required. The notification stated that the text in the drawings had not been properly translated. Applicant was afforded two months to file the required response and advised that the period could be extended pursuant to 37 CFR 1.136(a).

On 14 March 2005, applicant filed the present petition accompanied by a conditional

petition for a one-month extension of time.

DISCUSSION

A review of the application file in conjunction with applicant's response of 14 March 2005 shows that the inclusion of the Japanese characters in the drawings is essential to the understanding of the invention. Specifically, the character strings are examples which are in fact translated to show the functioning of the device in question. As such, the origianlly filed English translation was compliant and thus, applicant satisfied the 35 U.S.C. 371 requirements on 08 June 2004. As to the conditional petition for a one-month extension of time, applicant is correct that as the "Notification of Missing Requirements" was mailed in error the filing of the extension of time petition is not necessary. Therefore, the authorized extension of time fee will not be charged to applicant's deposit account.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

This application will be given an international application filing date of 26 November 2002 and a date of **08 June 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

The "Notification of Missing Requirements Under 35 U.S.C. 371"(Form PCT/DO/EO/905) mailed 13 December 2004 is hereby **VACATED**.

This application is being returned to the DO/EO/US for processing in accordance with this decision, namely, the mailing of a "Notification of Acceptance Under 35 U.S.C. 371" (Form PCT/DO/EO/903).

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21 SEP 2004

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Arthur G. Shaier
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50 Leavenworth Street
PO Box 1110
Waterbury, CT 06721-1110

In re Application of	:	
DACEY, Derek	:	
Application No.: 10/498,270	:	DECISION
PCT No.: PCT/GB02/04584	:	
Int. Filing Date: 09 October 2002	:	ON PETITION UNDER
Priority Date: 10 October 2001	:	
Docket No.: 24900-36A	:	37 CFR 1.137(b)
For: SPINE ASSEMBLY	:	

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 08 June 2004 is **GRANTED**.

Applicant states that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, as required by 37 CFR 1.137(b)(3). The appropriate national fee and the petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

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 June 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
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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

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MAR 1 1 2008

OFFICE OF PETITIONS

In re Application of	:	
Schmidt et al.	:	DECISION ON PETITION TO
Application Number: 10/498278	:	WITHDRAW HOLDING OF
Filing Date: 02/01/2005	:	ABANDONMENT
Attorney Docket Number:	:	
1690.1013	:	

This is a decision on the petition filed on January 29, 2008, to withdraw the holding of abandonment in the above-identified application.

The petition is **DISMISSED**.

The application was held abandoned for failure to timely respond to the final Office action mailed on February 1, 2007. Notice of Abandonment was mailed on December 31, 2007.

Petitioners assert that a Request for Continued Examination (RCE) and an amendment as the submission under 37 CFR 1.114, were timely filed. In support, petitioner has supplied a copy of an amendment, which petitioners assert was filed by facsimile on July 2, 2007.

37 CFR 1.8(b) states:

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

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

The petition lacks item (3).

Petitioner's counsel asserts that counsel's assistant filed the RCE and submission by facsimile on July 2, 2007. The petition also states that a copy of the report confirming transmission of the amendment and RCE is enclosed with the petition.

A review of the papers filed with the petition reveals, however, that while a copy of the RCE and submission have been received, the transmission report is not among the papers received with the present petition.

Therefore, the petition is dismissed without prejudice to reconsideration pending submission of a duplicate copy of the facsimile transmission report showing that the RCE and submission were filed by facsimile on July 2, 2007.

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

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

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

---

[1] 37 CFR 1.181(f).

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

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

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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WASHINGTON DC 20005

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APR 16 2008

In re Application of	:	
Schmidt et al.	:	DECISION ON PETITION TO
Application Number: 10/498278	:	WITHDRAW HOLDING OF
Filing Date: 02/01/2005	:	ABANDONMENT
Attorney Docket Number:	:	
1690.1013	:	

This is a decision on the renewed petition filed on March 19, 2008, to withdraw the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

The application was held abandoned for failure to timely respond to the final Office action mailed on February 1, 2007. Notice of Abandonment was mailed on December 31, 2007. The petition filed on January 29, 2008, was dismissed on March 11, 2008.

Petitioners again assert that a Request for Continued Examination (RCE) and an amendment as the submission under 37 CFR 1.114, were timely filed. In support, petitioner has supplied a copy of an amendment, which petitioners assert was filed by facsimile on July 2, 2007.

37 CFR 1.8(b) states:

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

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

Petitioner's counsel asserts that counsel's assistant filed the RCE and submission by facsimile on July 2, 2007. The petition also states that a copy of the report confirming transmission of the amendment and RCE is enclosed with the petition.

A copy of the sending unit's report confirming transmission has been filed with the present renewed petition.

As petitioner has provided convincing evidence, in the petition filed on January 29, 2008, and renewed on March 19, 2008, that a reply to the final Office action mailed on February 1, 2007, was transmitted to the USPTO on July 2, 2007, the showing of record is that a response was timely filed, and there is no abandonment in fact. Any inconvenience caused to applicant is regretted.

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

The application is referred to Technology Center Art Unit 3729 for further processing.

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

DIWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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NEW YORK, NY 10016

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OFFICE OF PETITIONS

In re Application of :
Hidenori Hagiwara :
Application No. 10/498,290 : ON PETITION
Filed: June 4, 2004 :
Attorney Docket No. YAN-38 :

This is a decision on the petition under 37 CFR 1.137(b), filed by facsimile transmission on March 5, 2007, to revive the above-identified application.

The above application became abandoned for failure to file a proper reply to the final Office action mailed July 26, 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) under 37 CFR 1.114, with the $395 filing fee; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application is being revived for consideration of the RCE.

The application file is being referred to Technology Center Art Unit 3772, for further consideration of the previously submitted amendment filed on October 24, 2006.

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

Andrea Smith
Petitions Examiner
Office of Petitions

03 MAR 2005

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Michael A. Glenn
GLENN PATENT GROUP
3475 Edison Way, Suite L
Menlo Park, CA 94025

In re Application of:
KASPERI, et al.
Application No.: 10/498,291
Filing Date: 04 June 2004
Attorney's Docket No.: SCHO0170
For: Apparatus And Method For Establishing A Correction Characteristic Curve For A Reduction Of Artefacts In Tomography

DECISION ON PETITION UNDER 37 CFR 1.181

This decision is issued in response to applicants' "Petition To Convert" filed 14 October 2004, treated herein under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 23 January 2003, applicants filed international application PCT/EP03/00683 which claimed a priority date of 24 January 2002 and which designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 24 July 2004.

On 04 June 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 17 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Acceptance (Form PCT/DO/EO/905) and a filing receipt.

On 14 October 2004, applicants filed the "Petition To Convert" considered herein. The petition requests that the present application be treated as 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). See 37 CFR 1.495(g):

> The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a) of the MPEP states the following:

> If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

On 04 June 2004, applicants submitted a specification which stated "[t]his application is a continuation of copending International Application No. PCT/EP03/00683, filed January 23, 2003, which designated the United States and was not published in English." The statement in the specification is inconsistent with the intent to enter the National State under 35 U.S.C. 371. Accordingly, the original papers filed on 04 June 2004 should have been treated as a filing under 35 U.S.C. 111(a).

CONCLUSION

Applicants' petition to convert the application from a national stage application under 35 U.S.C. 371 to an application filed under 35 U.S.C. 111(a) is **GRANTED**.

The Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt mailed 17 September 2004 are hereby **VACATED**.

The Office Of Initial Patent Examination will be instructed to continue processing of this application as an application filed under 35 U.S.C. 111(a), in accordance with the present decision.

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

27 DEC 2004

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Corporate Patent Counsel
Philips Electronics North America Corporation
P O Box 3001
345 Scarborough Road
Briarcliff Manor, NY 10510

In re Application of	:	
VAN EIJNDHOVEN et al.	:	
Application No.: 10/498,293	:	DECISION
PCT No.: PCT/IB02/05173	:	
Int. Filing Date: 05 December 2002	:	ON DECLARATION
Priority Date: 14 December 2001	:	
Attorney Docket No.: PHNL010950 US	:	
For: DATA PROCESSING SYSTEM	:	

This is a decision on the submission of a declaration filed in the United States Patent and Trademark Office (USPTO) on 09 June 2004.

BACKGROUND

On 09 June 2004, applicant filed a request for entry into the national stage under 35 U.S.C. 371(c) with the United States Designated/Elected Office (DO/EO/US) along with the basic national fee and an executed declaration.

The declaration indicated the name of second inventor Evert J. Pol as published in the international application; however, the declaration was altered and signed as Evert-Jan Daniel Pol. No explanation was provided.

A petition under 37 CFR 1.182 is required to accept the change in the name of the inventor. As explained in MPEP 605.04(c), applicant must provide a signed affidavit setting forth both names and the procedure whereby the change of name was effected, or a certified copy of the court order. Here, applicant should submitted the statement of Evert J. Pol regarding his respective change of name. The declaration, indicating Evert-Jan Daniel Pol as an inventor, is not in compliance with 37 CFR 1.497 and unacceptable.

Moreover, the declaration identifies each inventor and states their respective citizenship, residency and mailing address. However, the declaration submitted contained two identical sheets of page 2. Each page is signed by different inventors. It appears that the attorney pieced together two separate complete declarations into one composite declaration or the inventors were presented with an incomplete declaration. Thus, the declaration is not properly executed. What is required is one declaration where all inventors have signed or two separate complete declarations. The requirements of 37 CFR 1.497 have not been met and the declaration is unacceptable.

CONCLUSION

For the above reasons, the declaration does not meet the requirements of 37 CFR 1.497(a) and (b) and is unacceptable.

Applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 37 CFR 1.497 within **TWO (2) MONTHS** from the mail date of this Decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571) 272-3286

Rec'd PCT/PTO 09 FEB 2005

27 DEC 2004

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DOCKETED	DATE	INITIAL
COMPUTER	PC DEC 30 2004	

Corporate Patent Counsel
Philips Electronics North America Corporation
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In re Application of
VAN EIJNDHOVEN et al.
Application No.: 10/498,293
PCT No.: PCT/IB02/05173
Int. Filing Date: 05 December 2002
Priority Date: 14 December 2001
Attorney Docket No.: PHNL010950 US
For: DATA PROCESSING SYSTEM

DECISION

ON DECLARATION

04 DEC 30 AM 10:33

This is a decision on the submission of a declaration filed in the United States Patent and Trademark Office (USPTO) on 09 June 2004.

BACKGROUND

On 09 June 2004, applicant filed a request for entry into the national stage under 35 U.S.C. 371(c) with the United States Designated/Elected Office (DO/EO/US) along with the basic national fee and an executed declaration.

The declaration indicated the name of second inventor Evert J. Pol as published in the international application; however, the declaration was altered and signed as Evert-Jan Daniel Pol. No explanation was provided.

A petition under 37 CFR 1.182 is required to accept the change in the name of the inventor. As explained in MPEP 605.04(c), applicant must provide a signed affidavit setting forth both names and the procedure whereby the change of name was effected, or a certified copy of the court order. Here, applicant should submitted the statement of Evert J. Pol regarding his respective change of name. The declaration, indicating Evert-Jan Daniel Pol as an inventor, is not in compliance with 37 CFR 1.497 and unacceptable.

Moreover, the declaration identifies each inventor and states their respective citizenship, residency and mailing address. However, the declaration submitted contained two identical sheets of page 2. Each page is signed by different inventors. It appears that the attorney pieced together two separate complete declarations into one composite declaration or the inventors were presented with an incomplete declaration. Thus, the declaration is not properly executed. What is required is one declaration where all inventors have signed or two separate complete declarations. The requirements of 37 CFR 1.497 have not been met and the declaration is unacceptable.

CONCLUSION

For the above reasons, the declaration does not meet the requirements of 37 CFR 1.497(a) and (b) and is unacceptable.

Applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 37 CFR 1.497 within **TWO (2) MONTHS** from the mail date of this Decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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18 MAR 2005

#6

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In re Application of	
VAN EIJNDHOVEN et al.	
Application No.: 10/498,293	DECISION
PCT No.: PCT/IB02/05173	
Int. Filing Date: 05 December 2002	ON DECLARATION
Priority Date: 14 December 2001	
Attorney Docket No.: PHNL010950 US	
For: DATA PROCESSING SYSTEM	

This is a decision on the submission of a declaration filed in the United States Patent and Trademark Office (USPTO) on 09 February 2005.

On 09 June 2004, applicant filed a request for entry into the national stage under 35 U.S.C. 371(c) with the United States Designated/Elected Office (DO/EO/US) along with the basic national fee and an executed multi-page declaration, which contained two identical sheets of page 2.

On 27 December 2004, a decision dismissing the submission was mailed to applicant indicating that the declaration indicated the name of second inventor Evert J. Pol as published in the international application; however, the declaration was altered and signed as Evert-Jan Daniel Pol without any explanation. Moreover, the declaration was not properly executed as it appeared that the attorney pieced together two separate complete declarations into one composite declaration or the inventors were presented with an incomplete declaration Applicant was advised that a new declaration was required where all inventors have signed or two separate complete declarations.

On 09 February 2005, applicant submitted a newly executed 2 page declaration identifying Evert J. Pol as the inventor. The requirements of 37 CFR 1.497 have now been met and the declaration is acceptable.

The application will be forwarded to United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (2) and (4) date is **09 February 2005.**

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24 JAN 2005

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ITALY

In re Application of LONATI :
U.S. Application No.: 10/498,308 :
PCT Application No.: PCT/EP02/14063 :
Int. Filing Date: 11 December 2002 : DECISION
Priority Date Claimed: 14 December 2001 :
Attorney Docket No.: 39081/GM/Ip :
For: DEVICE FOR VARYING STITCH :
TIGHTNESS FOR KNITTING MACHINE :
FOR HOSIERY OR THE LIKE. . . . :

This is in response to the declaration filed 10 June 2004, which is being treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 11 December 2002, applicant filed international application PCT/EP02/14063, which claimed priority of an earlier Italy application filed 14 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 14 June 2004.

On 10 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) and the present request for status under 37 CFR 1.42.

DISCUSSION

The declaration states that inventor Francesco Lonati 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 is not acceptable because there is no indication that Ettore Lonati, Fausto Lonati, and Tiberio Lonati are the sole heirs of the deceased inventor. That is, there may be other heirs who are also required to sign the declaration. The declaration is further defective because it does not list the citizenship of Francesco Lonati as required by CFR 1.497(a)(3). Moreover, the declaration is improper because it lists Ettore Lonati, Fausto Lonati, and Tiberio Lonati as inventors of the claimed subject matter.

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.

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29 JUN 2005
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In re Application of LONATI :
U.S. Application No.: 10/498,308 :
PCT Application No.: PCT/EP02/14063 :
Int. Filing Date: 11 December 2002 : DECISION
Priority Date Claimed: 14 December 2001 :
Attorney Docket No.: 39081/GM/Ip :
For: DEVICE FOR VARYING STITCH :
TIGHTNESS FOR KNITTING MACHINE :
FOR HOSIERY OR THE LIKE. . . . :

This is in response to "Renewed Request for Status Under 37 CFR 1.42" filed 21 June 2005.

BACKGROUND

On 11 December 2002, applicant filed international application PCT/EP02/14063, which claimed priority of an earlier Italy application filed 14 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 14 June 2004.

On 10 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) and a request for status under 37 CFR 1.42.

On 24 January 2005, this Office mailed a decision dismissing the 10 June 2004 request for status.

On 21 June 2005, applicant filed the present renewed request for status under 37 CFR 1.42.

DISCUSSION

The declaration filed 10 June 2004 states that inventor Francesco Lonati 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 present renewed request for status sufficiently establishes that Ettore Lonati, Fausto Lonati, and Tiberio Lonati are joint inventors of the claimed subject matter and the sole heirs of the deceased inventor. However, the declaration remains defective because it does not list the citizenship of Francesco Lonati as required by CFR 1.497(a)(3).

MPEP 602.01 states in relevant part,

> The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required. However, in some cases, a deficiency in the oath or declaration can be corrected by a supplemental paper such as an application data sheet (see 37 CFR 1.76 and MPEP § 601.05) and a new oath or declaration is not necessary. See 37 CFR 1.63(c)(1) and (c)(2).

MPEP 601.05 states in relevant part,

> The naming of the inventors and the setting forth of the citizenship of each inventor must be provided in the oath or declaration under 37 CFR 1.63 (as is required by 35 U.S.C. 115) even if this information is provided in the application data sheet.

Accordingly, either a newly executed oath/declaration or a supplemental oath/declaration (see MPEP 603) is required.

CONCLUSION

For the reasons above, the renewed 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.

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09 SEP 2005

#9

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In re Application of LONATI	:	
U.S. Application No.: 10/498,308	:	
PCT Application No.: PCT/EP02/14063	:	
Int. Filing Date: 11 December 2002	:	DECISION
Priority Date Claimed: 14 December 2001	:	
Attorney Docket No.: 39081/GM/Ip	:	
For: DEVICE FOR VARYING STITCH TIGHTNESS FOR KNITTING MACHINE FOR HOSIERY OR THE LIKE. . . .	:	

This is in response to applicant's "Reply to the Response to 'Renewed Request for Status Under 37 CFR 1.42'" filed 29 August 2005.

BACKGROUND

On 11 December 2002, applicant filed international application PCT/EP02/14063, which claimed priority of an earlier Italy application filed 14 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 14 June 2004.

On 10 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) and a request for status under 37 CFR 1.42.

On 24 January 2005, this Office mailed a decision dismissing the 10 June 2004 request for status.

On 21 June 2005, applicant filed a renewed request for status under 37 CFR 1.42.

On 29 June 2005, this Office mailed a decision dismissing the 21 June 2005 renewed request for status.

On 29 August 2005, applicant filed the present renewed request for status under 37 CFR 1.42.

DISCUSSION

The declaration filed 10 June 2004 states that inventor Francesco Lonati 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 29 August 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 11 December 2002, and a date under 35 U.S.C. 371(c) of 29 August 2005.

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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07 FEB 2006

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

In re Application of	:	
MONTERO et al.	:	
Application No.: 10/498,313	:	DECISION ON
PCT No.: PCT/FR02/04190	:	
Int. Filing Date: 05 December 2002	:	PETITION UNDER
Priority Date: 11 December 2001	:	
Attorney Docket No.: 254431US0XPCT	:	37 CFR 1.47(a)
For: PHOSPHONATES USEFUL AS	:	
MODULATORS OF T-GAMMA-9-DELTA-2	:	
ACTIVITY	:	

This is a decision on applicants' petition under 37 CFR 1.47(a) filed on 04 November 2005 in the United States Patent and Trademark Office (USPTO) requesting the acceptance of the application without the signature of joint inventor Valerie Gallois. Applicant also requests a five month extension of time, which is granted.

BACKGROUND

On 04 November 2005, in response to 04 April 2005 Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a statement of facts by Valerie Corizzi.

DISCUSSION

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

Items (1) and (3) are satisfied.

Regarding item (2), 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.

Here the statement of facts was signed by Valerie Corizzi, employee for Cabinet Ores, having firsthand knowledge of the facts recited therein. Ms. Corizzi indicates that she attempted to reach or locate Valerie Gallois by calling co-inventor Dr. Jean-Louis Montero, contacting her last known place of employment regarding her whereabouts, and directing a communication to her last known address. These efforts were unsuccessful. The French postal service returned the communication indicating that the addressee no longer lived at that address. Thereafter, Ms. Corizzi conducted an Internet search (copies attached to the petition); however, the attempts were unsuccessful. The two persons identified by the same name were not the inventor of the above referenced application. Petitioner has shown the steps taken to locate the whereabouts of the nonsigning inventor. Petitioner has provided sufficient evidence to conclude that Ms. Gallois is unavailable to sign the application. Thus, item (2) is satisfied.

Regarding item (4), the declaration of the joint inventors was attached to the petition. The declaration of the applicants contains French language text, but it is not a USPTO form and is not accompanied by a statement that the English text is an accurate translation of the French text. See 37 CFR 1.69. As such, the declaration is unacceptable. Thus, item (4) has not been met at this time.

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. 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.

Cynthia M. Kratz
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12 MAY 2006
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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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In re Application of	:	
MONTERO et al.	:	
Application No.: 10/498,313	:	DECISION ON RENEWED
PCT No.: PCT/FR02/04190	:	
Int. Filing Date: 05 December 2002	:	PETITION UNDER
Priority Date: 11 December 2001	:	
Attorney Docket No.: 254431US0XPCT	:	37 CFR 1.47(a)
For: PHOSPHONATES USEFUL AS	:	
MODULATORS OF T-GAMMA-9-DELTA-2	:	
ACTIVITY	:	

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed on 24 February 2006 in the United States Patent and Trademark Office (USPTO) requesting the acceptance of the application without the signature of joint inventor Valerie Gallois.

BACKGROUND

On 04 November 2005, in response to 04 April 2005 Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a statement of facts by Valerie Corizzi.

On 07 February 2006, a decision dismissing the petition was mailed indicating that the declaration of the joint inventors contained French language text, but was not on a USPTO form and was not accompanied by a statement that the English text is an accurate translation of the French text pursuant to 37 CFR 1.69. As such, the declaration was unacceptable.

On 24 February 2006, applicants filed a renewed petition under 37 CFR 1.47(a) along with a statement that the English text is an accurate translation of the French text pursuant to 37 CFR 1.69.

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), (2) and (3) were previously satisfied.

Regarding item (4), the declaration of the joint inventors is attached to the petition and accompanied by a statement that the English text is an accurate translation of the French text. The declaration is now acceptable. Thus, item (4) has now been met. The requirements of 37 CFR 1.47(a) have been met and the petition is granted.

CONCLUSION

For the above reasons, applicants' 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 04 November 2005. The application has an international filing date of 05 December 2002 under 35 U.S.C. 363, and a date of 04 November 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.

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12 MAY 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Ms. Valerie Gallois
315, rue du Faubourg Saint Antoine
75011 Paris, France

In re Application of MONTERO et al. Application No.: 10/498,313 PCT No.: PCT/FR02/04190 Int. Filing Date: 05 December 2002 Priority Date: 11 December 2001 Attorney Docket No.: 254431US0XPCT For: PHOSPHONATES USEFUL AS MODULATORS OF T-GAMMA-9-DELTA-2 ACTIVITY	DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

Dear Ms. Gallois:

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

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

Cynthia M. Kratz
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28 SEP 2004

#3

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Carl A. Forest
Patton Boggs LLP
1660 Lincoln Street, Suite 2050
Denver, CO 80264

In re Application of :
MAKSIMOVIC, et al. :
U.S. Application No.: 10/498,337 : DECISION ON PETITION
PCT No.: PCT/US02/39189 :
Int. Filing Date: 09 December 2002 : UNDER 37 CFR 1.137(b)
Priority Date: 07 December 2001 :
Attorney Docket No.: 013743.0105PTUS :
For: VOLTAGE CONTROLLER FOR SWITCHING :
POWER SUPPLIES :

The petition to revive under 37 CFR 1.137(b) filed 10 June 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
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08 MAR 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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Carl A. Forest
Patton Boggs LLP
1660 Lincoln Street, Suite 2050
Denver, CO 80264

In re Application of :
MAKSIMOVIC, et al. :
U.S. Application No.: 10/498,337 : DECISION ON PETITION
PCT No.: PCT/US02/39189 :
Int. Filing Date: 09 December 2002 : UNDER 37 CFR 1.48(b)
Priority Date: 07 December 2001 :
Attorney Docket No.: 013743.0105PTUS :
For: VOLTAGE CONTROLLER FOR SWITCHING :
POWER SUPPLIES :

This decision is in response to applicant's "Petition to Delete Inventor Under Section 1.497(d)" filed 15 January 2005. For the reasons discussed below, the petition is being treated as a petition under 37 CFR 1.48(b). Applicant has provided payment of the $130.00 petition fee.

BACKGROUND

On 28 September 2004, applicant was mailed a decision granting applicant's petition to revive the present U.S. National stage application.

On 15 October 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 1.492(a) and (b). The notification set a two month time limit in which to respond. Applicant was advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 15 January 2005, applicant filed a petition under 37 CFR 1.497(d) to delete Sandeep Chaman Dhar as a named inventor and the requisite petition fee; a declaration signed by Dragan Maksimovic, Benjamin James Patella and Aleksandar Prodic; and a petition for a one-month extension of time.

DISCUSSION

37 CFR 1.497(d) [formally, 37 CFR 1.48] states in part: "If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application....applicant must submit:"

37 CFR 1.497(d) applies to situations where an inventor was mistakenly included or left

off an international application and the situation is being rectified in the national stage. Applicant states that "Co-inventor Sandeep Chaman DHAR has been deleted as an inventor from the 371 filing after significant narrowing of the claims in the PCT application." This situation is addressed by 37 CFR 1.48(b).

As to applicant's petition under 37 CFR 1.48(b), the present national stage application must first be executed by all the named inventors. The filing of a petition under 37 CFR 1.48(b) is not applicable prior to the application being executed by all the named inventors. Under 35 U.S.C. 363, an international application designating the United States has the effect of a national application for a patent regularly filed in the United States. In other words, the U.S. national stage application is considered to have been filed on the international filing date in the names of the inventors/applicants for the United States of America listed on the REQUEST form. The REQUEST indicated Sandeep Chaman Dhar, Dragan Maksimovic, Benjamin James Patella and Aleksandar Prodic as applicants/inventors for the United States of America.

37 CFR 1.48(f)(1), by its terms, applies only to a non-provisional application filed under 37 CFR 1.53(b). (See also, 37 CFR 1.9(a)(3)). A national application resulting from an international application entering the national stage under 37 U.S.C. 371 is not an application filed under 37 CFR 1.53(b), but an application that has entered that national stage under 37 CFR 1.494 or 1.495.

Accordingly, the requirements under 35 U.S.C. 371(c)(4) must be met, namely, that an oath or declaration of the inventors complying with the regulations for oaths or declaration of applications be filed. As set forth in 37 CFR 1.497, the oath or declaration must be executed by all the inventors.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.48(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. 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
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16 JUN 2005

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#9

Carl A. Forest
Patton Boggs LLP
1660 Lincoln Street, Suite 2050
Denver, CO 80264

In re Application of	:	
MAKSIMOVIC, et al.	:	
U.S. Application No.: 10/498,337	:	DECISION ON RENEWED
PCT No.: PCT/US02/39189	:	
Int. Filing Date: 09 December 2002	:	PETITION UNDER
Priority Date: 07 December 2001	:	
Attorney Docket No.: 013743.0105PTUS	:	37 CFR 1.48(b)
For: VOLTAGE CONTROLLER FOR SWITCHING POWER SUPPLIES	:	

This decision is in response to applicant's "Request For Reconsideration of Decision on Petition Under 37 CFR 1.48(b)" filed 02 May 2005.

BACKGROUND

On 08 March 2005, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.48(b) to delete inventor Sandeep Chaman DHAR from the present National stage application. Applicant was afforded two months to file any request for reconsideration.

On 02 May 2005, applicant filed the present renewed petition.

DISCUSSION

As explained in the decision mailed 08 March 2005 the filing of a petition under 37 CFR 1.48(b) is not applicable prior to the application being executed by all the named inventors. The requirements under 35 U.S.C. 371(c)(4) must be met, namely, that an oath or declaration of the inventors complying with the regulations for oaths or declaration of applications be filed. As set forth in 37 CFR 1.497, the oath or declaration must be executed by all the inventors.

Applicant has presently filed a declaration executed by all four of the inventors listed in the published international application. However, a review of the declaration shows that it does not comply with 37 CFR 1.497(a)-(b). Specifically, the declaration contains three pages "3 of 3." This suggests that the enclosed declaration was constructed from numerous complete declarations or that the inventors forwarded to counsel only the signatures pages of the declaration. Either alternative renders the submitted declaration defective under 37 CFR 1.497. While each inventor need not execute the same oath or declaration, where individual declarations are executed, they

must be submitted as individual declarations rather than combined into one declaration. (See MPEP 201.03 B. Oath or Declaration.) In addition, the pages "page 3 of 3" executed by inventors Patella and Prodic are different from the page executed by inventor Dhar in that they do not list inventor Dhar.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.48(b) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. 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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12 SEP 2005

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Carl A. Forest
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In re Application of	:	
MAKSIMOVIC, et al.	:	
U.S. Application No.: 10/498,337	:	DECISION ON RENEWED
PCT No.: PCT/US02/39189	:	
Int. Filing Date: 09 December 2002	:	PETITION UNDER
Priority Date: 07 December 2001	:	
Attorney Docket No.: 013743.0105PTUS	:	37 CFR 1.48(b)
For: VOLTAGE CONTROLLER FOR SWITCHING POWER SUPPLIES	:	

This decision is in response to applicant's "Petition For Reconsideration of Dismissed Request For Reconsideration of Decision on Petition Under 37 CFR 1.48(b)" filed 18 August 2005.

BACKGROUND

On 16 June 2005, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.48(b) to delete inventor Sandeep Chaman DHAR from the present National stage application. Applicant was afforded two months to file any request for reconsideration.

On 18 August 2005, applicant filed the present renewed petition. The renewed petition contains certification under 37 CFR 1.8 that the mailing was deposited for mailing with te United States Postal Service on 16 August 2005 and is therefore considered timely filed.

DISCUSSION

As explained in the decision mailed 16 June 2005 the filing of a petition under 37 CFR 1.48(b) is not applicable prior to the application being executed by all the named inventors. The requirements under 35 U.S.C. 371(c)(4) must be met, namely, that an oath or declaration of the inventors complying with the regulations for oaths or declaration of applications be filed. As set forth in 37 CFR 1.497, the oath or declaration must be executed by all the inventors.

Applicant's current submission of the combined declaration and power of attorney executed by all four of the named inventors completes the requirements for entry into the national stage under 35 U.S.C. 371; the 35 U.S.C. 371 date for the present application is **18 August 2005**.

Applicant's completion of the 35 U.S.C. 371 requirements permits action on the previously filed petition to correct inventorship under 37 CFR 1.48(b). The petition under 37 CFR 1.48(b) will be handled by the appropriate technology center.

CONCLUSION

For the reasons discussed above, applicant's renewed petition under 37 CFR 1.497(d) is **DISMISSED as moot**.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision. The 35 U.S.C. 371(c) date is **18 August 2005**.

After National stage processing is complete, with the mailing of a "Notification of Acceptance" (Form PCT/DO/EO/903), the application will be forwarded to the appropriate technology center for examination and resolution of applicant's request to delete inventor Sandeep Chaman DHAR pursuant to 37 CFR 1.48(b).

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OFFICE OF PETITIONS

In re Patent No. 7,498,338	:	LETTER REGARDING PATENT
Brown et al.	:	TERM ADJUSTMENT AND
Issue Date: March 3, 2009	:	NOTICE OF INTENT TO ISSUE
Application No. 10/498,338	:	CERTIFICATE OF CORRECTION
Filed: May 11, 2005	:	
Attorney Docket No. 01-1763-G	:	

This is in response to the "PETITION FOR RECALCULATION OF PATENT TERM ADJUSTMENT FILED UNDER 37 CFR §1.705(d)," filed May 1, 2009, requesting that the patent term adjustment determination for the above-identified patent be changed from three hundred ninety-one (391) days to six hundred eighty-seven (687) days. For the reasons set forth herein, the request for reconsideration is being treated as a request that the revised patent term adjustment be corrected from three hundred ninety-one (391) days to six hundred twenty-one(621) days.

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

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **six hundred twenty-one (621) days.**

Patentees are given THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer, from the mail date of this decision to respond to this decision. No extensions of time will be granted under § 1.136.

On March 3, 2009, the above-identified application matured into U.S. Patent No. 7,498,358 with a patent term adjustment of 391 days.

This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 1.705(d).

Pursuant to patentees' authorization, the Office is charging the $200.00 fee set forth in 37 CFR 1.18(e) to deposit account no. 13-2490. 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 pursuant to Wyeth, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." Patentees maintain that the period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), of 296 days and the period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a), of 398 days do not overlap, as these periods do not occur on the same day.

Patentees argue that the period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.702(b), is 296 days. Patentees calculate this 296 day period based on the application having been filed under 35 U.S.C. §371 on May 11, 2005, and the patent having not issued until March 3, 2009, three years and 296 days later.

Patentees are informed that the Three Year Delay period is triggered by the application's commencement date, not the § 371 fulfillment date. The commencement date is 30 months from the priority date claimed in the international application, or earlier. The priority date claimed in the international application is December 14, 2001. Thirty months from that date is June 14, 2004, which is the beginning of the Three Year Delay period. Accordingly, the period of adjustment under § 1.702(b) is 628 days, counting the number of days beginning on June 15, 2007 and ending on March 3, 2009 when the patent issued.

Patentees assert that in addition to the three year delay period, they are entitled to a period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a) of 398 days for the failure by the Office to mail at least one of a notification

under 35 U.S.C. 132 not later than fourteen months after the date the application fulfilled the requirements of 35 U.S.C. 371 in an international application, pursuant to § 1.702(a)(1). A restriction requirement was mailed on August 13, 2007, which was 14 months and 398 days after the § 371 fulfillment date.

Under 37 CFR § 1.703(f), Patentees are entitled to a period of patent term adjustment equal to the period of delays based on the grounds set forth in 37 CFR §1.702 reduced by the period of time equal to the period of time during which Patentees failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR §1.704. In other words, the period of Office delay reduced by the period of applicant delay. The period of reduction of 7 days for applicant delay is not in dispute. Patentees assert that the total period of Office delay is the sum of the period of Three Year Delay (296 days per patentees' calculation) and the period of Examination Delay (398 days, not in dispute) **to the extent that these periods of delay are not overlapping.**

Patentees contend there is no overlap. However, as discussed above, the Three Year Delay period is from June 15, 2007 to March 3, 2009. Therefore, applying patentees' definition of overlap, a portion of the period of delay of 398 days for the failure by the Office to mail at least one of a notification under 35 U.S.C. 132 not later than fourteen months after the date the application fulfilled the requirements of 35 U.S.C. 371 in an international application, pursuant to § 1.702(a)(1), (July 12, 2006 to August 13, 2007) overlaps with a portion of the Three Year Delay period (June 15, 2007 to March 3, 2009). This overlapping period is the 60 days running from June 15, 2007 to August 13, 2007. Considering that the three-year period is properly calculated based on the commencement date and is 628 days, not 296 days, and that the period of overlap is 60 days, applying patentees' definition of overlap to the correct three-year period, patentees assertion of the total period of Office delay is considered to be 966 days, which is the sum of the period of Three Year Delay (628 days) and the period of Examination Delay (398 days), reduced by the period of overlap (60 days).

Considering that the three-year period is properly calculated based on the commencement date and is 628 days, not 296 days, and that the period of overlap is 60 days, applying patentees' definition of overlap to the correct three-year period,

patentees assertion of entitlement to a patent term adjustment is considered to be 959 days (628 + 398 reduced by 60 overlap - 7 for applicant delay).

As discussed above, the Office states that the patent issued 3 years and 628 days after the application's commencement date. The Office agrees that the action detailed above was not taken within the specified time frames, and thus, the entry of period of adjustment of 398 days is correct. At issue is whether Patentees should accrue 568 (adjusted for overlap, per patentees' definition of overlap and Office's calculation of the Three Year Delay Period) days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as, 398 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that 398 days overlap. Patentees' interpretation of the period of overlap has been considered and found to be incorrect. 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, 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.

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. 54366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

The current wording of § 1.703(f) was revised in response to the misinterpretation of this provision by a number of Patentees. The rule was slightly revised to more closely track the corresponding language of 35 U.S.C. 154(b)(2)(A). The relevant portion differs only to the extent that the statute refers back to provisions of the statute whereas the rule refers back to sections of the rule. This was not a substantive change to the rule nor did it reflect a change of the Office's interpretation of 35 U.S.C. 154(b)(2)(A). As stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C.

154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed. The grounds specified in these sections cover the A) guarantee of prompt Patent and Trademark Office responses, B) guarantee of no more than 3 year application pendency, and C) guarantee or adjustments for delays due to interference, secrecy orders and appeals. A section by section analysis of 35 U.S.C. 154(b)(2)(A) specifically provides that:

> Section 4402 imposes limitations on restoration of term. In general, pursuant to [35 U.S.C.] 154(b)(2)(A)-(C), total adjustments granted for restorations under [35 U.S.C. 154](b)(1) are reduced as follows: (1) To the extent that there are multiple grounds for extending the term of a patent that may exist simultaneously (e.g., delay due to a secrecy order under [35 U.S.C.] 181 and administrative delay under [35 U.S.C.] 154(b)(1)(A)), the term should not be extended for each ground of delay but only for the actual number of days that the issuance of a patent was delayed; See 145 Cong. Rec. S14,718[1]

As such, the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the commencement date 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 commencement 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 from the application's commencement date through the date it matured into

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[1] The AIPA is title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948), which was incorporated and enacted as law as part of Pub. L. 106-113. The Conference Report for H.R. 3194, 106th Cong. 1st Sess. (1999), which resulted in Pub. L. 106-113, does not contain any discussion (other than the incorporated language) of S. 1948. A section-by-section analysis of S. 1948, however, was printed in the Congressional Record at the request of Senator Lott, See 145 Cong. Rec. S14,708-26 (1999)(daily ed. Nov. 17, 1999).

Patent No. 7,498,338, June 14, 2004 to March 3, 2009. (There were no periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)).

Therefore, 230 days, not 0 days, of patent term adjustment should have been entered for the Three Year Delay period, since the period of delay of 628 days attributable to the delay in the issuance of the patent overlaps with the adjustments of 398 days attributable to the ground specified in § 1.702(a)(1). 628 days is determined to be the actual number of days that the issuance of the patent was delayed, considering the 628 days over three years and the 398 days of examination delay. Accordingly, 230 days (628 - 398) should have been entered at issuance for a total Office delay of 628 days.

As such, patentees are entitled to a patent term adjustment of 621 days (398 days examination delay + 628 days Three Year delay reduced by 398 overlap - 7 days for applicant delay).

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is adjusted by six hundred twenty-one (621) days.

Telephone inquiries specific to this matter should be directed to Shirene Willis Brantley, Senior Petitions Attorney, at (571) 272-3230.

Nancy Johnson
Senior Petitions Attorney
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,498,358 B2

DATED : **March 3, 2009** **DRAFT**

INVENTOR(S) : S. Brown, 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 391 days

Delete the phrase "by 391 days" and insert – by 621 days--

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of S. Brown *et al.*	
Application No.: 10/498,338	
U.S. Patent No.: 7,498,358	Confirmation No.: 4531
Filing Date: May 11, 2005 *(Or 371(c) Date)*	Group Art Unit: 1624
Examiner: V. Balasubramanian	
Entitled: HUMAN ADAM-10 INHIBITORS	07/06/2009 CKHLOK 00000006 132498 7498358 01 FC:1455 200.00 DA

PETITION FOR RECALCULATION OF PATENT TERM ADJUSTMENT FILED UNDER 37 C.F.R. § 1.705(d)

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

Sir:

Applicants petition that the Patent Term Adjustment set forth for U.S. Serial No 10/498,338, which issued as U.S. Patent No. 7,498,358 on March 3, 2009, be recalculated because the total delay period that Patentees are entitled to for an adjustment under 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 154(b)(1)(B) have not been added. As a result, Patentees are being denied a portion of patent term to which it was entitled under U.S. Patent Law. Specifically, Patentees are entitled to 687 days of Patent Term Adjustment, not 391 days of Patent Term Adjustment as was calculated by the U.S.P.T.O.

In a recent decision (*Wyeth v. Dudas,* 580 F. Supp. 2d 138 (D.D.C. Sept 30, 2008)), the district court found that the USPTO has not been calculating PTAs correctly based on its misinterpretation of § 154(b)(1). According to the Court, the delays under the provisions of 154(b)(1)(A) and § 154(b)(1)(B) are supposed to be added together with the exception that if

CERTIFICATE OF TRANSMISSION (37 C.F.R. 1.8)
I hereby certify that this correspondence is being transmitted to the USPTO via the USPTO EFS on May 1, 2009.

Date: May 1, 2009

/Michael S. Greenfield/
Michael S. Greenfield

Conclusion

For all the reasons stated above, Patentees respectfully request the USPTO to recalculate the Patent Term Adjustment and add up the period of total delay under 35 U.S.C. § 154(b)(1)(A) and 35 U.S.C. § 154(b)(1)(B).

Fee Authorization: The Commissioner is authorized to charge the cost of any fees that may be associated with the filing of this Petition to Deposit Account No. 13-2490.

If there are any questions or comments regarding this application, the Office is encouraged to contact the undersigned in order to expedite prosecution.

Respectfully submitted,

Date: May 1, 2009

/Michael S. Greenfield/
Michael S. Greenfield
Registration No. 37,142

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OFFICE OF PETITIONS

In re Application of :
Georg THERKELSEN :
Application No. 10/498,342 : DECISION ON PETITION
Filed: June 16, 2004 :
Attorney Docket No. P25322 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 24, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, May 16, 2007, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 17, 2007.

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

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.

A revocation of power of attorney was filed by the assignee on March 16, 2007, however, was not accepted.

Telephone inquiries concerning this decision should be directed to Diane Goodwyn at (571) 272-6735.

This application is being referred to Technology Center AU 1623 for appropriate action by the Examiner in the normal course of business on the reply received April 24, 2008.

Thurman Page
Petitions Examiner
Office of Petitions

cc: DAVID M. GOODRICH
J.M. GUBER CORPORATION
333 THORNALL ST.
EDISON, NJ 08837

18 MAR 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

In re Application of	:	DECISION
KAMATA et al.	:	
Application No.: 10/498,349	:	
PCT No.: PCT/JP02/13761	:	
Int. Filing Date: 27 December 2002	:	
Priority Date: 28 December 2001	:	
Attorney Docket No.: 253746US2PCT	:	
For: ORGANIC THIN-FILM TRANSITOR	:	
AND METHOD OF MANUFACTURING	:	
METHOD THEREOF	:	

This decision is in response to applicants' "REQUEST FOR CORRECTED NOTICE OF ACCEPTANCE" filed in the United States Patent and Trademark Office (USPTO) on 02 March 2005, which has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 27 December 2002, applicants filed international application PCT/JP02/13761 which designated the US and claimed a priority date of 28 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 17 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 28 June 2004.

On 17 June 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 English translation of the international application as filed, and a declaration of the inventors.

On 15 February 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AN 37 CFR 1.495 (Form PCT/DO/EO/903) according the application a 35 U.S.C. § 371(c)(1), (c)(2), and (c)(4) date of 17 June 2004 and a 35 U.S.C. 371 date of 28 June 2004.

On 02 March 2005, applicants submitted the instant "REQUEST FOR CORRECTED NOTICE OF ACCEPTANCE" which has been treated as a petition under 37 CFR 1.181.

DISCUSSION

The NOTICE OF ACCEPTANCE OF APPLICATION mailed 15 February 2005 contained the incorrect international 35 U.S.C. 371 date. (The 35 U.S.C. 371 date was indicated as 28 June 2004 rather than as 17 June 2004.) Accordingly, the 15 February 2005 NOTICE OF ACCEPTANCE is hereby VACATED. It is noted, however, that the 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date accorded of 17 June 2004 in this NOTICE OF ACCEPTANCE was correct with respect to the above-identified application.

CONCLUSION

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

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for processing in accordance with this decision, that is for (1) mailing of a corrected NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495 (Form PCT/DO/EO/903) indicating both the 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) and the 35 U.S.C. 371 date as **17 June 2004**.

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

25 APR 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

Kevin D. McCarthy
Roach, Brown, McCarthy & Gruber, P.C.
1620 Liberty Building
420 Main Street
Buffalo, NY 14202

In re Application of :
SLATKINE et al. :
Application No.: 10/498,382 : DECISION
Filing Date: June 10, 2004 :
Attorney Docket No.: 0-03-152.01 :
For: METHOD AND APPARATUS FOR IMPROVING SAFETY DURING EXPOSURE TO A MONOCHROMATIC LIGHT SOURCE :

This decision is issued in response to applicant's "Petition under 37 CFR 1.181 or 1.182" filed January 03, 2007. Additionally, this decision is issued in response to applicant's "Request for Correct Filing Receipt" filed 19 January 2006. Applicant requests in the present petition that: (1) the certified copy of the above-identified application indicate a submission date of June 10, 2004, and (2) the certified copy of this application sets for the continuation-in-part application not the international application.

BACKGROUND

On June 10, 2004, applicant filed a Transmittal Letter for entry into the national stage accompanied, *inter alia,* by: the requisite basic national fee; a copy of the international application; an unexecuted declaration; and an information disclosure statement.

In response to the Notification of Missing Requirements mailed September 01, 2004, applicant submitted a declaration on October 18, 2004.

On May 31, 2005, 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 of October 18, 2004.

On January 19, 2006, applicant filed a "Request for Corrected Filing Receipt."

On January 03, 2007, applicant filed a "Petition under 37 CFR 1.181 or 1.182."

DISCUSSION

A review of the application file reveals that the above identified application was improperly treated under 35 U.S.C. 371. Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). See 37 CFR 1.495(g):

> The documents and fees submitted . . . must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a), page 1800-190 of the MPEP states that:

> If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

On June 10, 2004, applicant submitted a Transmittal Letter (Form PTO-1390) which stated "this application claims priority as a continuation in part of PCT/IL02/00635 filed August 2, 2002 and Israeli patent application nos. 147009 (12/10/2001), 150094 (6/6/2002); 160510 (2/22/2004); and as a continuation-in-part of U.S. nonprovisional patent application no. 10/614,672 (7/7/2003)." The statement on the Transmittal Letter (Form PTO-1390) is inconsistent with an intent to enter the national of the PCT under 35 U.S.C. 371. Accordingly, the original papers deposited on June 10, 2004 should have been treated as a filing under 35 U.S.C. 111(a).

CONCLUSION

Applicant's request is **REFUSED**.

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 February 28, 2003 is hereby **VACATED**.

This application will be treated as a filing under 35 U.S.C. 111(a).

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 returned to the Office of Initial Patent Examination (OIPE) for processing under 35 U.S.C. 111(a). Upon notification of a filing date accorded under 35 U.S.C. 111(a), applicant may request a certified copy of the application.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (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
www.uspto.gov

18 MAY 2007

Kevin D. McCarthy
Roach, Brown, McCarthy & Gruber, P.C.
1620 Liberty Building
420 Main Street
Buffalo, NY 14202

In re Application of :
SLATKINE et al. :
Application No.: 10/498,382 :
Filed: June 10, 2004 : DECISION ON PETITION
Attorney Docket No.: 0-03-152.01 :
For: METHOD AND APPARATUS FOR IMPROVING SAFETY DURING EXPOSURE TO A MONOCHROMATIC LIGHT SOURCE :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed May 07, 2007, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

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

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the

> claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The amendment submitted concurrently with the instant petition as drafted is unacceptable and, therefore, is not considered a proper reference under 37 CFR 1.78(a)(2)(i). In this regard, the amendment is physically part of the instant petition and, as such, does not comply with 37 CFR 1.121, 1.52, or 1.4(c). Note that 37 CFR 1.121 states that amendments are made by filing a paper, in compliance with § 1.52, directing that specified amendments be made. The pertinent section of 37 CFR 1.52 states that the claim (in this case, the claim for priority), must commence on a separate physical sheet. 37 CFR 1.4(c) states that each distinct subject must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office.

In view of the above, the amendment to add a priority claim to the first line of the specification, which is physically embedded in the instant petition, is not acceptable. Accordingly, a substitute amendment in compliance with the aforementioned rules, along with a renewed petition under 37 CFR 1.78(a)(3), must be submitted.

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

By mail:	Mail Stop PETITIONS Commissioner for Patents Post Office Box 1450 Alexandria, VA 22313-1450
By hand:	Customer Service Window Mail Stop Petitions Randolph Building 401 Dulany Street Alexandria, VA 22314
By fax:	(571) 273-8300 ATTN: Office of Petitions

Any questions concerning this matter may be directed to Anthony Smith at (571) 272-3298 .

Boris Milef
Legal Examiner
Office of Petitions and PCT Legal Administration

2 1 DEC 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Kevin D. McCarthy
Roach, Brown, McCarthy & Gruber, P.C.
1620 Liberty Building
420 Main Street
Buffalo, NY 14202

In re Application of :
SLATKINE et al. :
Application No.: 10/498,382 :
Filed: June 10, 2004 : DECISION ON PETITION
Attorney Docket No.: 0-03-152.01 :
For: METHOD AND APPARATUS FOR IMPROVING SAFETY DURING EXPOSURE TO A MONOCHROMATIC LIGHT SOURCE :

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed November 29, 2007, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed international and nonprovisional applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

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

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

require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1) above for the following reasons:

1) The current application was filed June 10, 2004 and therefore is not copending with PCT/IL01/00855.

2) The international filing date of PCT/IL01/00855 is not August 2, 2002.

3) The amendment fails to state the relationship of the present application to International Application No. PCT/IL01/00855 filed September 10, 2001. (See 37 CFR 1.78(a)(2)(i)) The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of International Application No. ---, filed---." A benefit claim that merely states: "This application claims the benefit of International Application No. ---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. See MPEP Section 201.11, Reference to Prior Application.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet (37 CFR 1.76(a)(5)) or a proper amendment (complying with the provisions of 37 CFR 1.121) to correct the above matters are required.

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

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

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

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

Any questions concerning this matter may be directed to Anthony Smith at (571) 272-3298.

Boris Milef
Legal Examiner
Office of Petitions and PCT Legal Administration

25 AUG 2009

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Proskauer Rose LLP
One International Place
Boston, MA 02110

In re Application of :
SLATKINE et al. :
Application No.: 10/498,382 :
Filed: June 10, 2004 : DECISION ON PETITION
Attorney Docket No.: 0-03-152.01 :
For: METHOD AND APPARATUS FOR :
IMPROVING SAFETY DURING :
EXPOSURE TO A MONOCHROMATIC
LIGHT SOURCE

This decision is in response to applicant's "Combined Petition under 37 CFR 1.55(c) and 1.78(a)(3)" dated July 02, 2009, requesting acceptance of an unintentionally delayed claim for priority under 35 U.S.C. 365(c) and 37 CFR 1.78(a)(3) to nonprovisional application no. 10/614,672.

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 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 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 proper reference to the prior-filed application has been included in an amendment to the first sentence of the specification, 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 petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §120 to the prior-filed 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 365(c) and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether 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 application, accompanies this decision on petition. Any questions concerning this matter may be directed to 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 Technology Center Art Unit 3772 for appropriate action on the amendment submitted July 02, 2009, including consideration by the examiner of the claim for benefit of the prior-filed application.

BryanLin

Bryan Lin
Legal Examiner
PCT Legal Administration

16 AUG 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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Rene A. Pereyna
Marsh Fischmann & Breyfogle LLP
3151 South Vaughn Way, Suite 411
Aurora, Colorado 80014

In re Application of :
Helfman :
Serial No.: 10/498,409 :
PCT No.: PCT/IL02/00991 :
Int. Filing Date: 09 December 2002 :
Priority Date: 10 December 2001 : DECISION
Attorney's Docket No.: 50152-00001 :
For: APPARATUS AND METHOD FOR OPTIMIZED AND SECURED REFLECTION OF NETWORK SERVICES TO REMOTE LOCATIONS :

This decision is in response to applicants' request for entry of the application data sheet filed 11 May 2005.

BACKGROUND

On 09 December 2002 applicants filed international application PCT/IL02/00991, which claimed priority of an earlier United States provisional application filed 10 December 2001. The thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 10 June 2004.

On 10 June 2004, applicants filed a transmittal letter for entry into national stage in the United States. The transmittal letter was accompanied by a copy of the international search report, the international preliminary examination report, and the basic national fee of $365. These papers were assigned Application No. 10/498,409.

On 05 October 2004, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration. The notification set a two-month time period in which to respond.

On 06 December 2004, applicant filed the declaration for the inventor.

On 30 December 2004, the United States Patent and Trademark Office in its capacity as an Elected Office mailed out a "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903). This notice indicated that the date of receipt of the requirements of 35 U.S.C. 371(c)(1), (2) and (4) was 06 December 2004.

On 11 May 2005, applicant filed the current paper requesting entry of the application data sheet.

DISCUSSION

In an Official Gazette Notice, published the 18 March 2003, the Office set out the following policy:

> The reference required by 37 CFR 1.78(a)(2) or (a)(5) must be included in an application data sheet (37 CFR 1.76), or the specification must contain, or be amended to contain, such reference in the first sentence following the title. Previously, the Office indicated that if an applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a) (e.g., if the claim is included in an oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a), the Office will not require a petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) to correct the claim if the information concerning the claim was recognized by the Office as shown by its inclusion on the filing receipt. If, however, a claim is included elsewhere in the application and not recognized by the Office as shown by its absence on the filing receipt, the Office will require a petition and the surcharge to correct the claim. See Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication Provisions, 66 Fed. Reg. 67087, 67089-90 (Dec. 28, 2001). The Office will continue to follow this practice.

In the instant application, the serial number of the priority application was not identified in the first paragraph of the specification. However, the serial number was correctly identified in the declaration. On processing, the priority claim was recognized by the Office, and was listed on the filing receipt. However, due to a typographical error on the part of the Office, the wrong serial number was listed for the priority claim on the filing receipt.

Because the Office did recognize the priority claim, the application data sheet will be entered and a new filing receipt listing the correct priority information will be issued.

CONCLUSION

The communication filed 11 May 2005 requesting entry of the application data sheet is **GRANTED**.

This application is being forwarded to national stage processing for a **corrected filing receipt** indicating a priority claim to United States Provisional Application Serial **60/337,795** filed **10 December 2001.**

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

Debra S. Brittingham
PCT Special Programs Examiner
Office of PCT Legal Administration

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

Telephone: (571) 272-3280
Facsimile: (571) 273-0459

16 AUG 2005

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Rene A. Pereyna
Marsh Fischmann & Breyfogle LLP
3151 South Vaughn Way, Suite 411
Aurora, Colorado 80014

RECEIVED

MARSH FISCHMANN & BREYFOGLE LLP

In re Application of
Helfman
Serial No.: 10/498,409
PCT No.: PCT/IL02/00991
Int. Filing Date: 09 December 2002
Priority Date: 10 December 2001
Attorney's Docket No.: 50152-00001
For: APPARATUS AND METHOD FOR OPTIMIZED AND SECURED REFLECTION OF NETWORK SERVICES TO REMOTE LOCATIONS

DECISION

This decision is in response to applicants' request for entry of the application data sheet filed 11 May 2005.

BACKGROUND

On 09 December 2002 applicants filed international application PCT/IL02/00991, which claimed priority of an earlier United States provisional application filed 10 December 2001. The thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 10 June 2004.

On 10 June 2004, applicants filed a transmittal letter for entry into national stage in the United States. The transmittal letter was accompanied by a copy of the international search report, the international preliminary examination report, and the basic national fee of $365. These papers were assigned Application No. 10/498,409.

On 05 October 2004, the United States Patent and Trademark Office in its capacity as an Elected Office mailed the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that applicant was required to file an oath/declaration. The notification set a two-month time period in which to respond.

On 06 December 2004, applicant filed the declaration for the inventor.

CONCLUSION

The communication filed 11 May 2005 requesting entry of the application data sheet is **GRANTED**.

This application is being forwarded to national stage processing for a **corrected filing receipt** indicating a priority claim to United States Provisional Application Serial **60/337,795** filed **10 December 2001.**

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

Debra S. Brittingham
PCT Special Programs Examiner
Office of PCT Legal Administration

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

Telephone: (571) 272-3280
Facsimile: (571) 273-0459

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference A02-40103/RR/MKR	**FOR FURTHER ACTION**	See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)
International application No. PCT/NL 02/00808	International filing date *(day/month/year)* 10.12.2002	Priority date *(day/month/year)* 14.12.2001
International Patent Classification (IPC) or both national classification and IPC B67C7/00		
Applicant STORK FOOD & DAIRY SYSTEMS B.V.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.

2. This REPORT consists of a total of 6 sheets, including this cover sheet.

   ☒ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

   These annexes consist of a total of 8 sheets.

3. This report contains indications relating to the following items:

   - I ☒ Basis of the opinion
   - II ☐ Priority
   - III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
   - IV ☐ Lack of unity of invention
   - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
   - VI ☐ Certain documents cited
   - VII ☐ Certain defects in the international application
   - VIII ☐ Certain observations on the international application

Date of submission of the demand	Date of completion of this report
14.07.2003	29.03.2004
Name and mailing address of the international preliminary examining authority: European Patent Office - P.B. 5818 Patentlaan 2 NL-2280 HV Rijswijk - Pays Bas Tel. +31 70 340 - 2040 Tx: 31 651 epo nl Fax: +31 70 340 - 3016	Authorized Officer Wartenhorst, F Telephone No. +31 70 340-3641

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/NL 02/00808

I. Basis of the report

1. With regard to the **elements** of the international application *(Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17))*:

Description, Pages

5-12	as originally filed
1-4	received on 23.01.2004 with letter of 23.01.2004

Claims, Numbers

1-20	received on 23.01.2004 with letter of 23.01.2004

Drawings, Sheets

1/4-4/4	as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

   These elements were available or furnished to this Authority in the following language: , which is:

   ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).

   ☐ the language of publication of the international application (under Rule 48.3(b)).

   ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

   ☐ contained in the international application in written form.

   ☐ filed together with the international application in computer readable form.

   ☐ furnished subsequently to this Authority in written form.

   ☐ furnished subsequently to this Authority in computer readable form.

   ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.

   ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

   ☐ the description, pages:

   ☐ the claims, Nos.:

   ☐ the drawings, sheets:

5. ☒ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

   (Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)

   see separate sheet

6. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes:	Claims	1-20
	No:	Claims	
Inventive step (IS)	Yes:	Claims	2,3,6,10-15,17-20
	No:	Claims	1,4,5,7-9,16
Industrial applicability (IA)	Yes:	Claims	1-20
	No:	Claims	

2. Citations and explanations

   see separate sheet

Re Item I

Basis of the report

The amendment of claim 1 by including the feature that "the housing extends at least along the filling station" is considered to go beyond the disclosure as originally filed as therein is only disclosed that the housing extends at least along the filling station **and** the closing station, i.e. the critical part of the processing line (see page 3, lines 8-16 and page 12, lines 11-16). Hence, the fact that the housing may be restricted to only the filling station has not been disclosed in the disclosure as originally filed.

Re Item V

Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

Reference is made to the following documents:

D1: DE 296 16 138 U (HAMBA MASCHF) 28 November 1996 (1996-11-28)

D2: US-A-5 022 165 (BESWICK FRANK) 11 June 1991 (1991-06-11)

D3: US-A-4 693 052 (REBMANN MANFRED ET AL) 15 September 1987 (1987-09-15)

1. As it is not clearly defined in claim 1 to which extend the housing is required to partially enclose the processing line of the filling device, the solution proposed in claim 1 of the present application cannot be considered as involving an inventive step (Article 33(3) PCT) for the following reasons:

1.1 Document D1, which is considered to represent the most relevant state of the art, discloses (cf. page 7, line 26 - page 8, line 30) a filling device comprising an endless conveyor, container infeed and discharge mechanisms and several workstations along processing lines from which the subject-matter of claim 1 differs in that a housing comprising gas supply means, partially encloses a processing line and that gas discharge means are provided in a central area defined between the conveyor sections.

1.2 However, these features have already been employed in a sterilization tunnel which may form a part of the filling device known from document D1, see document D2, column 4, line 55 - column 5, line 8 and figure 5. It would be obvious to the person skilled in the art to apply the sterilization tunnel of D2 in the filling device of D1 as an alternative for the sterilization section "Sterilmittel bereich

22 und anschließenden Trocknungsbereich 23" where circumstances make it desirable, thereby arriving at a filling device according to claim 1. The subject-matter of claim 1 does therefore not involve an inventive step.

2. Dependent claims 4, 5, 7-9 and 16 do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of inventive step, the reasons being as following:

2.1 The features of claims 4 and 5, i.e. supplying gases in a direction substantially perpendicular to the direction of conveyance and a partially tunnel-shaped housing, are evidently disclosed in document D2, see for example figure 5.

2.2 The feature of claim 7, i.e. driving parts are situated substantially on the outside of the housing, is disclosed in document D2, column 3, lines 52-56, figure 6.

2.3 The feature of claim 9, i.e. a distribution plate is provided with a plurality of passage apertures, is disclosed in document D2, column 4, line 13 "perforated distribution plate 54", column 5, lines 1,2 "porous plate 65" and line 46 "perforated plate 87", figures 4-6. The feature that this plate leaves clear a space with the container apertures with a height of less than 25 cm (claim 8) comes within the scope of the customary practice followed by persons skilled in the art.

2.4 Claim 16 does not comprise any *technical* feature which could make the invention over the prior art.

3. The subject-matter of claim 2 differs from the prior art in that the housing extends at least along the filling station, the closing station and in particular a drying station.

This feature provides the advantage that a flow of conditioned gases introduced into the housing, is achieved in a direction substantial perpendicular to the direction of the conveyor and to the heart of the conveyor system along the critical part of the processing line, and therewith preventing the spread of pollutants at the

position of at least the filling apertures of containers.

Although document D2 teaches the recirculation of expensive sterile air in the sterilizing zone, there is no teaching in this document to apply this system to a filling station, a closing station and a drying station according to the invention of claim 2 and in which conditioned air is discharged from a central area for different reasons.

The subject-matter of claim 2 is therefore considered to satisfy the criteria with respect to novelty and inventive step as set forth in Article 33(2) and Article 33(3) PCT.

3.2 The subject-matter of dependent claims 3, 6, 10-15 and 17-20 comprises features which are neither known from, nor rendered obvious by, the available prior art. Therefore, the dependent claims 10-15 and 17-20 as such also meet the requirements of the PCT with respect to novelty and inventive step.

Printed: 24-03-2004 DESCPAMD NL0200808

0/498436

P26505PC00/RR/MKR

EPO - DG 1

23. 01. 2004

(96)

Enclosure to our letter
dated 23 January 2004
PCT/NL02/00808
Stork Food & Dairy Systems B.V.

DT08 Rec'd PCT/PTO 10 JUN 2004

Short title: Filling device with housing having a central gas discharge

The invention relates to a filling device for filling containers with foods, in particular liquid foods. The device according to the invention here is of the type with an imaginary looped conveyor track having a bottom and a top track section, which sections are connected to each other by means of bend sections.

A filling device according to the preamble of claim 1 is known, and the applicant has already been constructing and selling it under the name Exact Volume CE 87 for a number of years now. The device comprises endless conveyor chains on which a plurality of container holders are fastened. The endless chains convey the container holders along an imaginary looped conveyor track with the abovementioned bottom and top track sections. By driving the chains, the container holders are conveyed in succession along a container infeed mechanism, a decontamination station, a drying station, a filling station, a closing station and a container discharge mechanism. The infeed and discharge mechanisms and the plurality of workstations are all disposed along the top track section. The greater part of the filling device, including conveyor chains, drive unit with chain wheels and processing stations, is enclosed in a substantially sealing manner by a large housing, in other words with the exception of the container infeed mechanism and the container discharge mechanism. During operation, conditioned air is blown in at slightly positive pressure through a plurality of air infeed mechanisms in the top side of the housing. The slight positive pressure serves to prevent polluted ambient air from being able to flow inwards into the housing during the filling process, for example through the container infeed mechanism or container discharge mechanism.

A disadvantage in the case of this known device is that there is a risk of pollutants being released or finding their way inside the housing. Such pollutants in this case very soon extend over the entire processing line. Polluted particles may be released in

particular in the case of the conveyor chains, the chain wheels and other moving parts of the conveyor system. If aseptic filling conditions are desired, the entire filling device inside the housing is treated with hydrogen peroxide before the actual filling process is started. During the filling process it is then difficult to keep all parts inside the housing sterile with sterile air. The shape and the size of the area around the processing line inside the housing do not permit this.

Furthermore, a filling device is known from DE-U-296 16 138, the device comprising a processing line having an endless conveyor with several workstations positioned there along, like a filling station and a closing station. The closing station comprises a magnetic cap feed track, and is partially enclosed by a tunnel shaped housing with gas supply means. It is not clear if a housing is also provided at the location of the filling station and if it comprises gas supply means. No means are disclosed for discharging gas from this known filling device.

The object of the present invention is to overcome the above-mentioned disadvantages at least partially, or to provide a useful alternative, and in particular to provide a compact filling device that is flexible in use, with an optimized processing functionality. More particularly, the object of the invention is to provide a compact, substantially aseptic filling device that is equipped with a minimized working area which can be kept substantially aseptic.

This object is achieved by a filling device according to claim 1. In the case of this device provision is made for gas discharge means that connect to or, as regards the sphere of influence, at least partially extend into the heart of the conveyor system, in order to discharge laterally there at least part, in particular the greater part, of the gases introduced into the housing. A flow of conditioned gases can therefore advantageously be achieved in a direction substantially perpendicular to the direction of conveyance of the conveyor system. The introduced gases flow in succession preferably first along the filling apertures of the containers to be filled, and only then along the outsides of the containers and parts of the conveyor system, and are then discharged by way of the gas discharge means from the central area between the top and bottom track sections of the conveyor system until they are outside the

housing. This specific arrangement of the gas discharge means produces a direction of flow of the conditioned gases towards the heart of the conveyor system by means of which the spread of pollutants at the position of at least the filling apertures of individual containers can advantageously be prevented. Furthermore, it is ensured that the most critical points during the filling process, i.e. the environment around the filling apertures of the containers, will not undesirably become polluted by dirt coming from the remainder of the outside of the container, or dirt coming from moving parts of the conveyor system. This advantageously also means that less high standards need be set for the cleanness of the outsides of the containers. For example, these outsides need no longer be made fully sterile, which produces both a gain in time and a cost saving.

The housing advantageously here extends at least not only along the filling station, but also along the closing station and, if desired along a drying station disposed upstream of the above stations. This means that along a critical part of a processing line, i.e. from the moment the container has been cleaned, is to be filled with perishable foods and subsequently closed, a desired direction of flow of conditioned gases along the containers can be achieved in the direction of the gas discharge means connecting in the heart of the conveyor system.

In a special embodiment, gas supply means that are designed for supplying conditioned gases in a direction substantially perpendicular to the direction of conveyance are connected to the housing. This gives a further guarantee of the desired flow of conditioned gases along the containers in the direction of the gas discharge means.

In particular, the housing is made at least partially tunnel-shaped, at least the part of the processing line that faces outwards being covered over. The covering leaves free a tunnel through which the containers to be filled can be conveyed along the stations. This gives the advantage that the area that has to be kept under certain processing conditions during operation, in particular the environment surrounding the filling apertures of the containers, is minimized. The number of parts, and also the surface area of these parts that is situated inside the housing segments, can also advantageously be

minimized. The quantity of conditioned gases required is advantageously small.

In a further embodiment, the device comprises a conveyor system with container holders for conveying containers in a plurality of adjacent rows along workstations, the device being designed with a plurality of housing segments disposed adjacent to each other. Each housing segment individually encloses at least partially one or more of the rows of containers to be processed. Each at least partially individually enclosed row or number of rows of containers to be processed is defined as a processing line. The plurality of processing lines thus defined extend adjacent to each other along a common imaginary conveyor track. The plurality of processing lines and housing segments situated adjacent to each other in this case bound a common central area in the heart of the conveyor track. Each housing segment is individually connected to gas supply means. The gas discharge means can advantageously be effective here as common gas discharge means for the conditioned gases fed individually into the plurality of housing segments.

According to the invention, individual processing conditions can advantageously prevail within each housing segment, for example the supply of different gases, the temperature, sterility, humidity etc. If one of the processing lines becomes polluted, this advantageously does not directly have the consequence that the other processing lines become polluted. If there is a fault in one of the processing lines, the device may, if desired, continue to operate for the other processing lines. The individual housing segments also make it possible expediently further to reduce the working area in which the filling operations have to be carried out, so that the desired processing conditions can be achieved and maintained in a simpler manner.

Further preferred embodiments of the invention are set out in the subclaims.

EPO - DG 1
23. 01. 2004
(96)

P26505PC00/RR/MKR

Enclosure to our letter
dated 23 January 2004
PCT/NL02/00808
Stork Food & Dairy Systems B.V.

10/498436
DT0R Rec'd PCT/PTO 10 JUN 2004

CLAIMS

1. Filling device for filling containers with foods and closing said containers, comprising:

- an endless conveyor system with drive means, for conveying container holders along an imaginary looped conveyor track with bottom and top track sections that are connected to each other by means of bend sections;
- a container infeed mechanism, for supplying containers to the container holders;
- workstations for carrying out operations on containers conveyed along, including a filling station and a closing station;
- a container discharge mechanism, for removing containers from the container holders;
- at least one processing line provided along the conveyor track, for containers to be processed;
- a housing that at least partially encloses the processing line and which housing extends at least along the filling station; and
- gas supply means, for feeding conditioned gases into the housing;

the workstations being disposed along the conveyor track, characterized in that:

a central area is defined between the top and bottom track sections and the bend sections of the at least one processing line situated along the conveyor track, and in that gas discharge means are provided for discharging by way of the central area at least part of the gases conveyed into the housing.

2. Filling device according to claim 1, in which the housing extending at least along the filling station also extends along the closing station, and in particular also along a drying station that is provided along the conveyor track upstream of the filling station.

3. Filling device according to claim 2, in which the housing extends substantially uniformly along a plurality of workstations.

4. Filling device according to one of the preceding claims, in which the gas supply means connecting to the housing are designed to supply the conditioned gases in a direction substantially perpendicular to the direction of conveyance.

5. Filling device according to one of the preceding claims, in which the housing is made at least partially tunnel-shaped, with housing walls that enclose at least a part of the corresponding processing line that faces outwards.

6. Filling device according to claim 5, in which the housing is designed as a substantially endless tunnel-shaped housing, leaving clear the infeed and the discharge mechanism.

7. Filling device according to one of the preceding claims, in which driving parts of the workstations are situated substantially on the outside of the housing.

8. Filling device according to one of the preceding claims, in which the housing is designed to leave clear between container filling apertures and the housing a space with a height of less than 25 centimetres, in particular less than 15 centimetres.

9. Filling device according to one of the preceding claims, in which a distribution plate provided with a plurality of passage apertures is provided in the housing, which distribution plate extends at least partially along the processing line and together with the housing walls forms a gas distribution chamber, and in which the gas supply means open into the gas distribution chamber.

10. Filling device according to claim 9, in which the distribution plate is of a profiled design corresponding to the shape of top parts of containers to be filled.

11. Filling device according to one of the preceding claims, in which the container discharge mechanism is provided downstream of the container infeed mechanism, viewed in the direction of conveyance,

further past at least one of the two bend sections, and past at least a part of the bottom track section,

in which the container holders are provided with retaining means for also conveying containers held substantially upside down, and

in which the conveyor system is equipped with container holders for conveying containers substantially upright along at least part of the top track section, and for conveying the containers retained substantially upside down along at least part of the bottom track section.

12. Filling device according to claim 11, in which the container infeed mechanism and the container discharge mechanism are provided close to or along the same bend section of the conveyor track.

13. Filling device according to one of the preceding claims, in which the conveyor system with container holders is designed to convey the containers along at least one of the two bend sections with filling apertures of containers to be conveyed facing outwards.

14. Filling device according to one of the preceding claims, in which at least one of the workstations is at least partially disposed along at least part of one of the two bend sections and/or the bottom track section, and in which the processing line is at least partially enclosed by the housing at the position of this workstation.

15. Filling device according to claim 14, in which the abovementioned workstation is a decontamination station for decontaminating at least the insides of containers being conveyed along.

16. Filling device according to one of the preceding claims, in which the container infeed mechanism and the container discharge mechanism are provided close to each other along the conveyor track.

17. Filling device according to one of the preceding claims, in which a plurality of processing lines are provided adjacent to each other along the conveyor track, in which the housing comprises a

plurality of housing segments disposed adjacent to each other and extending in the direction of conveyance, each housing segment at least partially enclosing one of the processing lines, in which gas supply means connect to each of the housing segments, in which the central area is defined in common between the top and bottom track sections and the bend sections of the plurality of processing lines lying adjacent to each other along the conveyor track, and in which the gas discharge means are provided for discharging by way of the common central area at least part of the gases introduced into the plurality of housing segments situated adjacent to each other.

18. Filling device according to claim 17, in which the individual housing segments are connected to one another, and in particular comprise common side wall parts.

19. Filling device according to claim 17 or 18, in which at least one of the workstations extends over the plurality of processing lines.

20. Filling device according to one of claims 17 - 19, in which control means for supplying differing quantities and/or compositions of conditioned gases to the individual housing segments in a controllable manner are provided.

#3

30 MAR 2005

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In re Application of	:	
Labarbe, et al.	:	
Serial No.: 10/489,439	:	
PCT No.: PCT/GB02/05543	:	DECISION
Int. Filing Date: 06 December 2002	:	
Priority Date: 11 December 2001	:	
Attorney's Docket No.: 04150.001101	:	
For: SYSTEM AND METHOD FOR TIME CORRELATED MULTI-PHOTON COUNTING MEASUREMENTS	:	

This decision is responsive to the request for express abandonment filed 16 September 2004. No fee is due.

BACKGROUND

On 06 December 2002 applicants filed international application PCT/GB02/05543, which claimed priority of an earlier British application filed 11 December 2001. The thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 11 June 2004.

On 10 June 2004, the above named counsel filed a transmittal letter for entry into national stage in the United States. The transmittal letter was accompanied by a preliminary amendment, an IDS, and the basic national fee of $920. These papers were assigned Application No. 10/498,439.

On 14 June 2004, counsel for the apparent assignee filed a second transmittal letter for entry into national stage in the United States. The transmittal letter was accompanied by a preliminary amendment, an IDS, and the basic national fee of $920. These papers were assigned Application No. 10/498,832.

On 16 September 2004, the above named counsel filed a petition for express abandonment of Application No. 10/498,439.

DISCUSSION

MPEP 1801 states, in part:

> The Patent Cooperation Treaty (PCT) enables the U.S. applicant to file one application, "an international application," in a standardized format in English in the U.S. Receiving Office (the U.S. Patent and Trademark Office), and have that application acknowledged as a regular national or regional filing in as many Contracting States to the PCT as the applicant "designates" or "elects," that is, names, as countries or regions in which patent protection is desired.

The application originally filed on 10 June 2004, Application No. 10/498,439 is the first filed national stage application. Since, as stated above, the applicant can file one international application, and have that application acknowledged as a regular national filing, the second national stage filing, Application No. 10/498,832 is not a proper filing. As a result, the contents of Application No. 10/498,832 will be placed in the 10/498,439 file wrapper.

With respect to the petition to expressly abandon the 10/498,439, applicant had not provided a proper power of attorney or declaration at the time this petition was filed. Therefore, the petition is dismissed.

CONCLUSION

The petition to expressly abandon Application No. 10/498,439 is **DISMISSED** for failure to provide the proper signatures.

All future correspondence with respect to this application (national stage filing of PCT/GB02/05543) should be directed to Application No. 10/498,439.

The basic national fee of **$920** paid by applicant in Application No. 10/498,832 has been **REFUNDED to Deposit Account # 50-2590**.

In response to this decision, applicant **must** provide a signed declaration and power of attorney with a clear indication of where any future correspondence in this application should be sent.

A proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

The application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Debra Brittingham
Office of PCT Legal Administration
DSB/RC:dsb

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Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

cc: Royal N. Ronning, Jr.
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28 SEP 2004

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Beth L. Kelly
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San Francisco, CA 94111-3834

In re Application of	:	
CHOW, Robert et al.	:	
Application No.: 10/498,450	:	DECISION
PCT No.: PCT/US02/38436	:	
Int. Filing Date: 27 November 2002	:	ON PETITION UNDER
Priority Date: 29 November 2001	:	
Docket No.: 020035-001110US	:	37 CFR 1.137(b)
For: STEM CELL SCREENING AND TRANSPLANTATION THERAPY FOR HIV INFECTION	:	

Applicants' "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 09 June 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.

E. M. Pender

Erin M. Pender
Attorney Advisor
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08 MAR 2005
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#7

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In re Application of :
POLLAND, Hans Joachim :
Application No.: 10/498,455 :
PCT No.: PCT/EP02/14258 :
Int. Filing Date: 13 December 2002 : **DECISION**
Priority Date: 14 December 2001 :
Attorney's Docket No.: P03100 :
For: IMPROVED SEQUENTIAL SCANNING :
WAVEFRONT MEASUREMENT AND :
RETINAL TOPOGRAPHY :

This decision is in response to applicant's "Response to Notification of Defective Response . . . " filed on 11 January 2005 which is treated as a petition under 37 CFR 1.182.

BACKGROUND

On 22 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(a) and (b) and a $130.00 surcharge fee was required.

On 15 November 2004, applicant filed a response which included, *inter alia*, an executed declaration and authorization to charge the $130.00 surcharge fee to Deposit Account No. 02-1425.

On 10 December 2004, the DO/EO/US mailed a Notification of a Defective Response (Form PCT/DO/EO/916) indicating that the declaration submitted on 15 November 2004 does not comply with 37 CFR 1.497(a) and (b) as the inventor's name is listed as Polland Hans-Joachim on the international publication while the declaration identifies the inventor as Hans-Joachim Polland.

On 11 January 2005, applicant submitted the instant response.

DISCUSSION

The inventor's name is listed as Hans Joachim Polland on the declaration filed 15 November 2004. However, the international publication ("WO 03/051187") recorded the name of the inventor as HANS-Joachim, Polland. Accordingly, this declaration does

not comply with 37 CFR 1.497(a)(3) in that it does not properly identify the inventor.

In the response, applicant claims that the declaration filed 15 November 2004 is proper as the inventor's family name is "Polland" and his given name is "Hans Joachim." Applicant admits that "the name was incorrectly given on the Request."

This is an adequate explanation for a grantable petition under 37 CFR 1.182. The $130.00 petition fee has been charged to Deposit Account No. 02-1425 as authorized.

CONCLUSION

Applicant's petition under 37 CFR 1.182 is **GRANTED**.

The declaration filed 15 November 2004 complies with 37 CFR 1.497(a) and (b).

Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 13 December 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 15 November 2004.

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

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20090414

DATE : April 14, 2009

TO SPE OF : ART UNIT 3742

SUBJECT : Request for Certificate of Correction on Patent No.: 7268321

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:

/TU B HOANG/
Supervisory Patent Examiner, Art Unit 3742

22 MAR 2005

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In re Application of	:	
SUKI, et al.	:	
PCT No.: PCT/JP02/12918	:	DECISION ON REQUEST
Application No.: 10/498,477	:	
Int. Filing Date: 10 December 2002	:	FOR FILING RECEIPT
Priority Date: 13 December 2001	:	
Atty. Docket No.: SATSUKI12	:	
For: COUMARIN COMPOUND	:	

This is a decision on applicant's "Second Request For Official Filing Receipt" filed on 17 March 2005 in the United States Patent and Trademark Office (USPTO).

On 10 December 2002, applicant filed international application PCT/JP02/12918 which claimed priority to an earlier Japanese application filed 13 December 2001. The deadline for payment of the full U.S. Basic National Fee expired on midnight, 13 June 2004.

On 14 June 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 English translation of the international application and an executed declaration of the inventors. 13 June 2004 being a Sunday, the National stage application was timely filed.

On 17 March 2005, applicant filed the present second request for official filing receipt.

A review of the application file finds that a "Notification of Acceptance" (Form PCT/DO/EO/903) was mailed on 11 March 2005. A courtesy copy is enclosed.

Applicant's request for official filing receipt is **GRANTED**.

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

Attachment: Form PCT/DO/EO/903

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. APPLICATION NUMBER NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
10/498,477	Makoto Satsuki	SATSUKI2

INTERNATIONAL APPLICATION NO.	
PCT/JP02/12918	
I.A. FILING DATE	PRIORITY DATE
12/10/2002	12/13/2001

001444
BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

CONFIRMATION NO. 6040

371 ACCEPTANCE LETTER

OC000000015423664

Date Mailed: 03/11/2005

NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C 371 AND 37 CFR 1.495

The applicant is hereby advised that the United States Patent and Trademark Office in its capacity as a Designated / Elected Office (37 CFR 1.495), has determined that the above identified international application has met the requirements of 35 U.S.C. 371, and is ACCEPTED for national patentability examination in the United States Patent and Trademark Office.

The United States Application Number assigned to the application is shown above and the relevant dates are:

06/14/2004	06/14/2004
DATE OF RECEIPT OF 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) REQUIREMENTS	DATE OF COMPLETION OF ALL 35 U.S.C. 371 REQUIREMENTS

A Filing Receipt (PTO-103X) will be issued for the present application in due course. **THE DATE APPEARING ON THE FILING RECEIPT AS THE " FILING DATE" IS THE DATE ON WHICH THE LAST OF THE 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4) REQUIREMENTS HAS BEEN RECEIVED IN THE OFFICE. THIS DATE IS SHOWN ABOVE.** *The filing date of the above identified application is the international filing date of the international application (Article 11(3) and 35 U.S.C. 363).* Once the Filing Receipt has been received, send all correspondence to the Group Art Unit designated thereon.

The following items have been received:

- Copy of the International Application filed on 06/14/2004
- Copy of the International Search Report filed on 06/14/2004
- Oath or Declaration filed on 06/14/2004
- Request for Immediate Examination filed on 06/14/2004
- U.S. Basic National Fees filed on 06/14/2004
- Priority Documents filed on 06/14/2004

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)

FREDERICK SMITH
Telephone: (703) 308-9140 EXT 210

PART 3 - OFFICE COPY

FORM PCT/DO/EO/903 (371 Acceptance Notice)

12 JUL 2005

#4

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Arent Fox Kintner Plotkin & Kahn
1050 Connecticut Avenue, N.W.
Suite 400
Washington, D.C. 20036

In re Application of :
SUCH et al. :
Application No.: 10/498,502 : DECISION ON PETITION
PCT No.: PCT/AU02/01735 : UNDER 37 CFR 1.181
Int. Filing Date: 20 December 2002 :
Priority Date: 21 December 2001 :
Attorney Docket No.: 100519-0005 :
For: AQUEOUS DISPERSIONS OF POLYMER PARTICLES

This decision is in response to applicants' "Petition to Withdraw the Holding of Abandonment" filed 24 June 2005. No petition fee is required.

BACKGROUND

On 20 December 2002, applicants filed international application PCT/AU02/01735, which claimed a priority date of 21 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 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, 21 June 2004.

On 18 June 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 copy of the international application; and a preliminary amendment.

On 28 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 one-month time limit in which to respond.

On 14 June 2005, applicants filed the present petition under 37 CFR 1.181.

DISCUSSION

Applicants state that the Notification of Missing Requirements under 35 U.S.C. 371 mailed 28 September 2004 was not received. With regards to applicants' 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 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).

Applicants have satisfied item (1),(2), and (3) above.

CONCLUSION

For the reasons above, the request is **GRANTED**. The holding of Abandonment is withdrawn.

This application is being returned to the DO/EO/US for processing in accordance with this decision, that is, for issuance of a new Notification of Missing Requirements (Form PCT/DO/EO/905), to inform applicant that an oath or declaration of the inventors in compliance with 37 CFR 1.497 must be submitted in order to avoid abandonment of the application.

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9 FEB 2006

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In re Application of
SUCH et al.
Application No.: 10/498,502
PCT No.: PCT/AU02/01735
Int. Filing Date: 20 December 2002
Priority Date: 21 December 2001
Attorney Docket No.: 100519-00005
For: AQUEOUS DISPERSIONS OF POLYMER PARTICLES

DECISION

This decision is in response to applicants' "Petition under 37 CFR 1.47(a)" filed 03 October 2005 to accept the application without the signature of the legal representative of the deceased joint-inventor, Robert John Hughes. Additionally, the declaration submitted on 03 October 2005 will be considered pursuant to 37 CFR 1.42.

BACKGROUND

On 20 December 2002, applicants filed international application PCT/AU02/01735, which claimed a priority date of 21 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 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, 21 June 2004.

On 18 June 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 copy of the international application; and a preliminary amendment.

On 28 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 one-month time limit in which to respond.

On 14 June 2005, applicants filed a petition under 37 CFR 1.181. In a Decision on Petition dated 12 July 2005, applicants' petition to withdraw the holding of abandonment was granted.

On 03 August 2005, 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 1.492(a) and (b).

On 03 October 2005, applicants filed the present petition.

DISCUSSION

Section 409.03(c) of the Manual of Patent Examining Procedure (MPEP) states, in part:

> "37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 U.S.C. 117 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. In re Application Papers Filed September 10, 1954, 108 USPQ 340 (Comm'r Pat. 1955). See 37 CFR 1.42 and MPEP § 409.01. However, 37 CFR 1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see MPEP § 409.03(e))."

Additionally, a petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17, (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1) and (3) have been satisfied.

Regarding item (1), applicant has only provided payment of $130.00 for the petition fee. Applicant is advised that pursuant to 37 CFR 1.17(g) the petition fee is $200.00. As authorized, the additional $70.00 due will be deducted from deposit account no.: 01-2300.

Regarding item (2) above, petitioner states that the legal representative has refused to sign the application. Section 409.03(d) of the MPEP, **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 applicants have not satisfied item (2) above, in that, the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to the legal representative. Michael James Caine states that various attempts have been made to contact the legal representative but the attempts have not yielded any response. However, no documentary evidence to support the refusal or the attempt has been supplied with the declaration.

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to the legal representative and when such papers were sent and that the legal representative has subsequently refused to execute the application. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

Regarding item (4) above, 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 filed declarations executed by five of the six inventors with the signature block of the nonsigning legal representative left blank. Additionally, applicants included a declaration where the signature block of the legal representative has been executed by one of the other joint inventors (Christopher Henry Such). Because applicants submitted a declaration specifically executed on behalf of the legal representative by one of the other joint inventors, the presumption that the other four inventors executed the declaration on their own behalf and on behalf of the legal representative cannot be applied to the present

declaration. Applicants must submit newly executed declarations executed by the cooperating inventors and containing unsigned signature blocks for the nonsigning legal representative. Such a declaration can than be treated as having been executed by the available inventors on their own behalf and on behalf of the nonsigning inventors. Until such declaration is submitted, item (4) is not satisfied.

Further, the declaration is not in compliance with 37 CFR 1.42 and 1.497(b)(2). 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.

Additionally, 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.

As stated above, the declaration must identify the legal representative's (executor, administrator, etc.) name, citizenship, and mailing address as well as the deceased inventor's name, citizenship and (last known) mailing address.

For the reasons stated above, it would not be appropriate to accept the application without the signature of legal representative under 37 CFR 1.47(a) at this time.

CONCLUSION

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

The petition under 37 CFR 1.42 is **REFUSED**.

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.

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18 APR 2006

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#9

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In re Application of
SUCH et al.
Application No.: 10/498,502
PCT No.: PCT/AU02/01735
Int. Filing Date: 20 December 2002
Priority Date: 21 December 2001
Attorney Docket No.: 100519-00005
For: AQUEOUS DISPERSIONS OF POLYMER PARTICLES

DECISION

This decision is issued in response to applicants' "Renewed Petition under 37 CFR 1.47(a)" filed 04 April 2006 to accept the application without the signature of the legal representative (Edna Olejnik) of the deceased joint-inventor, Robert John Hughes. Additionally, the declaration submitted on 04 April 2006 will be considered pursuant to 37 CFR 1.42.

BACKGROUND

On 20 December 2002, applicants filed international application PCT/AU02/01735, which claimed a priority date of 21 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 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, 21 June 2004.

On 18 June 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 copy of the international application; and a preliminary amendment.

On 28 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 14 June 2005, applicants filed a petition under 37 CFR 1.181. In a Decision on Petition dated 12 July 2005, applicants' petition to withdraw the holding of abandonment was granted.

On 03 August 2005, 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).

On 03 October 2005, applicants filed a petition under 37 CFR 1.47 and 37 CFR 1.42. In a decision dated 09 February 2006, applicants' petitions were dismissed without prejudice.

On 04 April 2006, applicants filed "Renewed Petition under 37 CFR 1.47(a)."

DISCUSSION

Section 409.03(c) of the Manual of Patent Examining Procedure (MPEP) states, in part:

> "37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 U.S.C. 117 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. In re Application Papers Filed September 10, 1954, 108 USPQ 340 (Comm'r Pat. 1955). See 37 CFR 1.42 and MPEP § 409.01. However, 37 CFR 1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see MPEP § 409.03(e))."

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

A review of the present petition and the accompanying papers reveal that applicants have satisfied item (2), in that the applicant has shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Edna Olejnik. The steps taken by Michael James Caine are sufficient to show that Edna Olejnik refuses to execute the application.

Regarding item (4) above, 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 has been submitted with the present petition. The declaration is in compliance with 37 CFR 1.497(a)- (b)(2) and 37 CFR 1.42.

Declaration of the Inventors under 37 CFR 1.42

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.

A review of the declaration filed reveals that Edna Olejnik the legal representative of deceased inventor, Robert John Hughes. The declaration lists the proper party under 37 CFR 1.42.

Accordingly, it is appropriate to accord the national stage application status under 37 CFR 1.47(a).

CONCLUSION

The petition under 37 CFR 1.47(a) is **GRANTED**.

The petition under 37 CFR 1.42 is **ACCEPTED**.

The application will be given an international filing date of 20 December 2002 under 35 U.S.C. 363, and a date of **04 April 2006** 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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04 MAY 2005

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In re Application of
RAJA (deceased)
Application No.: 10/498,543
PCT No.: PCT/IN01/00220
Int. Filing Date: 14 December 2001
Priority Date: None
Attorney Docket no.:US 1388/04
For: DUAL FREQUENCY NEMATIC LIQUID CRYSTAL DISPLAY

DECISION ON

PETITION

UNDER 37 CFR 1.42

This is a decision on a submission under 37 CFR 1.42 in the above referenced application, filed in the United States Patent and Trademark Office (USPTO) on 23 March 2005. Applicant also filed a petition for a three month extension of time, which is granted.

BACKGROUND

On 14 June 2004, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter were, *inter alia*, the requisite basic national fee. On 28 October 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) and the $65 surcharge for filing the oath or declaration after the thirty month period, was required.

On 23 March 2005, to satisfy the requirement that an oath or declaration of the inventors be furnished and in response to the Notification of Missing Requirements, applicant filed a declaration that was signed by two of the joint inventors and executed by Sujatha, as legal representative for first inventor Venkat Naga Raja, (deceased) and by Ila Chandrashekhar, as legal representative for third inventor, Shivaramakrishna Chandrashekhar (deceased). The submission was treated as a request for status under 37 CFR 1.42.

DISCUSSION

Pursuant to 37 CFR § 1.42, first sentence:

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

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal

representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

The declaration submitted on 23 March 2005 is executed by the co-inventors as identified in the published international application and indicates their respective citizenship, residency and mailing address. With respect to the deceased inventors, the declaration identifies legal representatives for both deceased inventors. However, the declaration does not identify the country of citizenship, residency and mailing address for both the legal representative and the deceased inventor and is unacceptable.

What is required is a declaration which clearly identifies all inventors, stating the country of citizenship, residency and mailing address for all inventors (including the deceased inventors) and identifying the legal representatives, stating their country of citizenship, residency and mailing address as required for compliance with 37 CFR 1.497(b). This declaration must be executed by the legal representatives on behalf of the deceased inventors. See also 37 CFR 1.64. Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **DISMISSED WITHOUT PREJUDICE.**

If reconsideration of the merits of the request for status under 37 CFR 1.42 is desired, applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 37 CFR 1.42 and 1.497 within TWO (2) MONTHS from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

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

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30 JUN 2005

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DINESH AGARWAL, P.C.
5350 SHAWNEE ROAD
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In re Application of
RAJA (deceased)
Application No.: 10/498,543
PCT No.: PCT/IN01/00220
Int. Filing Date: 14 December 2001
Priority Date: None
Attorney Docket no.:US 1388/04
For: DUAL FREQUENCY NEMATIC LIQUID CRYSTAL DISPLAY

DECISION ON

RENEWED PETITION

UNDER 37 CFR 1.42

This is a decision on a renewed submission under 37 CFR 1.42 in the above referenced application, filed in the United States Patent and Trademark Office (USPTO) on 28 June 2005.

BACKGROUND

On 14 June 2004, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter were, *inter alia*, the requisite basic national fee. On 28 October 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) and the $65 surcharge for filing the oath or declaration after the thirty month period, was required.

On 23 March 2005, to satisfy the requirement that an oath or declaration of the inventors be furnished and in response to the Notification of Missing Requirements, applicant filed a declaration that was signed by two of the joint inventors and executed by Sujatha, as legal representative for first inventor Venkat Naga Raja, (deceased) and by Ila Chandrashekhar, as legal representative for third inventor, Shivaramakrishna Chandrashekhar (deceased). The submission was treated as a request for status under 37 CFR 1.42.

On 04 May 2005, a decision dismissing the request for status under 37 CFR 1.42 was mailed indicating that the declaration did not identify the country of citizenship, residency and mailing address for both the legal representative and the deceased inventor and was unacceptable.

On 28 June 2005, applicant submitted a newly executed declaration.

DISCUSSION

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal

representative and indicate the citizenship, residency and mailing address of the legal representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

The declaration submitted on 28 June 2005 is executed by the co-inventors as identified in the published international application and indicates their respective citizenship, residency and mailing address. With respect to the deceased inventors, the declaration identifies legal representatives for both deceased inventors and identifies the country of citizenship, residency and mailing address for both the legal representative and the deceased inventor and is acceptable.

The declaration filed on 28 June 2005 is in compliance with 37 CFR 1.497(a) and (b) and is acceptable. Accordingly, it is appropriate, at this time, to accord the application status under 37 CFR 1.42.

CONCLUSION

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

The application will be forwarded to the United States Designated/Elected Office for further processing in accordance with this decision. 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

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ELMORE PATENT
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SEP 25 2008

OFFICE OF PETITIONS

In re Patent No.: 7,230,019 :
Issue Date: 12 June, 2007 :
Application No. 10/498,548 : DECISION
Filing/ §371(c) Date: 14 June, 2004 :
Attorney Docket No. 4040.3000 US (PAT 613W-2) :

This is a decision on the petition filed on 1 November, 2007, with a request to waiver regulatory provisions under 37 C.F.R. §1.183, to enable the alteration and correction of the inventive entity under the provisions of 37 C.F.R. §1.324,

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.

The petition under 37 C.F.R. §1.183 is **DISMISSED**; and the petition pursuant to 37 C.F.R. §1.324 is **DISMISSED**.

The conditions for a petition pursuant to 37 C.F.R. §1.324 are set forth in the regulation, to wit:

> **§1.324 Correction of inventorship in patent, pursuant to 35 U.S.C. §256.**
>
> (a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Director, pursuant to 35 U.S.C. 256, may, on application of all the parties and assignees, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under §41.121(a)(2) or §41.121(a)(3) of this title.

(b) Any request to correct inventorship of a patent pursuant to paragraph (a) of this section must be accompanied by:

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;

(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of §3.73(b) of this chapter; and

(4) The fee set forth in §1.20(b).

(c) For correction of inventorship in an application, see §§1.48 and 1.497.

(d) In a contested case before the Board of Patent Appeals and Interferences under part 41, subpart D, of this title, a request for correction of a patent must be in the form of a motion under §41.121(a)(2) or §41.121(a)(3) of this title.

Guidance in this matter is set forth at MPEP §1481.02, which provides in pertinent part:

1481.02Correction of Inventors' Names[R-3]

35 U.S.C. §256. Correction of named inventor.

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly.

In requesting the Office to effectuate a court order correcting inventorship in a patent pursuant to 35 U.S.C. §256, a copy of the court order and a Certificate of Correction under 37 C.F.R. §1.323 should be submitted to the Certificates of Corrections Branch.

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The petition to correct inventorship under 37 C.F.R. 1. §324 must include the statements and fee required by 37 C.F.R. §1.324(b).

Under 37 C.F.R. §1.324(b)(1), a statement is required from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on their part. In order to satisfy this, a statement such as the following is sufficient:

> "The inventorship error of failing to include John Smith as an inventor of the patent occurred without any deceptive intention on the part of John Smith."

***

Under 37 C.F.R. §1.324(b)(2), all current inventors who did not submit a statement under 37 C.F.R. §1.324(b)(1) must submit a statement either agreeing to the change of inventorship, or stating that they have no disagreement with regard to the requested change. "Current inventors" include the inventor(s) being retained as such and the inventor(s) to be deleted. These current inventors need not make a statement as to whether the inventorship error occurred without deceptive intention.

If an inventor is not available, or refuses, to submit a statement, the assignee of the patent may wish to consider filing a reissue application to correct inventorship, since the inventor's statement is not required for a non-broadening reissue application to correct inventorship. See MPEP §1412.04.

Under 37 C.F.R. §1.324(b)(3), a statement is required from the assignee(s) of the patent agreeing to the change of inventorship in the patent. The assignee statement agreeing to the change of inventorship must be accompanied by a proper statement under 37 C.F.R. §3.73(b) establishing ownership, unless a proper 37 C.F.R. §3.73(b) statement is already in the file. See MPEP § 324 as to the requirements of a statement under 37 C.F.R. §3.73(b).

While a request under 37 C.F.R. §1.48 is appropriate to correct inventorship in a nonprovisional *application*, a petition under 37 C.F.R. §1.324 is the appropriate vehicle to correct inventorship in a *patent*. If a request under 37 C.F.R. §1.48(a), (b), or (c) is inadvertently filed in a patent, the request may be treated as a petition under 37 C.F.R. §1.324 *** .

Similarly, if a request under 37 C.F.R. §1.48(a), (b), or (c) is filed in a pending application but not acted upon until after the application becomes a patent, the request may be treated as a petition under 37 C.F.R. §1.324, and if it is grantable, form paragraph 10.14 set forth below should be used.

The statutory basis for correction of inventorship in a patent under 37 C.F.R. §1.324 is 35 U.S.C. §256. It is important to recognize that 35 U.S.C. §256 is stricter than 35 U.S.C. §116, the statutory basis for corrections of inventorship in applications under 37 C.F.R. §1.48. 35 U.S.C. §256 requires "on application of all the parties and assignees," while 35 U.S.C. §116 does not have the same requirement. Under 35 U.S.C. §116 and 37 C.F.R. §1.48, waiver requests under 37 C.F.R. §1.183 may be submitted (see, e.g., MPEP §201.03, under the heading "Statement of Lack of Deceptive Intention"). This is not possible under 35 U.S.C. §256 and 37 C.F.R. §1.324. In correction of inventorship in a nonprovisional application under 37 C.F.R. §1.48(a), the requirement for a statement by each originally named inventor may be waived pursuant to 37 C.F.R. §1.183; however, correction of inventorship in a patent under 37 C.F.R. §1.324 requires petition of all the parties, i.e., originally named inventors and assignees, in accordance with statute (35 U.S.C. §256) and thus the requirement cannot be waived.

***

BACKGROUND

The record reflects that:

Application No. 10/498,548 issued as Patent No. 7,230,019 on 12 June, 2007.

Thereafter, on 1 November, 2007, Petitioner filed the instant petitions, seeking waiver under the provisions of under 37 C.F.R. §1.183, to enable the alteration and correction of the inventive entity under the provisions of 37 C.F.R. §1.324,

As is evident from the foregoing discussion, the statutory grant of authority under 35 U.S.C. §256 is more strict than that at 35 U.S.C. §116, and 35 U.S.C. §256 requires "application of all the parties and assignees" while 35 U.S.C. §116 does not have the same requirement.

Thus, the waiver sought under 37 C.F.R. §1.183 is inapplicable. Moreover, Petitioner has failed to comply with the statutory and regulatory requirements of relief sought by "all the parties and assignees" for correction under 35 U.S.C. §256 and 37 C.F.R. §1.324.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

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

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.

CONCLUSION

The petition under 37 C.F.R. §1.183 is **dismissed as moot**; and the petition pursuant to 37 C.F.R. §1.324 is **dismissed**.

The application file is being released to IFW Files Repository.

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[2]) 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

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[2] 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.

06 JUN 2006

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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Buchanan Ingersoll PC
(Including Burns, Doane, Swecker & Mathis)
Post Office Box 1404
Alexandria, VA 22313-1404

In re Application of
DREVIK et al.
Application No.: 10/498,562
PCT No.: PCT/SE02/02259
Int. Filing Date: 09 December 2002
Priority Date: 18 December 2001
Attorney Docket No.: 000515-351
For: ABSORBENT ARTICLE AND METHOD OF PRODUCTION OF AN ABSORBENT ARTICLE

DECISION ON PETITION

This decision is issued in response to applicants' "Request to Withdraw Holding of Abandonment and Request for Official Filing Receipt" filed 17 February 2006 and "Request for Corrected Official Filing Receipt" filed 20 March 2006.

The petition filed 17 February 2006 is accompanied by a copy of the declaration filed on 23 December 2004 in the United States Patent and Trademark Office and requests, in effect, that the copy of the declaration is accepted as a true copy of the declaration filed 23 December 2004. Additionally, applicants have presented a stamped postcard showing receipt of the declaration on 23 December 2004.

A review of the application file reveals that a declaration in compliance with 37 CFR 1.497 was received in the United States Patent and Trademark Office on 23 December 2004. Accordingly, applicants' request that the copy of the declaration filed with the petition is accepted as a copy of the original declaration filed 23 December 2004 is dismissed as moot, since the original declaration has been located and placed in the application file.

In view of the declaration filed 23 December 2004, the communication indicating that the application was abandoned is hereby **VACATED**. The application has an international filing date of 09 December 2002 under 35 U.S.C. 363 and a 35 U.S.C. 371(c) date of **23 December 2004.**

The Notice of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495 dated 01 March 2006 remains in effect.

This application is being returned to the United States/Elected Office for processing in accordance with this decision and to issue a corrected filing receipt indicating that Anette Gustavsson is the second inventor.

Anthony Smith

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

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OFFICE OF PETITIONS

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

In re Application of :
Kim Slaney et al. :
Application No. 10/498,571 : DECISION ON PETITION
Filed: June 14, 2004 : PURSUANT TO
Attorney Docket No.: MERCK-2882 : 37 C.F.R. § 1.181(A)
Title: BIAXIAL FILM :

This is a decision on the petition filed January 11, 2008, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

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

BACKGROUND

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed August 31, 2007, 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 December 1, 2007. A Notice of Abandonment was mailed on January 2, 2008.

1 See MPEP § 710.02(e).

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

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

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

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

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

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

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

docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. 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, and that a search of the practitioner's records, including the file jacket and docket records, indicated that the Office action was not received. Moreover, a copy of the master docket used by the practitioner where the non-received Notice of Allowance and Issue Fee Due would have been entered had it been received has been included.

However, **it does not appear that Petitioner has provided a statement describing the system used for recording an Office action received at the correspondence address of record with the**

USPTO, and further establishing that the docketing system is sufficiently reliable.

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.

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

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2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
3 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
4 (571) 273-8300- please note this is a central facsimile number.
5 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html
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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ARLINGTON VA 22201

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OFFICE OF PETITIONS

In re Application of	:	
Kim Slaney et al.	:	
Application No. 10/498,571	:	DECISION ON RENEWED PETITION
Filed: June 14, 2004	:	PURSUANT TO
Attorney Docket No.: MERCK-2882	:	37 C.F.R. § 1.181(A)
Title: BIAXIAL FILM	:	
	:	
	:	

This is a decision on the renewed petition filed August 19, 2008, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

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

BACKGROUND AND PROCEDURAL HISTORY

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 August 31, 2007, 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 December 1, 2007. A Notice of Abandonment was mailed on January 2, 2008.

1 See MPEP § 710.02(e).

An original petition pursuant to 37 C.F.R. § 1.181(a) was filed on January 11, 2008, and was dismissed via the mailing of a decision 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, and that a search of the practitioner's records, including the file jacket and docket records, indicated that the Office action was not received. Moreover, a copy of the master docket used by the

> practitioner where the non-received Notice of Allowance and Issue Fee Due would have been entered had it been received has been included.
>
> However, **it does not appear that Petitioner has provided a statement describing the system used for recording an Office action received at the correspondence address of record with the USPTO, and further establishing that the docketing system is sufficiently reliable** (emphasis included).

With this renewed petition, Petitioner has provided a statement describing the system used for recording an Office action received at the correspondence address of record with the USPTO, and has established that the docketing system is sufficiently reliable.

CONCLUSION

Petitioner has established that the Notice of Allowance and Issue Fee Due of August 31, 2007 was not received.

The Technology Center will be notified of this decision. The Technology Center's support staff will **re-mail the Notice of Allowance and Issue Fee Due of August 31, 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 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]. All other inquiries concerning examination procedures should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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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 of Petitioner's further action(s).

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9710 SCRANTON ROAD, SUITE S-170
SAN DIEGO CA 92121

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OFFICE OF PETITIONS

In re Application of :
Panayiotis P. CONSTANTINIDES et al. :
Application No. 10/498,572 : DECISION ON PETITION
Filed: May 27, 2005 :
Attorney Docket No. **8105-014-WO-US** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 15, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Restriction Requirement, mailed November 25, 2008 which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on December 27, 2008.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an election previously submitted January 26, 2009 (2) the petition fee of $810.00 and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the restriction requirement of November 25, 2008 has been accepted as having been unintentionally delayed.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. *See* In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $65.00 extension of time fee submitted with the petition on July 15, 2009 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 the undersigned at (571) 272-4231.

The application is being referred to the Technology Center AU 1619 for appropriate action on the concurrently filed election.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

24 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

Konstantine J. Diamond
4010 East 26th Street
Los Angeles, California 90023

In re Application of	:
HASSELL., Jon	:
Application No.: 10/498,602	:
PCT No.: PCT/US02/38767	: DECISION ON PETITION
Int. Filing Date: 05 December 2002	: UNDER 37 CFR 1.137(b)
Priority Date: 06 December 2001	:
Docket No.: 1038 PUSA	:
For: TRASH CART	

The petition to revive under 37 CFR 1.137(b) filed 09 June 2004 in the above-captioned application is hereby **GRANTED** as follows:

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

A review of the application file reveals that applicant has submitted the basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

Deposit Account No. 50-1984 will be charged a $130.00 surcharge fee under 37 CFR 492(e) for supplying an oath or declaration later than 30 months from the earliest claimed priority date.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

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FINA TECHNOLOGY INC
PO BOX 674412
HOUSTON TX 77267-4412

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JUL 0 6 2006

OFFICE OF PETITIONS

In re Application of :
Demain : DECISION ON PETITION
Application No. 10/498,620 :
Filed: January 31, 2005 :
Atty. Dkt. No.: F-838 :
(31223/00053) :

This decision is in response to the petition to withdraw the holding of abandonment under 37 CFR 1.181 filed May 22, 2006.

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is hereby **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." This is not a final agency decision.

This application was became abandoned December 15, 2005 for failure to timely submit a proper reply to the Restriction Requirement mailed November 14, 2005. The Restriction Requirement set a one month shortened statutory period of time for reply. No petition for extension of time was timely requested. This decision precedes Notice of Abandonment.

Petitioner argues that a response to the Restriction Requirement is believed to have been submitted on December 14, 2005. Petitioner has provided no supporting documentation of an actual submission. The copy of the response believed to have been submitted on December 14, 2005 fails to comply with the requirements of 37 CFR 1.8, thus, it cannot be given the benefit of a certificate of mailing. Petitioner has failed to submit a date stamped return postcard evidencing Office receipt of the response believed to have been submitted December 14, 2005.

Petitioner's docket report, copy of which was provided herewith, does not sufficiently support the argument that the response was

submitted December 14, 2005 as the docket report does not state that a response was actually submitted.

Even assuming arguendo that the docket report did indicate that a response was submitted December 14, 2005, petitioner has nonetheless failed to comply with the certificate of mailing requirements of 37 CFR 1.8.

The remarks set forth by petitioner rely upon practitioner's recall of routine events is not more persuasive than the record of what was filed as shown in the official file. Accordingly, the fact that counsel believes a response was filed is not more persuasive than the actual papers shown to have been received by the official file.

In view thereof, petitioner has failed to establish that a response to the Restriction Requirement was timely filed.

ALTERNATE VENUE

Petitioner is strongly urged to consider filing a petition stating that the delay was unintentional. Petitioner's attention is directed to 37 CFR 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable". An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee and reply.

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 delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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

By mail:

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

By facsimile: (571) 273-8300

By hand delivery: U.S. Patent and Trademark Office
Customer Window, **Mail Stop Petition**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

There is no indication that petitioner herein was ever empowered to prosecute the instant application. If petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision will be mailed to petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

CC: WILLIAM D. JACKSON
Schultz & Associates, P.C.
One Lincoln Centre
5400 LBJ Freeway, Suite 1200
Dallas, Texas 75240

UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 0 8 2007

OFFICE OF PETITIONS

FINA TECHNOLOGY INC
PO BOX 674412
HOUSTON TX 77267-4412

In re Application of :
Demain : DECISION ON PETITION
Application No. 10/498,620 :
Filed: January 31, 2005 :
Atty. Dkt. No.: F-838 :
(31223/00053) :

This decision is in response to the renewed petition to withdraw the holding of abandonment under 37 CFR 1.181 filed September 11, 2006.

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is hereby **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." This is not a final agency decision.

This application was became abandoned December 15, 2005 for failure to timely submit a proper reply to the Restriction Requirement mailed November 14, 2005. The Restriction Requirement set a one month shortened statutory period of time for reply. No petition for extension of time was timely requested. Notice of Abandonment was mailed July 21, 2006.

Petitioner continues to argue that a response to the Restriction Requirement is believed to have been submitted on December 14, 2005. Petitioner's evidence of said submission has been considered, but is not found convincing. The copy of the response believed to have been submitted on December 14, 2005 fails to comply with the requirements of 37 CFR 1.8, thus, it cannot be given the benefit of a certificate of mailing. Petitioner has not provided a copy of a date stamped return postcard evidencing Office receipt of a timely response.

Even assuming arguendo that petitioner's docket report does set forth the mailing of a response or the receipt of a date stamped

post card, absent a copy of a date stamped return postcard or a copy of a response bearing a proper certificate of mailing in accordance with 37 CFR 1.8 to substantiate petitioner's arguments, it cannot be found that a response was in fact timely submitted to the Office.

ALTERNATE VENUE

Petitioner is strongly urged to consider filing a petition stating that the delay was unintentional. Petitioner's attention is directed to 37 CFR 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable". An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee and reply.

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 delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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

By mail:	**Mail Stop Petition** Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
By facsimile:	(571) 273-8300
By hand delivery:	U.S. Patent and Trademark Office Customer Window, **Mail Stop Petition** Randolph Building 401 Dulany Street Alexandria, VA 22314

The previous designation of Customer Number 25264 prevents entering William D. Jackson as counsel of record. *See*, MPEP 403. Accordingly, the requested power of attorney for William D. Jackson

will not be entered as it does not appear that practitioner has been properly appointed. If practitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted. No further courtesy copies will be mailed to practitioner as all future correspondence will be directed to the correspondence address of record until such time as appropriate instructions are received to the contrary.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

CC: WILLIAM D. JACKSON
Schultz & Associates, P.C.
One Lincoln Centre
5400 LBJ Freeway, Suite 1200
Dallas, Texas 75240

UNITED STATES PATENT AND TRADEMARK OFFICE

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JUN 21 2007

OFFICE OF PETITIONS

FINA TECHNOLOGY INC
PO BOX 674412
HOUSTON TX 77267-4412

In re Application of
Demain
Application No. 10/498,620
Filed: January 31, 2005
Dkt. No.: F-838 (31223/00053)

: DECISION ON PETITION

This is a decision on the petition renewed under 37 C.F.R. § 1.137(b), filed March 12, 2007, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned December 15, 2005 for failure to timely reply to the Office action mailed November 14, 2005. The Office action set a one month shortened statutory period of time for reply. No extensions of time in accordance with 37 C.F.R. § 1.136 were timely requested. Notice of Abandonment was mailed July 21, 2006.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition has been reviewed and found in compliance with the provisions of 37 C.F.R. § 1.137(b). Accordingly, the failure to timely submit a proper reply to the Office communication is accepted as having been unintentionally delayed.

This application is being forwarded to Technology Center 1700 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
600 GALLERIA PARKWAY, S.E.
STE 1500
ATLANTA, GA 30339-5994

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JAN 14 2009

OFFICE OF PETITIONS

In re Application of :
Frank Emmrich, et al. :
Application No. 10/498,633 :
Filed: December 20, 2004 :
Attorney Docket No. 220202-1010 :

ON PETITION

This is a decision in response to the petition under 37 CFR 1.137(b), filed October 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 December 21, 2007. A Notice of Abandonment was mailed on March 21, 2008, 2008. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2).

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) , including the fee of $405 and the submission required by 37 CFR 1.114; (2) the petition fee of $810; and (3) an adequate statement of unintentional delay.

This application is being referred to Technology Center AU 1644 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.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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11 FEB 2008

Joseph S. Tripoli
THOMSON LICENSING INC.
Patent Dept.
PO Box 5312
Princeton, NJ 08543-5312

In re Application of :
RICHARDSON, John William :
U.S. Application No.: 10/498,635 :
PCT No.: PCT/US2002/039505 :
Int. Filing Date: 11 December 2002 :
Priority Date: 15 December 2001 :
Attorney Docket No.: PU010305 :
For: VIDEO CONFERENCING BANDWIDTH SELECTION MECHANISM :

DECISION ON PETITION UNDER 37 CFR 1.137(b)

Applicant's petition to revive under 37 CFR 1.137(b) filed on 14 December 2007 is hereby **GRANTED** as follows:

The basic national fee and petition fee have been paid. Applicant makes the required statement pursuant to 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 in compliance with 37 CFR 1.497(a) and (b) was provided with the petition.

This application is being forwarded to the Office of Patent Application Processing for further processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

17 NOV 2004

#5

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Kam W. Li
Procopio, Cory, Hargreaves & Savitch LLP
530 B Street, Suite 2100
San Diego, CA 92101

In re Application of BAI	:	
U.S. Application No.: 10/498,678	:	
PCT Application No.: PCT/CN02/00885	:	
Int. Filing Date: 11 December 2002	:	DECISION
Priority Date Claimed: 11 December 2001	:	
Attorney Docket No.: 111730-03	:	
For: ADJUSTABLE-SPEED LIFE-SAVING APPARATUS	:	

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 18 October 2004.

BACKGROUND

On 11 December 2002, applicant filed international application PCT/CN02/00885, which claimed priority of an earlier China application filed 11 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 19 June 2003. The thirty-month period for paying the basic national fee in the United States expired on 11 June 2004.

On 10 June 2004, applicant filed purported national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was not accompanied by the basic national fee required by 35 U.S.C. 371(c)(1).

On 24 September 2004, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909), which indicated that the present application became abandoned as to the United States for failure to timely pay the basic national fee.

On 18 October 2004, applicant filed the present petition under 37 CFR 1.137(b).

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

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

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 11 December 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 18 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

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Commissioner for Patents
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JUN 23 2009

OFFICE OF PETITIONS

KRATZ, QUINTOS & HANSON, LLP
1420 K Street, N.W.
Suite 400
WASHINGTON, DC 20005

In re Application of
Ana Teresa Marcos Rodriguez, et al.
Application No. 10/498,682
Filed: December 17, 2004
Attorney Docket No. U 015247-5

ON PETITION

This is a decision in response to the petition, filed February 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 failure to reply in a timely manner to the non-final Office action mailed January 24, 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 April 25, 2008. A Notice of Abandonment was mailed on August 15, 2008. On February 27, 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.

This application is being referred to Technology Center AU 1657 for appropriate action by the Examiner in the normal course of business on the reply received February 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

18 APR 2005

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Russ R. Stolle
Legal Department
Huntsman LLC
P.O. Box 15730
Austin, Texas 78752

In re Application of	:	
CLEAVER et al.	:	
Application No.: 10/498,692	:	
PCT No.: PCT/GB02/05652	:	DECISION ON PETITION
Int. Filing Date: 13 December 2002	:	UNDER 37 CFR 1.47(a)
Priority Date: 14 December 2001	:	
Attorney Docket No.: HAM T830001	:	
For: METHOD OF MAKING MODELS	:	

This is a decision on applicants' "Petition for filing under 37 CFR 1.47(a)" filed 15 March 2005 to accept the application without the signature of joint-inventors, Didier Arnoux. The required petition fee of $200.00 has been submitted.

BACKGROUND

On 13 December 2002, applicants filed international application PCT/GB02/05652 which claimed a priority date of 14 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, 14 June 2004.

On 14 June 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 18 January 2005, 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 15 March 2005, applicants filed a petition under 37 CFR 1.47(a) on behalf of Didier Arnoux.

DISCUSSION

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

1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the nonsigning joint inventor. Items (1), (3) and(4) have been satisfied.

A review of the present petition and the accompanying papers reveal that applicants have satisfied item (2), in that the applicants have shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Didier Arnoux. The steps taken by Britt Van Essche are sufficient to show that Didier Arnoux 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**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

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

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith

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

18 APR 2005

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

Mr. Didier Arnoux
81 avenue de St Maude
75012 Paris
France

In re Application of
CLEAVER et al.
Application No.: 10/498,692
PCT No.: PCT/GB02/05652
Int. Filing Date: 13 December 2002
Priority Date: 14 December 2001
Attorney Docket No.: HAM T830001
For: METHOD OF MAKING MODELS

Dear Mr. Arnoux:

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

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

Counsel of Record:
Russ R. Stolle
Legal Department
Huntsman LLC
P.O. Box 15730
Austin, Texas 78752

24 JAN 2005

UNITED STATES PATENT and TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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Lynn E. Cargill
56 Macomb Place
Mt. Clemens, MI 48043-5636

In re Application of	:	
Swiatek	:	
Application No.: 10/498,705	:	
PCT No.: PCT/US03/00318	:	
Int. Filing Date: 06 January 2003	:	
Priority Date: 04 January 2002	:	RESPONSE
Attorney's Docket No.: Swiatek P-301	:	
For: VEHICLE ACCESORY POWER CONNECTOR	:	

This is in response to applicant's request to refund $20, filed 26 October 2004. Applicant urges that the national stage fee was $365 for a small entity, not $385 as charged.

BACKGROUND

On 06 January 2003, applicants filed international application PCT/US03/00318 which claimed priority to United States applications, the earliest of which was filed 04 January 2002. A copy of the international application was communicated from the International Bureau on 17 July 2003. Accordingly, the thirty-month period for paying the basic national fee in the national stage in the United States expires at midnight on 04 July 2004.

On 14 June 2004, applicant filed a transmittal letter including, *inter alia*, including the basic national fee of $50, authorization to charge applicant's deposit account #03-0682 any additional fees that were due. These papers were assigned U.S. application number 10/498,705.

On 22 September 2004, the United States Patent and Trademark Office charged applicant's deposit account an additional $335 for payment of the basic national fee.

On 26 October 2004, the current request for refund was filed.

DISCUSSION

A review of the application indicates that applicant included $50. Further, applicant included the authorization to charge the deposit account to cover any unpaid fees. At the time the application was filed, the national stage filing fee for an application for a small entity that was searched in the United States Patent and Trademark Office, but which did not receive a favorable International Preliminary Examination Report, was $365. Therefore, applicant's deposit account should have been charged an additional $315. Instead, applicant's deposit account was charged $335. Applicant is entitled to a refund of $20.

CONCLUSION

For the above reasons, the request for refund is **GRANTED**.

Applicant's **Deposit Account #03-0682** has been refunded **$20**.

Debra S. Brittingham
PCT Special Programs Examiner
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

DSB/BM:dsb
Telephone: (571) 272-3280
Facsimile: (571) 273-0419

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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WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP
BRADFORD GREEN, BUILDING 5
755 MAIN STREET, P O BOX 224
MONROE, CT 06468

Mail Date: 04/22/2010

Applicant	: Koushik Maharatna	: DECISION ON REQUEST FOR
Patent Number	: 7606852	: RECALCULATION of PATENT
Issue Date	: 10/20/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/498,707	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 05/19/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1095** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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P.O. Box 980
Valley Forge, PA 19482

In re Application of	:	
Green et al	:	DECISION ON
PCT No.: PCT/US02/39685	:	
Application No: 10/498,711	:	
Int. Filing Date: 11 December 2002	:	PETITION UNDER
Priority Date: 14 December 2001	:	
Attorney's Docket No.: ITC-325US	:	
For: FLEXIBLE TEST HEAD INTERNAL INTERFACE	:	37 CFR 1.47(a)
	:	

This is in response to the "PETITION BY JOINT INVENTORS FILING ON BEHALF OF OTHER JOINT INVENYOR WHO REFUSES TO JOIN IN APPLICATION OR CANNOT BE REACH (37 CFR 1.47(a)" filed on 08 December 2004.

BACKGROUND

On 11 December 20002, applicants filed international application PCT/US02/39685, which claimed priority of an earlier application filed 14 December 2001.

On 14 June 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.

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 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 08 December 2004 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 Charles Spear.

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.

REFUSAL TO JOIN:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if

the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

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

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

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

Petitioner has satisfied requirements (1), (3) and (4) under 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

Regarding requirement (1), petitioner's Deposit Account No.: 18-0350 has been charged the petition fee of $130.00 under 37 CFR 1.17(h) as indicated by the communication on 08 December 2004.

Regarding requirement (2), it is unclear which standard under 1.47(a) petitioner asserts in the petition for filing on behalf of the non-signing inventor. The petition states that Charles Spear cannot be found after diligent effort. However, the averments of Lawrence E. Ashery appears to show actions of refusal by Mr. Spear since Mr. Ashery has not received a response to the letters sent to the non-signing inventor. The petition will be analysis under both standards but petitioner needs to state which standard applies under this circumstance.

I. INVENTOR CANNOT BE REACHED:

The averments of Lawrence E. Ashery are insufficient to support a finding that the nonsigning inventor, Mr. Charles Spear could not be found after diligent effort because Mr. Ashery's declaration fails to show diligent effort to locate inventor Spear. Mr. Ashery has not shown that he has searched for the above non-signing inventor's new address by using a broad search in the internet and in a telephone directory, which would show diligent effort by Mr. Spear to find the nonsigning inventor since Mr. Ashery currently appears to have limited his search to Mr. Spear's last know address.

II. REFUSAL TO JOIN:

In addition, in this case it has not been sufficiently demonstrated that a copy of the application papers were presented to the non-signing inventor, Charles Spear.
Petitioner states that the letter was sent to Charles Spear on July 2, 2004 and again on October 8, 2004 but no response has been received. The letter forwarded to him, however, did not appear to include a copy of the complete application papers (specification, including claims, drawings, and oath or declaration) as required under MPEP 409.03(d) since only the declaration and assignment were mentioned as being sent to Spear's last known addresses.

Consequently, at this time it can not be concluded that the nonsigning Mr. Spear could not be found after diligent effort or refuses to sign the required documents.

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

Accordingly, since item (2) under 37 CFR 1.47(a) has not been met it is not appropriate to accord the national stage application status at this time.

CONCLUSION

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

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

Any further correspondence with respect to this matter should be addressed to the 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

Leonard Smith
PCT Legal Examiner
PCT Legal Office

31 MAY 2005

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In re Application of	:	
Green et al	:	DECISION ON
PCT No.: PCT/US02/39685	:	
Application No: 10/498,711	:	
Int. Filing Date: 11 December 2002	:	PETITION UNDER
Priority Date: 14 December 2001	:	
Attorney's Docket No.: ITC-325US	:	
For: FLEXIBLE TEST HEAD INTERNAL INTERFACE	:	37 CFR 1.47(a)
	:	

This decision is in response to applicant's " RENEWED PETITION UNDER 37 CFR 1.47(a) AND THE SUPPLEMENTAL TO THE RENEWED PETITION" filed on 25 April 2005 and May 23, 2005 respectively in response to a decision by this Office dated 24 February 2005.

BACKGROUND

The decision by this Office dated 24 February 2005 indicated that requirement (2) under 37 CFR 1.47(a) had not been satisfied.

On 25 April 2005, petitioner submitted a "Renewed Petition Under 37 CFR 1.47(a)" requesting reconsideration of the Office's decision of 24 February 2005 with respect to accepting the above application without the signature of nonsigning inventor Mr. Spear.

On 23 May 2005, petitioner filed this supplemental renewed petition accompanied, inter alia, an executed declaration by Charles Spear.

DISCUSSION

The renewed petition states subsequent to the date of the Decision and the renewed petition, Charles Spear, executed the declaration. The declaration is now signed by all the inventors.

Accordingly, the declaration submitted on 23 May 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 **23 May 2005**

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
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02 NOV 2005

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E. Russell Tarleton
Seed Intellectual Property Law Group, PLLC
701 5th Avenue, Suite 6300
Seattle, WA 98104-7092

In re Application of
RANA
Application No.: 10/498,727
PCT No.: PCT/SG01/00253
Int. Filing Date: 14 December 2001
Priority Date: None
Attorney Docket No.: 851663.471USPC
For: TRANSIENT VOLTAGE CLAMPING CIRCUIT

DECISION ON PAPERS

UNDER 37 CFR 1.42

This application is before the Office of PCT Legal Administration for issues arising under 35 U.S.C. 371. The combined declaration and power of attorney filed 23 August 2005 is being treated as a request for status under 37 CFR 1.42. No petition fee is due.

BACKGROUND

On 14 December 2001, applicant filed international application PCT/SG01/00253. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 26 June 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 14 June 2004.

On 14 June 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); a First Preliminary amendment; an application data sheet and substitute specification.

On 24 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 inventor 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 23 August 2005, applicant filed the response including an executed combined declaration and power of attorney accompanied by a petition for a five-month extension of time and payment of the appropriate petition fee. With the filing of the petition for a five-month extension of time and payment of the petition fee, the present response is considered timely filed.

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 23 August 2005 was executed by Swarnali Rana as executor of the estate of the deceased inventor, Sakti Pada Rana. However, the filed declaration does not satisfy the requirements under 37 CFR 1.497(b). Specifically, the oath or declaration must provide the citizenship, residence, and mailing address of both the deceased inventor and the signing legal representative, as well as, state the relationship of the signing individual to the non-signing inventor. While the declaration does state that Swarnali Rana is the Legal Representative to the estate of the deceased inventor, the declaration and accompanying application data sheet filed on 23 August 2005 only provides the residence, citizenship, and post office address for Swarnali Rana. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b).

CONCLUSION

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

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

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

Derek A. Putonen
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Seattle, WA 98104-7092

In re Application of
RANA
Application No.: 10/498,727
PCT No.: PCT/SG01/00253
Int. Filing Date: 14 December 2001
Priority Date: None
Attorney Docket No.: 851663.471USPC
For: TRANSIENT VOLTAGE CLAMPING CIRCUIT

DECISION ON RENEWED PETITION UNDER 37 CFR 1.42

This decision is in response to applicant's "Renewed Petition Under 37 C.F.R. 1.42" filed 23 January 2006.

BACKGROUND

On 22 November 2005, applicant was mailed a decision dismissing applicant's renewed request for status under 37 CFR 1.42. Applicant was afforded two months to file any request for reconsideration and advised that this period could be extended pursuant to 37 CFR 1.136(a).

On 23 January 2006, applicant filed the present response.

DISCUSSION

As detailed in the decision mailed 30 April 2004, 37 CFR 1.42 states:

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

Applicant's previously filed declaration was rejected as it did not contain the residence, citizenship and post office address information for both the deceased inventor and the executor of his estate. Applicant has presently filed a combined declaration and power of attorney, along with supplemental sheet, providing the relevant information for both parties. As such, applicant has satisfied all of the concerns raised in the decision mailed 22 November 2005 and it is proper to grant applicant's renewed petition under 37 CFR 1.42 at this time.

CONCLUSION

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

This application will be given an international application filing date of 14 December 2001 and a date of **23 January 2006** 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.

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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	: Charles Chuanming Wang	: DECISION ON REQUEST FOR
Patent Number	: 7656824	: RECALCULATION of PATENT
Issue Date	: 02/02/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/498,740	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 10/26/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1058** 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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US PHILIPS CORPORATION
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BRIARCLIFF MANOR, NY 10510

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JUL 10 2006

OFFICE OF PETITIONS

In re Application of :
Nyik Siong Wong et al :
Application No. 10/498,770 : ON PETITION
Filed: June 15, 2004 :
Attorney Docket No. SG 010017 :

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

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

The above-identified application became abandoned for failure to submit the issue fee/publication fee in a timely manner in reply to the Notice of Allowance mailed January 11, 2006, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on April 12, 2006..

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue fee/publication fee; (2) the petition fee; and (3) the required statement of unintentionally delay have been received. Accordingly, the issue fee/publication fee are accepted as having been unintentional 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.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the

appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address of currently of record until such time as appropriate instructions are received to the contrary.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Publishing Division.

Wan Laymon

Wan Laymon
Petitions Examiner
Office of Petitions

cc: ADAM L. STROUD
PHILIPS ELECTRONICS NORTH AMERICA CORP
SAN JOSE, CA 95131

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YUAN XIE
APT. 303
1479 BALHAN DRIVE
CONCORD CA 94521

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OFFICE OF PETITIONS

In re Application of	:	
Yuan Xie	:	
Application Number: 10/498781	:	ON PETITION
Filing Date: 06/09/2004	:	
For: THREE-DIMENSION COVERAGE CELLULAR NETWORK	:	

This is a decision on the petition filed on 3 April, 2007, under 37 CFR 1.137(a)[1] to revive the above-identified application which is first treated as a petition to withdraw the holding of abandonment.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition to withdraw the holding of abandonment," or as discussed below "Renewed Petition under 37 CFR 1.137(b)."

---

[1] A grantable petition under 37 CFR 1.137(a) must be accompanied by:

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

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

(3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

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

The application became abandoned on 21 July, 2006, for failure to timely file a response to the Notice of Non-Compliant Amendment (37 CFR 1.121) mailed on 20 June, 2006, which set a one (1) month shortened period for response. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. An untimely response was filed on 24 July, 2006. Notice of Abandonment was mailed on 31 March, 2007.

Petitioner states that he did timely mail a response to the Office on 14 July, 2006, via express mail. Further, petitioner asserts unavoidable delay in that he was unaware of extension of time fees were necessary.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

The U.S. Patent and Trademark Office (Office) file is the official record of the papers filed in this application. A review of the papers filed reveals that no reply filed on 14 July, 2006, to the Notice mailed on 20 June, 2006, was ever received in the USPTO. An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. The fact that petitioner believes that the reply was (or should have been) timely received in the Office, is not more persuasive than the date the papers are shown to have been received in the official file.

In this regard, 37 CFR 1.6 states,

> 37 CFR 1.6. Receipt of correspondence.
>
> (a) *Date of receipt and Express Mail date of deposit.* Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:
>
> (1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

> (2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail " with the United States Postal Service.
>
> (3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

As such, the showing of record is that petitioner's reply to the Office communication mailed on 20 June, 2006, was not filed in accordance with 37 CFR 1.8 or 1.10.

In support, petitioner has provided a copy of a Canada Post express mail label.

37 CFR 1.10(c) states that:

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

Petitioner has not shown that the reply to the Notice mailed on 20 June, 2006, was filed in compliance with 37 CFR 1.10(c). At the outset, the showing of record is that petitioner filed the reply with the Canadian postal service. 37 CFR 1.10(c) requires a showing, however, that the reply was deposited with the United States Postal Service (USPS) and that the Express Mail label number was placed on the reply. Petitioner apparently did not mail the reply via USPS Express Mail Post Office to Addressee Service. As the showing of record is that the requirements of 37 CFR 1.10(c) have not been met, petitioner may not reply upon the "Express Mail" provisions of 37 CFR 1.10 to show that a reply was timely filed.

At best, the record shows that applicant intended to timely file on 14 July, 2006, a reply to the Notice mailed on 20 June, 2006.

As petitioner has presented no proof of the mailing date of his reply to the Office action, the Office is unable to grant the requested relief. As such, the petition to withdraw the holding of abandonment must be dismissed. In future filings, petitioner should avail himself of the itemized postcard receipt practice of MPEP 503 as well as the certificate of mailing or transmission procedures set forth in 37 CFR 1.8 or the "Express Mail" procedures set forth in 37 CFR 1.10.

As petitioner has not provided a sufficient showing that a reply to the Notice mailed on 20 June, 2006, was timely filed, the petition must be dismissed.

PETITION UNDER 37 CFR 1.137(a).

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

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

In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

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

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

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

The petition lacks item (3).

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".[2] Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[3]

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).[5]

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[2] 35 U.S.C. § 133.

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

Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[4]

Petitioner's argument has been considered, but is not persuasive. Petitioner is responsible for the proper prosecution of his application. A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay.[5] A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action.[6]

In this regard, petitioner's failure to file the reply at issue in compliance with 37 CFR 1.8 or 1.10 precludes a finding that the delay was unavoidable. A "reasonably prudent person" would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the USPTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant's failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute "unavoidable" delay.[7]

With regard to petitioner's assertion that he is acting *pro se*, petitioner was not forced, but rather made a conscious decision to prosecute the application *pro se*, and therefore must be held accountable for his actions, or lack thereof, before the Office. There are numerous resources available to petitioner, as to the others who have chosen this path of prosecution, to obtain the

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

[5] See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v, Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

[6] See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994)(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).

[7] See Krahn v. Commissioner, 15 USPQ2d 1823, 1825 (E.D. Va. 1990); see also MPEP 711.03(c)(III)(C)(2).

necessary information to prosecute the application before the Office.

Lastly, it is noted that the statement of unavoidable delay in the petition is signed by Randolph W. Larrabee. Mr. Larrabee is not listed as an inventor, nor does he appear to be a registered patent practitioner. Petitioner has not explained his relationship to the application for patent or the showing of unavoidable delay. If a renewed petition under 37 CFR 1.137(a) is filed and Larrabee has first-hand knowledge of the circumstances surrounding the delay, petitioner must provide that information in an affidavit or declaration of fact by a person with first hand knowledge. Petitioner should also note 37 CFR 1.33(b) which states who may sign papers filed in an application.

In summary, the showing of record suggests that the abandonment resulted from a lack of diligence on the part of petitioner rather than as a result of unavoidable delay. As the showing presented is insufficient to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). As petitioner has not shown that they exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.[8]

ALTERNATIVE VENUE

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b), which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

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

[8] See note 3, supra.

fee, the required reply must include payment of the publication fee.

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

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

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

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

It is noted that petitioner submitted $560.00 with the present petition, although the small entity fee for a petition under 37 CFR 1.137(a) is $310.00. Petitioner may request that the overpayment be applied to the fee due for a petition filed under 37 CFR 1.137(b). As such, should petitioner decide to file a petition under 37 CFR 1.137(b), the additional petition fee due would be $440.00 for a small entity.

A copy of the form for filing a petition under 37 CFR 1.137(b) to revive an application unintentionally abandoned is enclosed herewith for petitioner's convenience.

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

Enclosure: Form PTO/SB/64
Privacy Act Statement

PTO/SB/64 (04-07)
Approved for use through 09/30/2007. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional)

First named inventor:

Application No.: Art Unit:

Filed: Examiner:

Title:

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional.

1.Petition fee

☐ Small entity-fee $ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity – fee $ _____ (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of _____(identify type of reply):

☐ has been filed previously on _____.
☐ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of $ _____.

☐ has been paid previously on _____.
☐ is enclosed herewith.

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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

3. Terminal disclaimer with disclaimer fee

☐ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of $ _____ for a small entity or $ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

_____ Signature

_____ Date

_____ Typed or printed name

_____ Registration Number, if applicable

_____ Address

_____ Telephone Number

_____ Address

Enclosures:
☐ Fee Payment
☐ Reply
☐ Terminal Disclaimer Form
☐ Additional sheets containing statements establishing unintentional delay
☐ Other: _____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

_____ Date

_____ Signature

_____ Typed or printed name of person signing certificate

Privacy Act Statement

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

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

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DNW Nov-07

YUAN XIE
APT. 303
1479 BALHAN DRIVE
CONCORD CA 94521

COPY MAILED

NOV 0 9 2007

OFFICE OF PETITIONS

In re Application of :
Yuan Xie :
Application Number: 10/498781 :
Filing Date: 06/09/2004 : ON PETITION
For: THREE-DIMENSION COVERAGE :
CELLULAR NETWORK :

This is a decision communication in response to the petition under 37 CFR 1.137(b),[1] filed on September 28, 2007.

The petition is **GRANTED**.

The application became abandoned on July 21, 2006, for failure to timely file a response to the Notice of Non-Compliant Amendment (37 CFR 1.121) mailed on June 20, 2006, which set a one (1) month shortened period for response. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. An

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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. 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)).

untimely response was filed on July 24, 2006. Notice of Abandonment was mailed on March 21, 2007. The petition under 37 CFR 1.137(a) filed on April 3, 2007, was dismissed on August 7, 2007.

The amendment filed on July 24, 2006, will be construed as the required reply.

The application is referred to Technology Center Art Unit 2617 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

18 JAN 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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IRVINE CA 92614

In re Application of
FENN-BARRABAß
U.S. Serial No.: 10/498,783
PCT Application No.: PCT/EP02/14242
Int. Filing Date: 13 December 2002
Priority Date: 14 December 2001
Attorney Docket No.: MEISS85.003APC
For: PACKAGING AND SEALING TOOL FOR PRODUCTION THEREOF

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT and PETITION UNDER 37 CFR 1.497(d)

This is in response to applicants' "Petition Under 37 CFR 1.181(a)" to withdraw the holding of abandonment, filed in the United States Patent and Trademark Office (USPTO) on 30 October 2006 in the above referenced application. Applicant also filed, in effect, a request under 37 CFR 1.497(d).

On 22 March 2005, a Notification of Missing Requirements (FORM/PCT/DO/EO/ 905) was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b) and English translation of the international application, and the surcharge for filing the oath or declaration and processing fee for filing the English translation, after the thirty month period, were required.

On 25 July 2005, applicant responded to the 905 with an English translation of the international application and a declaration identified and executed by Christian Fenn-Barrabaß, the sole inventor as listed on the international application, and by Gerhard Rieder.

On 12 January 2006, a Notification of Defective Response (FORM/PCT/DO/EO/916) was mailed to applicant indicating that the declaration was not in compliance with 37 CFR 1.497(a) and (b), in that a second inventor executed the declaration where the international application only identified one inventor.

On 28 August 2006, a Notification of Abandonment (FORM/PCT/DO/EO/ 909) was mailed to applicant indicating that the application was abandoned for failure to respond to the 905.

On 30 October 2006, applicant filed a Petition to Withdraw the Holding of Abandonment, contending that he did not receive the 916. Applicant also provides a copy of the docket record and affidavit of the docket clerk for the law firm along with a statement from Gerhard Rieder to be added as an inventor.

DISCUSSION

Petition under 37 CFR 1.181

Applicant petitions to withdraw the holding of abandonment for failure to timely respond to the Notification of Defective Response. Counsel indicates that the Notification of Defective Response was not received by applicant.

In order to establish that papers were not received, as set forth in the Official Gazette at 1156 OG 53, applicant must provide the following: (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 practitioner's statement). No petition fee is required.

The showing required to establish nonreceipt of an Office communication must include *a statement from the practitioner* (1) stating that the Office communication was not received by the practitioner and (2) attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. *A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.* In the instant case, a one month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date one month from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

Counsel's submission does not fulfill the requirements set forth above. Although Counsel states that the Notification of Defective Response was "never received by applicant's representative, as attested to by the attached declaration and docket records", he does not state that a search of the file jacket and the docket records was conducted and that such search indicates that the Office action was not received.

Furthermore, the evidence necessary to demonstrate that the Office action was not received is a copy of the docket record where the non-received Office action would have been entered had it been received. The docketing supervisor states "the standard procedure for U.S. docketing [is] to enter both the base date from which a response date is calculated and the response date itself into computerized records maintained for each patent application". The

docketing supervisor provided "the docketing record for all docketed dates based on a January 12, 2006 base date". No docket record for "the response date itself" was submitted. The evidence presented is not the docketing record for the date the response is due (the due dates of 12 and 13 February 2006 as the one month due date for the reply to the 916 was Sunday, 12 February 2006). Such records are required. The docket record provided does not appear to be a tickler system created to timely respond to USPTO actions because it references "US-PAT FAX ASSIGNMENT", "US PAT FAX RESTRICTION RESP" and the like. This docket record does not appear to be the docket record where the non-received Office action would have been entered had it been received (that is, the docket record for 12 and 13 February 2006, the due date for the reply to the 916). See MPEP §711.03(c), p.700-155.

The petition to withdraw the holding of abandonment is dismissed without prejudice. What is required is a statement by the practitioner that the Office action was not received by the practitioner and attesting that a search of the file jacket and docket records indicates that the Office action was not received; and 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 practitioner's statement).

Petition under 37 CFR 1.497(d)

On 25 July 2005, applicant submitted a declaration which identified and was executed by Christian Fenn-Barrabass (named as the sole inventor in the published international application), and by Gerhard Rieder. 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).[1]

On 30 October 2006, applicant submitted an incomplete petition under 37 CFR 1.497(d).

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[1]37 CFR 1.497(d) states, in part: 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.

With regard to Item (1), a statement from Gerhard Rieder the inventor being added indicating that any error in inventorship occurred without deceptive intention on his part was provided. As for Item (2), the fee $130 was charged per applicant's authorization. However, Item (3) is not satisfied because the written consent of the assignee was not signed.

The declaration, in compliance with 37 CFR 1.497(a) and (b) is required and has not yet been presented.

CONCLUSION

For the reasons discussed above, the petition under 37 CFR 1.181 is **DISMISSED WITHOUT PREJUDICE**. The application remains **ABANDONED**.

Applicant should submit a statement by the practitioner that the Office action was not received by the practitioner and attesting that a search of the file jacket and docket records indicates that the Office action was not received; and 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 practitioner's statement).

With respect to the addition of Gerhard Rieder in a petition under 37 CFR 1.497(d), the written consent of the assignee must be signed. The declaration, in compliance with 37 CFR 1.497(a) and (b) is required.

Any request for reconsideration on the merits of this decision must be filed within **TWO (2) MONTHS** from the mail date of this decision.

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

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27 JUN 2007

KNOBBE MARTENS OLSON & BEAR LLP
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IRVINE CA 92614

In re Application of
FENN-BARRABAß
U.S. Serial No.: 10/498,783
PCT Application No.: PCT/EP02/14242
Int. Filing Date: 13 December 2002
Priority Date: 14 December 2001
Attorney Docket No.: MEISS85.003APC
For: PACKAGING AND SEALING TOOL FOR PRODUCTION THEREOF

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT and PETITION UNDER 37 CFR 1.497(d)

This is in response to applicants' "Second Petition to Withdraw Holding of Abandonment", treated as a renewed petition under 37 CFR 1.181(a), filed in the United States Patent and Trademark Office (USPTO) on 05 March 2007 in the above referenced application. Applicant also filed a renewed petition under 37 CFR 1.497(d).

BACKGROUND

On 22 March 2005, a Notification of Missing Requirements (FORM/PCT/DO/EO/ 905) was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b) and English translation of the international application, and the surcharge for filing the oath or declaration and processing fee for filing the English translation, after the thirty month period, were required.

On 25 July 2005, applicant responded to the 905 with an English translation of the international application and a declaration identifying and executed by Christian Fenn-Barrabaß, the sole inventor as listed on the international application, and by Gerhard Rieder.

On 12 January 2006, a Notification of Defective Response (FORM/PCT/DO/EO/916) was mailed to applicant indicating that the declaration was not in compliance with 37 CFR 1.497(a) and (b), in that a second inventor executed the declaration where the international application only identified one inventor.

On 28 August 2006, a Notification of Abandonment (FORM/PCT/DO/EO/ 909) was

mailed to applicant indicating that the application was abandoned for failure to respond to the 905.

On 30 October 2006, applicant filed a Petition to Withdraw the Holding of Abandonment, contending that he did not receive the 916. Applicant also provided a copy of the docket record and affidavit of the docket clerk for the law firm along with a statement from Gerhard Rieder to be added as an inventor.

On 18 January 2007, a decision dismissing the petition was mailed indicating that applicant had not established that the Notification of Defective Response was not received and had not fulfilled the requirements of 37 CFR 1.497(d) to add inventor Gerhard Rieder. On 3 March 2007, applicant filed the instant renewed petition.

DISCUSSION

Petition under 37 CFR 1.181

The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner (1) stating that the Office communication was not received by the practitioner and (2) attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. In the instant case, a one month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date one month from the mail date of the nonreceived Office action (12 February 2006) must be submitted as documentary proof of nonreceipt of the Office action.

Counsel's submission now fulfills the requirements set forth above. Counsel states that the Notification of Defective Response was never received and he attests that a search of the file jacket and the docket records was conducted and that such search indicates that the Office action was not received.

Furthermore, Petitioner provided the evidence necessary to demonstrate that the Office action was not received; a copy of the docket record where the non-received Office action would have been entered had it been received, the docket record for 12 and 13 February 2006, the due date for the reply to the 916 and referenced in the practitioner's statement. The docket record supports Petitioner's contention that the 916 was not received. The petition to withdraw the holding of abandonment under 37 CFR 1.181 is hereby **GRANTED**.

Petition under 37 CFR 1.497(d)

On 25 July 2005, applicant submitted a declaration which identified and was executed by

Christian Fenn-Barrabass (named as the sole inventor in the published international application), and by Gerhard Rieder.

As previously stated, 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).

Petitioner previously satisfied Item (1) with a statement from Gerhard Rieder that any error in inventorship occurred without deceptive intention on his part and Item (2) with payment of the petition fee.

However, Item (3) is not satisfied because the written consent of the assignee was not provided. It appears that the assignee is Ablemarle Corporation. The document submitted to satisfy Item (3) is signed by Huhtamaki Ronsberg, President, Division GM-Sales on behalf of Deutschland GmbH & Co. KG. This is not the assignee on the assignment which was recorded in this application. The petition under 37 CFR 1.497(d) is hereby **DISMISSED without prejudice.** The declaration, filed on 25 July 2005, is not in compliance with 37 CFR 1.497(a) and (b), and thus, is not acceptable.

CONCLUSION

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

For the reasons discussed above, the submission under 37 CFR 1.497(d) to add Gerhard Rieder as inventor is hereby **DISMISSED without prejudice**.

Applicant has **ONE (1)** month within which to reply. No extensions of time are available. The written consent of the assignee to the addition of Gerhard Rieder as an inventor in this application is required.

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

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0 6 SEP 2007

KNOBBE MARTENS OLSON & BEAR LLP
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FOURTEENTH FLOOR
IRVINE CA 92614

In re Application of	:	
FENN-BARRABAß	:	DECISION ON
U.S. Serial No.: 10/498,783	:	
PCT Application No.: PCT/EP02/14242	:	PETITION
Int. Filing Date: 13 December 2002	:	
Priority Date: 14 December 2001	:	UNDER 37 CFR 1.497(d)
Attorney Docket No.: MEISS85.003APC	:	
For: PACKAGING AND SEALING TOOL FOR PRODUCTION THEREOF	:	

This is in response to applicants' "Response to Decision on Petition to Withdraw Holding of Abandonment and Renewed Petition under 37 CFR 1.497(d)", filed in the United States Patent and Trademark Office (USPTO) on 19 July 2007 in the above referenced application.

BACKGROUND

On 30 October 2006, applicant filed a Petition to Withdraw the Holding of Abandonment, and affidavit of the docket clerk for the law firm along with a statement from Gerhard Rieder to be added as an inventor.

On 18 January 2007, a decision dismissing the petition was mailed indicating that applicant had not established that the Notification of Defective Response was not received and had not fulfilled the requirements of 37 CFR 1.497(d) to add inventor Gerhard Rieder. On 3 March 2007, applicant filed a renewed petition. On 27 June 2007, a decision was mailed withdrawing the holding of abandonment and indicating that applicant had not yet satisfied the requirements of 37 CFR 1.497(d).

DISCUSSION

On 25 July 2005, applicant submitted a declaration which identified and was executed by Christian Fenn-Barrabass (named as the sole inventor in the published international application), and by Gerhard Rieder. 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).[1]

On 30 October 2006, applicant submitted an incomplete petition under 37 CFR 1.497(d). With regard to Item (1), a statement from Gerhard Rieder the inventor being added indicating that any error in inventorship occurred without deceptive intention on his part was provided. As for Item (2), the fee was paid.

Item (3) is now satisfied because the written consent of the assignee is signed. With the submission of the present petition and written consent of the assignee, applicant has completed the requirements of 37 CFR 1.497(d). The declaration, in compliance with 37 CFR 1.497(a) and (b), has been provided.

CONCLUSION

Applicant's petition under 37 CFR 1.497(d) to add inventor Gerhard Rieder 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 **25 July 2005.**

Cynthia M. Kratz
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[1]37 CFR 1.497(d) states, in part: 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.

11 JAN 2005

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FOLEY AND LARDNER
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3000 K STREET NW
WASHINGTON, DC 20007

In re Application of CHAWLA et al	:	
U.S. Application No.: 10/498,788	:	
PCT Application No.: PCT/US02/40161	:	
Int. Filing Date: 12 December 2002	:	DECISION
Priority Date Claimed: 14 December 2001	:	
Attorney Docket No.: 039386-0359	:	
For: ENZYMES	:	

This is in response to the correspondence filed 14 June 2004, which is being treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 12 December 2002, applicant filed international application PCT/US02/40161, which claimed priority of an earlier United States application filed 14 December 2001. The thirty-month period for paying the basic national fee in the United States expired on 14 June 2004.

On 14 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) and 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 declarations signed by the available inventors, each on his/her own behalf and on behalf of the nonsigning inventor Ann Gorvad.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.
>
> * * *
>
> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, petitioner has attempted to secure the signature of Ann Gorvad by mail on 24 June 2003, 13 August 2003, and 04 November 2003, by telephone on 23 June 2003, 14 July 2003, and 19 August 2003, by electronic mail on 17 July 2003, and by facsimile on 08 September 2003 (see affidavit of Lisa McDill dated 31 March 2004). As all of the correspondence apparently reached the intended destination, it would not be reasonable to conclude that Ms. Gorvad cannot be located. However, petitioner's repeated, varied, and unsuccessful attempts to obtain Ms. Gorvad's signature constitute sufficient evidence that Ms. Gorvad refuses to join in the application.

With regard to item (3) above, the requisite petition fee will be charged to Deposit Account No. 19-0741 as authorized in the Transmittal Letter filed 14 June 2004.

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 12 December 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 14 June 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

11 JAN 2005

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Ann Gorvad
2519 Sylvan Street
Bellingham, WA 98226

In re Application of CHAWLA et al
U.S. Application No.: 10/498,788
PCT Application No.: PCT/US02/40161
Int. Filing Date: 12 December 2002
Priority Date Claimed: 14 December 2001
For: ENZYMES

Dear Ann Gorvad:

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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FOLEY AND LARDNER
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3000 K STREET NW
WASHINGTON, DC 20007

Attorney Docket No.: 039386-0359

13 DEC 2004

#3

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Neil F. Greenblum
GREENBLUM & BERNSTEIN
1950 Roland Clark Place
Reston, VA 20191

In re Application of:	:	
BELPAUME, Charles	:	DECISION ON PETITION TO
U.S. Application No.: 10/498,825	:	REVIVE ABANDONED
PCT No.: PCT/FR02/03648	:	APPLICATION UNDER 37
International Filing Date: 24 October 2002	:	CFR 1.137(b)
Priority Date: 24 October 2001	:	
Attorney's Docket No.: P25376	:	
For: SHORTS OR UNDERPANTS RETAINING THE SEXUAL ORGANS	:	

This decision is issued in response to applicant's petition for revival of the application under 37 CFR 1.137(b) filed on 23 June 2004. Applicant has paid the required small entity petition fee.

BACKGROUND

On 24 October 2002, applicant filed international application PCT/FR02/03648 which claimed a priority date of 24 October 2001 and which designated the United States. On 01 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., 26 April 2004 (24 April 2004 was a Saturday).

On 23 June 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 the petition for revival under 37 CFR 1.137(b) considered herein.

DISCUSSION

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Regarding item (1), the "required reply," section 711.03(c) of the Manual of Patent Examining Procedures states that:

> [g]enerally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.

Here, a copy of the international application had previously been communicated to the USPTO by the IB. The "required reply" was therefore payment of the basic national fee. Payment of the basic national fee was included with applicant's 23 June 2004 submission. Thus, applicant has made a submission which would have been "sufficient to have avoided abandonment" had it been made in a timely manner, that is, on or before 26 April 2004. Accordingly, applicant has submitted the "required reply." Item (1) is satisfied.

Item (2) is the petition fee required under 37 CFR 1.17(m). The petition for revival was accompanied by payment of the small entity petition fee. Item (2) is satisfied.

As for item (3), the petition for revival was accompanied by a "Verified Statement In Support Of Petition For Revival Of Unintentional Abandonment Under 37 CFR 1.137(b)" in which the applicant explains the cause of the abandonment and states that the "entire delay in effecting entry into the U.S. National Stage for the above-acptioned International Application was unintentional." However, the facts set forth in applicant's statement require further clarification before it can be concluded that the abandonment was unintentional. Specifically, further information is required as to whether the original licensee was contractually responsible for filing the U.S. national stage application on the date such filing was due, that is, 26 April 2004. This is unclear from applicant's statement, which does not provide details as to the specific obligations of the licensee and the specific dates involved (i.e., was the licensse contractually responsible for filing the national stage application, when did the licensee inform applicant that it would not be carrying out its obligations, etc.). Applicant must provide further clarification, accompanied by available supporting documentary evidence, demonstrating who was responsible for filing the national stage application as of 26 April 2004. Until such materials are provided, item (3) is not satisfied.

Under the terms of 37 CFR 1.137(c), the terminal disclaimer listed as item (4) above is not required for this application.

CONCLUSION

Applicant's petition for revival 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 be entitled "Renewed Petition Under 37 CFR 1.137(b)" and include the additional statement and materials needed to satisfy item (3) of a grantable petition, as discussed above.

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.

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UNITED STATES PATENT AND TRADEMARK OFFICE

#5

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Reston, VA 20191

In re Application of: BELPAUME, Charles	:	
U.S. Application No.: 10/498,825	:	DECISION ON RENEWED
PCT No.: PCT/FR02/03648	:	PETITION TO REVIVE
International Filing Date: 24 October 2002	:	37 CFR 1.137(b)
Priority Date: 24 October 2001	:	
Attorney's Docket No.: P25376	:	
For: SHORTS OR UNDERPANTS RETAINING THE SEXUAL ORGANS	:	

In a decision mailed by this Office on 13 December 2004, applicants' petition under 37 CFR 1.137(b) was dismissed for failure to satisfy the requirements of a grantable petition. Specifically, it was not clear from the filed petition whether the entire delay in filing the required reply was unintentional.

On 25 January 2005, applicant filed a renewed petition, considered herein. The renewed petition clarifies the statements in the original petition regarding the facts that caused the abandonment here. Applicant's statements herein, in combination with those made in the original petition, are 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." Applicant must inform this Office immediately if this is not a proper interpretation of such statements. Based on this interpretation, the requirement of 37 CFR 1.137(b)(3) is now satisfied.

All the requirements for a grantable petition have now been submitted. Accordingly, the renewed petition for revival of the application under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accordance with this decision, including review of the English translation and declaration materials filed by applicant on 25 January 2005.

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GOLDEN BRIDGE, NY 10526

COPY MAILED

NOV 16 2006

OFFICE OF PETITIONS

In re Application of :
EPHRAT, et al. :
Application No. 10/498,834 : DECISION ON PETITION
Filed: June 14, 2004 : TO WITHDRAW
Attorney Docket No. 702/1 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 14, 2006.

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

A review of the file record indicates that the power of attorney to Sean L. Kelleher and the attorneys of LILLING & LILLING PC has been revoked by the assignee of the patent application on October 12, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **NATH & ASSOCIATES PLLC**
1030 15TH STREET NW, 6TH FLOOR
WASHINGTON, DC 20005

14 APR 2005

#6

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David B. Bonham
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In re Application of :
JOSHI, et al. :
Serial No.: 10/498,857 :
PCT No.: PCT/US02/39906 :
Int. Filing Date: 12 December 2002 :
Priority Date: 13 December 2001 :
Atty Docket No.: 006018 USA/ETCH/DRIE/JB1 :
For: SELF-ALIGNED CONTACT ETCH WITH HIGH SENSITIVITY TO NITRIDE SHOULDER :

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to the petition under 37 CFR 1.47(a) filed 06 January 2005 in the United States Patent and Trademark Office (USPTO) to accept the application without the signature of joint inventor Pui Man Agnes Ng.

BACKGROUND

On 12 December 2002, applicant filed international application PCT/US02/39906 which claimed priority to a previous application filed 13 December 2001.

On 14 June 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a preliminary amendment.

On 02 September 2004, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors was required. Applicant was afforded two months to file a proper response and advised that this period could be extended with the filing of a petition under 37 CFR 1.136(a).

On 06 January 2005, applicant filed the present response including a petition under 37 CFR 1.47(a). The petition was accompanied by a petition for a two-month extension of time and payment of the appropriate extension fee; therefore the response is considered timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint investor refuses to execute the application or

cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1, 3 and 4.

As to item (2), applicant states that the non-signing inventor's current address is unknown while the signed statement of Ms. Scariati states that she emailed a copy of the application papers to Ms. Ng without any response and that "No further contact information for Ms. Ng is available at this time." This is insufficient to show diligent effort under 47 CFR 1.47(a). Applicant is advised that the Manual of Patent Examination Procedure (MPEP) section 409.03(d) states that in cases where the inventor cannot be found, "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." No such materials were submitted with the present petition.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(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 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

#8

28 OCT 2005

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David B. Bonham
Mayer Fortkort & Williams, PC
251 North Avenue West, 2nd Floor
Westfield, NJ 07090

In re Application of	:	
JOSHI, et al.	:	
U.S. Application No.: 10/498,857	:	DECISION ON RENEWED
PCT No.: PCT/US02/39906	:	
Int. Filing Date: 12 December 2002	:	PETITION UNDER
Priority Date: 12 December 2001	:	
Attorney Docket No.: 006018 USA/ETCH/DRIE/JB1	:	37 CFR 1.47(a)
For: SELF-ALIGNED CONTACT ETCH WITH HIGH SENSITIVITY TO NITRIDE SHOULDER	:	

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.47(a)" filed 17 October 2005 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 14 April 2005, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor Pui Man Agnes Ng. Applicant was afforded two months to file any request for reconsideration.

On 17 October 2005, applicant filed the present renewed petition with certification under 37 CFR 1.8 that the paper was deposited with the United States Postal Service on 14 October 2005. In addition, applicant authorized the charging of any necessary extension of time fees to deposit account No. 50-1047. As such, a four-month extension of time will be charged to deposit account No. 50-1047 and the response is considered timely filed.

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. All applicant previously satisfied items 1, 3 and 4. With the filing of the present renewed petition and accompanying papers, applicant has satisfied the remaining fourth item and it is appropriate to grant the renewed petition under 37 CFR 1.47(a).

Specifically, applicant has detailed efforts to present the non-signing inventor with a complete set of application papers and declaration for execution. Applicant has included

documentary evidence of the attempted delivery of the papers, as well as, efforts to obtain a current address, telephone number and email account.

Accordingly, applicant has satisfied all four items detailed above and it is proper to grant applicant's renewed 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 12 December 2002 under 35 U.S.C. 363, and will be given a date of **06 January 2005** 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 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. Specifically, the mailing of a Notification of Acceptance (Form PCT/DO/EO/903).

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

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SYNGENTA CROP PROTECTION , INC.
PATENT AND TRADEMARK DEPARTMENT
410 SWING ROAD
GREENSBORO, NC 27409

Mail Date: 04/20/2010

Applicant	: Beat Jau	: DECISION ON REQUEST FOR
Patent Number	: 7598376	: RECALCULATION of PATENT
Issue Date	: 10/06/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/498,865	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 03/14/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **202** 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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/498,871	02/23/2005	Ronald F.M. Lange	4662-281	6931

23117 7590 07/25/2008
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

EXAMINER	
CHEN, VIVIAN	
ART UNIT	**PAPER NUMBER**
1794	

MAIL DATE	DELIVERY MODE
07/25/2008	PAPER

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

The time period for reply, if any, is set in the attached communication.

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wk

7-25-08

In re application of :
Lange et al. : DECISION ON
Serial No. 10/498,871 : PETITION
Filed: February 23, 2005 :
For: Instrument Panel Comprising A Layer Of A Thermoplastic Copolyester Elastomer Composition

This is a decision on the request filed on November 13, 2007. The request is to reset the period for Reply from the office action mailed on September 26, 2007. Applicants assert that a review of the Transaction History for the application in the PAIR system reveals that an action was mailed on September 26, 2007 however the IFW of the application does not include the Action. The examiner of record verified that the action could not be located.

DECISION

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee), and is evaluated under the procedures regarding an acceptable showing of non-receipt of an office action, TMOG 1156 O.G. 53, November 16, 1993, (see also MPEP 711.03(c) - NEW PROCEDURE TMOG 1170 O.G. 114). A review of the petitioner's evidence indicates that the request has merit. The evidence presented is sufficient to establish that the applicant or any authorized representative of the applicant did not receive the office action mailed on September 26, 2007.

The application is being forward to the examiner of record for issuance of a new action with the period of response set from the date of mailing of the new action.

The Petition is **GRANTED**.

Jacqueline M. Stone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Bryan H. Davidson
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901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON VA 22203

10 JAN 2005

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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON DC 20004

In re Application of
Takeo FUJIYAMA
Serial No.: 10/498,873
PCT App. No.: PCT/JP02/08074
Int'l Filing Date: 07 August 2002
Priority Date: 08 August 2001
Attorney Docket No.: 040894-7055
For: SAFETY APPARATUS OF AIR IMPACT DRIVER

DECISION ON

PETITION UNDER

37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 19 November 2004 in the above-captioned application is hereby **GRANTED** as follows:

On 16 June 2004, more than four months after the expiration of the thirty month period after which time the international application was abandoned as to the U.S. national stage, applicant filed a request for entry into the U.S. national stage. The request was accompanied by the basic national fee but without a petition to revive under 37 CFR 1.137. On 22 October 2004, a Notification of Abandonment was mailed to applicant erroneously indicating the reason for the abandonment was that applicant had failed to provide a copy of the international application by the 30 month period. On 19 November 2004, applicant filed the instant petition.

Applicant's statement that the "entire delay in filing the national stage application in the USPTO as well as the entire delay in filing this Petition from the due date set forth by 37 C.F.R. 1.497(b) until the filing of this Petition 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 has been provided. The required petition fee of $1370 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 $130 surcharge for filing the declaration and the $130 processing fee for filing the English translation of the international application after the thirty month period will be charged to applicant's deposit account per his authorization. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is **19 November 2004.**

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

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OFFICE OF PETITIONS

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE, SUITE 100
SAN DIEGO CA 92130-2040

In re Application of :

KUILMAN, et al. :
Application No. 10/498,924 : DECISION ON PETITION
Filed: January 3, 2005 : TO WITHDRAW
Attorney Docket No. 246152022700 : 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 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 Thomas Ciotti on behalf of all attorneys of record. All attorney/agent 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: **Mr. Thijs Kuilman**
Regenboog 9
KZ Venlo, The Netherlands 5923 KZ

cc: **Mr. Bryan H. Davidson**
Nixon & Vanderhye PC
901 North Glebe Road
Arlington, VA 22203-1808

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/498,924	01/03/2005	Thijs Kuilman	246152022700

CONFIRMATION NO. 2868

OC000000021234179

25225
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date Mailed: 11/15/2006

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/29/2006.

- 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.

MONICA A GRAVES
OP (571) 272-7253

FORMER ATTORNEY/AGENT COPY

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THOMAS J. TIGHE, ESQ.
P.O. BOX 22900
SAN DIEGO, CA 92192-2900

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OFFICE OF PETITIONS

In re Application of
Christian Hieronimi, et al.
Application No. 10/498,930
Filed: November 15, 2004
Attorney Docket No. JFIE4.001APC

ON PETITION

This is a decision in response to the petition, filed June 25, 2007, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for a failure to reply in a timely manner to a non-final Office action mailed May 1, 2006. A Notice of Abandonment was mailed on December 8, 2006. In response, on June 25, 2007, the present petition was filed.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay.

The application is being referred to Technology Center AU 2882 for consideration of the amendment filed June 29, 2007.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

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MAY 28 2010

OFFICE OF PETITIONS

In re Application of Westh et al. :
Application No. 10/498,998 : Decision on Petition
Filing Date: November 29, 2004 :
Attorney Docket No. 55320.100001 :

This is a decision on the petition under 37 CFR 1.137(b), filed January 19, 2010, to revive the above-identified application.

The petition is **granted**.

The Office mailed a final Office action on June 3, 2009.

A request for continued examination ("RCE") and payment for a three-month extension of time were filed December 1, 2009.

Unfortunately, the RCE was not submitted with a submission and an amendment had not been previously filed after the Office mailed the June 3, 2009 Office action. As a result, the application became abandoned on December 4, 2009. A Notice of Abandonment was mailed December 16, 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 submission to be considered in conjunction with the previously filed RCE.

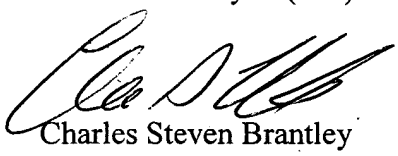
Petitioner has submitted the required petition fee of $810.

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.

Technology Center Art Unit 1634 will be informed of the instant decision and the RCE filed December 1, 2009, and the submission filed January 19, 2010, will be considered in due course.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON, MA 02111

Mail Date: 05/07/2010

Applicant	: Martti Tuulos	: DECISION ON REQUEST FOR
Patent Number	: 7626932	: RECALCULATION of PATENT
Issue Date	: 12/01/2009	: TERM ADJUSTMENT IN VIEW
Application No	: 10/499,002	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 08/13/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1109** 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.

03 JUN 2005

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Brett E. Bretchneider
MORRISON & FOERSTER LLP
1650 Tysons Boulevard
Suite 300
McLean, VA 22102

In re Application of:	:	
ROCKE, Alexander, Simon, David	:	DECISION ON PETITION UNDER
U.S. Application No.: 10/499,004	:	37 CFR 1.47(b)
PCT No.: PCT/GB02/05170	:	
International Filing Date: 15 November 2002	:	
Priority Date: 21 December 2001	:	
Attorney's Docket No.: 424662008200	:	
For: CLEANER HEAD FOR A VACUUM CLEANER	:	

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a)" filed 02 May 2005, treated herein under 37 CFR 1.47(b).[1] Deposit Account No. 03-1952 will be charged the required petition fee.

BACKGROUND

On 15 November 2002, applicant filed international application PCT/GB02/05170 which claimed a priority date of 21 December 2001 and which designated the United States. On 10 July 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., 21 June 2004 (10 July 2004 was a Saturday).

On 18 June 2004, petitioner 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 01 October 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration acceptable under 37 CFR 1.497, the surcharge for filing the declaration later than thirty months after the priority date, and additional claims fees were required.

On 02 May 2005, petitioner filed a response to the Notification Of Missing Requirements (with required extension fee). The response included payment for the required fees and surcharge, and the petition considered herein. The petition seeks acceptance of the application

[1] Where, as here, none of the inventors have executed the application, the applicable regulation is 37 CFR 1.47(b).

without the signature of the sole inventor, whom petitioner states has refused to execute the application.

DISCUSSION

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

Regarding item (1), petitioner has authorized a charge to Deposit Account No. 03-1952 for the required petition fee ($200). Based on this authorization, item (1) is satisfied.

Regarding item (2), where it is asserted that the inventor has refused to execute the application papers, section 409.03(d) of the MPEP requires that the nonsigning inventor first be provided with a copy of the complete application papers, including specification, drawings and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Here, petitioner has provided a firsthand statement from Janet Smith, with accompanying exhibits, demonstrating that a copy of the complete application papers have been provided to the nonsigning inventor and that the inventor has failed to provide the signed declaration, despite repeated requests. Based on this submission, item (2) is considered satisfied.

Regarding item (3), the petition includes an express statement of the last known address of the nonsigning inventor. Item (3) is satisfied.

Regarding item (4), the petition includes a declaration that was apparently executed on behalf of the nonsigning inventor. However, the declaration does not identify the person who executed the declaration. A revised declaration is required that properly identifies both the nonsigning inventor and the 37 CFR 1.47(b) applicant. This declaration must be executed by a specifically named individual with stated or apparent authority to act on behalf of the 37 CFR 1.47(b) applicant. On the present record, item (4) is not satisfied.

Regarding item (5), section 409.03(f) of the MPEP states the following:

> 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.

In the declaration of Gillian Ruth Smith, petitioner asserts a proprietary interest based on a purported employment agreement. The MPEP states the following with respect to such circumstances:

> When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

Here, Ms. Smith states that the invention underlying the present application was made during the inventor's employment and in the course of his duties at Dyson Limited. However, petitioner has not provided a copy of the employment agreement referred to, as required by the MPEP. In addition, Ms. Smith's statement refers to a subsequent assignment of this application from Dyson Limited to Dyson Technology Limited, a separate but related entity and apparently the 37 CFR 1.47(b) applicant herein. However, petitioner has not provided a copy of this assignment to demonstrate the full chain of title from the inventor to Dyson Limited to Dyson Technology Limited. Petitioner here must provide copies of the employment agreement which serves as the basis for Dyson Limited's claim of proprietary interest in the application, and a copy of the assignment from Dyson Limited to Dyson Technology Limited before it can be concluded that Dyson Technology Limited has the proprietary interest necessary to serve as the 37 CFR 1.47(b) applicant. Until such materials are provided, item (5) is not considered satisfied.

Regarding item (6), petitioner has not made the express statement that granting of the present petition is necessary to preserve the rights of the parties or to prevent irreparable damages

Based on the above, petitioner has failed to satisfy all the requirements for a grantable petition.

CONCLUSION

Applicants' petition under 37 CFR 1.47(b) 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(b)" and must include the materials required to satisfy items (4), (5), and (6) of a grantable petition, as discussed above and in the applicable sections of the MPEP.

Failure to provide a proper and timely 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

27 FEB 2006

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McLean, VA 22102

In re Application of:	
ROCKE, Alexander, Simon, David	DECISION ON RENEWED
U.S. Application No.: 10/499,004	PETITION UNDER
PCT No.: PCT/GB02/05170	37 CFR 1.47(b)
International Filing Date: 15 November 2002	
Priority Date: 21 December 2001	
Attorney's Docket No.: 424662008200	
For: CLEANER HEAD FOR A VACUUM CLEANER	

In a decision mailed by this Office on 03 June 2005, applicant's original "Petition Under 37 CFR 1.47(a)" (treated under 37 CFR 1.47(b)) was dismissed for failure to satisfy all the requirements for a grantable petition. Specifically, the decision stated that applicant had failed to satisfy the following elements of a grantable petition: (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application: and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages.

The decision provided an extendable two-month deadline for applicant to provide a response, stating that any such response "must include the materials required to satisfy items (4), (5), and (6) of a grantable petition." The decision also stated that the "[f]ailure to provide a proper and timely response will result in abandonment of the application."

On 03 January 2006, applicants filed the "Renewed Petition Under 37 CFR 1.47(a)" considered herein, with the required five-month extension fee. However, this submission was virtually identical to the original petition filed on 02 May 2005. The only apparent difference is the title and a minor change to the first page of the petition, whereby the renewed submission is identified as being filed in response to the earlier decision (the original petition had been identified as responsive to the Notification Of Missing Requirements). The petition was apparently not even resigned by counsel, as the signature page is identical to the original petition (including the May 2, 2005 date). No additional materials have been provided to satisfy any of the outstanding requirements for a grantable petition specified and required by the previous decision.

Based on the above, the 03 January 2006 submission is not considered a proper reply to the 03 June 2005 decision. Because the failure to file the proper response does not appear to

have been the result of an inadvertent omission, applicants will not be accorded a new time period to correct the deficiencies in the response.

CONCLUSION

For the above reasons, the renewed petition under 37 CFR 1.47 is **REFUSED** and the application is **ABANDONED**.

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

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

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19 JAN 2007

Barry E. Bretschneider
MORRISON & FOERSTER LLP
1650 Tysons Boulevard
Suite 300
McLean, VA 22102

In re Application of:
ROCKE, Alexander, Simon, David
U.S. Application No.: 10/499,004
PCT No.: PCT/GB02/05170
International Filing Date: 15 November 2002
Priority Date: 21 December 2001
Attorney's Docket No.: 424662008200
For: CLEANER HEAD FOR A VACUUM CLEANER

DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b) AND RENEWED PETITION UNDER 37 CFR 1.47(b)

This decision is issued in response to the "Renewed Petition Under 37 CFR 1.47(a)" (treated herein under 37 CFR 1.47(b)) and the petition for revival under 37 CFR 1.137(b) filed 22 September 2006. Applicant has paid the petition fee required for the petition under 37 CFR 1.137(b); no additional fee is required for the renewed petition under 37 CFR 1.47(b).

BACKGROUND

The procedural background for this application this application is set forth in the decisions mailed herein on 03 June 2005 and 27 February 2006.

The decision mailed 03 June 2005 dismissed the petition under 37 CFR 1.47(b) filed 02 May 2005 for failure to satisfy all the requirements for a grantable petition. Specifically, petitioner had failed to provide an acceptable oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor, adequate proof of the 37 CFR 1.47(b) applicant's proprietary interest in the application, and the required statement that the petition was necessary to preserve the rights of the parties or to prevent irreparable damages.

The decision mailed 27 February 2006 held that the materials filed by petitioner on 03 January 2006 were in fact virtually identical to the previously filed petition and, as such, were not a proper reply t the previous decision. Accordingly, the application was held abandoned for failure to file a proper response to the decision mailed 03 June 2005.

On 22 September 2006, applicants filed the petition for revival under 37 CFR 1.137(b) and the "Renewed Petition Under 37 CFR 1.47(a)" considered herein.

DISCUSSION

1. Renewed Petition Under 37 CFR 1.47(b)

The renewed petition is accompanied by a declaration that is properly executed on behalf of the non-signing inventor by Gillian R. Smith, who is clearly identified as an authorized officer of the 37 CFR 1.47(b) applicant, Dyson Technology Limited. This satisfies the declaration requirement for a grantable petition.

As for the showing of proprietary interest, the original petition asserted that the petitioner's proprietary interest was based on an employment agreement between Dyson Limited and the non-signing inventor. However, while the petition included a statement that the invention underlying the present application was made during the inventor's employment and in the course of his duties at Dyson Limited, the petition did not include copies of the employment agreement, as required. In addition, petitioner had not provided a showing demonstrating the transfer of the rights in this application from Dyson Limited to the 37 CFR 1.47(b) applicant, Dyson Technology Limited.

The present renewed petition includes copies of the required employment agreement and assignment documents. These materials, in combination with the previously filed materials, provide the required showing of the 37 CFR 1.137(b) applicant's proprietary interest in the application.

Finally, the renewed petition includes an express statement that granting of the present petition is necessary to preserve the rights of the parties or to prevent irreparable damages

Based on the above and the previous decisions mailed herein, petitioner has now satisfied all the requirements for a grantable petition under 37 CFR 1.47(b).

2. Petition For Revival Under 37 CFR 1.137(b)

Applicant's 22 September 2006 filing included a petition for revival of the application under 37 CFR 1.137(b).

The explanation for the abandonment contained in petitioner's "Statement Regarding Unintentional Delay," in combination with the statement in the petition 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 requirement of 37 CFR 1.137(b)(3).

Applicant has now submitted the "required reply," that is, a proper renewed petition under 37 CFR 1.47(b) responsive to the decision mailed 03 June 2005, and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the United States of America.

CONCLUSION

The renewed petition under 37 CFR 1.47(b) and the petition for revival under 37 CFR 1.137(b) are **GRANTED**.

The application is accepted without the signature of inventor Alexander Simon David BOCKE.

A notice of the acceptance of the application will be published in the Official Gazette, and a letter informing the inventor of the application will be forwarded to the non-signing inventor at his 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 22 September 2006.

Richard M. Ross
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SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : March 21, 2007

TO SPE OF : ART UNIT 1751

SUBJECT : Request for Certificate of Correction for Appl. No. 10/499019 patent No.: 7179,770

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

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

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

Magdalene Talley

Certificates of Correction Branch

703-308-9390 ext. 116

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

Doyle McGinty — SPE

1751 — Art Unit

PAGE 2/2 * RCVD AT 4/4/2007 10:08:01 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/30 * DNIS:2709942 * CSID:2024084400 * DURATION (mm-ss):01-20

~~24 MAR 2006~~ 26 MAY 2005 Corrected

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

In re Application of	:	
NIEMINEN et al.	:	DECISION ON
Application No.: 10/499,039	:	
PCT No.: PCT/FI02/01052	:	PAPERS
Int. Filing Date: 20 December 2002	:	
Priority Date: 21 December 2001	:	UNDER 37 CFR 1.42
Attorney's Docket No.: 01762.010500	:	
For: METHOD AND APPARATUS FOR GASIFYING CARBONACEOUS MATERIAL	:	

This is a decision on the submission filed by applicants on 17 June 2004. The indication in the declaration of inventorship under PCT Rules 4.17(iv) and 51bis.1(a)(iv) that inventor Jorma Nieminen is deceased has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 20 December 2002, applicants filed international application PCT/FI02/01052 which claimed a priority date of 21 December 2001 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 June 2004.

On 17 June 2004, applicants filed, *inter alia*, a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee.

DISCUSSION

The declaration of inventorship under PCT Rules 4.17(iv) and 51bis.1(a)(iv) fails to comply with 37 CFR 1.497(a)-(b). The declaration does not include the residence, mailing address and citizenship of the person(s) signing on behalf of the deceased inventor (37 CFR 1.497(b)(2)) in addition to the full name *and citizenship* of the deceased inventor (37 CFR 1.497(a)(3)). Also, the declaration must include the signature of the legal representative or the signature of all of the heirs (or if there is only one heir, the sole heir). If the declaration is signed by a legal representative, the declaration should state that this person is the legal representative. Here, the declaration simply states that the deceased is "represented" by Katriina Nieminen. If the declaration is not signed by a legal representative and does not indicate that the persons signing are all of the heirs (or the sole heir), then it must be accompanied by a statement by either

those signing or by the attorney which sets forth (1) that they are in fact all the heirs of the deceased and (2) that no legal representative of the deceased's estate has been appointed or is required by the applicable law to be appointed.

CONCLUSION

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

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.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

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

17 MAR 2006

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FITZPATRICK CELLA HARPER & SCINTO
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NEW YORK NY 10112

In re Application of	:	
NIEMINEN et al.	:	DECISION ON
Application No.: 10/499,039	:	
PCT No.: PCT/FI02/01052	:	PAPERS
Int. Filing Date: 20 December 2002	:	
Priority Date: 21 December 2001	:	UNDER 37 CFR 1.42
Attorney's Docket No.: 01762.010500	:	
For: METHOD AND APPARATUS FOR GASIFYING CARBONACEOUS MATERIAL	:	

This is a decision on applicants' "RENEWED SUBMISSION UNDER 37 CFR 1.42" filed in the United States Patent and Trademark Office (USPTO) on 26 August 2005.

BACKGROUND

On 20 December 2002, applicants filed international application PCT/FI02/01052 which claimed a priority date of 21 December 2001 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 June 2004.

On 17 June 2004, applicants filed, *inter alia*, a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee.

On 26 May 2005, a decision was mailed treating applicants' indication in the declaration of inventorship under PCT Rules 4.17(iv) and 51bis.1(a)(iv) that inventor Jorma Nieminen is deceased as a request for status under 37 CFR 1.42. The decision refused applicants' request for such status.

On 26 August 2005, applicants filed the instant "RENEWED SUBMISSION UNDER 37 CFR 1.42" which was accompanied by a declaration of inventors.

DISCUSSION

The submission filed 26 August 2005 has been reviewed and has been found in compliance with 37 CFR 1.42. The declaration filed 26 August 2005 is in compliance with 37 CFR 1.497(a)-(b).

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 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 in accordance with this decision.

Daniel Stemmer
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Paper No.

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MEMPHIS TN 38116

MAILED

JUL 07 2009

OFFICE OF PETITIONS

In re Application of :
Crabtree et al. :
Application No. 10/499,047 : ON APPLICATION FOR
Filed: June 16, 2004 : PATENT TERM ADJUSTMENT
Atty Docket No. 10557/300865 :

This is in response to the COMMUNICATION REGARDING PATENT TERM ADJUSTMENT (PTA) INDICATED IN NOTICE OF ALLOWANCE filed on January 8, 2009. This decision is made in light of the supplemental communication regarding PTA, also filed on January 8, 2009. Applicant requests that the determination of patent term adjustment be increased from five hundred thirty-three (533) days by six hundred eighty-eight (688) days to one thousand two hundred twenty-one (1221) days, if the patent issues on Tuesday, May 5, 2009. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

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 change of correspondence address filed on January 8, 2009 is acknowledged and made of record.

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

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

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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DIANA HOUSTON
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Mail Date: 04/21/2010

Applicant	: Paul Crabtree	: DECISION ON REQUEST FOR
Patent Number	: 7572292	: RECALCULATION of PATENT
Issue Date	: 08/11/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/499,047	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/16/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1310** 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.

02 MAR 2
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#3

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON VA 22202

In re Application of	:	
GREIJER, Thomas	:	
Application No.: 10/499,060	:	DECISION
PCT No.: PCT/SE02/02275	:	
Int. Filing Date: 10 December 2002	:	ON REQUEST UNDER
Priority Date: 21 December 2001	:	
Attorney's Docket No.: 1435-2(2595-117)	:	37 CFR 1.497(d)
For: CONCRETE SLAB FORM SYSTEM	:	

This decision is in response to "Request to Correct Inventorship Under 37 CFR §1.48(a)," filed in the United States Patent and Trademark Office on 19 November 2004.

BACKGROUND

On 10 December 2002, applicant filed international application PCT/SE02/02275, which claimed a priority date of 21 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 31 July 2003. The deadline for entry into the national stage in the United States was midnight on 21 June 2004.

On 17 June 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.

On 19 November 2004, applicant submitted the instant request.

DISCUSSION

The inventor in the international application is Thomas Greijer. Applicant files this request to add Karl Axel Stjernström 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. Applicant has 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), applicant has not indicated whether an assignment has occurred and have not provided consent of the assignee, if applicable.

CONCLUSION

For the above reasons, applicant's request under 37 CFR 1.497(d) is **REFUSED**.

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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24 JUN 2005
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In re Application of :
GREIJER, Thomas :
Application No.: 10/499,060 : DECISION
PCT No.: PCT/SE02/02275 :
Int. Filing Date: 10 December 2002 : ON REQUEST UNDER
Priority Date: 21 December 2001 :
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 to Correct Inventorship Under 37 CFR §1.48(a)," filed in the United States Patent and Trademark Office on 13 April 2005. The request has been treated as a request under 37 CFR 1.497(d).

BACKGROUND

On 10 December 2002, applicants filed international application PCT/SE02/02275, which claimed a priority date of 21 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 31 July 2003. The deadline for entry into the national stage in the United States was midnight on 21 June 2004.

On 17 June 2004, applicants filed a submission for entry into the national stage in the United States, accompanied by, *inter alia*, the U.S. Basic National Fee.

On 19 November 2004, applicants submitted a request to correct the inventorship.

On 02 March 2005, the Office mailed Decision on Request Under 37 CFR 1.497(d).

On 13 April 2005, applicants submitted the instant renewed request.

DISCUSSION

The inventor in the international application is Thomas Greijer. Applicant files this request to add Karl Axel Stjernström 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 supplied assignments from the inventors 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 **19 November 2004**.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: (571) 272-3292
Facsimile: (571) 273-0459

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

COPY MAILED

JAN 04 2010

In re Application of Muhonen et al. Application No. 10/499,074 Filed: June 15, 2004 Attorney Docket No. NC16300US (P3584US00)	: : : : : :	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 22, 2009.

The request is **DISMISSED** as involving a moot issue.

A review of the file record indicates that the power of attorney to the attorneys/agents associated with Customer Number 30542 was revoked by the assignee of the patent application on November 6, 2009. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Liana Walsh
Petitions Examiner
Office of Petitions

cc: DITTHAVONG MORI & STEINER, P.C.
918 PRINCE STREET
ALEXANDRIA VA 22314

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TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

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AUG 25 2006

OFFICE OF PETITIONS

In re Application of :
Peter Lambauer et al :
Application No. 10/499,095 : ON PETITION
Filed: June 16, 2004 :
Attorney Docket No. 080631-000000US :

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

The petition is **GRANTED.**

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

Petitioner is advised that the issue fee paid on August 18, 2006, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 1722 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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

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MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Mail Date: 04/27/2010

Applicant	: Wanli Xing	: DECISION ON REQUEST FOR
Patent Number	: 7632674	: RECALCULATION of PATENT
Issue Date	: 12/15/2009	: TERM ADJUSTMENT IN VIEW
Application No	: 10/499,098	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 12/30/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

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

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

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JUL 19 2005

OFFICE OF PETITIONS

Applicant: Awaya
Appl. No.: 10/499, 140
International Filing Date: February 10, 2003
Title: Image Forming Apparatus with Heat Exhausting Means
Attorney Docket No.: 25886
Pub. No.: US 2005/0235882 A1
Pub. Date: April 7, 2005

This is a decision on the request for a "Corrected Notice of Publication of Application, filed on April 27, 2005, for the above-identified application

The request is DISMISSED.

Applicant requests that the Notice of Publication of Application be corrected because the data was incorrectly entered, as the title of the invention "Image Forming Apparatus with Heat Exhausting Means" is misprinted as "DIELECTRIC FILM FORMING METHOD."

The Notice of Publication cannot be reprinted with the typographical correction as requested, as there is not a method to regenerate the Notice.

On December 14, 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 using the facsimile number (703-746-9195) on the Filing Receipt.

Inquiries relating to this matter may be directed to Mark Polutta at (571) 272-7709 (voice)

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

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BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON DC 20001-5303

In re Application of:
LAUGESEN, MARTIN SIBAST
Serial No.: 10/499,149
Filed: Apr. 19, 2005
Docket: LAUGESEN1
Title: DISPOSABLE ABSORPTIVE ARTICLE

3/4/09

DECISION ON PETITION

This is a decision on the petition filed on February 24, 2009 seeking to withdraw the finality of the Office action mailed December 10, 2008. This petition is being considered pursuant to 37 CFR §1.181. No fee is required.

The petition is **DISMISSED AS UNTIMELY**.

In the February 24, 2009 petition, the petitioner requests the finality of the Office action of December 10, 2008 be vacated or withdrawn because the examiner failed to address certain claim limitations and answer applicant's arguments in the Office action.

The record shows that:

1) On March 26, 2008, the examiner mailed a non-final Office Action. Claims 1-24 and 27-29 were rejected by the prior art references under various applicable sections of 35 U.S.C. 102(b) or 103 (a).
2) On July 24, 2008, the applicant submitted a Reply under 37 CFR 1.111 with substantive amendment to the claims and added additional new claims 30-31.
3) On December 10, 2008, the examiner mailed a final Office action. The examiner again, rejected claims 1-24 and 27-31 by the prior art references under various applicable sections of 35 U.S.C. 102(b) or 103 (a). In addition, new rejection of claims under 35 USC 112 was necessitated by the amendment to claims.
4) On February 24, 2009, the applicant submitted an amendment after final with more amendment to the claims and arguments to traverse the rejection.
5) On February 24, 2009 the present petition was filed. Applicant requests that the finality of the final Office action be withdrawn.

Discussion and Analysis

A review of the record shows that the instant petition was filed more than two months after the mailing date of the final Office action of December 10, 2008. Pursuant to 37 CFR 1.181(f)[1], the petition is not timely filed since the petition was not filed within two months of the action complained of. As the petition was not timely filed, the requested withdrawal of finality of the Office action of Dec. 10, 2008 will not be granted. The final rejection stands.

With regard to the substantive arguments of the particular limitations in the claims regarding a volume space between the absorbent material and outer packaging surface and existence of the volume space at a particular location, the examiner did respond to the applicant's arguments in the final rejection of December 10, 2008. Apparently, the applicant is not satisfied with the examiner's response. In the petition, the issues presented by petitioner are clearly directed to the propriety of the examiner's response to the applicant's argument and the rejection of claims 1-24 and 27-31 under various sections of applicable 35 USC § 102 and 103. The question of whether the examiner has properly considered and interpreted certain claim limitations in the rejection of claims under 35 USC § 102 and 103 is clearly an appealable issue under 37 CFR § 41.31(a) (1). According to 37 CFR § 1.181(a)(1)[2], it is clear that petitioner's arguments will not support the requested relief, because the relief requested is simply not the type of relief that can be obtained by petition. The propriety of claim interpretation in a rejection of a claim, ultimately, is to be determined by the Board of Patent Appeals and Interferences in accordance with 37 CFR § 1.181(a) (1).

Conclusion

In view of the record, petitioner's request to withdraw the finality of the Office action dated December 10, 2008 is dismissed as untimely. Issues regarding the interpretation of claim limitations in the rejection of claims are appealable and will not be decided by petition.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3761 for consideration of the amendment after final filed on February 24, 2009. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

---

[1] 37 CFR 1.181(f): The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

[2] 37 CFR § 1.181(a) (1) states: Petition may be taken to the Director: (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.

PETITION DISMISSED AS UNTIMELY.

Donald T. Hajec, Director
Technology Center 3700

03 MAR 2005

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Stephen A. Becker
McDermott Will & Emery LLP
600 13th Street NW
Washington DC 20005-3096

In re Application of
DAVID GEORGE GILL (Deceased)
Application No.: 10/499,153
PCT No.: PCT/GB02/05784
Int. Filing Date: 19 December 2002
Priority Date: 19 December 2001
Attorney Docket no.: 64108-019
For: PAINT COMPOSITION AND PAINT SPRAYING APPARATUS WITH PREHEATED PAINT

DECISION ON

REQUEST

UNDER 37 CFR 1.42

This is a decision on applicant's Response to Notification of Missing Requirements filed in the United States Patent and Trademark Office (USPTO) on 18 January 2005 and is being treated as a request under 37 CFR 1.42.

BACKGROUND

On 18 June 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 10 December 2004, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), was required.

On 18 January 2005, applicant filed a response to the Notification submitting a declaration signed by inventors Jos Johannes Jules Verhoosel and Hans Meeuwissen and identifying Sheila Gill as the legal representative of deceased inventor, David George Gill.

DISCUSSION

37 CFR § 1.42 requires that in the case of the death of the inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent.

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

Although the declaration identifies Sheila Gill as the legal representative of deceased inventor David George Gill, the declaration is defective because it does not state the country of citizenship, former residency and mailing address for *both* the deceased inventor and the legal representative, to meet the requirements for compliance with 37 CFR 1.497.

What is required is a declaration executed by Sheila Gill, which identifies her as legal representative for deceased inventor David George Gill. The declaration must provide Sheila Gill's citizenship, residency and mailing address and identify David George Gill as the deceased inventor, providing his citizenship, former residency and mailing address on the declaration.

Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **DISMISSED WITHOUT PREJUDICE.**

Applicant is required to correct the above-noted defects including the furnishing of a oath/declaration in compliance with 37 CFR 1.42 and 1.497 within **TWO (2) MONTHS** from the mail date of this Decision.

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

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

20 JUN 2005

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Stephen A. Becker
McDermott Will & Emery LLP
600 13th Street NW
Washington DC 20005-3096

In re Application of
DAVID GEORGE GILL (Deceased)
Application No.: 10/499,153
PCT No.: PCT/GB02/05784
Int. Filing Date: 19 December 2002
Priority Date: 19 December 2001
Attorney Docket no.: 64108-019
For: PAINT COMPOSITION AND PAINT SPRAYING APPARATUS WITH PREHEATED PAINT

DECISION ON

REQUEST

UNDER 37 CFR 1.42

This is a decision on applicant's Response to Notification of Missing Requirements filed in the United States Patent and Trademark Office (USPTO) on 22 April 2005 and is being treated as a request under 37 CFR 1.42.

BACKGROUND

On 18 June 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 10 December 2004, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), was required.

On 18 January 2005, applicant filed a response to the Notification submitting a declaration signed by inventors Jos Johannes Jules Verhoosel and Hans Meeuwissen and identifying Sheila Gill as the legal representative of deceased inventor, David George Gill.

On 03 March 2005, a decision dismissing applicant's response was mailed indicating that the declaration was defective because it did not state the country of citizenship, former residency and mailing address for *both* the deceased inventor and the legal representative, to meet the requirements for compliance with 37 CFR 1.497.

On 22 April 2005, applicant submitted a Response to Decision on Request under 37 CFR 1.42 along with a declaration executed by the legal representative on behalf of the deceased inventor..

DISCUSSION

The declaration filed on 22 April 2005 was executed by the legal representative, identifying all of the inventors as listed on the international application. This declaration

included the country of citizenship, residency and mailing address for both the deceased inventor and his legal representative. The declaration filed on 22 April 2005 is in compliance with 37 CFR 1.497(a) and (b) and is acceptable.

CONCLUSION

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

The application will be forwarded to the United States Designated/Elected Office for further processing in accordance with this decision. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is **22 April 2005.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

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Basell USA Inc.
Delaware Corporate Center II
2 Righter Parkway, Suite #300
Wilmington DE 19803

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OFFICE OF PETITIONS

In re Application of	:	
Pelliconi et al.	:	DECISION ON PETITION TO
Application Number: 10/499182	:	WITHDRAW HOLDING OF
Filing Date: 06/16/2004	:	ABANDONMENT
Attorney Docket Number: TC 5481 (US)	:	

This is a decision on the petition filed on February 13, 2009, to withdraw the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

A Notice of Abandonment was mailed on December 23, 2008, stating that the application was abandoned for failure to timely file a proper reply to the final Office action mailed on November 27, 2007.

Petitioners assert that the Notice of Abandonment should be withdrawn because a timely reply was filed.

A review of the record reveals that on November 27, 2007, a final Office action was mailed, setting a three (3) month shortened statutory period for reply.

In response, on May 27, 2008, a Notice of Appeal was filed, along with a petition for a three (3) month extension of time and the required fee, and an amendment after final rejection.

On July 1, 2008, a Advisory Action Before the Filing of an Appeal Brief was mailed, stating that the reply filed on May 27, 2008, fails to place this application in condition for allowance. Receipt of the Notice of Appeal was also acknowledged.

On December 29, 2008 (certificate of mailing date December 23, 2008), a Request for Continued Examination (RCE) was filed, along

with a petition for a five (5) month extension of time, and an amendment as the submission under 37 CFR 1.114.

As such, a timely reply was filed in the form of the Notice of Appeal and extension of time filed on May 27, 2008, and the RCE and submission and extension of time filed on December 29, 2008 (certificate of mailing date December 23, 2008). Therefore, there is no abandonment in fact.

The holding of abandonment is **withdrawn**. The Notice of Abandonment is **vacated**.

The application is referred to Technology Center Art Unit 1796 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

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OFFICE OF PETITIONS

IMMUNEX CORPORATION
LAW DEPARTMENT
1201 AMGEN COURT WEST
SEATTLE WA 98119

In re Patent No. 7,396,662
Issued: July 8, 2008
Application No. 10/499,184
Filed: June 17, 2004
Dkt. No.: 3303-US-PCT

: DECISION ON PATENT TERM
:ADJUSTMENT and NOTICE OF INTENT
: TO ISSUE CERTIFCATE OF
: CORRECTION
:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed September 8, 2008. This matter is being treated as an application for patent term adjustment under 37 CFR 1.705(d).

The application for patent term adjustment ("PTA") under 37 CFR 1.705(d) is **GRANTED TO THE EXTENT INDICATED HEREIN**.

The above-identified application matured into U.S. Patent No. 7,396,662 on July 8, 2008. The instant request for reconsideration was timely filed. The patent issued with a PTA of 95 days. Patentee argues that the application is entitled to an adjustment of 129 days. Patentee further argues that the reductions of 64 days and 48 days in connection with the drawings and amendment filed March 19, 2008 are in error. Patentee argues that the correct reduction in connection with the submission of the drawings and amendment on March 19, 2008 is 78 days.

After careful review of patentee's arguments and the record, it has been determined that the calculation of adjustment contains errors. The correct period of adjustment is 77 days, as set forth herein.

REDUCTIONS TOTALING 308 DAYS:

The reduction of 24 days in accordance with 37 CFR 1.704(b) in connection with the reply filed July 17, 2006 is correct.

The reduction of one day in accordance with 37 CFR 1.704(c)(8) in connection with the information disclosure statement filed July 18, 2006 is correct.

The reduction of 92 days in accordance with 37 CFR 1.704(b) in connection with the reply filed February 14, 2007 is correct.

The reduction of 63 days in accordance with 37 CFR 1.704(b) in connection with the reply filed October 9, 2007 is correct.

Review of the calculation of adjustment reveals that the Office failed to reduce the adjustment an additional 50 days under 37 CFR 1.704(c)(8) in connection with the supplemental reply filed November 28, 2007. The reduction commenced October 10, 2007, the day after the date that the initial reply was filed, and ended November 28, 2007, the date that the supplemental reply (amendment) was filed.

The adjustment is subject to a reduction of 78 days, rather not 48 days plus 64 days, as argued by patentee, in connection with the amendment, including drawings, under 37 CFR 1.312 filed March 19, 2008. The reduction commenced March 19, 2008, the date that the amendment and drawings were filed, and ended June 4, 2008, the date that a reply thereto was mailed. See, 37 CFR 1.704(c)(10)(i).

ADJUSTMENTS TOTALING 385 DAYS:

The application was accorded an adjustment of 218 days in accordance with 37 CFR 1.702(a)(1) in connection with the mailing of the restriction requirement on March 23, 2006.

A review of the record reveals that the Office did not calculate the period of adjustment under 37 CFR 1.702(b) based on the application's "commencement date" of June 19, 2004. Accordingly, the period of adjustment under 37 CFR 1.702(b) is 385 days and not 387 days. The adjustment commenced June 20, 2004, the day after the date that is three years from the date of commencement, and ended July 8, 2008, the date that the patent issued. See, 37 CFR 1.703(b).

The relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay under 37 CFR 1.702(a) and 1.702(b) "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period during which the application was pending before the Office, or, June 17, 2004, to the date the patent issued on July 8, 2008. Prior to the issuance of the patent, 218 days of patent term adjustment were accorded for the Office failing to respond within a specified time frame during the pendency of the application. All of the 218 days for Office examination delay overlap with the 385 days of Office delay in issuing the patent. Accordingly, as the 218 days attributable to examination delay overlaps with the adjustment of 385 days of delay in issuance of the patent, entry of both periods is not warranted as the issuance of the patent was delayed a total of 385 days.

Accordingly, at the time of issuance, the application was entitled to a patent term adjustment of 77 days (adjustments totaling 385 days less reductions of 308 days).

As authorized, the $200.00 application fee required under 37 CFR 1.18(e) has been charged to Deposit Account 09-0089.

Any request for reconsideration of this decision must be submitted within ONE MONTH of the mail date indicated herein. The time period for seeking reconsideration is not subject to extension under 37 CFR 1.136.

This application file will be forwarded to the Certificate of Corrections branch for issuance of a certificate of correction to indicate that the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 77 days.

Telephone inquiries specific to this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT	:	7,396,662 B2
DATED	:	July 8, 2008
INVENTOR(S)	:	Baum

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 95 days

Delete the phrase "by 95 days" and insert – by 77 days--

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1650 MARKET STREET
PHILADELPHIA, PA 19103

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JAN 23 2006

OFFICE OF PETITIONS

In re Application of	:	
Carl T. Brighton et al	:	DECISION ON PETITION
Application No. 10/499,191	:	TO MAKE SPECIAL UNDER
Filed: June 17, 2004	:	37 CFR 1.102(c)(1)
Attorney Docket No. UPN-4412	:	

This is a decision on the petition under 37 CFR1.102(c)(1), filed December 22, 2005, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section IV: Applicant's Age must be accompanied by evidence showing that at least one of the applicants is 65 years of age, or more, such as a birth certificate or a statement by applicant. No fee is required

The petition includes a copy of a driver's license. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Wan Laymon at 571-272-3220.

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center AU 3762 for action on the merits commensurate with this decision.

Denise Pothier
Petitions Examiner
Office of Petitions

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Paper No.

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

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JUN 24 2010

OFFICE OF PETITIONS

In re Application of :
Vendeville et al. :
Application No. 10/499,221 : ON APPLICATION FOR
Filed: April 12, 2005 : PATENT TERM ADJUSTMENT
Atty Docket No. TIP0030US/PCT :
Title: BROADSPECTRUM :
HETEROCYCLIC SUBSTITUTED :
PHENYL CONTAINING SULFONAMIDE :
HIV PROTEASE INHIBITORS :

This is in response to the "APPLICATIONS FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b) WITHIN THREE MONTHS OF RECEIPT OF THE NOTICE OF ALLOWANCE," filed February 3, 2010. Applicant submits that the correct patent term adjustment to be indicated on the patent is at least one thousand, two hundred and fifty (1250) days, not five hundred and seventy-three (573) 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.

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 cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.[1]

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

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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.

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 decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

Anthony Knight
Director
Office of Petitions

01 SEP 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Carol M. LaSalle
Bozicevic, Field & Francis, LLP
1900 University Avenue, Suite 200
E. Palo Alto, CA 94303

In re Application of
HARRISON, et al.
Serial No.: 10/499,237
PCT No.: PCT/AU02/01752
Int. Filing Date: 30 December 2002
Priority Date: 02 January 2002
Atty Docket No.: RICE-031
For: 2 DIMENSIONAL STRUCTURE QUERIES

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to the petition under 37 CFR 1.47(a) filed 06 July 2005 to accept the application without the signature of joint inventor Mathew Harrison. As authorized, the $200.00 petition fee will be charged to Deposit Account No.: 50-0815.

BACKGROUND

On 30 December 2002, applicant filed international application PCT/AU02/01752 which claimed priority to a previous application filed 02 January 2002. A copy of the international application was transmitted to the United States on 10 July 2003. Pursuant to 37 CFR 1.495 the period for providing payment of the full, U.S. Basic National Fee was set to expire thirty months from the priority date, or midnight 02 July 2004.

On 16 June 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 preliminary amendment.

On 06 December 2004, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors was required, as well as, payment of the $130.00 surcharge for providing an executed oath or declaration later than thirty months from the earliest claimed priority date. Applicant was afforded two months to file a proper response.

On 06 July 2005, applicant filed the present petition under 37 CFR 1.47(a) accompanied by a petition for a five-month extension of time and payment of the appropriate extension fee. Therefore, applicant's response is considered timely filed.

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. Applicant has satisfied items 1 and 3.

As to item (2), applicant has provided a signed statement from Dr. Paula Tito detailing her efforts to provide the non-signing inventor with a complete set of applications papers and declaration for signature. The declaration references several emails and between the parties, as well as, a mailing of the documents on 21 March 2005. However, applicant has not included these items as exhibits. Copies of these materials should be provided so that the actions of the non-signing inventor can be constituted as a refusal to sign the declaration. (See MPEP §409.03(d).

Regarding item 4, applicant has provided a declaration executed by the remaining inventors. However, the declaration is not in compliance with 37 CFR 1.497 (a)-(b). Manual of Patent Examining Procedure (MPEP) Section 201.03 explains:

> An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

The filed declaration contains two pages three of three. As such, it appears that the inventors were not provided with complete declarations for signature or only returned the signature pages. Either scenario renders the documents non-compliant.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(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 directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

26 JAN 2006

Carol M. LaSalle
Bozicevic, Field & Francis, LLP
1900 University Avenue, Suite 200
E. Palo Alto, CA 94303

In re Application of	
HARRISON, et al.	DECISION ON RENEWED
Serial No.: 10/499,237	
PCT No.: PCT/AU02/01752	PETITION UNDER
Int. Filing Date: 30 December 2002	
Priority Date: 02 January 2002	37 CFR 1.47(a)
Atty Docket No.: RICE-031	
For: 2 DIMENSIONAL STRUCTURE QUERIES	

This decision is in response to the renewed petition under 37 CFR 1.47(a) filed 27 October 2005 to accept the application without the signature of joint inventor Mathew Harrison.

BACKGROUND

On 01 September 2005, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(a). Applicant was afforded two months to file any request for reconsideration.

On 27 October 2005, applicant filed the present renewed petition.

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. Applicant previously satisfied items 1 and 3.

As to item (2), applicant has provided sufficient evidence showing that the non-signing inventor, Mr. Harrison was presented with a complete set of the application papers and declaration and has to date not returned an executed oath or declaration.

Regarding item 4, applicant has presently filed complete declarations executed by the remaining inventors in compliance with 37 CFR 1.497 (a)-(b).

Therefore, applicant has successfully addressed all of the concerns detailed in the decision of 01 September 2005 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(a) is **GRANTED**.

The application has an international filing date of 30 December 2002 under 35 U.S.C. 363, and will be given a date of **27 October 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mr. Mathew Harrison
655/221 Sydney Park Road
Erskineville 2043, NSW
AUSTRALIA

In re Application of
HARRISON, et al.
Serial No.: 10/499,237
PCT No.: PCT/AU02/01752
Int. Filing Date: 30 December 2002
Priority Date: 02 January 2002
Atty Docket No.: RICE-031
For: 2 DIMENSIONAL STRUCTURE QUERIES

Dear Mr. Harrison:

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

Carol M. LaSalle
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United States of America

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GARDNER GROFF, P.C.
2018 POWERS FERRY ROAD
SUITE 800
ATLANTA GA 30339

COPY MAILED

DEC 13 2005

OFFICE OF PETITIONS

Applicant: Lee et al.
Appl. No.: 10/499,245
International Filing Date: February 27, 2003
Title: DIRECT DISTRIBUTION SYSTEM FOR CONSUMER GOODS AND SERVICES
Attorney Docket No.: 2L05.1-011
Pub. No.: US 2005/0080635 A1
Pub. Date: April 14, 2005

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), filed on May 19, 2005, for the above-identified application

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication contains a material error on the front page of the publication, as it improperly includes Bradley K. Groff the attorney of record as the first named inventor.

37 CFR 1.221(b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. [1]

The error noted by requestor wherein the attorney is included as a named inventor is an Office error but the mistake is not a material error under 37 CFR 1.221(b). The mistake does not affect the public's ability to appreciate the technical disclosure of the patent application publication, or determine the scope of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.

[1] Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

On December 14, 2004, a Filing Receipt was mailed, which improperly listed the inventive entity. To avoid this type of problem in the future, applicant's representative should make request a corrected filing receipt.

The Office electronic records have been corrected and a Corrected Filing Receipt is enclosed. The country of citizenship "Korea" listed on the Declaration has been listed as KR for South Korea in the Office electronic records.

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 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

Enclosure: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
10/499,245	06/17/2004	3627	540	2L05.-011	30	41	10

CONFIRMATION NO. 8946

CORRECTED FILING RECEIPT

OC000000017635383

23506
GARDNER GROFF, P.C.
2018 POWERS FERRY ROAD
SUITE 800
ATLANTA, GA 30339

Date Mailed: 12/12/2005

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)

Hohyung Lee, Green Way, GA;

Power of Attorney:

Bradley Groff–39695

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/US03/05941 02/27/2003
which claims benefit of 60/360,356 02/28/2002

Foreign Applications

If Required, Foreign Filing License Granted: 12/11/2005

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/499,245

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

** SMALL ENTITY **

Title

Direct distribution system for consumer goods and services

Preliminary Class

705

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

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

12 NOV 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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SCHIFF HARDIN, LLP
PATENT DEPARTMENT
6600 SEARS TOWER
CHICAGO, IL 60606-6473

In re Application of
NOREN et al.
Application No.: 10/499,253
PCT No.: PCT/SE02/01817
Int. Filing: 04 October 2002
Priority Date: 19 December 2001
Attorney Docket No.: PO4,0057
For: AN IMPLANTABLE HEART STIMULATING DEVICE, A SYSTEM INCLUDING SUCH A DEVICE AND A MANNER OF USING THE SYSTEM

: DECISION ON PETITION
:UNDER 37 CFR 1.47(a)

This is a decision on applicant's "Petition Under 37 CFR 1.47(a) For Filing and Prosecution with Non-Signing Inventor", filed in the United States Patent and Trademark Office (USPTO) on 17 June 2004, to accept the application without the signature of joint inventor, Lars Mandal.

BACKGROUND

On 17 June 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 and the instant petition under 37 CFR 1.47(a). The petition requested the acceptance of the application without the signature of inventor, Lars Mandal, alleging that Mr. Mandal refuses to sign the application.

DISCUSSION

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

The petition included the requisite petition fee, satisfying Item (1). Item (3) is satisfied because the last known address of non-signing inventor 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 declaration under 37 CFR 1.47(a) from Per-Erik Watz, head of the Patent Department of St. Jude Medical AB, regarding attempts by his assistant Christina Barkstedt to obtain the signature of Lars Mandal.

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in 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... It is important that the statement contain facts as opposed to conclusions.
>
> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or , if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
> ....
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a *bona fide* attempt was made to present *a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature*, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

(Emphasis added.)

Mr. Watz indicates that under his supervision, his assistant Christina Barkstedt sent a complete copy of the application to Mr. Mandal. This is not presented as a statement of first hand knowledge by Mr. Watz regarding the contents of the mailing. The non-signing inventor must be provided with a complete copy of the application papers (specification, including claims, drawings, and oath or declaration). A copy of the letter sent to Mr. Mandal was attached but did not itemize the contents of the enclosures. The letter requests return of a Power of Attorney, rather than a declaration. It may be that Mr. Mandal refuses to give a Power of Attorney but would not refuse to sign a declaration. 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.

Mr. Watz states that Ms. Barkstedt sent an E-mail on 16 March 2004 to obtain Mr. Mandal's signature on the declaration, to which Mr. Mandal responded. Thereafter, on 25 March 2004, Ms. Barkstedt sent another E-mail on 25 March 2004, to which Mr. Mandal replied "I have today spoken with Per-Erik about this matter and am waiting for clearer/further information before I can send back the signed documents." Copies of the E-mails, with English translations, were attached to the statement. Mr. Mandal's e-mail response cannot be considered a refusal to sign the application papers.

Mr. Watz further states that "Following these e-mail transmissions, I had at least one telephone discussion with Lars Mandal wherein I again requested that he sign the Declaration, however, he still expressed an unwillingness to sign the Declaration". (Watz Decl., ¶4) In his 08 June 2004 statement, Mr. Watz concludes that based upon the correspondence and his conversation with Lars Mandal, Mr. Mandal refuses to sign the Declaration for the above application.(Watz Decl., ¶5) Mr. Watz indicates that Mr. Mandal was unwilling to sign the declaration. However, Mr. Watz does not specify the time of the refusal in the statement of facts or provide any indication of the reason for Mr. Mandal's "unwillingness". It may be that Mr. Mandal never received a complete copy of the application papers or that he does not wish to sign a Power of Attorney. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition. Thus, at this time it cannot be concluded that Mr. Fiedler refuses to sign the application.

The evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

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

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

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

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

25 JAN 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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SCHIFF HARDIN, LLP
PATENT DEPARTMENT
6600 SEARS TOWER
CHICAGO, IL 60606-6473

In re Application of
NOREN et al.
Application No.: 10/499,253
PCT No.: PCT/SE02/01817
Int. Filing: 04 October 2002
Priority Date: 19 December 2001
Attorney Docket No.: PO4,0057
For: AN IMPLANTABLE HEART STIMULATING DEVICE, A SYSTEM INCLUDING SUCH A DEVICE AND A MANNER OF USING THE SYSTEM

: DECISION ON
: RENEWED PETITION
:UNDER 37 CFR 1.47(a)

This is a decision on applicant's "Request for Reconsideration of Petition Under 37 CFR 1.47(a) For Filing and Prosecution with Non-Signing Inventor", filed in the United States Patent and Trademark Office (USPTO) on 03 January 2005, to accept the application without the signature of joint inventor, Lars Mandal.

BACKGROUND

On 17 June 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 and the instant petition under 37 CFR 1.47(a). The petition requested the acceptance of the application without the signature of inventor, Lars Mandal, alleging that Mr. Mandal refuses to sign the application.

On 12 November 2004, a decision dismissing the petition was mailed indicating that applicant had failed to provide sufficient evidence of Mr. Mandal's refusal to sign the application.

On 03 January 2005, Petitioner filed a Renewed Petition under 37 CFR 1.47(a) accompanied by the declarations of Christina Barkstedt and Anders Fast.

DISCUSSION

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

Petitioner has previously satisfied Item (1), (3) and (4). With regard to Item (2), Petitioner submits the declaration of Christina Barkstedt, patent administrator in the Patent

Department of St. Jude Medical AB, regarding her attempts to obtain the signature of Lars Mandal. Ms. Barkstedt specifically states that "on March 5, 2004, I sent a complete copy of the application to the inventor Lars Mandal at his last known address: Tunvägen 2, 17068 Solna, Sweden." Ms. Barkstedt is a person having firsthand knowledge of the facts recited in her statement and fulfills the requirement to provide the nonsigning inventor with a complete copy of the application papers.

Likewise, Anders Fast's declaration was submitted. Mr. Fast indicates that:

> I spoke with Mr. Mandal on two occasions in mid-April 2004. In those discussions, Mr. Mandal informed me that the reason for his refusal to sign the Combined Declaration for Patent Application and Power of Attorney was that he wanted to be treated in the same way as if he were an employee of St. Jude Medical AB (Mr. Mandal currently being a former employee of St. Jude Medical AB). If Mr. Mandal were treated by St. Jude Medical AB in the same manner as a current employee, he would be compensated by St. Jude Medical AB according to a formula specified under a Collective Bargaining Agreement.
>
> ...Mr. Mandal informed me he still was unwilling to sign the Combined Declaration for Patent Application and Power of Attorney, because he wanted St. Jude Medical AB to acknowledge that the Collective Bargaining Agreement applied to him. Thus, it can be concluded that Mr. Mandal refuses to sign the application.

Mr. Fast's statement indicates that Mr. Mandal was unwilling to sign the Declaration. The evidence submitted supports a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

The petition under 37 CFR §1.47(a) is **GRANTED.**

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 17 June 2004. The application has an international filing date of 04 October 2002 under 35 U.S.C. 363, and a date of 17 June 2004 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

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

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

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: (571) 272-3286

25 JAN 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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LARS MANDAL
TUNVÄGEN 2
17068 SOLNA, SWEDEN

In re Application of
NOREN et al.
Application No.: 10/499,253
PCT No.: PCT/SE02/01817
Int. Filing: 04 October 2002
Priority Date: 19 December 2001
Attorney Docket No.: PO4,0057
For: AN IMPLANTABLE HEART STIMULATING DEVICE, A SYSTEM INCLUDING SUCH A DEVICE AND A MANNER OF USING THE SYSTEM

: DECISION ON
: RENEWED PETITION
:UNDER 37 CFR 1.47(a)

Dear Mr. Mandal:

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

SCHIFF HARDIN, LLP
PATENT DEPARTMENT
6600 SEARS TOWER
CHICAGO, IL 60606-6473

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FISH & RICHARDSON P.C.
P.O BOX 1022
MINNEAPOLIS MN 55440-1022

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SEP 29 2009

OFFICE OF PETITIONS

In re Patent No. 7,514,471
Lindstedt et al.
Issue Date: 04/07/2009
Application No. 10/499261
Filing or 371(c) Date: 03/04/2005
Attorney Docket No.
06275-404US1

ON APPLICATION FOR
PATENT TERM ADJUSTMENT

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(d), filed June 5, 2009. Applicant submits that the correct patent term adjustment is 747 days, not 440 days as calculated by the Office. Applicant requests this correction based upon (1) the Office took in excess of three years to issue this patent, and (2) an assertion that the Office did not apply the proper standard for determining the period of "B Delay" under 35 U.S.C. 154(b)(1)(B).

The request for reconsideration patent term adjustment is **DISMISSED**.

On April 7, 2009, the above-identified application matured into U.S. Patent No. 7,514,471 with a patent term adjustment of 440 days. On June 5, 2009, patentee timely submitted this request for reconsideration of patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 747 days. Patentee asserts that pursuant to Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008), the only way a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) is if they occur on the same day.

Patentees assert that for purposes of calculating the "B Delay," the relevant statutes and regulations require that when calculating "B Delay" for national stage filing under 35 U.S.C. §371, application pendency must be measured from the date that is 30 months from the priority date of the international application. Thus, patentees assert entitlement to an overall adjustment of 747 days ("A Delay" of 470 + "B Delay" of 366 days – 59 overlapping days – 30 days of applicant delay).

OPINION

The Office agrees that as of the filing of the RCE on June 19, 2008, the application was pending three years and 366 days after the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application. The commencement date is the date 30 months from the earliest

priority date claimed in the international application[1]. In this application, the earliest priority date claimed, as shown on the Notice of Acceptance of Application Under 35 U.S.C. § 371 and 37 CFR 1.495, mailed April 22, 2005, is December 19, 2001. Accordingly, the period of adjustment of 366 days pursuant to 37 CFR 1.702(b) and 1.703(b) commenced June 20, 2007 (the day after the date that is three years after June 19, 2004, the day the national stage commenced), and ended June 19, 2008, the date that the RCE was filed.

The Office contends that the period of 366 days of delay in issuance of the patent overlaps with the period of 470 days of examination 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.

[1] The commencement date may be earlier than 30 months where (1) an applicant expressly requested early commencement, and completed all requirements under 35 U.S.C. 371(c), or (2) Demand was timely filed requesting a change in commencement from 20 to 30 months. Neither is applicable here.

> 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A),* 69 Fed. Reg. 34283 (June 21, 2004).

The current wording of § 1.703(f) was revised in response to the misinterpretation of this provision by a number of Patentees. The rule was slightly revised to more closely track the corresponding language of 35 U.S.C. 154(b)(2)(A). The relevant portion differs only to the extent that the statute refers back to provisions of the statute whereas the rule refers back to sections of the rule. This was not a substantive change to the rule nor did it reflect a change of the Office's interpretation of 35 U.S.C. 154(b)(2)(A). As stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding § 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed. The grounds specified in these sections cover the A) guarantee of prompt Patent and Trademark Office responses, B) guarantee of no more than 3-year application pendency, and C) guarantee or adjustments for delays due to interference, secrecy orders and appeals. A section by section analysis of 35 U.S.C. 154(b)(2)(A) specifically provides that:

> Section 4402 imposes limitations on restoration of term. In general, pursuant to [35 U.S.C.] 154(b)(2)(A)-(C), total adjustments granted for restorations under [35 U.S.C. 154](b)(1) are reduced as follows: (1) To the extent that there are multiple grounds for extending the term of a patent that may exist simultaneously (e.g., delay due to a secrecy order under [35 U.S.C.] 181 and administrative delay under [35 U.S.C.] 154(b)(1)(A)), the term should not be extended for each ground of delay but only for the actual number of days that the issuance of a patent was delayed; See 145 Cong. Rec. S14,718[2]

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[2] The AIPA is title IV of the Intellectual Property and Communications Omnibus Reform Act of 1999 (S. 1948), which was incorporated and enacted as law as part of Pub. L. 106-113. The Conference Report for H.R. 3194, 106th Cong. 1st Sess. (1999), which resulted in Pub. L. 106-113, does not contain any discussion (other than the incorporated language) of S. 1948. A section-by-section analysis of S. 1948, however, was printed in the Congressional Record at the request of Senator Lott, See 145 Cong. Rec. S14,708-26 (1999)(daily ed. Nov. 17, 1999).

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 this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the entire period during which the application was pending before the Office, March 4, 2005, as terminated by the filing of the RCE on June 19, 2008. Prior to the filing of the RCE, 470 days of patent term adjustment were accorded for the Office failing to respond within a specified time frame during the pendency of the application. All of the 470 days for Office examination delay overlap with the 366 days of Office delay in issuing the patent. During that time, the issuance of the patent was delayed by 470 days, not 470 days + 366 days. The Office took 14 months and 470 days to issue a first Office action. Otherwise, the Office took all actions set forth in 37 CFR 1.702(a) within the prescribed timeframes. Nonetheless, given the initial 470 days of Office delay, and the time allowed within the time frames for processing and examination, as of the filing date of the RCE, the application was pending three years and 366 days. However, the Office did not delay 470 days and also delay an additional 366 days. Accordingly, 470 days of patent term adjustment was properly entered because the period of delay of 366 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 470 days attributable to grounds specified in § 1.703(b). Entry of both periods is not warranted.

Accordingly, at issuance, the Office did not enter any additional days of patent term adjustment pursuant to 37 CFR 1.702(b).

CONCLUSION

In view thereof, no adjustment to the patent term will be made.

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

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

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

15 MAR 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of	
MORINI et al.	
Serial No.: 10/499,273	
PCT No.: PCT/EP02/14875	DECISION ON SUBMISSION
Int. Filing Date: 20 December 2002	
Priority Date: 24 June 2001	
Attorney's Docket No.: TC 5484 (US)	
For: SEPARATION OF DIASTEREOISMERS	

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

On 18 June 2004, applicants filed a Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371 (Form PTO 1390) along with, *inter alia*, the basic national fee and declaration executed by the inventors, pursuant to PCT Rule 4.17.

On 10 January 2005, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 24 January 2005, applicant filed the instant response accompanied by a copy of the Request for PCT application PCT/EP02/14875, which was filed on 20 December 2002. The Request included the declaration filed under PCT Rule 4.17 and was signed by the inventors.

The International Bureau confirms that the declaration was submitted under PCT Rule 4.17 on 20 December 2002 along with the Request. The declaration identifies each inventor, and states the residency, citizenship and mailing address of each inventor. Thus, the declaration submitted on 20 December 2002 is acceptable and the requirements of 37 CFR 1.497(a) and (b) are met.

The application will be forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing. The 35 U.S.C. 371 date is **18 June 2004.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571)272-3286

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OFFICE OF PETITIONS

In re Patent No. 7,082,901
Issued: August 1, 2006
Application No. 10/499,277
Filed: November 18, 2004
Attorney Docket Number: 4841-005

ON PETITION

This is a decision on the petition under 37 CFR 1.183 and for a certificate of correction under 37 CFR 1.323, filed April 16, 2007, to correct the assignee's name on the front of the Patent. The request is being treated as a request under 37 CFR 3.81(b)[1].

The petition is **DISMISSED**.

Petitioner states that the name of the assignee was incorrectly identified on the Recordation Form Cover Sheet and also on the Fee(s) Transmittal form PTOL-85(b) filed June 15, 2006 and thus incorrectly printed on the front of the patent. Accordingly, petitioner requests that a certificate of correction be issued to reflect the correct name of the assignee on the front page of the Letters Patent.

U.S. Patent and Trademark Office assignment records disclose that an assignment was submitted for recordation on March 31, 2005 identifying the assignee as MARK IV SYSTEMES MOTEURS and that the information provided on the Recordation Form Cover Sheet was recorded as submitted. Further, the assignee noted on the Issue Fee Transmittal (PTOL-85B) filed June 15, 2006 is MARK IV SYSTEMES MOTEURS . Even though the Office assignment records reflected that MARK IV SYSTEMES MOTEURS was the assignee and the PTOL-85(b) was in agreement with the office assignment records, what is printed on the face of the patent is the information printed on the PTOL-85(b). A certificate of correction would be in order if the information provided on the PTOL-85(b) was different from that included in the Office assignment records and it could be proven that the correct assignment information was recorded prior to the payment of the issue fee.

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

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

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

Petitioner may seek to correct the assignment records with the Assignments Branch, however, given the above, a petition to issue a certificate of correction in this instance would not be appropriate since the assignment was recorded precisely as filed and the patent issued in the name of the assignee as it was indicated on the Issue Fee Transmittal.

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

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

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

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

ON PETITION

In re Patent No. 7,082,901 :
Issued: August 1, 2006 :
Application No. 10/499,277 :
Filed: November 18, 2004 :
Attorney Docket Number: 4841-005 :

This is a decision on the renewed petition under 37 CFR 1.183 and for a certificate of correction under 37 CFR 1.323, filed December 10, 2007, to correct the assignee's name on the front of the Patent. The request is being treated as a request under 37 CFR 3.81(b)[1].

The petition is **GRANTED**.

Petitioner states that while the name of the assignee was incorrectly identified on the Recordation Form Cover Sheet and also on the Fee(s) Transmittal form PTOL-85(b) filed June 15, 2006, the name of the assignee was properly noted on the actual assignment. The name of the assignee thus was incorrectly printed on the front of the patent. Accordingly, petitioner requests that a certificate of correction be issued to reflect the correct name of the assignee on the front page of the Letters Patent.

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

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

Even though U.S. Patent and Trademark Office assignment records disclose that the

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

recordation coversheet for the assignment submitted on March 31, 2005 identified the assignee as MARK IV SYSTEMES MOTEURS, the actual assignment document identified the assignee as MARK IV SYSTEMES MOTEURS (SOCIETE ANONYME) and was properly recorded prior to issuance of the patent.

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

The petition fee and the fee for the certificate of correction have been properly posted to the finance records for this patent.

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

This file is being referred to the Certificates of Correction Branch for issuance of a certificate of correction.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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09 AUG 2007

23505
CONLEY ROSE, P.C.
P.O. Box 3267
Houston, TX 77253-3267

In re Application of :
MARATH *et al* :
U.S. Application No.: 10/499,285 :
PCT No.: PCT/SG01/00256 :
Int. Filing Date: 20 December 2001 : **DECISION**
Priority Date: None :
Docket No.: 2060-03000 :
For: HIGH DYNAMIC RANGE RECEIVER :

Applicants' petition to revive under 37 CFR 1.137(b) filed on 03 August 2007 is hereby **GRANTED** as follows:

The basic national fee and the petition fee have been paid. Applicants make the required statement pursuant to 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 in compliance with 37 CFR 1.497(a) and (b) was provided.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 20 December 2001 under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 03 August 2007.

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

#5

18 JUL 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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23505
CONLEY ROSE, P.C.
P.O. Box 3267
Houston, TX 77253-3267

In re Application of :
MARATH *et al* :
U.S. Application No.: 10/499,285 :
PCT No.: PCT/SG01/00256 :
Int. Filing Date: 20 December 2001 : **DECISION**
Priority Date: None :
Docket No.: 2060-03000 :
For: HIGH DYNAMIC RANGE RECEIVER :

This decision is in response to the petition to withdraw the holding of abandonment filed on 09 June 2006. No fee is required.

BACKGROUND

On 04 November 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a declaration in compliance with 37 CFR 1.497(a) and (b) and a $130.00 surcharge fee must be provided. A two-month time period for response was set with extensions of time available pursuant to 37 CFR 1.136(a).

On 22 December 2004, applicants purportedly filed via facsimile a reply to the Form PCT/DO/EO/905 which was accompanied by, *inter alia*, an executed declaration and authorization to charge the surcharge fee to Deposit Account No. 03-2769. These papers were not located in the file and the fee was not charged.

On 11 May 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) stating that the above-captioned application was abandoned.

On 16 May 2006, applicants filed via facsimile copies of the documents purportedly filed via facsimile on 22 December 2004, a copy of the "Confirmation Report" and a copy of an "Auto-Reply Facsimile Transmission" dated 13 May 2004

On 09 June 2006, applicants filed via facsimile a petition to withdraw the holding of abandonment which was accompanied by, *inter alia*, copies of the documents submitted on 16 May 2006.

DISCUSSION

Applicants claim that a response to the Form PCT/DO/EO/905 which included an executed declaration and authorization to charge the required surcharge fee was filed via facsimile on 22 December 2004. However, these papers were not located in the file and USPTO financial records for the above-captioned application show that the surcharge fee has not been charged.

37 CFR 1.8 *Certificate of mailing or transmission*, states in part:

> (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:
>
> (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
>
> (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
>
> (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit 's report confirming transmission may be used to support this statement.

Here, applicants provided a copy of the documents purportedly filed 22 December 2004. Applicants also included an "Auto-Reply Facsimile Transmission" from the USPTO along with a copy of the "TX Report" received on their facsimile machine. Applicants included a statement that the documents were "fax-filled on December 22, 2004."

A review of the evidence provided shows that the USPTO received a facsimile on 22 December 2004. The cover page of the facsimile was titled "FAX TRANSMITTAL COVER SHEET" and lists the proper U.S. application number. The cover page notes that a "Response to Notification of Missing Requirements" was filed 22 December 2004. The "TX Report" shows that a facsimile transmission of 7 pages was submitted on 22 December 2004 and that this transmission was successful.

This evidence meets the requirements of 37 CFR 1.8(b).

CONCLUSION

Applicants' petition to withdraw the holding of abandonment is **GRANTED**.

The Form PCT/DO/EO/909 mailed 11 May 2006 is hereby **VACATED**.

A review of the declaration originally filed 22 December 2004 shows that it is in compliance with 37 CFR 1.497(a) and (b). The surcharge fee of $130.00 has been charged to Deposit Account 03-2769 as authorized.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 20 December 2001, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 22 December 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

0 3 MAY 2007

#9

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23505
CONLEY ROSE, P.C.
P.O. Box 3267
Houston, TX 77253-3267

In re Application of	:	
MARATH *et al*	:	
U.S. Application No.: 10/499,285	:	
PCT No.: PCT/SG01/00256	:	
Int. Filing Date: 20 December 2001	:	**DECISION**
Priority Date: None	:	
Docket No.: 2060-03000	:	
For: HIGH DYNAMIC RANGE RECEIVER	:	

This decision is in response to the declaration filed 26 September 2006.

A communication mailed 27 July 2006 informed applicants that the declaration originally filed 22 December 2002 was not in compliance with 37 CFR 1.497(a)(3). Applicants were given two months to respond.

Applicants submitted another declaration on 26 September 2006. The declaration properly identifies the first inventor as MARATH, Ashok Kumar. However, the declaration fails to include the second inventor, Naveen Altaf Ahmed Syed. Accordingly, the declaration is not in compliance with 37 CFR 1.497(a) & (b).

Thus, the above-captioned application is **ABANDONED**.

If reconsideration of this decision is desired, a response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Applicants may also consider filing a petition to revive under 37 CFR 1.137(b) along with a declaration in compliance with 37 CFR 1.497(a) & (b).

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

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

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#11

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CONLEY ROSE, P.C.
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Houston, TX 77253-3267

In re Application of :
MARATH *et al* :
U.S. Application No.: 10/499,285 :
PCT No.: PCT/SG01/00256 :
Int. Filing Date: 20 December 2001 : **DECISION**
Priority Date: None :
Docket No.: 2060-03000 :
For: HIGH DYNAMIC RANGE RECEIVER :

Applicants' petition to revive under 37 CFR 1.137(b) filed on 03 August 2007 is hereby **GRANTED** as follows:

The basic national fee and the petition fee have been paid. Applicants make the required statement pursuant to 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 in compliance with 37 CFR 1.497(a) and (b) was provided.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 20 December 2001 under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 03 August 2007.

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

#5

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04 JAN 2006

Michael J. Mallie
Blakely Sokoloff Taylor & Zafmann
12400 Wilshire Boulevard, 7th Floor
Los Angeles CA 90025-1030

In re Application of	:	
VON MUTIUS	:	
Application No.: 10/499,289	:	DECISION ON
PCT No.: PCT/EP02/14667	:	
Int. Filing Date: 20 December 2002	:	PETITION UNDER
Priority Date: 20 December 2001	:	
Attorney Docket No.: 6097.P051	:	37 CFR 1.137(b)
For: METHOD FOR OPERATING A WIND POWER PLANT AND A WIND POWER PLANT	:	

This decision is in response to applicant's petition under 37 CFR 1.137(b) filed 12 December 2005.

BACKGROUND

On 20 December 2002, applicant filed international application PCT/EP02/14667 which designated the U.S. and claimed a priority date of 20 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 03 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 June 2004 (20 June 2004 being a Sunday).

On 18 June 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the basic national fee.

On 13 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, *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. The Notification set a two-month extendable time period for reply.

On 12 December 2005, applicant submitted the instant petition under 37 CFR 1.137(b) which was accompanied by, *inter alia*, a declaration of the inventor and the surcharge under 37 CFR 1.492(e).

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 a declaration of inventors in compliance with 37 CFR 1.497(a)-(b) on 12 December 2005.

As to item (2), applicant submitted the petition fee on 12 December 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.

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

MAILED

MAR 31 2010

OFFICE OF PETITIONS

In re Patent No. 7,435,812 :
Pinza et al. : DECISION ON REQUEST FOR
Issue Date: October 14, 2008 : RECONSIDERATION OF
Application No. 10/499,293 : PATENT TERM ADJUSTMENT
Filed: January 10, 2005 : AND NOTICE OF INTENT
Atty Docket No. 253975US0PCT : TO ISSUE CERTIFICATE OF
Title: METHOD FOR PREPARING A : CORRECTION
GLUCOSAMINE COMPOUND AND :
COMPOUND THUS OBTAINED :

This is a decision on the petition filed on December 11, 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 six hundred eighteen (618) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.** The patent term adjustment is corrected to indicate that the term of the above-identified patent is extended or adjusted by **seven hundred fifty-nine (759)** days.

Patentee fails to account for the fact that this is an international application filed under 35 U.S.C. 371(b). The priority date of this application is December 28, 2001. Further, since the requirements for early commencement were not met, the national stage commenced in this application on June 29, 2004. As such, the over three year period is 473 days, beginning on June 30, 2007 and ending on October 14, 2008, the date of issuance of the patent. Further, patentee fails to account for the filing of a Notice of Appeal on March 14, 2008. The 54 days of the over three year period consumed by appellate review is not included in the B delay. *See* 35 U.S.C. §

154(b)(1)(B)(ii). Thus, the B delay is 419 days. The Office has determined that there are zero (0) days of overlap. Thus, the patent term adjustment is increased by 419 days to 759 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 **seven hundred fifty-nine (759)** days.

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

Telephone inquiries specific to this matter should be directed to 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 : 7,435,812 B2

DATED : **October 14, 2008** **DRAFT**

INVENTOR(S) : Pinza et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 340 days

Delete the phrase "by 340 days" and insert – by 759 days--

17 DEC 2004

#5

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DICKSTEIN, SHAPIRO, MORIN & OSHINSKY LLP
1177 Avenue of the Americas (6th Ave)
New York, NY 10036-2417

In re Application of :
WALLING, Alex :
Application No.: 10/499,295 :
PCT Application No.: PCT/SE02/02147 :
Int. Filing Date: 22 November 2002 : **DECISION**
Priority Date: 21 December 2001 :
Attorney Docket No.: E0226.0036/P036 :
For: HANDHELD PRINTING DEVICE :
CONNECTABLE TO A MOBILE UNIT :

This decision is in response to applicant's letter filed 02 December 2004 requesting that the above-captioned application be considered as a continuation of PCT/SE02/02147 instead of as a filing under 35 U.S.C. 371. This letter is treated as a petition under 37 CFR 1.181. No fee is required.

Applicant's petition under 37 CFR 1.181 is hereby **DISMISSED** without prejudice.

The official USPTO Notice published in the Official Gazette at 1077 OG 13 (April 14, 1987) entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371, (the National Stage of PCT)" states, in part, that: "[i]f there are any conflicting instructions as to which section of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111."

A review of the file reveals that the above-captioned application was properly treated by the Office as a filing under 35 U.S.C. 371. Applicant used a transmittal letter (Form PTO-1390) which is intended for a national stage filing under 35 U.S.C. 371 with the initial filing on 21 June 2004. There were no conflicting instructions found in any of the other papers submitted with the transmittal letter.

Accordingly, the above-captioned application was properly abandoned pursuant to 37 CFR 1.495(b)(2) for failing to provide the U.S. Basic National Fee by 30 months.

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). Applicant may also consider filing a petition to revive pursuant to 37 CFR 1.137(a) or (b).

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

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

01 MAR 2005

#7

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Stephen A. Sofen
DICKSTEIN, SHAPIRO, MORIN & OSHINSKY LLP
2101 L Street
Washington, DC 20037-1526

In re Application of :
WALLING, Alex :
U.S. Application No.: 10/499,295 :
PCT No.: PCT/SE02/02147 :
Int. Filing Date: 22 November 2002 :
Priority Date: 21 December 2001 :
Attorney Docket No.: EO226.0036/P036 :
For: HANDHELD PRINTING DEVICE :
CONNECTABLE TO A MOBILE UNIT :

DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)

Applicant's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed on 27 December 2004 is hereby **GRANTED** as follows:

The basic filing fee, search fee, extra claim fee and examination fee of $1,100.00 and the petition fee of $1,500.00 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 has not yet been provided.

Accordingly, this application is being forwarded to the United States Designated/Elected Office for further processing including mailing a Notification of Missing Requirements 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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

17 MAY 2005

#11

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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DICKSTEIN, SHAPIRO, MORIN & OSHINSKY LLP
2101 L Street
Washington, DC 20037-1526

In re Application of :
WALLING, Alex :
U.S. Application No.: 10/499,295 :
PCT No.: PCT/SE02/02147 :
Int. Filing Date: 22 November 2002 : **DECISION**
Priority Date: 21 December 2001 :
Attorney Docket No.: EO226.0036/P036 :
For: HANDHELD PRINTING DEVICE :
CONNECTABLE TO A MOBILE UNIT :

This decision is in response to the "Petition Under 37 C.F.R. 1.182 to Change Inventors Name" submitted on 22 April 2005 which is treated as a petition under 37 CFR 1.182.

BACKGROUND

On 07 March 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) must be provided.

On 22 April 2005, applicants filed the instant petition which was accompanied by, *inter alia*, a petition fee of $130.00, a surcharge fee of $130.00, an executed declaration and a copy of a document in the Swedish language.

DISCUSSION

In the response filed 22 April 2005, petitioners claim that the sole inventor has changed her last name from WALLING to BRETON. As such, a declaration indicating the name change has been provided. Petitioner included a copy of a document in a foreign language and claims that this is "the official Swedish document evidencing and effecting the name change."

This is not sufficient to meet the requirements outlined in the Manual of Patent Examining Procedures (MPEP). Section 605.04(c), *Inventor Changes Name*, of the MPEP states, in part:

The petition must include an appropriate petition fee and an affidavit

signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

In this case, applicant must provide an English translation of the official document used to show the name change of the inventor. The Office will accept and record non-English language documents only if accompanied by an English translation signed by the individual making the translation. *See* 37 CFR 1.52.

It is also noted that the petition fee under 37 CFR 1.182 for questions not specifically provided for increased to $400.00 pursuant to 37 CFR 1.17(f). The $270.00 difference has been charged to Deposit Account No. 04-1073 as authorized.

CONCLUSION

Accordingly, applicant's petition is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182." 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 the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

26 JUL 2005

#13

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Stephen A. Sofen
DICKSTEIN, SHAPIRO, MORIN & OSHINSKY LLP
2101 L Street
Washington, DC 20037-1526

In re Application of :
BRETON, Alex :
U.S. Application No.: 10/499,295 :
PCT No.: PCT/SE02/02147 :
Int. Filing Date: 22 November 2002 : **DECISION**
Priority Date: 21 December 2001 :
Attorney Docket No.: EO226.0036/P036 :
For: HANDHELD PRINTING DEVICE :
CONNECTABLE TO A MOBILE UNIT :

This decision is in response to the "Request for Reconsideration of Decision on Petition Under 37 C.F.R. 1.182 to Change Inventors Name" submitted on 11 July 2005.

BACKGROUND

On 17 May 2005, a decision dismissing applicant's petition to change the name of an inventor was mailed. Applicants were given two months to respond.

On 11 July 2005, applicant filed a renewed petition which was accompanied by an English translation of a Swedish official government document.

DISCUSSION

As previously stated, section 605.04(c), *Inventor Changes Name*, of the MPEP lists the procedures required to change the name of an inventor and states, in part:

> The petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Petitioner claims that the sole inventor has changed her last name from WALLING to BRETON. The initial petition was dismissed because petitioner did not provide an English translation of the official document used to show the name change of the inventor.

In the renewed petition, applicant has provided an English translation of the document as required. A review of this document shows that the inventor has legally

changed her last name to BRETON. This is sufficient for a grantable petition.

Accordingly, the declaration submitted 22 April 2005 is now in compliance with 37 CFR 1.497(a) and (b).

CONCLUSION

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

Applicant has completed the requirements for acceptance under 35 U.S.C. § 371(c). The application has an international filing date of 22 November 2002, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 22 April 2005.

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

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MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
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SUITE 370
ALEXANDRIA VA 22314

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SEP 26 2008

OFFICE OF PETITIONS

In re Application of	:	
Tsutomu Udagawa, et al.	:	
Application No. 10/499,307	:	DECISION GRANTING PETITION
Filed: June 18, 2004	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. KAS-210	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed September 26, 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 September 17, 2008 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This application is being referred to Technology Center AU 3745 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

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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C. IRVIN MCCLELLAND
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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ALEXANDRIA VA 22314

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NOV 30 2006

OFFICE OF PETITIONS

Applicant: Giordano et al.
Appl. No.: 10/499,338
International Filing Date: December 17, 2002
Title: PROCESS FOR PREPARATION OF INCLUSION COMPOUNDS BETWEEN A NON-STEROIDAL ANTI-INFLAMMATORY DRUG AND BETACYCLODEXTRIN BY MICROWAVE TREATMENT
Attorney Docket No.: 254567US0PCT
Pub. No.: US 2005/0042471 A1
Pub. Date: February 24, 2005

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221, received on May 2, 2006, for the above-identified application.

The request is DISMISSED.

The instant request is that the application be republished because the patent application publication contains the contents of another application.

37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. [1]

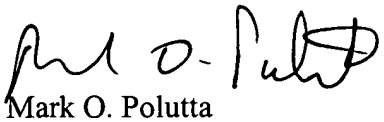
The request for corrected publication received on May 2, 2005, was not timely filed under 37 CFR 1.221(b).

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

[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).

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 (voice).



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

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MAR 16 2007

C. IRVIN MCCLELLAND
OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT, PC
1940 DUKE STREET
ALEXANDRIA, VA 22314

In re Application of	:
Yihua Liao et al	:
Serial No.: 10/499,346	: PETITION DECISION
Filed: February 28, 2005	:
Attorney Docket No.: 254001US0PCT	:

This is in response to the petition under 37 CFR 1.144, filed January 18, 2007, requesting withdrawal of an improper Lack of Unity requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on February 28, 2005, and contained claims 1-130, as filed. In a first Office action, mailed August 22, 2006, the examiner set forth a Lack of Unity between the inventions claimed, as follows:

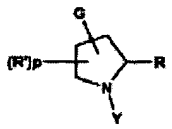
Group I – Claims 77-126 and 128-130, drawn to compounds and compositions where:
G is halogen, optionally substituted alkyl or optionally substituted alkylcarbonate ester,
A is $(CR^2R^3)q$, and
R', p, Y, U, U', B, V and L are defined in claim 1 (sic 77);

Group II – Claims 77-126 and 128-130, drawn to compounds and compositions where:
G is oxo, hydroxyl, optionally substituted alkoxy,
A is $(CR^2R^3)q$, and
R', p, Y, U, U', B, V and L are defined in claim 1 (sic 77);

Group III – Claims 77-126 and 128-130, drawn to compounds and compositions where:
G is halogen, optionally substituted alkyl or optionally substituted alkylcarbonate ester,
A is oxygen or sulfur, and
R', p, Y, U, U', B, V and L are defined in claim 1 (sic 77);

Group IV – Claims 77-126 and 128-130, drawn to compounds and compositions where:
G is carboxylate,
A is oxygen or sulfur, and
R', p, Y, U, U', B, V and L are defined in claim 1 (sic 77);

Group V – Claims 77-126 and 128-130, drawn to compounds and compositions where:
G is carboxylate,
A is $(CR^2R^3)q$, and
R', p, Y, U, U', B, V and L are defined in claim 1 (sic 77);
Group VI – Claims 77-126 and 128-130, drawn to compounds and compositions where:
G is oxo, hydroxyl or optionally substituted alkoxy,
A is oxygen or sulfur, and
R', p, Y, U, U', B, V and L are defined in claim 1 (sic 77);
Group VII – Claims 1-76, drawn to a method of using the products of formula I where:
G is halogen, optionally substituted alkyl or optionally substituted alkylcarboxylate ester;
Y, R and each R' represent hydrogen, alkyl...optionally substituted heteroalkenyl;
Group VIII – Claims 77-126 and 128-130 drawn to compounds and compositions of formula I where:
G is oxo, hydroxyl, or optionally substituted alkoxy;
Y, R and each R' represent hydrogen, alkyl...optionally substituted heteroalkenyl;
Group IX, - Claims 77-126 and 128-130 drawn to compounds and compositions of formula I where:
G is halogen, optionally substituted alkyl or optionally substituted alkylcarboxylate ester;
Y, R and each R' represent optionally substituted heteroaryl, optionally substituted heteroarylalkyl or optionally substituted heteroalicyclicalkyl;
Group X, Claims 77-130 drawn to compounds and compositions of formula I where:
G is oxo, hydroxyl, or optionally substituted alkoxy;
Y, R and each R' represent optionally substituted heteroaryl, optionally substituted heteroarylalkyl or optionally substituted heteroalicyclicalkyl.

Formula I was shown as:  and the pyrrolidine ring described as the common core structure. The ten groups listed were described as exemplary only in view of the number of variables.

The examiner reasoned that the pyrrolidine ring was the only common structure present among all of the compounds and was so well known as to not constitute a special technical feature which defined over the prior art. In view of this, Lack of Unity existed among all of the compounds. The examiner advised of rejoinder if a significant structural element could be described by applicants which would define over the art according to PCT Unity guidelines. Applicants were invited to elect a single invention for further prosecution by defining all variables contained therein.

Applicants replied on September 22, 2006, electing Group I for further prosecution and as a single compound, example 78. Applicants argued that the claims were not independent and distinct, referring to M.P.E.P. 803. Applicants also argued that the members of a Markush group

need possess one property in common which is responsible for the function (activity) of the claimed relationship which applicants then defined as replacing the carbon on the 12th position of the prostanoic nucleus. Applicants also argued that no serious burden existed on the Office to examine all claims.

The examiner mailed a new Office action to applicants on December 1, 2006, acknowledging the election of Group I and the species, and the traversal of the requirement. The examiner noted the arguments for traversal included burden on the Office and dismissed them in part as improper under Lack of Unity guidelines and also because of the plethora of compounds and variables requiring searching in numerous classes and databases. Claims 77-79, 106, 115, 118 and 122-124 were objected to as containing non-elected subject matter. Claims 80-105, 107-114, 116-117, 119-121, 125-126 and 128-130 were also objected to as depending from objected to claims. The examiner identified the compounds of claim 77 where G is halogen, optionally substituted alkyl or optionally substituted alkylcarbonate ester, A is $(CR^2R^3)q$, and R', p, Y, U, U', B, V and L are defined in claim 77 as allowable.

Applicants initiated an interview on December 21, 2006, seeking to broaden the definition of G, but no agreement to do so was reached.

This petition was filed on January 18, 2007, traversing the restriction requirement as being in error. On March 1, 2007, applicants filed a response to the last Office action which has not been considered by the examiner.

DISCUSSION

Applicants argue that the examiner's grouping of the claims is arbitrary and lacks any indication or explanation as to why they were so grouped. Applicants argue that the groups defined are only exemplary and leave open to speculation what other or how many other groups may exist. Applicants also point out inconsistencies and errors in the groupings which make them indefinite as to scope. Applicants argue that the pyrrolidine ring, *per se*, is not the special technical feature, but their use in treatment of prostaglandin disorders. Applicants lastly argue that the Office has shown no undue burden for searching all claims.

Applicants' arguments have been noted as well as the examiner's prosecution of this application. The examiner's finding that the pyrrolidinyl ring is the significant structural element common to all compounds, compositions and methods of use of the compounds and compositions is correct. That the pyrrolidine ring is well-known and present in may compounds and compositions, especially in the pharmaceutical area is also found to be correct. Thus no true Unity of Invention exists for the plethora of compounds and compositions claimed. Further, applicants' argument regarding burden on the Office is inapposite as "burden" is not a consideration on which Unity or Lack of Unity can be based. The Lack of Unity requirement, to the extent it is set forth, is not incorrect.

Applicants are correct that the examiner has given no reason for why the compounds have been grouped as set forth in the Lack of Unity requirement other than that they lack a common special technical feature which is all that is required. Speculatively it may have been based on the

creation of groups of compounds each having a significant structural feature common to all of the compounds, part of which is the pyrrolidine ring, grouped in such a manner as to potentially define over the art. Applicants are also correct that the Lack of Unity requirement appears to be incomplete based on the examiner's statement that the identified groups are only exemplary and the examiner's invitation to applicants to identify any other group which they would wish to have examined which would meet Unity standards.

In view of the above the examiner's' actions are deemed proper. Any deficiency in the Lack of Unity requirement is excused in view of the immense number of compounds encompassed within the scope of the claims and lack of a truly significant structural element upon which the common property or activity is based and which defines over the prior art. The Groups defined by the examiner set forth larger significant structural elements which meet the requirements for Unity, but is not and is not expected to be, exhaustive of all possible groups. Thus the invitation to applicants to provide an alternative grouping which would meet Unity guidelines.

DECISION

The petition is **DENIED.**

The application will be forwarded to the examiner for consideration of the amendment filed March 1, 2007, and further action as appropriate.

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

George C. Elliott.
Director, Technology Center 1600

29 JUL 2004

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Sung I. Oh
Squire, Sanders & Dempsey, LLP
801 S. Figueroa Street, 14th Floor
Los Angeles, CA 90017

In re Application of	:	
WARD, et al.	:	DECISION ON PETITION
Application No.: 10/499,351	:	
PCT No.: PCT/US02/35167	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 01 November 2002	:	
Priority Date: 02 November 2001	:	
Atty. Docket No.: 37100-00102	:	
For: DUAL ANTENNA COIL TRANSPONDER SYSTEM	:	

The petition to revive under 37 CFR 1.137(b) filed 14 June 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing this petition under 37 CFR 1.137(b) and the attached patent application based on the PCT application serial no. PCT/US02/35167 from the thirty (30) month PCT deadline of November 2, 2001 was unintentional", the signed affidavit of David B. Abel 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 treatment in accordance with this decision, specifically the preparation and mailing of a "Notification of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors is required.

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18 NOV 2004

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Charles Gorenstein
Birch, Stewart, Kolasch & Birch, LLP
P.O. Box 747
Falls Church, VA 22040-0747

In re Application of	:	
HAYASHIDA, et al.	:	
Application No.: 10/499,357	:	DECISION ON PETITION
PCT No.: PCT/JP02/12906	:	
Int. Filing Date: 10 December 2002	:	UNDER 37 CFR 1.181
Priority Date: 21 December 2001	:	
Attorney Docket No.: 0020-5245PUS1	:	
For: LIGHT RECEIVING DEVICE, LIGHT RECEIVING UNIT INCORPORATING CIRCUIT AND OPTICAL DISK DRIVE	:	

This decision is in response to applicant's "Petition Under 37 CFR 1.181 Requesting That The Notification of Missing Requirements be Vacated" filed 03 November 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 10 December 2002, applicants filed the international application, which claimed a priority date of 21 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 07 March 2002. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 21 June 2004.

On 18 June 2004, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee, an English translation of the international application, an executed declaration of the inventors and a preliminary amendment.

On 21 September 2004, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant that the number of claims in the international application and the number of claims in the translation were not the same. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

DISCUSSION

Applicant has presently provided an explanation that the subject international application

was republished on 10 February 2003. An examination of the republished international application supplied by applicant shows that it contains seven claims, the same number as listed in the filed English translation. As such, it is proper to grant applicant's petition at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

The Form PCT/DO/EO/905 mailed on 21 September 2001 is hereby **VACATED**.

The application will be given an international filing date of 10 December 2002 under 35 U.S.C. 363 and a date of **18 June 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 (US/DO/EO) for further processing in accordance with this decision, namely the issuance of a "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" (Form PCT/DO/EO/903) indicating a 371 date as detailed above.

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09 SEP 2004

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Daniel B. Ruble
Law Department
Sealed Air Corporation
P.O. Box 464
Duncan, SC 29334

In re Application of
THELE, Bernard :
Application No.: 10/499,382 : DECISION ON PETITION
PCT No.: PCT/EP00/06425 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 06 July 2000 :
Priority Date: 23 July 1999 :
Attorney Docket No.: 43235-01 :
For: PROTECTING LAMINATE FOR AUTOMOTIVE CARPETING :

The petition to revive under 37 CFR 1.137(b) filed 16 June 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "entire delay in submitting the required reply or other required action, from the due date for reply or other action 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). **The above-identified application has been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR .137(b) was unintentional. See Changes to Patent and Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. 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).**

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.

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KIRSCHSTEIN OTTINGER ISRAEL & SCHIFFMILLER
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In re Application of:	:	
MADDERN, Thomas, Slade, et al.	:	
U.S. Application No.: 10/499,389	:	DECISION ON PETITION
PCT No.: PCT/GB02/05702	:	UNDER 37 CFR 1.47(a)
International Filing Date: 16 December 2002	:	
Priority Date: 21 December 2001	:	
Attorney's Docket No.: P/6320	:	
For: COMMUNICATION NETWORK	:	

This decision is issued in response to applicants' petition under 37 CFR 1.47(a) filed on 24 May 2005. Applicants have paid $130 of the required $200 petition fee; Deposit Account No. 11-1145 will be charged the remaining $70.

BACKGROUND

On 16 December 2002, applicants filed international application PCT/GB02/05702. The application claimed a priority date of 21 December 2001 and designated the United States. On 10 July 2003, a copy of the international application was communicated to the United States Patent And Trademark Office (USPTO) by the International Bureau (IB). Payment of the basic national fee was required before the expiration of thirty months from the priority date, i.e., 21 June 2004.

On 17 June 2004, applicants filed a transmittal letter requesting entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 24 March 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required.

On 24 May 2005, applicants filed a response to the Notification Of Missing Requirements. The response included payment for the required surcharge, a declaration executed by two of the three inventors, and the petition under 37 CFR 1.47(a) considered herein. The petition requests acceptance of the application without the signature of the remaining inventor, Richard John PROCTOR, whom applicants assert has refused to execute the application.

DISCUSSION

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

Applicant has submitted a portion of the petition fee and authorized a charge to Deposit Account 11-1145 for additional fees. Item (1) is therefore satisfied.

The "Declaration Under 37 CFR 1.47(a)" executed by Alan ISRAEL expressly states the last known address of the nonsigning inventor. Item (2) is therefore satisfied.

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

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

Here, applicants have submitted a declaration executed by two of the three inventors and containing an unsigned signature block identifying the nonsigning inventor. The declaration is accepted as having been signed by these inventors on their own behalf and on behalf of the nonsigning inventor. Item (3) is satisfied.

With respect to item (4), the "Declaration Under 37 CFR 1.47(a)" executed by Alan ISRAEL provides a firsthand statement confirming that the nonsigning inventor has been provided with a copy of the application and has refused to execute the required documents. Item (4) is satisfied.

Based on the above, applicants have satisfied all the requirements of a grantable petition under 37 CFR 1.47(a).

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

The application is accepted without the signature of nonsigning inventor Richard J. PROCTOR.

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

This application is being forwarded to the National Stage Processing Branch of the PCT Operations Division for further processing in accord with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 24 May 2005.

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KIRSCHSTEIN OTTINGER ISRAEL & SCHIFFMILLER
489 Fifth Avenue
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In re Application of:	:	
MADDERN, Thomas, Slade, et al.	:	
U.S. Application No.: 10/499,394	:	DECISION ON PETITION
PCT No.: PCT/GB02/05703	:	UNDER 37 CFR 1.47(a)
International Filing Date: 16 December 2002	:	
Priority Date: 21 December 2001	:	
Attorney's Docket No.: P/63507	:	
For: COMMUNICATION NETWORK	:	

This decision is issued in response to applicants' petition under 37 CFR 1.47(a) filed on 11 April 2005. Applicants have paid $130 of the required $200 petition fee; Deposit Account No. 11-1145 will be charged the remaining $70.

BACKGROUND

On 16 December 2002, applicants filed international application PCT/GB02/05703. The application claimed a priority date of 21 December 2001 and designated the United States. On 10 July 2003, a copy of the international application was communicated to the United States Patent And Trademark Office (USPTO) by the International Bureau (IB). Payment of the basic national fee was required before the expiration of thirty months from the priority date, i.e., 21 June 2004.

On 17 June 2004, applicants filed a transmittal letter requesting entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 10 January 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required.

On 11 April 2005, applicants filed a response to the Notification Of Missing Requirements (with required extension fee). The response included payment for the required surcharge, a declaration executed by four of the five inventors, and the petition under 37 CFR 1.47(a) considered herein. The petition requests acceptance of the application without the signature of the remaining inventor, Richard John PROCTOR, whom applicants assert has refused to execute the application.

DISCUSSION

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

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

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

Here, applicants have not submitted an acceptable declaration executed by the other inventors on behalf of themselves and the nonsigning inventor. The three pages of declaration submitted appear to be a compilation of more than one copy of the declaration (the pages identified as "2/3" and "3/3" are copies of the same page, though signed by different inventors). 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"). It is also unclear whether the page numbers were added after the declaration was signed; such post-execution modification would be improper. Applicants must submit complete versions of the declarations executed by the signing inventors which comply with the requirements of 37 CFR 1.497 and which can be accepted as having been signed by these inventors on their own behalf and on behalf of the nonsigning inventors. Until such declarations are submitted, item (3) is not satisfied.

Applicants have failed to satisfy all the requirements of a grantable petition under 37 CFR 1.47(a). The petition is therefore not grantable 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** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and should include proper and complete declarations executed by the signing inventors on their own behalf and on behalf of the nonsigning inventor, as discussed above. No additional petition fees are required.

Failure to file a timely and proper response will result in abandonment. Extensions of time are available under 37 CFR 1.136(a).

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

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14 OCT 2005

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#10

KIRSCHSTEIN OTTINGER ISRAEL & SCHIFFMILLER
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New York, NY 10017

In re Application of:	:	
MADDERN, Thomas, Slade, et al.	:	
U.S. Application No.: 10/499,394	:	DECISION ON RENEWED
PCT No.: PCT/GB02/05703	:	PETITION UNDER
International Filing Date: 16 December 2002	:	37 CFR 1.47(a)
Priority Date: 21 December 2001	:	
Attorney's Docket No.: P/63507	:	
For: COMMUNICATION NETWORK	:	

In a decision mailed 15 June 2005, applicants' under 37 CFR 1.47(a) was dismissed without prejudice for failure to provide the outstanding requirements for a grantable petition under 37 CFR 1.47(a). Specifically, applicants had failed to provide an acceptable oath or declaration by the cooperating inventors on their own behalf and on behalf of the non-signing inventor.

On 15 August 2005, applicants filed the renewed petition considered herein. The renewed petition is accompanied by a declaration executed by the four cooperating inventors which contains an unsigned signature block for the nonsigning inventor, Richard John PROCTOR. This declaration satisfies the final requirement for a grantable petition under 37 CFR 1.47(a).

Applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**. The application is accepted without the signature of nonsigning inventor Richard John PROCTOR.

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

This application is being forwarded to the National Stage Processing Branch of the PCT Operations Division for further processing in accord with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 15 August 2005.

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Richard John PROCTOR
28 Diprose Road, Corfe Mullen
Wimborne, Dorset
BH21 2HU
UNITED KINGDOM

In re Application of: MADDERN, Thomas, Slade, et al.
U.S. Application No.: 10/499,394
PCT No.: PCT/GB02/05703
International Filing Date: 16 December 2002
Priority Date: 21 December 2001
Attorney's Docket No.: P/63507
For: COMMUNICATION NETWORK

Dear Mr. PROCTOR:

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

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

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Counsel of Record:
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ARLINGTON VA 22201-4714

In re Application of
SCHMITT et al.
Application No.: 10/499,403
PCT No.: PCT/FR02/02594
Int. Filing Date: 19 July 2002
Priority Date: 20 July 2001
Attorney Docket No.:3665-99
For: COMPOSITIONS DERIVED FROM QUIONOXALINE, PREPARATION AND USE THEREOF

DECISION ON REQUEST

UNDER 37 CFR 1.48(a)(1)

This is a decision on applicants' "Request Pursuant to 37 CFR 1.48(a)(1)", filed on 01 March 2004 in the United States Patent and Trademark Office (USPTO). Petitioner seeks to add Mustapha Abarghaz, Gael Ronsin and Patrick Wagner as inventors in the above referenced application. The requisite $130 petition fee was paid.

BACKGROUND

On 04 June 2004, within the thirty month deadline for filing a national stage application, applicant filed a transmittal requesting entry into national stage under 35 U.S.C. 371 along with the basic national filing fee, an English translation of the international application and a petition to revive.

On 14 July 2004, a decision granting the petition to revive was mailed to applicant. The decision noted that the processing fee for filing an English translation of the international application after the thirty month period has been paid and that the application was being forwarded to the United States Designated/Elected Office for further processing, having a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 04 June 2004.

On 30 July 2004, a Notification of Missing Requirements was erroneously mailed to applicant indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. However, the declaration was filed in the international application under PCT Rule 4.17.

On 20 August 2004, applicant filed a response indicating that the declaration had been filed in the international application along with an itemized postcard receipt indicating that a copy of the declaration had been submitted on 04 June 2004. A review of the international application revealed that the declaration under PCT Rule 4.17 had been submitted to the International Bureau within the time limit set forth in PCT Rule 26ter.1.

On 01 March 2005, applicant filed a petition under 37 CFR 1.48(a)(1) for correction of inventorship, to add Mustapha Abarghaz, Gael Ronsin and Patrick Wagner as inventors. In addition to the $130 petition fee, Petitioner provided the statement of the inventor Messrs.

Abarghaz, Ronsin and Wagner as inventors in support of the correction of inventorship under 37 CFR 1.48(a)(1). A newly executed declaration by the joint inventors was provided.

DISCUSSION

A review of the application file reveals that the 30 July 2004 Notification of Missing Requirements indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was mailed in error. Applicant filed a declaration, in compliance with 37 CFR 1.497(a) and (b), in the international application with the International Bureau on 31 January 2003.

With regard to applicants' petition, applicants satisfied the requirements of 37 CFR 1.48(a)(1) and met all of the requirements to add Mustapha Abarghaz, Gael Ronsin and Patrick Wagner as co-inventors in the above-identified international application.

CONCLUSION

For the reasons discussed above, the submission under 37 CFR 1.48(a)(1) to add Mustapha Abarghaz, Gael Ronsin and Patrick Wagner as inventors is hereby **GRANTED**.

The application will be forwarded to the United States Designated/Elected Office for further processing including issuance of a Notification of Acceptance indicating a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 04 June 2004.

Cynthia M. Kratz
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Boris Milef
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CMK/BM:cmk

14 JUL 2004

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NIXON & VANDERHYE, PC
1100 N GLEBE ROAD
8TH FLOOR
ARLINGTON VA 22201-4714

In re Application of
SCHMITT et al.
Application No.: 10/499,403
PCT No.: PCT/FR02/02594
Int. Filing Date: 19 July 2002
Priority Date: 20 July 2001
Attorney Docket No.: 3665-99
For: COMPOSITIONS DERIVED FROM QUINOLINE AND QUINOXALINE, PREPARATION AND USE THEREOF

DECISION ON

PETITION

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 04 June 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 proper reply, that is, payment of 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.

The processing fee for filing an English translation of the international application after the thirty month period has been paid. 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 04 June 2004.

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

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

OIPE JC109 JUN 04 2004 PATENT & TRADEMARK OFFICE

OIPE JC109 JUN 04 2004

DAE $

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

SCHMITT et al

Atty. Ref.: 3665-99

National Phase of PCT/FR02/02594

Serial No. Unknown

Group:

Filed: June 4, 2004

Examiner:

For: COMPOSITIONS DERIVED FROM QUINOLINE AND QUINOXALINE, PREPARATION AND USE THEREOF

* * * * * * * * * * * *

RECEIVED
JUN 09 2004
OFFICE OF PETITIONS

June 4, 2004

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

RECEIVED
29 JUN 2004
Legal Staff
International Division

Sir:

PETITION UNDER RULE 137(b)

The above-identified application (copy attached) has become unintentionally abandoned at the end of 30 months from its priority date.

The applicants' delay in prosecuting the present application which led to its abandonment was unintentional. The entire delay in filing the required reply from the

Adjustment date: 07/14/2004 WCLAYBRO
06/10/2004 AKELLEY 00000008 10499403
01 FC:1453 -1330.00 OP
02 FC:1999 -1406.00 OP

Rule 137(b) was unintentional.

A Transmittal Letter for filing the National Phase application is attached.

07/14/2004 WCLAYBRO 00000008 10499403
1330.00 OP

A copy of the published international application WO 03/010146A1 (230 pages) is attached.

An English translation of the international application (197 pages) is attached.

An inventors' Declaration is attached.

06/10/2004 AKELLEY 00000008 0202594
01 FC:1453 1330.00 OP
1999 1406.00 OP
Repln. Ref: 07/14/2004 WCLAYBRO 00144306OO
DAM:141140 Name/Number:10499403
FC: 9204 $1406.00 CR

The required basic filing fee, , claims fee and petition fee (totaling $1330) are attached.

The Commissioner is hereby authorized to charge any fee specifically authorized herein, or any deficiency in the fee(s) filed, or asserted to be filed, or which should have been filed herewith or concerning any paper filed hereafter, and which may be required under Rules 16-18 (deficiencies only) now or hereafter relative to this application and the resulting Official Document under Rule 20, or credit any overpayment, to our Deposit Account No. 14-1140, for which purpose a duplicate copy of this Petition is attached. This statement does not authorize charge of the issue fee, and any previous statement read to the contrary is hereby revoked.

In view of the above and the attached, the applicants respectfully submit the present Petition should be granted and the National Phase application be revived. Prompt written notification of same is requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____
B. J. Sadoff
Reg. No. 36,663

BJS:
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
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0 9 DEC 2004

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Joseph Teja, Jr.
LOWRI, LANDO & ANASTASI
Riverfront Office Park
One Main Street, Suite 11
Cambridge, MA 02142

In re Application of:	
KIM, Sung-the, et al.	DECISION ON PETITION TO
U.S. Application No.: 10/499,404	REVIVE ABANDONED
PCT No.: PCT/JP02/13216	APPLICATION UNDER 37
International Filing Date: 18 December 2002	CFR 1.137(b)
Priority Date: 18 December 2001	
Attorney's Docket No.: J2000-7000US	
For: AUTOMATIC APPARATUS FOR BLOOD DIALYSIS AND PRIMING METHOD USING THE APPARATUS	

The petition to revive under 37 CFR 1.137(b) filed 09 November 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply (the payment of fees) from the due date for the reply until the filing of this petition 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: (571) 272-3296
Facsimile: (571) 273-0459

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

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DEC 23 2009

OFFICE OF PETITIONS

In re Patent No. 7,547,816 :
Day, et al. : DECISION ON
Issue Date: June 16, 2009 : REQUEST FOR
Application No. 10/499,407 : RECONSIDERATION OF
Filed: December 2, 2004 : PATENT TERM ADJUSTMENT
Attorney Docket No. IBTI-P01-001 :
// SGM 6938.5 (SIG 045/4)

This is a decision on the "REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. § 1.705," filed August 17, 2009, requesting that the patent term adjustment determination for the above-identified patent be changed from eighty (80) days to one hundred(100) days.

The request for reconsideration of patent term adjustment is **DISMISSED**.

On June 16, 2009, the above-identified application matured into U.S. Patent No. 7,547,816 with a patent term adjustment of 80 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 37 C.F.R. § 1.705(d).

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

Patentees assert entitlement to a patent term adjustment of 100 days (360 + 19 + reduced by 0 overlap - 279 (applicant delay)).

First of all, the over three-year period is 182 days, not 19 days. The application accrued a period of adjustment of 182 days for over three year pendency, calculated from the day after three years after the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, (Monday) June 21, 2004, and ending on December 20, 2007, the day before RCE was

filed.[1] In asserting a period of delay of 19 days, patentees fail to consider that this application is a national stage application[2].

Accordingly, the period of adjustment under § 1.702(b) for over three year pendency is 182 days, counting the number of days beginning on June 22, 2007 and ending on December 20, 2007, the day before the RCE was filed.

Secondly, the Office does not agree with patentees' interpretation of the overlap provision. It is the Office's position that the period for over 3 year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the application filing date overlap with the actual dates in the periods accorded for Office delay during the pendency of the application. The relevant overlap 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, 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.

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

---

[1] The filing of a RCE cuts-off applicants' ability to accumulate any additional patent term adjustment against the three-year pendency provision, but does not otherwise affect patent term adjustment. 37 CFR § 1.703(b)(1).

[2] Patentees are informed that the Three Year Delay period is triggered by the application's commencement date, not the § 371 fulfillment date. Patentees incorrectly calculate this as a 19 day period based on the application having fulfilled requirements under 35 U.S.C. §371 on December 2, 2004, and a Request for Continued Examination (RCE) being filed on December 21, 2007.

term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 Ú.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).

Moreover, as the period subsequent to the filing of an RCE is not included in the three-year time frame specified in 35 U.S.C. 154(b)(1)(B), in cases where an RCE has been filed, 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 application's filing date to the day before the date of filing of a request for continued examination. 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 filing of the request for continued examination (RCE) 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).

As such, the period for over 3 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 application was pending before the Office, June 21, 2004 to December 20, 2007, the day before the date on which the RCE was filed. 293 days of patent term adjustment were accorded prior to the filing of the RCE for the Office failing to respond within specified time frames during the pendency of the application. All of the 182 days for Office delay in issuing the patent overlap with the 293 days of Office delay (67 days were accorded subsequent to the filing of the RCE).

The 182 days attributed to the delay in the issuance of the patent overlaps with the adjustment of 293 days attributable to the ground specified in 37 C.F.R. § 1.702(a)(1). Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment for the Office taking in excess of 3 years to issue the patent.

With respect to patentees' argument that applicant delay in connection with the amendment under 37 CFR 1.312, filed on April 23, 2009, was calculated incorrectly, patentees are reminded that the period is calculated from the date the amendment under 1.312 was filed and ends on the date of the mailing of the supplemental Office action or a Notice of Allowance or four months. In this instance, the period is measured from April 23, 2009 to April 30, 2009, which is 8 days, not 7 as patentees' argue.

In view thereof, no adjustment to the patent term will be made.

As a one time courtesy, a copy of this decision will be mailed to the address listed on the petition. If a change in correspondence address/fee address is desired, appropriate documents should be filed.

Telephone inquiries specific to this matter should be directed to Shirene Willis Brantley, Senior Attorney, at (571) 272-3230.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

CC: TIMOTHY B. MCBRIDE
SENNIGER POWERS LLP
100 NORTH BROADWAY, 17TH FLOOR
ST. LOUIS MO 63102

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

Mail Date: 04/21/2010

Applicant	: Billy N. Day	: DECISION ON REQUEST FOR
Patent Number	: 7547816	: RECALCULATION of PATENT
Issue Date	: 06/16/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/499,407	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 12/02/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **215** 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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ROPES & GRAY LLP
PATENT DOCKETING 39/41
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

Mail Date: 05/18/2010

Applicant : Billy N. Day
Patent Number : 7547816
Issue Date : 06/16/2009
Application No: 10/499,407
Filed : 12/02/2004

: 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 **262** 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).

05 JAN 2005

#4

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Lorusso Loud & Kelly LLP
Pease International Tradeport
15 Rye Street
Suite 312
Portsmouth NH 03801

In re Application of	:	
CARLI et al.	:	
Application No.: 10/499,409	:	DECISION ON
PCT No.: PCT/EP02/14472	:	
Int. Filing Date: 18 December 2002	:	PETITION UNDER
Priority Date: 19 December 2001	:	
Attorney Docket No.: NBG-105	:	37 CFR 1.137(b)
For: PHARMACEUTICAL COMPOSITION COMPRISING AN OIL/WATER/OIL DOUBLE MICROEMULSION INCORPORATED INTO A SOLID SUPPORT	:	

This decision is in response to applicants' "PETITION FOR REVIVAL OF APPLICATION" filed in the United States Patent and Trademark Office (USPTO) on 03 November 2004, which has been treated as a petition under 37 CFR 1.137(b).

BACKGROUND

On 18 December 2002, applicants filed international application PCT/EP02/14472 which designated the U.S. and claimed a priority date of 19 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 at midnight on 21 June 2004 (19 June 2004 being a Saturday).

On 18 June 2004, applicants filed a transmittal letter for entry into the national stage in the United States. The Transmittal Letter was not accompanied by a check for the U.S. Basic National Fee and did not include an authorization to charge the U.S. Basic National Fee to a Deposit Account.

On 01 November 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States of America for failure to provide the full U.S. Basic National Fee by thirty months.

On 03 November 2004, applicants submitted the instant "PETITION FOR REVIVAL OF APPLICATION" which has been treated as a petition 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), applicants submitted the U.S. Basic National Fee on 03 November 2004.

As to item (2), applicants submitted the petition fee on 03 November 2004.

As to item (3), petitioner's statements regarding the "unintentional omission of authorization to charge the deposit order account" has been construed as meaning that the "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional." If this interpretation is incorrect, applicant must *immediately* notify the Office of PCT Legal Administration of such fact.

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

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PEASE INTERNATIONAL TRADEPORT
SUITE 312
15 RYE STREET
PORTSMOUTH NH 03801

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OFFICE OF PETITIONS

In re Application of :
Carli, et al. :
Application No. 10/499,409 : ON PETITION
Filed: June 18, 2004 :
Attorney Docket No. NBG-105 :

This is a decision on the petition to revive under 37 CFR 1.137(b), filed November 7, 2008.

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

The above-identified application became abandoned for failure to timely file a reply in response to the Office action mailed November 29, 2007. This Office action set a shortened statutory period for reply of one (1) month. No response having been received, the application became abandoned on December 30, 2007. The Office mailed a Notice of Abandonment on October 8, 2008.

With the instant petition, petitioner made the proper statement of unintentional delay, paid the petition fee, and submitted the required reply in the form of an Election.

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 forwarded to Group Art Unit 1615 for consideration of the Election filed November 7, 2008.

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

Cliff Congo
Petitions Attorney
Office of Petitions

cc: Lorusso & Associates
PO Box 21915
Portsmouth NH 03802

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MOORE, HANSEN & SUMNER, PLLP
225 SOUTH SIXTH ST
MINNEAPOLIS MN 55402

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OFFICE OF PETITIONS

In re Application of	:	
Ockenden, Lynn Marie	:	DECISION ON PETITION
Application No. 10/499,427	:	TO WITHDRAW
Filed: October 1, 2004	:	FROM RECORD
Attorney Docket No. O3-008-03-US	:	

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 24, 2006.

The request is **APPROVED**.

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

The request was signed by Robert C. Freed on behalf of all attorneys of record who are associated with Customer Number 22854.

All attorneys/agents associated with Customer Number 22854 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

Telephone inquires concerning this decision should be directed to Petitions Examiner Liana Chase at (571) 272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

David Bucci
Petitions Examiner
Office of Petitions

Cc: SHAWN DEMPSTER
45 ISLAND ROAD
NORTH OAKS MN 55127

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Paper No.

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON DC 20007

MAILED

JUL 20 2010

OFFICE OF PETITIONS

In re Patent No. 7,481,266	:	DECISION ON REQUEST
Demuth et al.	:	FOR
Issue Date: January 27, 2009	:	RECONSIDERATION OF
Application No. 10/499,440	:	PATENT TERM ADJUSTMENT
Filed: June 21, 2004	:	and
Atty Docket No. 016906-0317	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION

This is a decision on the petition filed on March 25, 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 one (901) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.** The patent term adjustment is corrected to indicate that the term of the above-identified patent is extended or adjusted by **nine hundred twenty-eight (928)** days.

The "B" delay period is 949 days. In an international application, the over 3 year pendency period is based on the failure of the Office to issue a patent within three years after the national stage commenced under 35 U.S.C. 371(b) or (f). See 1.702(b). In this instance, the national stage commencement date is Monday, June 23, 2003 (not June 21, 2004, the date used by patentees for this calculation). The priority date of this application is December 21, 2001. As the requirements for early commencement were not met, the national stage commenced in this application at the end of the thirty-month period. Further, 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. Accordingly, the commencement date is Monday, June 23, 2003. Thus, the over 3 year period is 949 days, counting the number of days beginning on June 24, 2006 and ending on January 27, 2009, the date of issuance of the patent. However, 245 days of this period beginning on June 24, 2006 and ending on February 23, 2007 overlap with the A delay. Accordingly, the patent term adjustment is increased by 704 days for "B" delay. (The period of adjustment of 35 days entered at issuance for "B" delay is being removed and the 704 days entered).

Moreover, the Office delay pursuant to 37 CFR §§ 1.702(a)(1) and 1.703(a)(1) should have been entered as 460, not 551 days. The requirements of 35 U.S.C. 371 were not fulfilled on June 21, 2004, but rather were fulfilled with the filing of a declaration for patent on September 20, 2004. Given the first Office action was mailed on February 23, 2007, the period of Office delay is 460 days.

In view thereof, the correct patent term adjustment is 928 days, which is 1164 (460 + 704) days of Office delay - 236 days of applicant delay.

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

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

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 twenty-eight (928) 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 : 7,481,266 B2

DATED : **January 27, 2009** **DRAFT**

INVENTOR(S) : Demuth 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 350 days

Delete the phrase "by 350 days" and insert – by 928 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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MACCORD MASON PLLC
300 N. GREENE STREET, SUITE 1600
P. O. BOX 2974
GREENSBORO, NC 27402

COPY MAILED

DEC 11 2006

OFFICE OF PETITIONS

In re Application of :
Mark K. Seifert :
Application No. 10/499,461 : DECISION ON PETITION
Filed: June 18, 2004 : TO WITHDRAW
Attorney Docket No. 7426-005-1A : 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 18, 2006.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to MacCord Mason, PLLC has been revoked by the assignee of the patent application on November 2, 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 April Wise at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: Mark Seifert
107 Saint Brides Court
Cary, NC 27518

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
10/499,461	06/18/2004	Mark K. Seifert	1209-005P

CONFIRMATION NO. 8955

OC000000021542653

OC000000021542653

04678
MACCORD MASON PLLC
300 N. GREENE STREET, SUITE 1600
P. O. BOX 2974
GREENSBORO, NC 27402

Date Mailed: 12/08/2006

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 11/02/2006.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

April M Wise

APRIL M WISE
OP (571) 272-1642

FORMER ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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INTELLECTUAL PROPERTY GROUP
FREDRIKSON & BYRON, P.A.
200 SOUTH SIXTH STREET, SUITE 4000
MINNEAPOLIS, MN 55402

Mail Date: 05/05/2010

Applicant	: Toshiaki Anzaki	: DECISION ON REQUEST FOR
Patent Number	: 7612015	: RECALCULATION of PATENT
Issue Date	: 11/03/2009	: TERM ADJUSTMENT IN VIEW
Application No	: 10/499,462	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 05/20/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1069** 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

PITTS AND BRITTIAN P C
P O BOX 51295
KNOXVILLE TN 37950-1295

In re Application of
SHOFNER et al.
Serial No.: 10/499,473
PCT App. No.: PCT/US01/24183
Int'l Filing Date: 01 August 2001
Priority Date: 01 August 2000
Attorney Docket No.: 26276.10
For: GENERATION, DELIVERY, MEASUREMENT AND CONTROL OF AEROSOL, BOLI FOR DIAGNOSTICS AND TREATMENTS OF OF THE RESPIRATORY/PULMONARY TRACT OF A PATIENT

DECISION ON

PETITION UNDER

37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 17 June 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 $50 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 **17 June 2004.**

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

03 NOV 2004

#3

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

In re Application of STEPHANOU Serial No.: 10/499,483 PCT App. No.: PCT/AP01/00001 Int'l Filing Date: 20 August 2001 Priority Date: None Attorney Docket No.: U 015188-5 For: AN INTERCHANGEABLE MULTI-PURPOSE COOKING APPARATUS	DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 18 June 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 $540 was provided. The required petition fee of $665 was also paid. Thus, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office for further processing. The $65 surcharge for filing the declaration after the thirty month will be charged to applicant's deposit account per his authorization. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is **18 June 2004.**

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: —

DATE : 6/11/07

TO SPE OF : ART UNIT 2877

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/499507 Patent No: 7215427B2

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: _____

SPE

2886
Art Unit

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OFFICE OF PETITIONS

DAVIS BUJOLD
& DANIELS, P.L.L.C.
112 PLEASANT STREET
CONCORD NH 03301

In re Application of :
Schwenger, et al. :
Application No. 10/499,512 : DECISION
Filed: 21 June 2004 :
Attorney Docket No. ZAHFRI P637US :

This is a decision on the petition, filed on 29 September, 2008, considered as a petition under 37 C.F.R. §1.137(b) to revive the application as having been abandoned due to unintentional delay.

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

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

BACKGROUND

The record reflects that:

Applicant, failed to reply timely and properly to the Notice of Allowance/Allowability and Fees Due mailed on 10 April, 2008, with reply due under a non-extendable deadline on or before 10 July, 2008.

The application went abandoned after midnight 10 July, 2008.

The Office mailed the Notice of Abandonment on 7 August, 2008.

On 29 September, 2008, Petitioner filed the instant petition with fee, a reply in the form of fees due, 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.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2] The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[3]))

As to Allegations of Unintentional Delay

The requirements under 37 C.F.R. §1.137(b) have been satisfied.

CONCLUSION

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

---

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

[2] 35 U.S.C. §133 provides:

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

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

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

The instant application is released to Publications Branch to be processed into a patent 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 Publications Branch in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the Publications Branch where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[4]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

---

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

§1.2 Business to be transacted in writing.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 4-23-08

Paper No.: _____

TO SPE OF : ART UNIT 3661

SUBJECT : Request for Certificate of Correction on Patent No.: 7319917 10/499516

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.

Should drawing be entered?

Eva James

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-305-8309

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

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

Comments:

_____

_____

_____

_____

_____

SPE 3661 **Art Unit**

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21 JUL 2006

CONNOLLY BOVE LODGE & HUTZ, LLP
P O BOX 2207
WILMINGTON, DE 19899

In re Application of BIESGEN :
U.S. Application No.: 10/499,518 :
PCT Application No.: PCT/EP02/14302 :
Int. Filing Date: 16 December 2002 : DECISION
Priority Date Claimed: 20 December 2001 :
Attorney Docket No.: 532622007500 :
For: METHOD FOR THE TRANSFORMATION :
OF PLANT PLASTIDS :

This is in response to applicant's "Request for Withdrawal of Holding of Abandonment or in the Alternative, Petition to Revive" filed 17 July 2006.

BACKGROUND

On 16 December 2002, applicant filed international application PCT/EP02/14302, which claimed priority of an earlier Germany application filed 20 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 03 July 2003. The thirty-month period for paying the basic national fee in the United States expired on 21 June 2004 (20 June 2004 was a Sunday).

On 21 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 25 February 2005, applicant's previous representative filed a request to withdraw as attorney.

On 01 April 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 a translation of the drawings and a copy of the sequence listing in computer readable form was required.

International application PCT/EP02/14302 became abandoned as to the United States for failure to timely respond to the Notification of Missing Requirements.

On 17 July 2006, applicant filed the present request to withdraw the holding of abandonment, which is being treated as a petition under 37 CFR 1.181, or in the event the petition under 37 CFR 1.181 is not granted, a petition under 37 CFR 1.137(b).

DISCUSSION

I. Petition Under 37 CFR 1.181

37 CFR 1.36(b) states in relevant part, "A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director."

MPEP 402.06 states in relevant part, "The **withdrawal is effective when approved** rather than when received." (Emphasis in original.)

In the present case, the request to withdraw as attorney had not been approved before the Notification of Missing Requirements was mailed. Therefore, because the request to withdraw as attorney was not yet effective, the Notification of Missing Requirements was sent to the correct address, and the holding of abandonment due to applicant's failure to respond to the Notification of Missing Requirements was proper.

II. Petition Under 37 CFR 1.137(b)

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

With regard to item (2), the required petition fee will be charged to Deposit Account No. 03-2775 as authorized in the petition.

With regard to item (3), the petition states, "[T]he total delay of the application up until the abandonment was unintentional. . . .Applicants did not intend for this application to be abandoned." 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.

III. Additional Observations

A review of the drawings submitted on 21 April 2004 reveals that an English translation of the drawings is not required.

CONCLUSION

For the reasons in §I above, the petition under 37 CFR 1.181 is DISMISSED without prejudice.

For the reasons in §II above, the petition under 37 CFR 1.137(b) is GRANTED.

For the reasons in §III above, the portion of the Notification of Missing Requirements mailed 01 April 2005 which required a translation of the drawings and the associated processing fee is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 16 December 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 21 June 2004.

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

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21 JUL 2006

MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 300
MCLEAN, VA 22102

In re Application of BIESGEN :
U.S. Application No.: 10/499,518 :
PCT Application No.: PCT/EP02/14302 :
Int. Filing Date: 16 December 2002 : DECISION
Priority Date Claimed: 20 December 2001 :
Attorney Docket No.: 532622007500 :
For: METHOD FOR THE TRANSFORMATION :
OF PLANT PLASTIDS :

This is in response to applicant's "Request for Withdrawal as Attorney or Agent" filed 25 February 2005.

BACKGROUND

On 16 December 2002, applicant filed international application PCT/EP02/14302, which claimed priority of an earlier Germany application filed 20 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 03 July 2003. The thirty-month period for paying the basic national fee in the United States expired on 21 June 2004 (20 June 2004 was a Sunday).

On 21 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 25 February 2005, the present request to withdraw as attorney was filed.

DISCUSSION

MPEP 402.06 states in relevant part,

> The Director of the United States Patent and Trademark Office usually requires that there be at least 30 days between approval of withdrawal and the later of the

> expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a). This is so that the applicant will have sufficient time to obtain other representation or take other action. If a period has been set for reply and the period may be extended without a showing of cause pursuant to 37 CFR 1.136(a) by filing a petition for extension of time and fee, the practitioner will not be required to seek such extension of time for withdrawal to be approved. In such a situation, however, withdrawal will not be approved unless at least 30 days would remain between the date of approval and the last date on which such a petition for extension of time and fee could properly be filed.

In the present case, at least 30 days remain between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

CONCLUSION

For the reasons above, the request for withdrawal as attorney or agent is ACCEPTED.

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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OCT 24 2006

OFFICE OF PETITIONS

Morrison & Foerster LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

In re Application of :

Petra Verhoef et al. :
Application No. 10/499,532 : DECISION ON PETITION
Filed: August 25, 2004 : TO WITHDRAW
Attorney Docket No. 246152022900 : 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 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 Thomas Ciotti on behalf of all attorneys of record.

All attorneys/agents have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

There is no outstanding Office action at this time.

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

Amelia Au
Petitions Examiner
Office of Petitions

cc: **Petra Verhoef**
Rietveldlaan 29
6411 TE HEERLEN, the Netherlands
Dutch, Netherlands

cc: **Mr. Brian H. Davidson**
Nixon & Vanderhye P.C.
11th Floor
901 Glebe Road
Arlington, VA 22203-1808

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

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MAR 16 2009

OFFICE OF PETITIONS

In re Application of
Guillaume Bichot et al
Application No. 10/499,541
Filed: June 21, 2004
Attorney Docket No. PU010315

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 17, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the nonfinal rejection mailed April 22, 2008, is accepted as having been unintentionally delayed.

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

This application is being referred to Technology Center AU 2617 for appropriate action by the Examiner in the normal course of business on the reply received February 17, 2009.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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OFFICE OF PETITIONS

CALFEE HALTER & GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND OH 44114

In re Application of :
Lloyd. :
Application No. 10/499,548 : DECISION
Filed: 21 June, 2004 :
Attorney Docket No. 29204/04001 :

This is a decision on the petition filed on 5 June, 2007, and supplemented on 20 September, 2007, and considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.

The petition as considered under 37 C.F.R. §1.181 is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the final Office action mailed on 24 November, 2006, with reply due on or before 24 February, 2007;
- the application went abandoned after midnight 24 February, 2007;
- it does not appear that the Office mailed the Notice of Abandonment on 31 May, 2007;
- on 5 June, 2007, Petitioner filed the instant petition with, *inter alia*:

— an averment (with copies of the papers in question) that a reply was filed on 29 May, 2007, over a 24 May, 2007, certificate of mailing (and request and fee for extension of time) in the form of a request for continued examination (RCE) with fee and, as the submission under 37 C.F.R. §1.114, in the form of an amendment; and

- on 20 September, 2007, Petitioner supplemented his petition with a copy of the dates-stamped ("MAY 29 2007") receipt card (see: MPEP §503).

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[2]

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.

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

See specifically, the regulations at 37 C.F.R. §10.18.

[3] 35 U.S.C. §133 provides:

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

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

The 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.

Petitioner appears to have satisfied the showing requirements herein.

---

[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).

CONCLUSION

Petitioner appears to have satisfied the burdens herein, and the petition as considered under 37 C.F.R. §1.181 is **granted** and the 31 May, 2007, Notice of Abandonment is **vacated**.

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

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[9]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

---

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

§1.2 Business to be transacted in writing.

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

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MORRISON & FOERSTER LLP
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SAN DIEGO CA 92130-2040

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OFFICE OF PETITIONS

In re Application of
Jan G. Kortes
Application No. 10/499,550
Filed: December 18, 2006
Attorney Docket No. 246152022200

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 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 Thomas E. Ciotti on behalf of all attorneys of record who are associated with this application.

All attorneys/agents associated with this 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 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). The power of attorney filed on September 29, 2006 does not include one of the above two options.

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: Jan Gerrit Kortes
Can Daatselaarhof 18
3833 HV Leusden
The Netherlands

cc: Mr. Bryan H. Davidson
Nixon & Vanderhye, P.C.
901 North Glebe Road
11th Floor
Arlington, VA 22203-1808

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ARLINGTON, VA 22203

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OFFICE OF PETITIONS

In re Application of
Jan Gerrit Kortes
Application No. 10/499,550
Filed: June 21, 2004
Attorney Docket No. 4662-345

DECISION ON REQUEST FOR REVOCATION OF POWER OF ATTORNEY

This is a decision on the Request to Revoke the attorney or agent of record under 37 C.F.R. § 1.36(a), filed September 29, 2006.

The request is **NOT APPROVED**.

A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceeding of a case by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant under § 3.71(b). Fewer than all of the applicants (or by fewer than the assignee of the entire interest of the applicant) may only revoke the power of attorney upon a showing of sufficient cause, and payment of the petition fee set forth § 1.17(h). For the assignee to take action a proper statement under § 3.73(b) is required.

The request cannot be approved because the statement under 3.73(b) is not proper or no statement under 3.73(b) was filed.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number). The power of attorney filed on September 29, 2006 does not include the reel and frame number on the 3.73(b) statement.

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

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: DSM IP ASSETS B.V.
HET OVERLOON
6411 TE HEERLEN
NETHERLANDS

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THOMSON LICENSING LLC
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JUL 27 2007

OFFICE OF PETITIONS

In re Application of :
Brian David Bajgrowicz et al :
Application No. 10/499,555 : ON PETITION
Filed: June 21, 2004 :
Attorney Docket No. PU010313 :

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the Issue fee and Publication fee in a timely manner in reply to the Notice of Allowance mailed December 8, 2006, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on March 9, 2007.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the Issue fee and Publication fee; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the issue fee is accepted as having been unintentionally delayed.

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

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

Irvin Dingle
Petitions Examiner
Office of Petitions

10 JAN 2005

#5

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

In re Application of	:	
MAHLER et al.	:	DECISION ON
Application No.: 10/499,569	:	
PCT No.: PCT/EP02/13223	:	PAPERS
Int. Filing Date: 25 November 2002	:	
Priority Date: 12 December 2001	:	UNDER 37 CFR 1.42
Attorney's Docket No.: MERCK-2890	:	
For: LYOPHILISED PREPARATION COMPRISING ANTIBODIES AGAINST THE EFG RECEPTOR	:	

This is a decision on the submission filed by applicants on 22 November 2004, which was accompanied by, *inter alia*, a declaration of the inventors. The indication in this declaration that inventor Ludwig Kruger is deceased has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 25 November 2002, applicants filed international application PCT/EP02/13223 which claimed a priority date of 21 December 2001 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 June 2004.

On 21 June 2004, applicants filed, *inter alia*, a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee.

On 28 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) 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 22 November 2004, applicants filed the instant submission which was accompanied by, *inter alia*, a declaration of inventors and the surcharge under 37 CFR 1.492(e). The indication in this declaration that inventor Ludwig Kruger is deceased has been treated as a request for status under 37 CFR 1.42.

DISCUSSION

The declaration filed 22 November 2004 fails to comply with 37 CFR 1.497(a)-(b).

-First, it is not clear from the declaration whether the information below Margarete Kruger's name is her residence, mailing address, and citizenship, or if it is the residence, mailing address, and citizenship of Ludwig Kruger. Additionally, the declaration does not include the residence, mailing address and citizenship of the person(s) signing on behalf of the deceased inventor (37 CFR 1.497(b)(2)) in addition to the full name *and citizenship* of the deceased inventor (37 CFR 1.497(a)(3)).

-Second, under 37 CFR 1.42, the declaration must include the signature of the legal representative or the signature of all of the heirs (or if there is only one heir, the sole heir). If the declaration is signed by a legal representative, the declaration should state that this person is the legal representative. Alternatively, applicants' attorney may file a statement certifying that the person signing is the legal representative. If the declaration is not signed by a legal representative and does not indicate that the persons signing are all of the heirs (or the sole heir), then it must be accompanied by a statement by either those signing or by the attorney which sets forth (1) that they are in fact all the heirs of the deceased and (2) that no legal representative of the deceased's estate has been appointed or is required by the applicable law to be appointed.

CONCLUSION

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

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.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

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

16 MAR 2005

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In re Application of	:	
MAHLER et al.	:	DECISION
Application No.: 10/499,569	:	
PCT No.: PCT/EP02/13223	:	
Int. Filing Date: 25 November 2002	:	
Priority Date: 12 December 2001	:	
Attorney's Docket No.: MERCK-2890	:	
For: LYOPHILISED PREPARATION COMPRISING ANTIBODIES AGAINST THE EFG RECEPTOR	:	

This is a decision on the "RENEWED SUBMISSION UNDER 37 CFR 1.42" filed by applicants on 10 March 2005, which was accompanied by, *inter alia*, three declarations of the inventors.

BACKGROUND

On 25 November 2002, applicants filed international application PCT/EP02/13223 which claimed a priority date of 21 December 2001 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 June 2004.

On 21 June 2004, applicants filed, *inter alia*, a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee.

On 28 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) 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 22 November 2004, applicants filed a submission which was accompanied by, *inter alia*, a declaration of inventors and the surcharge under 37 CFR 1.492(e). The indication in this declaration that inventor Ludwig Kruger is deceased was treated as a request for status under 37 CFR 1.42.

On 10 January 2005, a decision was mailed refusing applicants' request for status under 37 CFR 1.42.

On 10 March 2005, applicants filed the instant "RENEWED SUBMISSION UNDER 37 CFR 1.42", which was accompanied by, *inter alia*, three declarations of the inventors.

DISCUSSION

Request for Status Under 37 CFR 1.42

The submission filed 10 March 2005 has been reviewed and has been found in compliance with 37 CFR 1.42.

Change of Name Due to Marriage

One of the declarations of inventors filed 10 March 2005 identifies one of the inventors as Ulrike Altenburger rather than Ulrike Martini-Marr. The renewed submission indicates that this change in name is due to marriage. The Manual of Patent Examining Procedure at § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include (1) the appropriate petition fee and (2) an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

With regard to item (1), the petition fee has not been paid.

With regard to item (2), applicants have not provided an affidavit signed with both names setting forth the procedure whereby the change of name was effected, nor was a certified copy of the court order provided.

CONCLUSION

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

For the reasons set forth above, the petition under 37 CFR 1.182 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 1.182".

A proper response must include an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Failure to timely file a proper response to this decision in a timely manner will result in abandonment of the application with regards to national stage prosecution in the United States.

Please direct 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
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20 JUN 2005

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Millen, White, Zelano, Branigan, PC
2200 Clarendon Blvd., Suite 1400
Arlington, VA 22201

In re Application of	:	
MAHLER et al	:	
Application No.: 10/499,569	:	
PCT No.: PCT/EP02/13223	:	
Int. Filing Date: 25 November 2002	:	DECISION
Priority Date: 21 December 2001	:	
Atty. Docket No.: MERCK-2890	:	
For: LYOPHILISED PREPARATION	:	
COMPRISING ANTIBODIES...	:	

This is a decision on applicants' "RENEWED PETITION UNDER 37 CFR 1.182" filed in the U.S. Patent and Trademark Office (USPTO) on 06 April 2005. The petition was accompanied by a "DECLARATION OF NAME CHANGE TO ACCOMPANY PETITION UNDER 37 CFR 1.182." The petition is **GRANTED** as discussed below.

On 16 March 2005, this Office mailed a decision which granted applicants' renewed request under 37 CFR 1.42, but which dismissed applicants' petition under 37 CFR 1.182 to record a change in the name of one of the inventors. The petition was dismissed on the grounds that the requisite petition fee and the requisite statement setting forth the reason for the name change had not been submitted.

A review of the present submission reveals that applicants have now submitted the requisite statement, and the requisite petition fee of **$400** has been charged to counsel's Deposit Account No. **13-3402** as authorized in the renewed petition.

The application has an international filing date of 25 November 2002, under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (2), and (4) date of **10 March 2005**.

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

27 JUN 2005
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Myers Bigel Sibley & Sajovec, PA
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Raleigh, NC 27627

In re Application of	:	
COLBERT, Adrian	:	
Application No.: 10/499,570	:	DECISION ON
PCT No.: PCT/GB02/05829	:	
Int. Filing Date: 20 December 2002	:	PETITION UNDER
Priority Date: 21 December 2001	:	
Attorney Docket No.: 9052-196	:	37 CFR 1.47(b)
For: ABSORBENT ARTICLES WITH BUFFER	:	

This is a decision on applicant's "Petition Under 37 C.F.R. §1.47(b)," filed in the United States Patent and Trademark Office (USPTO) on 27 April 2005.

BACKGROUND

On 20 December 2002, applicant filed international application PCT/GB02/05829, which claimed a priority date of 21 December 2001. A copy of the international application was transmitted to the United States Patent and Trademark Office on 10 July 2003. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 21 June 2004.

On 21 June 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 24 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 21 April 2005, applicant submitted a petition under 37 CFR 1.47(b), accompanied by the fee for a five 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(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 the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1), (2), (3) and (6) have been met. (1) The petition fee of $130 under 37 CFR 1.17(h) has been paid. (2) Applicant has furnished evidence that the inventor has refused to execute a declaration of inventorship after presentation with a complete copy of the application papers. (3) Applicant states the last known mailing address of Mr. Adrian Colbert as 124 Litchfield Close; Four Oaks, Sutton Coldfield; B74

2TA; Great Britain. (4) The declaration complies with 37 CFR 1.47 and 37 CFR 1.497(a)-(b). (6) Applicant has demonstrated that irreparable harm will result if the application is not permitted to proceed.

Item (5) has not been met. Applicant has provided a job description and an employment handbook to establish proprietary interest. Neither appears to be signed by Mr. Colbert. As such, neither can function as an agreement to assign the invention. MPEP 409.03(f). In the absence of either a written agreement to assign or an assignment, applicant must demonstrate sufficient proprietary interest in the invention. Id. Such proprietary interest may be demonstrated by an appropriate legal memorandum, as set forth in MPEP 409.03(f):

> A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

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 P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

06 OCT 2005

#9

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Myers Bigel Sibley & Sajovec, PA
PO Box 37428
Raleigh, NC 27627

In re Application of	:	
COLBERT, Adrian	:	
Application No.: 10/499,570	:	DECISION ON
PCT No.: PCT/GB02/05829	:	
Int. Filing Date: 20 December 2002	:	PETITION UNDER
Priority Date: 21 December 2001	:	
Attorney Docket No.: 9052-196	:	37 CFR 1.47(b)
For: ABSORBENT ARTICLES WITH BUFFER	:	

This is a decision on applicant's "Response to Decision on Petition Under 37 C.F.R. 1.47(b)," filed in the United States Patent and Trademark Office (USPTO) on 29 September 2005.

BACKGROUND

On 20 December 2002, applicant filed international application PCT/GB02/05829, which claimed a priority date of 21 December 2001. A copy of the international application was transmitted to the United States Patent and Trademark Office on 10 July 2003. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 21 June 2004.

On 21 June 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 24 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 21 April 2005, applicant submitted a petition under 37 CFR 1.47(b), accompanied by the fee for a five month extension of time.

On 27 June 2005, the Office mailed Decision On Petition Under 37 CFR 1.47(b) dismissing applicants petition without prejudice. The decision set a two month extendable period for reply.

On 29 September 2005, applicants filed the instant renewed petition with a certificate of mailing indicating that was deposited in first class mail on 27 September 2005.

DISCUSSION

The fee for a one month extension of time will be charge to deposit account no. 50-0220, as authorized.

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 the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1), (2), (3), (4) and (6) were previously satisfied.

Item (5) has not been satisfied. Applicants have attempted to establish proprietary interest through submission of a legal memorandum, accompanied by a declaration from Christopher Fuller. MPEP 409.03(f) states:

> 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.

Mr. Fuller does not claim that all of the information in his declaration is his firsthand knowledge. See Declaration ¶14. The facts in support of the legal memorandum must be set out by one with firsthand knowledge of those facts.

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 P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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26 JUN 2006

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PO Box 37428
Raleigh, NC 27627

In re Application of	:	
COLBERT, Adrian	:	
Application No.: 10/499,570	:	DECISION ON
PCT No.: PCT/GB02/05829	:	
Int. Filing Date: 20 December 2002	:	PETITION UNDER
Priority Date: 21 December 2001	:	
Attorney Docket No.: 9052-196	:	37 CFR 1.47(b)
For: ABSORBENT ARTICLES WITH BUFFER	:	

This is a decision on applicant's "Response to Decision on Petition Under 37 C.F.R. 1.47(b)," filed in the United States Patent and Trademark Office (USPTO) on 01 December 2005.

BACKGROUND

On 06 October 2005, the Office mailed Decision On Petition Under 37 CFR 1.47(b) dismissing applicants petition without prejudice.

On 01 December 2005, applicant filed the instant renewed petition accompanied by a revised statement of facts from Mr. Christopher Fuller.

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 the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1), (2), (3), (4) and (6) were previously satisfied.

Item (5) has now been satisfied. Applicants have supplied a legal memorandum from Michael Robert Harrison to establish proprietary interest supported by a revised declaration from Christopher Fuller.

CONCLUSION

For the above reasons, applicant's 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 **27 April 2005**.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
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26 JUN 2006

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Mr. Adrian Colbert
124 Litchfield Close
Four Oaks, Sutton Coldfield
B74 2TA
Great Britain

In re Application of
COLBERT, Adrian
Application No.: 10/499,570
PCT No.: PCT/GB02/05829
Int. Filing Date: 20 December 2002
Priority Date: 21 December 2001
Attorney Docket No.: 9052-196
For: ABSORBENT ARTICLES WITH BUFFER

Dear Mr. Colbert:

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
PCT Legal Administration

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Raleigh, NC 27627

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

Mail Date: 06/01/2010

Applicant	: Jacob Hendrik De Greef	: DECISION ON REQUEST FOR
Patent Number	: 7622691	: RECALCULATION of PATENT
Issue Date	: 11/24/2009	: TERM ADJUSTMENT IN VIEW
Application No	: 10/499,582	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/27/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **933** 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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COATS & BENNETT, PLLC
1400 Crescent Green, Suite 300
Cary, NC 27518

Mail Date: 04/21/2010

Applicant	: Rance Cleaveland	: DECISION ON REQUEST FOR
Patent Number	: 7644398	: RECALCULATION of PATENT
Issue Date	: 01/05/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/499,583	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 02/18/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1043** 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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COATS & BENNETT, PLLC
1400 CRESCENT GREEN, SUITE 300
CARY NC 27518

MAILED

APR 20 2010

OFFICE OF PETITIONS

In re Application of :
Rance Cleaveland et al :
Application No. 10/499,583 : DECISION ON REQUEST FOR REFUND
Filed: June 18, 2004 :
Attorney Docket No. 6263-001 :

This is a decision on the Request For Refund filed February 2, 2010.

The request is **DISMISSED**.

Applicant request a refund of the large entity portion of the filing fee ($558) paid on June 18, 2004 and the surcharge fee ($65) paid on February 18, 2005.

The request for refund is dismissed because the large entity fees were paid more than three months prior to the request for refund on February 2, 2010. Note 37 CFR 1.28(a), which only provides a three month window for refunds of large entity fees.

A review of Office records show that small entity status was not indicated on the Transmittal Letter submitted with the application upon filing on June 18, 2004.

In view of the above, the request for refund in this matter is not appropriate and is therefore dismissed.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

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DEC 13 2007

OFFICE OF PETITIONS

In re Patent No. 7,001,174 :
Issue Date: February 21, 2006 :
Application No. 10/499,591 : ON PETITION
Filed: June 18, 2004 :
Patentee(s): Shugen Hu, et. al. :

This is a decision on the petition under 37 CFR 1.183 filed on July 17, 2006, which is being treated as a petition under 37 CFR 3.81[1], to correct the order of the assignee on the front page of the above-identified patent by way of a Certificate of Correction. The delay in responding is regretted.

The petition is **GRANTED**.

The order of the names of the assignee will be corrected to reflect the assignment records as recorded in the USPTO at reel 016035 and frame 0884 as follows:

1. Ningbo Xinhai Electronics Manufacture Co., Ltd.

2. Zhejiang University

This patent file is being forwarded to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3226. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

Andrea Smith
Petitions Examiner
Office of Petitions

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

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KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND, OR 97204

Mail Date: 04/21/2010

Applicant	: Dennis M. Klinman	: DECISION ON REQUEST FOR
Patent Number	: 7615227	: RECALCULATION of PATENT
Issue Date	: 11/10/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/499,597	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/17/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1306** 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.

08 MAR 2005

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#3

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J. Mitchell Jones
Medlen & Carroll, LLP
101 Howard Street, Suite 350
San Francisco, CA 94105

In re Application of	:	
Khomchenko	:	
Application No.: 10/499,606	:	
PCT No.: PCT/RU01/00303	:	
Int. Filing Date: 25 July 2001	:	DECISION
Priority Date: 12 September 2000	:	
Attorney Docket No.: KNAUTHE-09066	:	
For: Method Of Laser Depilation	:	

The petition to revive under 37 CFR 1.137(b) filed 16 June 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 $540.00 was provided. The required petition fee of $665.00 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 filing of an oath or declaration of the inventor in compliance with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(e).

Boris Milef
PCT Legal Examiner
PCT Legal Office

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

22 DEC 2004

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J. Mitchell Jones
Medlen & Carroll, LLP
101 Howard Street, Suite 350
San Francisco, CA 94105

In re Application of :
KHOMCHENKO, Vladimir Valentinovich :
Application No.: 10/499,610 : DECISION
PCT No.: PCT/RU01/00304 :
Int. Filing Date: 25 July 2001 : ON PETITION UNDER
Priority Date: 12 September 2000 :
Docket No.: KNAUTHE-09067 : 37 CFR 1.137(b)
For: METHOD FOR LASER COAGULATING :
BLOOD VESSELS :

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 16 June 2004 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 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

Telephone: 571-272-3292
Facsimile: 571-273-0459

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04 OCT 2006

Gerald T. Shekleton
WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, IL 60606-3913

In re Application of :
HISAO IGA :
Appl. No.: 10/499,612 : DECISION UNDER
PCT No.: PCT/JP02/13214 : 37 CFR 1.181
Int. Filing Date: 18 December 2002 :
Priority Date: 18 December 2001 :
Agent's File Reference: 1110/92335 :
For: SILICON WAFER AND METHOD FOR PRODUCTION OF SILICON WAFER

Applicant's 18 July 2006 "Petition for Revival" has been received. The 18 July 2006 petition is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment. No petition fee is required. The petition is **GRANTED.**

BACKGROUND

On 16 June 2004, applicant filed U.S. application 10/499,612 as a national stage entry of international application PCT/JP02/13214. An english translation of the specification, claims abstract and drawings was not included with the application papers.

On 28 December 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) informing applicant that an english translation of the specification, claims, abstract and drawings.

On 18 January 2005, applicant filed a response to the Form PCT/DO/EO/905 mailed 28 December 2004 forwarding a surcharge in the amount of $130.

On 25 February 2005, the DO/EO/US mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO 916) indicating that the requirement for an english translation and for a translation of the text in the drawings remains outstanding.

On 12 July 2006, the DO/EO/US mailed a "NOTIFICATION OF ABANDONMENT"

(Form PCT/DO/EO/909) informing applicants that U.S. application 10/499,612 is abandoned because applicants purportedly failed to respond to the Form PCT/DO/EO/905 mailed 28 December 2004.

On 18 July 2006, applicant filed the present petition requesting that the Form PCT/DO/EO/909 mailed 12 July 2006 be vacated.

DISCUSSION

MPEP at section 503 provides that:

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

A review of the papers filed with the present petition reveals that applicant filed a response to the Form PCT/DO/EO/905 on 18 January 2005. The copy of the return receipt postcard itemizes, inter alia, "English translation of specification". Furthermore, a review of the drawings filed on 16 June 2004 reveals that the drawings do not require an english translation of the text. Therefore, the english translation of the specification may properly be accepted in lieu of the original filed on 18 January 2005. The Form PCT/DO/EO/909 mailed 12 July 2006 was sent in error.

CONCLUSION

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is **GRANTED.** The Form PCT/DO/EO/909 mailed 12 July 2006 is hereby **VACATED.** This application is being returned to the DO/EO/US for further processing in accordance with this decision.

Leonard Smith
Supervisory PCT Legal Examiner
Office of PCT Legal Administration

JSF/LS:jf

Jeremy Fleming
Paralegal Specialist
Office of PCT Legal Administration

(571) 272-3284

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EAST HANOVER NJ 07936-1080

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OFFICE OF PETITIONS

In re Application of :

GREIL, et al. :
Application No. 10/499,616 : DECISION ON PETITION
Filed: October 4, 2004 : TO WITHDRAW
Attorney Docket No. 32339A : 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 16, 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, "transfer files" does not meet any of the conditions set forth in 37 CFR 10.40.

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

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

Denise Pothier
Petitions Examiner
Office of Petitions

cc: **D. Peter Hochberg Co., LPA**
1940 East 6th Street, 6th Floor
Cleveland, OH 44114-2294

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OFFICE OF PETITIONS

In re Application of :
GREIL, et al. :
Application No. 10/499,616 : DECISION ON PETITION
Filed: October 4, 2004 : TO WITHDRAW
Attorney Docket No. IB/G-32339A : 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, 2006.

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

A review of the file record indicates that the power of attorney to John D. Thallemer has been revoked by the applicant of the patent application on November 20, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **D. PETER HOCHBERG CO, PLA**
1940 EAST 6TH STREET, 6TH FLOOR
CLEVELAND, OH 44114

22 MAY 2007

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GLAXOSMITHKLINE
Corporate Intellectual Property
P.O. Box 1539
King of Prussia, PA 19406-0939

In re Application of	:	DECISION ON
Coulton et al	:	
Application No.: 10/499,621	:	
PCT No.: PCT/GB02/05819	:	
Int. Filing Date: 10 February 1999	:	PETITION UNDER
Priority Date: 10 February 1998	:	
Attorney's Docket No.: 7238/OH418	:	
For: APPARATUS FOR EXCTUING ACTIVITIES...	:	
IN SUCH AN APPARATUS	:	37 CFR 1.181

This decision is in response to applicants' "Communication" filed on 24 February 2006, which is being treated as a petition under 37 CFR 1.181 requesting the Date of Completion of all 35 USC 371 requirements is 12 April 2005 and not as stated in the PCT/DO/EO/903 (26 April 2005).

BACKGROUND

On 21 June 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 copy of the international application. However, no executed Declaration as set forth by 35 U.S.C. 371(c)(4) was filed on such time.

On 04 April 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the oath or declaration complying with 37 CFR 1.497(a) and (b), identifying the application by International application number and international filing date must be furnished within the time period set forth. The notification set a two (2) month time limit or 32 months from the priority date for the application, whichever is later to respond. Failure to properly respond would result in abandonment.

On 12 April 2005, applicants filed, inter alia, an executed declaration.

On 26 April 2005, an executed declaration for application 10/512,766 was mistakenly placed in application 10/499,621.

A Notification of Acceptance (Form PCT/DO/EO/903) was mailed on 29 June 2005 stating that the Date of Receipt of 35 USC 371 (c)(1), (c)(2), and (c)(4) requirements and the Date of Completion of All 35 USC 371 Requirements is 26 April 2005.

On 23 August 2005, a second Notification of Acceptance (Form PCT/DO/EO/903) was mailed stating that the Date of Receipt of 35 USC 371 (c)(1), (c)(2), and (c)(4) requirements was 12 April 2005 and the Date of Completion of All 35 USC 371 Requirements is 26 April 2005.

On 24 February 2006, applicant filed on the current petition.

DISCUSSION

A review of the file shows that the correct executed declaration for application 10/499,621 was filed on 12 April 2005. Thus, the date of receipt of 35 USC 371(c)(1), (c)(2), and (c)(4) requirements and the date that all of the requirements under 35 U.S.C. 371 have been satisfied is 12 April 2005.

DECISION

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

The Notification of Acceptances (Form PCT/DO/EO/903) mailed on 29 June 2005 and 23 August 2005 are **VACATED** with the mailing of this decision.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371 and for issuing a new PCT/EO/DO/ form 903. The 35 USC 371(c)(1), (c)(2), and (c)(4) date and the date of completion of all 35 USC 371 requirements of this application is **12 April 2005.**

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3276
Fax: (571) 273-0459

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MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

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OFFICE OF PETITIONS

In re Application of :
WARMERDAM, et al. :
Application No. 10/499,627 : DECISION ON PETITION
Filed: June 21, 2004 : TO WITHDRAW
Attorney Docket No. 4662-346 : 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 29, 2006.

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 October 20, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to Patricia Volpe at (571) 272-6825.

Volpe for

David Bucci
Petitions Examiner
Office of Petitions

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

06 JUN 2006

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ARLINGTON VA 22204

In re Application of	:	DECISION ON
Ulf GRAWUNDER et al	:	
Application No. 10/499,631	:	
PCT No.: PCT/EP01/15303	:	
Int. Filing Date: 22 December 2001	:	
Priority Date: NA	:	PETITION UNDER
Attorney's Docket No.: STURK0014	:	
For: METHOD FOR THE GENERATION	:	
OF GENETICALLY MODIFIED...	:	
BINDING PROTEINS	:	37 CFR 1.137 (b)

This decision is in response to applicants' "PETITION FOR REVIAVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)," filed on 12 September 2005.

BACKGROUND

On 22 December 2001, this international application was filed. The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 23 June 2004.

On 04 March 2004, applicant filed a Transmittal letter for entry into the national stage in the United States Patent and Trademark Office (USPTO), which was accompanied by, the basic national fee. No executed declaration or oath was filed at such time.

On 04 January 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the oath or declaration complying with 37 CFR 1.497(a) and (b), identifying the application by the International application number and International filing date must be furnished within the time period set forth. The notification set a two months time limit or 32 months from the priority date for the application, whichever is later to respond, and that failure to properly respond would result in abandonment.

The deadline for filing the executed declaration in response to the Notification of Missing Requirements mailed on 04 January 2005 was 04 August 2005.

On 04 March 2005, applicants submitted a response to the Notice of Missing Requirements. However, it did not include an executed declaration.

On 12 September 2005, applicants filed the instant petition under 37 CFR 1.137(b), and an executed declaration.

On 09 November 2005, the United States Designated/Elected Office erroneously mailed a Notification of Acceptance (Form PCT/DO/EO/903) and it incorrectly informed the applicants the 35 USC 37(c)(1),(c)(2), and (c)(4) date of this application is 04 March 2005.

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 an executed declaration, (2) the petition fee set forth in §1.17(m) and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Accordingly, the petition is deemed to satisfy requirements (1) - (4) under 37 CFR 1.137(b).

Because the United States Designated/Elected Office erroneously mailed a Notification of Acceptance (Form PCT/DO/EO/903), the Notification of Acceptance (Form PCT/DO/EO/903) mailed on 09 November 2005 is **VACATED** with the mailing of this decision.

DECISION

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

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing. The 35 USC 371(c)(1),(c)(2), and (c)(4) date of this application is **12 September 2005.**

A new Notification of Acceptance (Form PCT/DO/EO/903) will be mailed stating the correct date of receipt of 35 USC 371(c)(1), (c)(2), and (c)(4) requirements.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 73-0459

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OFFICE OF PETITIONS

In re Application of
GRAWUNDER, Ulf et al.
Application No. 10/499,631
Filed: September 12, 2005
Attorney Docket No. **STURK0014**

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 June 13, 2008 and re-submitted on July 11, 2008.

The request is **NOT APPROVED**.

The Office has revised its change in procedure for request to withdraw from representation applies to requests filed on or after May 12, 2008.

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 acts (1) thru (3) noted in the above-identified certifications have been performed.

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 Tredelle Jackson at 571-272-2783.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

cc: **MR. JOACHIM STURKEN**
BIO TECH PARK
ENGESSERSTRASSE 4 A
FREIBURG D-79108

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OFFICE OF PETITIONS

In re Application of :
GRAWUNDER, Ulf et al. :
Application No. 10/499,631 : DECISION ON PETITION
Filed: September 12, 2005 : TO WITHDRAW
Attorney Docket No. **STURK0014** : 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 11, 2008.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. 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 Joerg Szipl on behalf of all attorneys of record who are associated with customer No. 24203. All attorneys/agents associated with the Customer Number 24203 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: **ULF GRAWUNDER**
BIRSSTRASSE 94
BASEL CH-4052
SWITZERLAND

cc: **4-ANTIBODY AG**
PHARMAZENTRUM
KLINGELBERGSTRASSE 50
BASEL CH-4056
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OFFICE OF PETITIONS

In re Application :
Ulf Grawunder et al. :
Application No. 10/499,631 : DECISION ON APPLICATION
Filed: September 12, 2005 : FOR PATENT TERM ADJUSTMENT
Attorney Docket No. :
2265.0220000/TJS/CFN

This is in response to the Request for Reconsideration of Patent Term Adjustment Under 37 C.F.R. § 1.705(b) filed December 18, 2009. Applicant requests that the determination of patent term adjustment be corrected from 314 days to 26 days. Applicant also believes that at least 703 (910 less 207) days of PTA should be added due to PTO delay under 37 C.F.R. §1.702(b) and 35 U.S.C. §154(b)(1)(B) upon actual issuance of a patent in the above-captioned application, based on calculations to date. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

To the extent that this 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 patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the 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 such a request as premature.

With respect to the over 3 year calculation, rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the Notice of Allowance, the application for patent term adjustment is **GRANTED**.

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is twenty-six (26) days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On September 18, 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 340 days. Applicants assert that an additional circumstance constituting a failure to engage was the abandonment of the application on March 4, 2005.

The instant application for patent term adjustment was timely filed[1] on or before payment of the issue fee.

37 C.F.R. § 1.704(c) states:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment

[1] PALM records indicate that the issue fee was paid on December 18, 2009.

set forth in § 1.703 to the extent that the periods are not overlapping:

> (3) Abandonment of the application or late payment of the issue fee, 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 date of abandonment or the date after the date the issue fee was due and ending on the earlier of:
>
> (i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or
>
> (ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

Therefore, Applicants should have been assessed delay for the period from March 4, 2005 (the date the application became abandoned) to January 12, 2006 (the date the decision reviving the application was mailed), or 314 days.

In view thereof, the determination of Patent Term Adjustment at the time of the mailing of the notice of allowance is TWENTY-SIX (26)days (428 days of Office delay reduced by 402 days of applicant delay).

The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office and 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 Patricia Faison-Ball at (571) 272-3212.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of Revised PALM Screen

Day : Tuesday
Date: 5/11/2010

PALM INTRANET

Time: 13:32:40

PTA Calculations for Application: 10/499631			
Application Filing Date:	09/12/2005	PTO Delay (PTO):	428
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	88
Post-Issue Petitions:	0	Total PTA (days):	26
PTO Delay Adjustment:	-314		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
100	05/11/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		88	
99	05/11/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		226	
86	09/18/2009	MAIL NOTICE OF ALLOWANCE			
85	09/14/2009	DOCUMENT VERIFICATION			
84	09/14/2009	ISSUE REVISION COMPLETED			
83	09/14/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
82	09/14/2009	CASE DOCKETED TO EXAMINER IN GAU			
81	09/14/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
79	09/14/2009	EXAMINER'S AMENDMENT COMMUNICATION			
78	09/14/2009	NOTICE OF ALLOWABILITY			
75	08/25/2009	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
74	08/25/2009	CORRESPONDENCE ADDRESS CHANGE			
72	08/14/2009	DATE FORWARDED TO EXAMINER			
71	08/13/2009	AMENDMENT AFTER FINAL REJECTION			
70	05/14/2009	MAIL FINAL REJECTION (PTOL - 326)			
69	05/11/2009	FINAL REJECTION			
67	07/11/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	45
66	01/16/2009	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
65	02/26/2009	DATE FORWARDED TO EXAMINER			
64	01/16/2009	RESPONSE AFTER NON-FINAL ACTION			
63	10/16/2008	MAIL NON-FINAL REJECTION			
62	10/14/2008	NON-FINAL REJECTION			

61	07/11/2008	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
55	09/29/2008	MAIL-PETITION DECISION - GRANTED			
54	09/29/2008	PETITION DECISION - GRANTED			
53	09/11/2008	PETITION ENTERED			
52	09/26/2008	CORRESPONDENCE ADDRESS CHANGE			
50	09/04/2008	MAIL-PETITION DECISION - DISMISSED			
49	09/04/2008	PETITION DECISION - DISMISSED			
48	07/11/2008	REFERENCE CAPTURE ON IDS			
47	07/11/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
46	07/29/2008	DATE FORWARDED TO EXAMINER			
45	07/11/2008	RESPONSE TO ELECTION / RESTRICTION FILED		88	39
44	07/11/2008	REQUEST FOR EXTENSION OF TIME - GRANTED			
42	07/11/2008	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
41	06/13/2008	PETITION ENTERED			
40	04/22/2008	CASE DOCKETED TO EXAMINER IN GAU			
39	01/14/2008	MAIL RESTRICTION REQUIREMENT	428		34
38	01/07/2008	REQUIREMENT FOR RESTRICTION / ELECTION			
34	09/12/2005	371 COMPLETION DATE			
33	06/08/2006	APPLICATION RETURN FROM OIPE			
32	06/09/2006	NOTICE OF DO/EO ACCEPTANCE MAILED			
31	09/12/2005	ADDITIONAL APPLICATION FILING FEES			
30	09/12/2005	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
29	11/09/2005	PRE-EXAM OFFICE ACTION WITHDRAWN			
28	06/08/2006	APPLICATION RETURN TO OIPE			
27	06/06/2006	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
26	09/12/2005	PETITION ENTERED			
21	12/28/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
17	12/28/2005	CASE DOCKETED TO EXAMINER IN GAU			
16	11/25/2005	CLEARED BY OIPE CSR			
15	11/25/2005	CLEARED BY OIPE CSR			
14	11/25/2005	CLEARED BY OIPE CSR			

13	11/25/2005	CLEARED BY OIPE CSR			
12	11/25/2005	CLEARED BY OIPE CSR			
11	11/25/2005	CLEARED BY OIPE CSR			
10	11/25/2005	CLEARED BY OIPE CSR			
8	11/09/2005	APPLICATION DISPATCHED FROM OIPE			
7	11/09/2005	NOTICE OF DO/EO ACCEPTANCE MAILED			

Search Another: Application# [ ] Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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March 26, 2007

Michael P. Byrne
NOVAK DRUCE & QUIGG, LLP
1300 Eye St., N. W.
Washington, D.C. 20005

Patent No.: 7,015,169 B2
Application No.: 10/499,633
Inventor(s): **FÖTTINGER, et al.**
Issued: **March 21, 2006**
Title: **CATALYST SYSTEMS OF THE ZIEGLER-NATTA TYPE AND THEIR PREPARATION**

Re: Request for Certificate of Correction

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

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

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

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

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

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

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

By mail:	Mail Stop PETITIONS Commissioner for Patents Post Office Box 1450 Alexandria, VA 22313-1450
By hand:	Customer Service Window Mail Stop Petitions Randolph Building 401 Dulany Street Alexandria, VA 22314
By fax:	(571) 273-0025 ATTN: Office of Petitions

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

Virginia Tolbert
For Cecelia Newman
Decisions & Certificate of Correction Branch
(703) 305-8309 or (703) **308-9390 ext 113**

vt

16 DEC 2004

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Armstrong, Kratz, Quintos, Hanson & Brooks
Suite 1000, 1725 K Street, NW
Washington, D.C. 20006

In re Application of :
FUKUI et al. :
Application No.: 10/499, 652 : DECISION ON REQUEST
PCT No.: PCT/JP02/13705 :
Int. Filing Date: 26 December 2002 :
Priority Date: 28 December 2001 :
Attorney Docket No.: 040308 :
For: INFORMATION PRESENTING SUBSTANCE-CONTAINING MATERIAL, AND IDENTIFICATION METHOD, IDENTIFICATION SYSTEM AND DEVICE THEREOF

This is a decision on the request regarding the correction of the second inventor's name filed 23 November 2004 notifying the Office that the correct spelling of the second inventor's name is YOSHIHITO Miyako as indicated on the declaration rather than Fukuhito Miyako as indicated on the published international application.

As indicated in Section 201.03 of the Manual of Patent Examining Procedure, where a typographical or transliteration error in the spelling of an inventor's name is discovered, a petition under 37 CFR 1.48 is not required. Accordingly, applicant's explanation of the difference in the spelling of the second inventor's name is accepted and noted for the record.

For the reasons above, the request is **GRANTED**.

This application is being forwarded to the United States Designated/Elected Office for further processing and for review of the national stage papers submitted 23 November 2004.

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

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OFFICE OF PETITIONS

Morrison and Foerster LLP
755 Page Mill Rd
Palo Alto, CA 94304

In re Application of :
Mylene Caussette et al. :
Application No. 10/499,663 : DECISION ON PETITION
Filed: November 16, 2004 : TO WITHDRAW
Attorney Docket No. 246152022600 : 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 29, 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 the firm Morrison & Foerster has been revoked by the assignee of the patent application on October 20, 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
Petitions Examiner
Office of Petitions

cc: **Nixon & Vanderhye, PC**
901 North Glebe Road
11th Floor
Arlington, VA 22203

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/499,663	11/16/2004	Mylene Caussette	246152022600

CONFIRMATION NO. 3321

OC000000021097122

OC000000021097122

Kate H Murashige
Morrison & Foerster
3811 Valley Centre Drive
Suite 500
San Diego, CA 92130-2332

Date Mailed: 11/03/2006

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/20/2006.

- 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

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/499,663	11/16/2004	Mylene Caussette	246152022600

CONFIRMATION NO. 3321

23117
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

OC000000021097176
OC000000021097176

Date Mailed: 11/03/2006

NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/20/2006.

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

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/499,663	11/16/2004	Mylene Caussette	246152022600

CONFIRMATION NO. 3321

OC000000021097122

OC000000021097122

Kate H Murashige
Morrison & Foerster
3811 Valley Centre Drive
Suite 500
San Diego, CA 92130-2332

Date Mailed: 11/03/2006

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/20/2006.

- 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

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/499,669	06/21/2004	Cyrill Zagar	53144	7269

26474 7590 01/09/2009

NOVAK DRUCE DELUCA + QUIGG LLP
1300 EYE STREET NW
SUITE 1000 WEST TOWER
WASHINGTON, DC 20005

EXAMINER	
CHUI, MEI PING	

ART UNIT	PAPER NUMBER
1616	

MAIL DATE	DELIVERY MODE
01/09/2009	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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NOVAK DRUCE DELUCA + QUIGG LLP
1300 EYE STREET NW
SUITE 1000 WEST TOWER
WASHINGTON DC 20005

In re Application of:	:
Zagar et al.	:
Serial No.: 10/499,669	: PETITION DECISION
Filed: June 21, 2004	:
Attorney Docket No.: 53144	:

This is in response to the petition under 37 CFR § 1.181, filed December 5, 2008, requesting that the finality of the Office action of August 5, 2008 be withdrawn.

It is noted that applicants filed this petition under 37 CFR § 1.181 on December 5, 2008 requesting relief from the finality of the Office action mailed August 5, 2008. This petition was not filed within two months from the mailing of the final Office action and is thus untimely. Nevertheless, a decision on this petition is rendered herein.

BACKGROUND

The examiner mailed a non-final Office action on November 26, 2007 setting a three month statutory limit for reply. At the time this Office action was mailed, claims 1-16 and 18-25 were pending and claims 14-16 and 18-25 were withdrawn from consideration on the merits as being directed toward a non-elected invention. The examiner subsequently examined the remaining claims, claims 1-13 on their merits. The examiner instituted the following rejections over the claims:

1) Claims 1-13 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 10-17 of Zagar et al. (U. S. Patent No. 6,482,774) in view of Selby et al. (U. S. Patent No. 5,739,326)

2) Claims 1-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Zagar et al. (U. S. Patent No. 6,482,774) in view of Selby et al. (U. S. Patent No. 5,739,326) and

3) Claims 1-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al. (WO 00/13508).

In reply to the non-final Office action, applicants submitted a response on April 28, 2008 comprising claim amendments and arguments traversing the examiner's rejections.

The examiner mailed a final Office action on August 5, 2008 setting a three month statutory time for reply. At the time this final Office action was mailed, claims 1-18 and 18-41 were pending, claims 14-16, 18-25 and 37-41 were withdrawn from consideration as being directed toward a non-elected invention and claims 1-13 and 26-36 were examined on their merits. Inter alia, the examiner instituted the following rejections:

1) Claims 1-13 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 and 10-17 of Zagar et al. (U. S. Patent No. 6,482,774) in view of Selby et al. (U. S. Patent No. 5,739,326),

2) Claims 1-13 were 26-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zagar et al. (U. S. Patent No. 6,482,774) in view of Selby et al. (U. S. Patent No. 5,739,326) and

3) Claims 1-13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukamoto et al. (WO 00/13508).

Applicants, in reply to the final Office action, submitted a response under 37 CFR 1.113 and 1.116 which included claim amendments and remarks traversing the examiner's rejections.

Applicants filed this petition under 37 CFR § 1.181 on December 5, 2008, requesting that the finality of the Office action of August 5, 2008 be withdrawn.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition, applicants argue that the examiner has not, throughout prosecution of this case, substantively considered applicants unexpected results:

> The non-final office action of November 26, 2007, failed to consider the showings of unexpected results. The subsequent Office action of August 05, 2008, also failed to consider the unexpected results. The failure to consider at least Example 30 on page 73 of the present specification is evidenced by the incorrect assertion on page 8, lines 5 - 7 of the Office action of August 05, 2008, that "there is no evidence and data provide [*sic*] by the specification indicating the instantly claimed composition that exhibits synergistic herbicidal effect comprises all three actives (a), (b) and (c). (p. 1, Petition)

Applicants offer cooberating arguments as well as support of their contentions with excerpts from the MPEP § 706.01(d), 706.01(a):

"The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of... any secondary evidence."[1] Since the Office action fails to consider the unexpected results presented in the specification, the Office action is not an action on the merits of the present application. "Under present practice, second or any subsequent actions on the merits shall be final .... ,, [2] Since Applicants have yet to receive an action on the merits of their application, which includes evidence of unexpected results, the finality of the Office action mailed August 05, 2008, should be withdrawn. Moreover, "[b]efore 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; .... ,3 Withdrawal of the finality of the Office action of August 05, 2008, is respectfully solicited.

However, contrary to applicants' assertions, a detailed, comprehensive assessment of applicants' alleged unexpected results found on pages 63-75, which includes Example 30 present on page 73 of the specification, was in-fact carried out by the examiner:

> In addition, in response to Applicants' amendment for instant claim 1, where the herbicidal active composition comprising synergistically effective amounts of (a) at least one 7-pyrazolybenzoxazole compound of the formula (I), (b) at least one further active compound of class bl-bl5 and (e) a safener as recited (see Remarks: page 2, second paragraph). Applicants' amendment is not sufficient to overcome the non-statutory obviousness-type double patenting rejection, as set forth above, because the features upon which applicants rely (i.e. the required amount for synergistic effect from the combination of (a) the active herbicide, (b) the co- herbicide and (e) the safener, are not recited in the rejected claim(s)... In the instant case, Applicants claim the composition comprising a combination of the three recited actives (a), (b) and (e) present in an effective amount exhibits synergistic herbicidal effect for controlling undesirable vegetations. However, this limitation (i.e. the effective amount present in the combination of (a), (b) and (e)) on which Applicants critically rely upon is not recited in the claims, and the specification did not provide any evidence indicating this limitation must be read into the claims to give meaning to the disputed composition. Furthermore, the synergistic herbicidal effect of the instantly claimed composition ***requires all three recited actives, namely a 7-pyrazolybenzoxazole compound of the formula (I) a compound of class b 1-b 15 and a safener as claimed, to be present in the composition in order to produce such effect. However, the examples disclose in the instant specification (see pages 63-75) only show the synergistic effect of mixtures comprising a 7-pyrazolybenzoxazole compound of the formula (I) and a compound of class b l-bl5, or mixtures comprising a 7- pyrazolybenzoxazole compound of the formula (I) and a safener as claimed. Indeed, there is no evidence and data provide by the specification indicating the instantly claimed composition that exhibits synergistic herbicidal effect comprises all three actives (a), (b) and (c)***. Therefore, the rejection as set forth above is maintained. (pages 7-8, final Office action, emphasis in bold added herein)

This assessment by the examiner is further reiterated in the response to applicants' arguments pertaining to the 35 USC 103(a) rejections and can be found on pages 14-15 of the final Office action mailed August 5, 2008.

Hence, the detailed review of the specification by the examiner for results of an unexpected nature to determine patentability of the claimed invention precludes the withdrawal of finality of the Office action mailed August 5, 2008. No impropriety can be found on the part of the examiner for rendering said Office action final in that it appears that the examiner substantively

considered all of the putative unexpected results as found in the specification on pages 63-75 which would include page 73 detailing the results of Example 30. Subsequently, it is deemed that a clear issue for appeal has been established in the record of this case.

Pertaining to applicants' arguments contending that the examiner did not consider applicants' putative unexpected results in the non-final Office action is not found persuasive. Although the examiner did not explicitly expound on the evidence presented in the specification within the body of the non-final Office action, it is presumed, absent evidence to the contrary, that the examiner did fully consider such evidence. Furthermore, it is evident as a whole, from the examiner's explicit, inclusive consideration of the evidence presented in the specification as articulated in the final Office action, that at the time the non-final Office action was instituted, the examiner was of the opinion that the claimed invention was not commensurate in scope with the results found in the specification. This opinion is implicitly extrapolated because the claims at the time of the non-final Office action, similar to the claims at the time the final Office action were mailed, were also not commensurate in scope with the showing of unexpected results as found in the specification. Moreover, while applicants specifically point to Example 30 on page 73 of the specification *in this petition* requesting relief from the finality of the previous Office action; applicants did not timely, in their response to the non-final Office action, specifically beseech the examiner to give this particular example any additional, meaningful consideration. Nevertheless, the examiner has made his opinion of the claims in light of the results present in the specification clear – that the claims are not commensurate in scope with the showing of unexpected results as found on pages 63-75 which necessarily includes Example 30 present on page 73 of the specification. Hence, the Office action mailed August 5, 2008 is deemed complete, in that applicants have been provided a full and fair hearing. Consequently, the finality of the Office action mailed August 5, 2008 will not be withdrawn.

DECISION

The petition is subsequently **DENIED**.

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.

George C. Elliott

George Elliott
Director, Technology Center 1600

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Venable LLP
P.O. Box 34385
Washington, D.C. 20043

In re Application of
FISCHER-NAGELE et al.
U.S. Application No. 10/499,682
PCT No.: PCT/EP02/14272
Int. Filing Date: 14 December 2002
Priority Date: 22 December 2001
Attorney Docket No.: 31608-204544
For: USE OF A PHOSPHATE MIXTURE FOR THE PRODUCTION OF CONCENTRATED SOLUTIONS AND BRINE FOR THE FOOD INDUSTRY

DECISION ON REQUEST

This decision is in response to applicants' "Response to Notification of Missing Requirements and Declaration under Rule 37 CFR 1.41(f)" filed 11 July 2005, which is being treated as a Petition under 37 CFR 1.497(d). The $130 petition fee will be charged to Deposit Account no.22-0261.

BACKGROUND

On 14 December 2002, applicants filed international application PCT/EP02/14272 which claimed a priority date of 22 December 2001. The international application named Ulrike Fischer-Nagele and Frank Neumann as applicants/inventors. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the priority date, 22 June 2004.

On 22 June 2004, applicants filed a transmittal letter for entry into the national stage accompanied by, *inter alia*: the requisite basic national fee and an English translation of the international application.

On 10 January 2005, 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 11 July 2005, applicants filed the present petition under 37 CFR 1.497(d); an assignment; a four-month extension of time; and a declarations executed by: Richard Tanzler; Frank Neumann; Peter Braun; Ulrike Fischer-Nagele and Bernd Krug.

DISCUSSION

As defined in 37 CFR 1.9(a)(3), a U.S. national stage application must first comply with the requirements of 35 U.S.C. 371(c) to constitute a "nonprovisional" application, therefore, applicants' request will be treated under 37 CFR 1.497(d). In the instant case, the international application named BK Giulini Chemie GMBH[1] and Peter Braun as applicants and Ulrike Fischer-Nagele and Frank Neumann as applicants/inventors. Applicants request to add Richard Tanzler and Bernd Krug as an 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). Item (1) and (3) have been satisfied.

As to Item (2), the declaration filed on 11 July 2005 is defective pursuant to 37 CFR 1.497(a)(3) which requires that the declaration "identify each inventor and the residence and country of citizenship of each inventor." Section 201.03 of the Manual of Patent Examining Procedure states, in part,

> While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity . . . For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor . . .

Here, each inventor has executed a separate declaration which only identifies the particular inventor signing that declaration, which is improper. Additionally, the declaration sets forth an additional inventor (Peter Braun) who has not been named as applicant/inventor in the international application. (In order to include Peter Braun to the instant application, applicants must submit an additional submission under 37 CFR 1.497(d) or a show that a PCT Rule 92bis change was made prior to the National stage

---

[1]The name of applicant has been changed under PCT Rule 92bis. (See Notification of the Recording of a Change (Form PCT/IB/306) dated 23 June 2004.

filing.) Therefore, applicants are required to file a newly executed declaration which complies with 37 CFR 1.497(a) and (b).

Further, in order to satisfy item (4), applicants are required to submit a written consent of assignee to the correction in inventorship pursuant to 37 CFR 3.73(b).

For the reasons discussed above, it is inappropriate, at this time, to grant applicants request for correction of inventorship.

CONCLUSION

For the reasons discussed above, applicants' request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

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

#10

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Venable LLP
P.O. Box 34385
Washington, D.C. 20043-9998

In re Application of
FISCHER-NAGELE et al.
U.S. Application No. 10/499,682
PCT No.: PCT/EP02/14272
Int. Filing Date: 14 December 2002
Priority Date: 22 December 2001
Attorney Docket No.: 31608-204544
For: USE OF A PHOSPHATE MIXTURE FOR THE PRODUCTION OF CONCENTRATED SOLUTIONS AND BRINE FOR THE FOOD INDUSTRY

DECISION ON REQUEST

This decision is in response to applicants' "Transmittal Letter Re: Decision of September 29, 2005" filed 29 November 2005 which is being treated as a renewed request under 37 CFR 1.497(d).

BACKGROUND

On 14 December 2002, applicants filed international application PCT/EP02/14272 which claimed a priority date of 22 December 2001. The international application named Ulrike Fischer-Nagele, Peter Braun, and Frank Neumann as applicants/inventors. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the priority date, 22 June 2004.

On 22 June 2004, applicants filed a transmittal letter for entry into the national stage accompanied by, *inter alia*: the requisite basic national fee; an English translation of the international application; and an Information Disclosure Statement.

On 10 January 2005, 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 11 July 2005, applicants filed a request under 37 CFR 1.497(d); an assignment; a four-month extension of time; and declarations executed by: Richard Tanzler; Frank

Neumann; Peter Braun; Ulrike Fischer-Nagele; and Bernd Krug. In a decision dated 29 September 2005, applicants' request under 37 CFR 1.497(d) was dismissed without prejudice.

On 29 November 2005, applicants filed the present request under 37 CFR 1.497(d).

DISCUSSION

In the instant case, the international application named Peter Braun, Ulrike Fischer-Nagele and Frank Neumann as applicants/inventors. Applicants request to add Richard Tanzler and Bernd Krug as applicants/inventors. 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(h); 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). Items (1); (3) and (4) have been satisfied.

As to item (2), the declaration filed 29 November 2005 is not in compliance with 37 CFR 1.497(a)-(b), in that, alterations were made to the declaration after it was executed. Specifically, it appears that Paul Braun has made alteration to pages 1 and 2 after the declaration had been executed by the other joint-inventors.

37 CFR 1.52(c) states:

(c) Any interlineation, erasure, cancellation or other alteration of the application papers filed should be made before the signing of any accompanying oath or declaration pursuant to § 1.63 referring to those application papers and should be dated and initialed or signed by the applicant on the same sheet of paper. Application papers containing alterations made after the signing of an oath or declaration referring to those application papers must be supported by a supplemental oath or declaration under 1.67.

Further, section 602.01 of the Manual of Patent Examining Procedure (MPEP) states, in part:

The wording of an oath or declaration cannot be amended, altered, or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required.

Regarding item (4), applicants have submitted a written consent of assignee to the correction in inventorship pursuant to 37 CFR 3.73(b).

For the reasons discussed above, it is inappropriate, at this time, to grant applicants request for correction of inventorship.

CONCLUSION

For the reasons discussed above, applicants' request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

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

13 JUN 2006

#12

UNITED STATES PATENT AND TRADEMARK OFFICE

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Venable LLP
P.O. Box 34385
Washington, D.C. 20043-9998

In re Application of
FISCHER-NAGELE et al.
U.S. Application No. 10/499,682
PCT No.: PCT/EP02/14272
Int. Filing Date: 14 December 2002
Priority Date: 22 December 2001
Attorney Docket No.: 31608-204544
For: USE OF A PHOSPHATE MIXTURE FOR THE PRODUCTION OF CONCENTRATED SOLUTIONS AND BRINE FOR THE FOOD INDUSTRY

DECISION ON REQUEST

This decision is issued in response to applicants' "Response to Decision on Request Regarding Missing Requirements" filed 24 April 2006 which is being treated as a renewed request under 37 CFR 1.497(d).

BACKGROUND

On 14 December 2002, applicants filed international application PCT/EP02/14272 which claimed a priority date of 22 December 2001. The international application named Ulrike Fischer-Nagele, Peter Braun, and Frank Neumann as applicants/inventors. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the priority date, 22 June 2004.

On 22 June 2004, applicants filed a transmittal letter for entry into the national stage accompanied by, *inter alia*: the requisite basic national fee; an English translation of the international application; and an Information Disclosure Statement.

On 10 January 2005, 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 11 July 2005, applicants filed a request under 37 CFR 1.497(d); an assignment; a four-month extension of time; and declarations executed by: Richard Tanzler; Frank Neumann; Peter Braun; Ulrike Fischer-Nagele; and Bernd Krug. In a decision dated 29 September 2005, applicants' request under 37 CFR 1.497(d) was dismissed without prejudice.

On 29 November 2005, applicants filed a second request under 37 CFR 1.497(d). In a decision dated 22 February 2006, applicants' petition under 37 CFR 1.497(d) was dismissed without prejudice because the declaration was not in compliance with 37 CFR 1.497(a)-(b).

On 24 April 2006, applicants filed the present renewed petition under 37 CFR 1.497(d).

DISCUSSION

In the instant case, the international application named Peter Braun, Ulrike Fischer-Nagele and Frank Neumann as applicants/inventors. Applicants request to add Richard Tanzler and Bernd Krug as applicants/inventors. 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 provided items (1), (3) and (4).

As to item (2), a review of the declaration filed on 24 April 2006 reveals that the declaration is in compliance with 37 CFR 1.497(a)-(b).

Applicants have now 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 14 December 2002 and a date of **26 April 2006** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

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

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Redbank Manor Pty Ltd
21 Rolling Meadows Drive
Sunbury, Vic 3429 AU **AUSTRALIA**

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JUN 0 3 2008

OFFICE OF PETITIONS

In re Application of :
Eric Wilson :
Application No. 10/499,687 : ON PETITION
Filed: June 18, 2004 :
Attorney Docket No. 366-002 :

This is a decision on the petition under 37 CFR 1.137(b), filed on October 29, 2007, to revive the above-identified application.

The above application became abandoned for failure to file a proper reply to the final Office action mailed March 21, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) with the $405 filing fee and the submission under 37 CFR 1.114; (2) the petition fee of $770; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application is being revived for consideration of the RCE.

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 file is being referred to Technology Center Art Unit 2176 for further processing.

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

Andrea Smith
Petitions Examiner
Office of Petitions

cc: Eric Wilson
14 Gilchrist Crescent
Sunbury 3429 **AUSTRALIA**

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KENYON & KENYON LLP
1500 K STREET N.W.
SUITE 700
WASHINGTON, DC 20005

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APR 26 2010

OFFICE OF PETITIONS

In re Patent No. 7,042,197 :
Issue Date: May 9, 2006 :
Application No. 10/499,694 : NOTICE
Filed: August 13, 2004 :
Attorney Docket No. 11848/15 :

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.

There is no indication that the request is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Mr. Kendal M. Sheets 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. Sheets desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to Mr. Sheets, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

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

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-6059.

The patent file will be forwarded to the Files Repository.

Alicia Kelley
Petitions Examiner
Office of Petitions

cc: KENDAL SHEETS
COMPUTER PATENT ANNUITIES NORTH AMERICA
225 REINEKERS LANE
SUITE 400
ALEXANDRIA, VA 22314

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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JONES DAY
222 EAST 41ST ST
NEW YORK NY 10017

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NOV 2 1 2008

OFFICE OF PETITIONS

In re Application of : Eric Appelman, et al. : Application No. 10/499,702 : DECISION GRANTING PETITION
Filed: November 8, 2004 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 118989-04297119 :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed November 19, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on October 17, 2008 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

[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.*

This application is being referred to Technology Center AU 1796 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

cc: **Intellectual Property Group**
51 Louisiana Avenue, N.W.
Washington, D.C. 20001

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BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON DC 20001-5303

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APR 25 2007

OFFICE OF PETITIONS

In re Application of :
Baruch Glattstein :
Application No. 10/499,719 : DECISION ON PETITION
Filed: 21 June, 2004 :
Atty Docket No. GLATTSTEIN1 :
:

This is a decision on the petition filed on 5 February, 2007, under 37 CFR 1.137(b), [1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 13 December, 2006, for failure to timely submit a proper reply to the final Office action mailed on 12 July, 2006, which set a three (3) month shortened statutory period for reply. On 11 December, 2006, a two (2) month extension of time under 37 CFR 1.136(a) was filed,

---

[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)).

along with an amendment after final rejection. The amendment, however, failed to place the application in condition for allowance. An Advisory Action was mailed on 18 January, 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 required reply under 37 CFR 1.114.

This application is being referred to Technology Center 1743 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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 5/4/10 Paper No.: ____

TO SPE OF : ART UNIT 2111

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/499724 Patent No.: 7702834B2

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580

Virginia Tolbert
Certificates of Correction Branch
571-272-0460

Thank You For Your Assistance

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

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

Comments: _____

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 5/4/10 **Paper No.:** ____

TO SPE OF : ART UNIT 2111

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/499724 Patent No.: 7702834B2

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580

Virginia Tolbert
Certificates of Correction Branch
571-272-0460

Thank You For Your Assistance

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

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

Comments: _____

/Matthew Spittle/ 05/26/2010

/Mark Rinehart/
Supervisory Patent Examiner
Art Unit 2111

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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DARBY & DARBY P.C.
P.O. BOX 770
Church Street Station
New York, NY 10008-0770

Mail Date: 04/21/2010

Applicant	: Yoel Arieli	: DECISION ON REQUEST FOR
Patent Number	: 7609388	: RECALCULATION of PATENT
Issue Date	: 10/27/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/499,758	: 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 **1230** 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.

08 AUG 2005

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#7

QUALCOMM INCORPORATED
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

In re Application of:	:	
Smith, Alan	:	
U.S. Application No.: 10/499,759	:	COMMUNICATION
PCT No.: PCT/GB02/05808	:	REGARDING SUBMISSION
International Filing Date: 19 December 2002	:	UNDER 37 CFR 1.42
Priority Date: 19 December 2001	:	
Attorney's Docket No.: 020211	:	
For: A METHOD AND APPARATUS FOR HANDLING MESSAGES IN A MOBILE COMMUNICATIONS ENVIRONMENT	:	

This communication is issued in response to applicant's submission on 05 July 2005 of a "Response To Notification Of Missing Requirements" and the inclusion therein of a declaration executed on behalf of the deceased inventor, which has been treated as a submission under 37 CFR 1.42.

BACKGROUND

On 19 December 2002, applicant filed international application PCT/GB02/05808 which claimed a priority date of 19 December 2001 and which designated the United States. On 26 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 19 June 2004 (thirty months from the priority date).

On 18 June 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.

On 03 March 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 in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration alter than thirty months after the priority date were required.

On 05 July 2005, applicant filed the "Response To Notification Of Missing Requirements" considered herein (with required extension fee). The response included the surcharge and a declaration executed on behalf of the deceased sole inventor Alan SMITH by his legal representative Julie STUART, considered herein under 37 CFR 1.42.

DISCUSSION

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

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

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.

37 CFR 1.497(b)(2) requires that citizenship, mailing address, and residence information be provided for **both** the deceased inventor and the legal representative. Here, the declaration filed 05 July 2005 does not comply with 37 CFR 1.497(b)(2), discussed above, in that it does not include the citizenship of the legal representative.

Because the declaration submitted does not include all the information required by 37 CFR 1.497(b)(2), the declaration cannot be accepted under 37 CFR 1.497 and 1.42.

CONCLUSION

For the reasons discussed above, the request for status under 37 CFR 1.42 is **DISMISSED** 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. Extensions of time are available under 37 CFR 1.136(a).

A proper response must include a new declaration in compliance with 37 CFR 1.497 executed by the legal representative and including all the required information discussed above.

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

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

#9

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Commissioner for Patents
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QUALCOMM INCORPORATED
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

In re Application of:	:	
Smith, Alan	:	
U.S. Application No.: 10/499,759	:	DECISION REGARDING
PCT No.: PCT/GB02/05808	:	SECOND SUBMISSION
International Filing Date: 19 December 2002	:	UNDER 37 CFR 1.42
Priority Date: 19 December 2001	:	
Attorney's Docket No.: 020211	:	
For: A METHOD AND APPARATUS FOR HANDLING MESSAGES IN A MOBILE COMMUNICATIONS ENVIRONMENT	:	

In a communication mailed by this Office on 08 August 2005, the declaration filed by applicant on behalf of deceased inventor Alan SMITH was dismissed for failure to include all the information required under 37 CFR 1.497 (the communication noted that the declaration did not include the citizenship of the legal representative).

On 07 October 2005, applicant filed a response to the previous communication that was accompanied by a revised declaration. The declaration submitted on 07 October 2005 identifies the deceased inventor and states the deceased inventor's country of citizenship and residence, is signed by Julie STUART as "Legal Representative," states her relationship to the deceased (i.e., Legal Representative), 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) and 37 CFR 1.42.

The request for status under 37 CFR 1.42 is **GRANTED**.

The application will be forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 07 October 2005.

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

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

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JUL 20 2007

OFFICE OF PETITIONS

In re Application of :
FARIA CAVALCANTI :
Application No.: 10/499,779 : DECISION ON PETITION
Filing Date: June 21, 2004 : UNDER 37 CFR 1.137(B)
Attorney Docket No.: 6492US :

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed November 27, 2006, which set a statutory period for reply of three (3) months. Accordingly, by operation of law, the above-identified application became abandoned on February 28, 2007.

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

This application is being referred to the Office of Publications.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3303.

Bryan Lin

Bryan Lin
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy

17 JUN 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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#5

Law Offices of
Ira S. Dorman
330 Roberts Street
Suite 200
East Hartford, CT 06108

In re Application of
WALTON, Phillip
US Application No.: 10/499,795
PCT Application No.: PCT/GB02/05756
Int. Filing Date: 18 December 2002
Priority Date: 21 December 2001
Attorney's File Reference: EBAC-12
For: FEED TUBE FOR USE IN A LIQUID DELIVERT SYSTEM

: DECISION

This decision is in response to the "Petition to Revive" filed in the United States Patent and Trademark Office (USPTO) on 09 December 2004. For reasons below, the petition to revive will be held in abeyance, and the communication has been treated as including a petition under 37 CFR 1.10(d).

BACKGROUND

On 18 December 2002, applicants filed international application PCT/GB02/05756. The international application designated the United States and did claim priority to an earlier filed application. A copy of the international application was communicated from the International Bureau to the United Stated Patent and Trademark Office (USPTO) on 10 July 2003. The deadline for paying the basic national fee in the United States was thirty months from the priority date. That date was Monday, 21 June 2004.

On 22 June 2004, applicant filed *inter alia*, a Transmittal Letter (Form PTO-1390), payment of the basic national fee, and a declaration and power of attorney.

On 12 November 2004 the USPTO sent Form PCT/DO/EO/909 Notification of Abandonment. The determination of abandonment given at that time was that applicant had failed to provide a copy of the International Application by 30 months as required by 37 CFR 1.495(b)(1).

On 09 December 2004 applicant filed the current petition to revive under 37 CFR 1.137(a) and (b). The filing was accompanied by, *inter alia*, notification informing the applicant of the communication of the international application to the designated offices, a declaration of Cynthia M. Villancourt, a copy of an Express Mail customer receipt, a stamped return postcard and photocopies of a notebook maintained in the office of applicant's attorney.

DISCUSSION

Initially it is noted that the abandonment of the current application was improperly indicated on the Notice of Abandonment as caused by applicants' failure to provide a copy of the International Application by 30 months. As noted by applicant, such a copy was not required under 35 U.S.C. 371(a). Rather, the Notification of Abandonment should have indicated that abandonment was the result of the national fee required under 35 U.S.C. 371(c)(1) as not having been timely paid.

Because the Notification of Abandonment did not identify the proper basis for the holding of abandonment, applicants' petition to revive under 37 CFR 1.137(a) and (b) will be held in abeyance to give applicant an opportunity to decide whether, in light of the basis for holding the instant application to be abandoned, applicant wishes to persist in revival of the application under 37 CFR 1.137(a) or (b).

For reasons below, applicant has not established that the basic national fee was paid prior to midnight of 21 June 2004. Petitioner asserts that the basic national fee was timely paid on 18 June 2004. Because the Express Mail label used in filing the basic national fee bears a "date in" date of 22 June 2004, the petition has been treated under the provisions of 37 CFR 1.10(d)

37 CFR 1.10(d) states:

> (d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the ``date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and
>
> (3) The petition includes a showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

In this instance the requirements of 37 CFR 1.10(d)(3) have not been satisfied because petition has not provided either corroborating evidence from the USPS or provided evidence that came into being after deposit and within one business day of the deposit of the correspondence. Moreover, even assuming, *arguendo*, that the notebook entries attached to Ms. Vaillancourt's declaration were created after deposit and within one business day, such does not satisfy the requirement for an Express Mail log as set forth in MPEP 513.

CONCLUSION

The petition under 37 CFR 1.10(d) is **DISMISSED** without prejudice.

Applicants may within a time period of **TWO (2) MONTHS** from the mail date of this Decision either submit a renewed petition under 37 CFR 1.10(d) satisfying the requirements therein or in the alternative, request consideration of the petition to revive under 37 CFR 1.137(a) and/or (b). Applicant should note that any request to consider a petition to revive under both the unavoidable standard (1.137(a)) and the unintentional standard (1.137(b)) will require separate petition files of $250 and $750, respectively, for a small entity. In this regard, it is noted that the $685.00 submitted 09 December 2004 was insufficient to cover the small entity petition fee under 37 CFR 1.137(b) as petition fees were increased effective 08 December 2004 pursuant to the Consolidated Appropriations Act, 2005.

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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03 OCT 2005

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#7

Ira S. Dorman
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In re Application of WALTON
Application No.: 10/499,795
PCT Application No.: PCT/GB02/05756
Int. Filing Date: 18 December 2002
Priority Date Claimed: 21 December 2001
Attorney Docket No.: EBAC-12
For: FEED TUBE FOR USE IN A LIQUID DELIVERY SYSTEM

DECISION ON RENEWED PETITION UNDER 37 CFR 1.137(b)

Applicant' Renewed Petition For Revival Under 37 CFR 1.137(b), filed in the United States Patent and Trademark Office on 11 August 2005 is **GRANTED**.

BACKGROUND

On 18 December 2002, applicant filed international application PCT/GB02/05756. The international application claims a priority date of 21 December 2001 and designates the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 2003. The deadline for paying the basic national fee in the United States is thirty months from the priority date, that is 21 June 2004.

On 22 June 2004, applicant filed, *inter alia*, a transmittal letter for entry into the US national stage under 35 U.S.C. 371, the required basic national fee as required by 35 U.S.C. 371(c)(1), an executed declaration as required by 35 U.S.C. 371(c)(4).

On 12 November 2004, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant, indicating that this international application had become abandoned with respect to the national stage in the United States for failing to provide a copy of the International Application by 30 months as required by 37 CFR 1.495(b)(1).

On 09 December 2004, applicant filed a petition to revive under 37 CFR 1.137(a) and 37 CFR 1.137(b). The filing was accompanied by, *inter alia*, a notification informing the applicant of the communication of the international application to the designated offices, a declaration of Cynthia M. Vaillancourt, a copy of an Express Mail customer receipt, a stamped return postcard and photocopies of a notebook maintained in the office of applicant's attorney. In view of the arguments and evidences presented, the above petition was treated as including a petition under the provisions of 37 CFR 1.10(d) since the Express Mail label used in filing the basic national fee bears a "date-in" date of 22 June 2004.

On 17 June 2005, a Decision dismissing the petition under 37 CFR 1.10(d) was mailed to applicant. The Decision indicated that the requirements of 37 CFR 1.10(d)(3) have not been satisfied because the petition has not provided either corroborating evidence from the United States Postal Service or provided evidence that came into being after deposit and within one business day of the deposit of the correspondence. Moreover, even assuming, *arguendo*, that the notebook entries attached to Ms. Vaillancourt's declaration were created after deposit and within one business day, such does not satisfy the requirement for an Express Mail log as set forth in MPEP 513. The Decision also indicated that the petition failed to include sufficient petition fees required under 35 CFR 1.137(a) and 35 CFR 1.137(b), and that such petitions were held in abeyance in order to permit applicant an opportunity to address the actual reason for abandonment, which reason was incorrectly stated on the Notification of Abandonment mailed 12 November 2004.

On 11 August 2005, applicant filed the instant petition, "RENEWED PETITION TO REVIVE", under 37 CFR 1.137(b) requesting that the abandonment be considered unintentional and the application be revived.

DISCUSSION

Initially, it is noted, for petitioner's benefit, that 35 U.S.C. 41(a)(7) requires separate petition fees for a petition filed for the revival of an unintentionally abandoned application and a petition filed for the revival of an unavoidable abandoned application. At the same time, it should be noted that there is no charge for a petition under 37 CFR 1.10(d).

It is further noted that a petition fee of $685 was received with the petition filed December 9, 2004 having a Certificate of Mailing dated December 7, 2004; however, the required petition fee which is due by applicant is $750, effective December 8, 2004. The provision of 37 CFR 1.8 only applies to "correspondence required to be filed in the Patent and Trademark Office within a set period of time ...". Accordingly, no benefit is given to the Certificate of Mailing (in this case 12/07/04) and the actual date of receipt will be used (in this case 12/09/04). Thus, $65 has been charged to Deposit Account No. 502982 as authorized in the petition filed August 11, 2005.

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper reply, (2) the petition fee required by law, (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995). Payment of the basic national fee constitutes a proper reply for entry into the national stage.

Applicant's statement in the petition that "the entire delay in taking all requisite actions, from the due date for doing so to the submission of this renewed petition, was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3). The submission of the national fee 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.

The application has an international filing date of 18 December 2002 under 35 U.S.C. 363 and a date of 22 June 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.

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Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

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AUG 14 2009

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1940 Duke Street
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In re Application of :
Antoine Durand et al : DECISION ON PETITION
Application No. 10/499,820 : REGARDING INFORMATION
Filed: July 2, 2004 : DISCLOSURE STATEMENT
Attorney Docket No.: 254635US6PCT :
For: THREADED TUBULAR JOINT :
COMPRISING SEALING FACES :

This is in response to applicants' petition filed April 14, 2009 seeking to have Document AX cited in the Information Disclosure Statement (IDS) of September 5, 2007 considered by the examiner.

The petition is **DENIED**.

Applicants indicate that the examiner has failed to properly consider the IDS filed on September 5, 2007 by not considering Document AX even though a legible copy of the document was provided and the publication was in the English language. Applicants' further allege that the examiner's holding that the publication was not properly cited is in error and that the entire IDS of September 5, 2007 complies with 37 CFR 1.97 and 1.98.

A review of the record reveals that the examiner's action mailed November 13, 2007 included an initialed copy of the form PTO-1449 with Document AX lined through. As indicated at the bottom of the form PTO-1449, a citation is lined through when "not in conformance and not considered". On page 2 of the Office action, lines 3-4, it is stated that Document AX was not properly cited. Taken together, the examiner's action indicates that the IDS, itself, has been considered, but Document AX was not considered by the examiner because it was not properly cited.

The record also reveals that since the above noted Office action, applicants held a telephone interview on February 26, 2008, filed a reply on March 13, 2008, filed a Notice of Appeal on April 14, 2008, filed an Appeal Brief on May 30, 2008, held a telephone interview on August 19, 2008, filed a second Appeal Brief on August 25, 2008, and held a telephonic interview on January 6, 2009 that agreed to changes by examiner's amendment to place the application in condition for allowance. In none of these communications does the record indicate any concern by applicants about the propriety of the examiner not having considered Document AX nor that

applicants requested reconsideration from the examiner. Note 37 CFR 1.181(c). The instant petition of April 14, 2009 fails to explain why, three months after the Notice of Allowance was mailed on January 15, 2009, the non-consideration of Document AX is now being complained about. The instant petition has been filed well outside the two month period from the action now being complained about and thus is untimely. See 37 CFR 1.181(f).

Nevertheless, 37 CFR 1.98(b)(5) requires that each publication listed must be identified by publisher, author (if any), title, relevant pages, date, and place of publication. MPEP 609.04(a), while indicating that 37 CFR 1.98(b) requires that each item of information in an IDS be identified properly, goes on to state that the date must include at least the month and year of publication. In the instant case, no date for Document AX has been provided on the form PTO-1449.

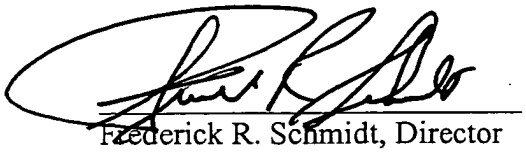
Applicants state in the instant petition that Document AX contains a date on the lower right hand side of the last page of the publication. Be that as it may, there is nothing to indicate that this date is the date of publication of the item of information nor is there any indication that this is the date of retrieval of that information from the online source. In particular, the date found at the bottom of page 3 of Document AX is indicated as being the date that the page was "last modified". It is unclear what "last modified" is supposed to mean and who did the "modifying". Nevertheless, 37 CFR 1.98(b)(5) does not merely require that there be a date somewhere on the copy of the item of information being listed. Rather, 37 CFR 1.98(b)(5) requires that the listing on the form PTO-1449 include a date. As previously indicated above, no date has been provided on the form PTO-1449 for Document AX. Moreover, the citation of an electronic document from an online source is supposed to include identification of the type of electronic medium in square brackets (e.g., [online]) and the date when the document was retrieved in square brackets (e.g., [retrieved on xx/xx/xxxx]). Note MPEP 707.05(e) IV. The listing of Document AX on the form PTO-1449 fails to identify the electronic medium and fails to identify the date of retrieval.

It is further noted that the copy of Document AX provided in the IDS contains three pages. However, according to the listing of the citation on the form PTO-1449, apparently only page 1 is being listed for consideration. See the listing and note that it lists only page "1 of 3".

In view of the above, it is evident that the listing on the form PTO-1449 for Document AX does not comply with 37 CFR 1.98(b)(5) because such listing fails to include the date of publication of the document as well as the date of retrieval of the document and identification of the electronic medium as --[online]--. Further, it is unclear from the listing just what pages of Document AX are actually being cited for consideration, i.e., merely page 1 or all three pages.

In summary, the listing of Document AX on the form PTO-1449 does not comply with 37 CFR 1.98 and the instant petition is untimely. Accordingly, applicants' belated request to have Document AX considered is **DENIED**.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Daniel P. Stodola at (571) 272-7087.



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OFFICE OF PETITIONS

In re Application of :
Hiroaki Yamamoto et al :
Application No. 10/499,830 : ON PETITION
Filed: July 8, 2004 :
Attorney Docket No. 02-123-TN

This is a decision on the petition, filed March 6, 2006 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on August 30, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2834 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
Petitions Examiner
Office of Petitions

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

13 MAY 2005
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Craig A. Fieschko
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In re Application of	:	DECISION ON
MALYAN, Beresford et al	:	
Application No.: 10/499,831	:	
PCT No.: PCT/GB02/05553	:	
Int. Filing Date: 09 December 2002	:	PETITION UNDER
Priority Date: 07 December 2001	:	
Attorney's Docket No.: 78104071/N15704	:	
For: TEST APPARATUS	:	37 CFR 1.47(a)

This is in response to the "PETITION UNDER 37 CFR §1.47(a)" filed on 06 April 2005. The $130.00 petition fee has been paid by check.

BACKGROUND

On 09 December 2002, applicants filed international application PCT/GB02/05553, which claimed priority of an earliest priority date of 07 December 2001. Accordingly, the time period for paying the basic national fee in the United States of America expired at midnight on 07 June 2004.

On 07 June 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. No executed oath or declaration from the inventors accompanied the Transmittal Letter at such time. A copy of the intentional application was transmitted on 12 June 2003 to the USPTO from the International Bureau.

On 14 January 2005, 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.

On 06 April 2005, petitioner filed the present petition accompanied, inter alia, an executed Declaration without the signature of Beresford Malyan.

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.

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

"Where inability to find or reach a nonsigning inventor 'after diligent effort' is the reason for filing under 37 CFR 1.47, an affidavit or declaration of the facts should be submitted that 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 instructions, telegrams, etc. that support a finding that the nonsigning inventor could not be found or reached should be made a part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

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 the facts should be submitted that 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 instructions, telegrams, etc. that support a finding that the nonsigning inventor could not be found or reached should be made a part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact 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.

The averments of Mr. Reynolds are insufficient to support a finding that the nonsigning inventor, Beresford Malyan, could not be found after diligent effort because Mr. Reynolds' petition fails to show diligent effort to locate him. The petition only states that e-mails and letters were sent to Malyan's last known postal address, which is a University address and not Malyan's residential address, and that he has not responded to it. More over, it is unclear if the documents were delivered to Malyan and that he refused to sign the documents since it is unclear if Malyan received them either by mail or e-mail (appears to be a university email account) since he might have left the university.

In addition, Mr. Reynolds has not shown that he searched for the above non-signing inventor new residential address either by the internet or by telephone directory, which would show diligent effort to find inventor Beresford Malyan. Mr. Balachandran's response to the whereabouts of Mr. Malyan is helpful but not dispositive without taking the steps indicated above.

If Malyan is located, then petitioner has an obligation under 37 CFR 1.47(a) to make a bona fide attempt to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing joint inventor Malyan. Here, it is unclear if a complete was sent to inventor Malyan since Mr. Reynolds only mentions the declaration, preliminary amendment and information disclosure statement.

Consequently, at this time it can not be concluded that the nonsigning inventor, Beresford Malyan, could not be found after diligent effort or that he refuses to sign the required documents.

CONCLUSION

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

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
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02 AUG 2005

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In re Aplication of	:	DECISION ON RENEWED
BALACHANDRAN, Wamadiva et al	:	
PCT No.: PCT/GB02/05553	:	
Application No: 10/499,831	:	
Int. Filing Date: 09 December 2002	:	PETITION UNDER
Priority Date: 07 December 2001	:	
Attorney's Docket No.: 78104071/N15704	:	
For: TEST APPARATUS	:	37 CFR 1.47(a)

This is in response to the "RENEWED PETITION UNDER 37 CFR 1.47(a)," filed on 18 July 2005.

BACKGROUND

In a decision from this Office on 13 May 2005, the initial petition under 37 CFR 1.47(a) was dismissed. The decision stated that requirement (2) under 37 CFR 1.47(a) was not met because the petition did not sufficiently demonstrated that nonsigning inventor Beresford Malyan could not be found after diligent effort.

On 18 July 2005, petitioner submitted a "Renewed Petition Under 37 CFR 1.47(a)" requesting reconsideration of the Office's decision of 13 May 2005. Petitioner states that successful contact with Malyan was recently made, and thus the nonsigning inventor has been located. However, petitioner indicates that Malyan's actions show a refusal to sign the Declaration.

DISCUSSION

PETITION UNDER 37 CFR 1.47(a):

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

The renewed petition of 18 July 2005 does not satisfy requirement (2) under 37 CFR 1.47(a).

With respect to requirement (3), a statement of the last known address of the missing inventor has been provided.

With respect to requirement (2), Mr. Reynolds' averments do not sufficiently demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for his signature as stipulated under MPEP 409.03(d) since it is unclear if Malyan received those papers because no documentary evidence has been provided such as a registered returned envelope, a certified mail return receipt, etc..., to show that the letters were sent to Malyan and received by him. The cover letter is silent with respect to this issue since it only refers to the Declaration and Power of Attorney. Moreover, there is no clear affirmation in the declaration provided by Mr. Reynolds with respect to the phoned conversations with Mr. Malyan or his wife that he received the application papers mailed by Reynolds. Consequently, it is unclear if Mr. Malyan actually received the application papers.

Furthermore, although Reynolds states that Maylan did not meet or contact him on July 08, 2005 as scheduled, Reynolds' declaration is dated that same day, July 08, 2005, which would not have given Malyan the opportunity to contact him later that day or within a few days. If Maylan after receiving or reviewing the application papers failed to contact Reynolds after a number of days his actions could then be construed as a refusal to execute the application

Consequently, the current record does not sufficiently establish Mr. Maylan's refusal to join in the application because no proper evidentiary document has been submitted to show that a *bona fide* attempt was made to deliver the complete application to him and that after he reviewed it 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 "Second 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.

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#4

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Craig A. Fieschko
DEWITT ROSS & STEVENS, S.C.
Excelsoir Financial Centre
8000 Excelsior Drive, Suite 401
Madison, Wisconsin 53717-1914

In re Aplication of	:	DECISION ON RENEWED
BALACHANDRAN, Wamadiva et al	:	
PCT No.: PCT/GB02/05553	:	
Application No: 10/499,831	:	
Int. Filing Date: 09 December 2002	:	PETITION UNDER
Priority Date: 07 December 2001	:	
Attorney's Docket No.: 78104071/N15704	:	
For: TEST APPARATUS	:	37 CFR 1.47(a)

This is in response to the "RENEWED PETITION UNDER 37 CFR 1.47(a)," filed on 05 October 2005.

BACKGROUND

In a decision from this Office on 02 August 2005, the renewed petition under 37 CFR 1.47(a) was dismissed. The decision stated that requirement (2) under 37 CFR 1.47(a) was not met because the petition did not establish Mr. Malyan's refusal to join in the application because no evidentiary document had been submitted to show that a *bona fide* attempt was made to deliver the complete application to him and that after he reviewed it he refused to sign the required papers.

On 05 October 2005, petitioner submitted a "Renewed Petition Under 37 CFR 1.47(a)" requesting reconsideration of the Office's decision of 02 August 2005. Petitioner states that a letter containing the complete application was mailed to Malyan on August 8, 2005 (via trackable Royal Mail, with a copy of the Royal Mail's confirmation of delivery being attached).

DISCUSSION

PETITION UNDER 37 CFR 1.47(a):

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

The renewed petition of 05 October 2005 still does not satisfy requirement (2) under 37 CFR 1.47(a).

With respect to requirement (2), Mr. Reynolds' averments still do not sufficiently demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for his signature as stipulated under MPEP 409.03(d) because it is unclear if Malyan received those papers. The copy of the Royal Mail confirmation of delivery, the relevant part, only states that :... was delivered from our EASTBOURNE Delivery Office ..." but it does not state the address that the item was delivered to and whether it was received (signed) by Mr. Malyan.

Consequently, it is unclear if Mr. Malyan actually received the application papers because no documentary evidence has been provided such as a registered returned envelope, a certified mail return receipt that the required papers were delivered to Malyan's address and were received at that address by Malyan as demonstrated by a signature showing receipt of these papers.

Therefore, the current record does not sufficiently establish Mr. Maylan's refusal to join in the application.

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 "Third 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
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Facsimile: (571) 273-0459

#10

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9 FEB 2006

In re Aplication of	:	DECISION ON RENEWED
BALACHANDRAN, Wamadiva et al	:	
PCT No.: PCT/GB02/05553	:	
Application No: 10/499,831	:	
Int. Filing Date: 09 December 2002	:	PETITION UNDER
Priority Date: 07 December 2001	:	
Attorney's Docket No.: 78104071/N15704	:	
For: TEST APPARATUS	:	37 CFR 1.47(a)

This is in response to the "RENEWED PETITION UNDER 37 CFR 1.47(a)," filed on 19 December 2005.

BACKGROUND

In a decision from this Office on 19 October 2005, the renewed petition under 37 CFR 1.47(a) was dismissed. The decision stated that requirement (2) under 37 CFR 1.47(a) was not met because it was unclear if Mr. Malyan actually received the application papers.

On 19 December 2005, petitioner submitted a "Renewed Petition Under 37 CFR 1.47(a)" requesting reconsideration of the Office's decision of 19 October 2005. Petitioner states that another letter containing the complete application was mailed to Malyan's address on December 7, 2005 and that there has been no response from him.

DISCUSSION

PETITION UNDER 37 CFR 1.47(a):

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

The renewed petition of 19 December 2005 still does not satisfy requirement (2) under 37 CFR 1.47(a).

With respect to requirement (2), although a copy of the patent application papers including the Specification, Claims, Drawings, and a Declaration were mailed to Mr. Malyan's address on December 7, 2005, the deadline given to return the signed papers by December 12, 2005 and the renewed petition filed on December 19, 2005 was not enough time to constitute a refusal on the part of Mr. Malyan because of the short time period to review, sign and return the papers to petitioner. Mr. Malyan's failure to respond given the short time period of less than a week can not be construed as a refusal at this time. However, if Mr. Malyan has still not returned the papers signed by the time of the subsequent renewed petition, this would constitute a refusal on his part.

Therefore, the current record does not sufficiently establish Mr. Maylan's refusal to join in the application.

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 "Fourth 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.

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06 JUL 2006

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Madison, Wisconsin 53717-1914

In re Aplication of	:	DECISION ON RENEWED
BALACHANDRAN, Wamadiva et al	:	
PCT No.: PCT/GB02/05553	:	
Application No: 10/499,831	:	
Int. Filing Date: 09 December 2002	:	PETITION UNDER
Priority Date: 07 December 2001	:	
Attorney's Docket No.: 78104071/N15704	:	
For: TEST APPARATUS	:	37 CFR 1.47(a)

This is in response to the "RENEWED PETITION UNDER 37 CFR 1.47(a)," filed on 30 June 2006.

BACKGROUND

In a decision from this Office on 09 February 2006, the renewed petition under 37 CFR 1.47(a) was dismissed. The decision stated that requirement (2) under 37 CFR 1.47(a) was not met because not enough time was given to Mr. Malyan to respond.

On 30 June 2006, petitioner submitted a "Renewed Petition Under 37 CFR 1.47(a)" requesting reconsideration of the Office's decision of 09 February 2006.

DISCUSSION

PETITION UNDER 37 CFR 1.47(a):

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

The renewed petition of 19 December 2005 satisfies requirement (2) under 37 CFR 1.47(a).

With respect to requirement (2), Mr. Reynolds has indicated that it has been 6 months from the December 7, 2005 date that the Declaration and complete copy of the application papers were mailed again to Mr. Malyan and that he has still not responded. Thus, the conduct of Mr. Malyan is interpreted as a refusal to sign the required papers. Consequently, the current record does sufficiently establish that Mr. Malyan refusal to join in the application because petitioner has shown a *bona fide* attempt was made to deliver the complete application to him and that he refused to sign the required papers.

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

CONCLUSION

The petition under 37 CFR 1.47(a) is **GRANTED**.

The Application Division and the International Division are authorized to accept the application as a 37 CFR 1.47(a) application and to mail a filing receipt. The application will be given a 35 U.S.C. 371(c) date of **06 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 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.

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06 JUL 2006

Mr. Beresford Malyan
6 New Road
Polegate
East Sussex, BN26 6ER
United Kingdom

In re Aplication of
BALACHANDRAN, Wamadiva et al
PCT No.: PCT/GB02/05553
Application No: 10/499,831
Int. Filing Date: 09 December 2002
Priority Date: 07 December 2001
Attorney's Docket No.: 78104071/N15704
For: TEST APPARATUS

Dear Mr. Malyan:

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.

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Cook Alex McFarron Manzo
Cummings & Mehler
Suite 2850
200 West Adams Street
Chicago, IL 60606

MAILED

APR 09 2010

OFFICE OF PETITIONS

In re Patent of Mourier	:	DECISION ON REQUEST
Patent No. 7,591,113	:	FOR RECONSIDERATION OF
Issue Date: September 22, 2009	:	PATENT TERM ADJUSTMENT
Application No. 10/499,835	:	AND NOTICE OF INTENT TO
Filing Date: November 29, 2004	:	ISSUE CERTIFICATE OF
Atty. Docket No. 0157-0027(HP/LP6232474)	:	CORRECTION

This is a decision on the petition filed October 21, 2009, 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 one thousand ninety-seven (1097) 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 one thousand ninety-seven (1097) days is **GRANTED to the extent indicated herein**.

Patentee asserts the delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") is 503 days which is the number of days beginning November 30, 2007, the day after the date three years after the date the application fulfilled the requirements of 35 U.S.C. § 371, and ending on April 15, 2009, the date a request for continued examination ("RCE") was filed.

37 C.F.R. § 1.702(b) states, with emphasis added,

> Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) *or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application*, but not including....

Based on the provisions of 37 C.F.R. § 1.702(b), the period of B Delay actually began on June 22, 2007, the day after the date three years after the date of commencement.

Pursuant to 37 C.F.R. § 1.702(b)(1), the period of B Delay does not include any time consumed by continued examination under 35 U.S.C. § 132(b). In other words, the period of B Delay ended April 14, 2009, *the day before* the RCE was filed.

The period of B Delay is 663 days which is the number of days beginning on June 22, 2007, and ending on April 14, 2009.

Patentee contends the number of days of overlap between delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") and B Delay is 127 days. However, the number of days of overlap is 288 days which is the number of days beginning on June 22, 2007, the day after the date three years after the date of commencement, and ending on April 4, 2008, the date the Office first mailed an Office action under 35 U.S.C. § 132 or a notice of allowance.

In view of the prior discussion, the patent term adjustment is 1,096 days which is the sum of 796 days of A Delay and 663 days of B Delay reduced by 288 days of overlap and 75 days of Applicant delay.

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, 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 37 C.F.R. § 1.136.

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 **one thousand ninety-six (1096)** 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.	:	7,591,113 B2
ISSUE DATE	:	September 22, 2009
INVENTOR(S)	:	Mourier

DRAFT

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 721 days.

Delete the phrase "by 721 days" and insert - by 1096 days--

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CARSTENS & CAHOON, LLP
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DALLAS TX 75380

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APR 0 4 2007

OFFICE OF PETITIONS

In re Application of	:	
Shimizu, Shohachi	:	
Application No. 10/499,836	:	ON PETITION
Filed: June 18, 2004	:	
Attorney Docket No. CONDA.00020	:	

This is a decision on the petition under 37 C.F.R. § 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 a Request for Continued Examination (RCE) and a Preliminary Amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

This matter is being referred to Technology Center 3600 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

12 JAN 2005

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Marakis Nikolaos
10 M. Odigitrias Str.,
GR-71201
Heraklion, Greece

In re Application of :
NIKOLAOS, Marakis :
U.S. Application No.: 10/499,845 :
PCT No.: PCT/GR02/00009 : **DECISION**
Int. Filing Date: 19 February 2002 :
Priority Date: 20 February 2001 :
Attorney Docket No.: None :
For: HARVESTER OF OLIVES :

This is a decision in response to the "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unavoidable Under 37 CFR 1.137(a)" filed with the national stage papers on 23 June 2004.

BACKGROUND

On 23 June 2004, applicant submitted paperwork to enter the national stage for PCT/GR02/00009 which was accompanied by, *inter alia*, an executed declaration, the basic national fee, a petition under 37 CFR 1.137(a) and the $55.00 petition fee.

DISCUSSION

Applicant included the subject petition to revive under 37 CFR 1.137(a) with the national stage papers because the thirty-month period had expired.

A petition to revive an abandoned application pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply; (2) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; (3) any terminal disclaimer required pursuant to 37 CFR 1.137(c); and (4) the petition fee.

Filing the national stage papers is an acceptable reply. The $55.00 petition fee has been paid. A terminal disclaimer is not required. Thus, items (1), (3) and (4) are complete.

However, applicant has not satisfied item (2). Applicants argue that the abandonment in the above-captioned application was unavoidable because the Greek Industrial Property Organization erroneously informed applicant that the deadline for entrance into the national phase was 20 August 2004.

This claim does not meet the unavoidable standard of 37 CFR 1.137(a). An applicant for patent is solely responsible for meeting all applicable deadlines. Relying on inaccurate advice does not make this mistake unavoidable. Applicant should have verified that the advice was accurate.

CONCLUSION

For the reason discussed above, applicants' petition for revival pursuant to 37 CFR 1.137(a) is **DISMISSED** without prejudice.

The above-captioned application remains **ABANDONED**.

Any renewed petition under 37 CFR 1.137(a) or petition to revive under 37 CFR 1.137(b) must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Applicants may also wish to consider filing a petition under 37 CFR 1.137(b) requesting that the application be revived under the unintentional standard.

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

#PCT

DT08 RECD PCT/PTO 14 MAR 2005

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Alexandria, VA 22313-1450
USA

OIPE JC07 MAR 14 2005 TRADEMARK

Attention: The Office of PCT Legal Administration

March 7, 2005

TRANSMISSION BY FACSIMILE
TOTAL NUMBER OF PAGES: 7 incl. this one
COPY BY EXPRESS MAIL

RECEIVED
13 APR 2005
Legal Staff
International Division

Re: In re application of United States Patent
Application No. 10/499,845
PCT No.: PCT/GR02/00009
Int. Filing Date: 19 February 2002
Priority Date: 20 February 2001
Inventor/Applicant: MARAKIS, Nikolaos
For: HARVESTER OF OLIVES

PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

In response to the decision dated 12 January, 2005 (copy attached) from which follows that the Petition of the undersigned inventor for Revival of the above International Application for Patent designating the U.S. abandoned unavoidably under 37 CFR 1.137 (a) was accepted as to fulfilling the requirements of filing the national stage papers including the basic national fee, but rejected as to meeting the unavoidable standard of 37 CFR 1.137(a), the inventor herewith attaches a Petition for Revival of the above International

Application for Patent designating the U.S. abandoned unintentionally under 37 CFR 1.137 (b) together with a bank check in remittance of the applicable fee of USD 750.00.

Following submission of the present petition under the unavoidable standard, it is believed that an earnest effort has been made to comply with USPTO requirements and bring this application in condition for revival. **The undersigned inventor kindly asks the USPTO not to hesitate to ask for any further information that might be required in view of revival of this application.**

Respectfully submitted

MARAKIS, Nikolaos
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Facsimile: +302810-286 141
e-mail: hefesti@hotmail.com

PTO/SB/64/PCT (12-04)
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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Docket Number (Optional)

First Named Inventor: MARAKIS, Nikolaos

International (PCT) Application No.: PCT/GR02/00009

U.S. Application No.: 10/499,845 (if known)

Filed: 19 February 2002 (19.02.2002)

Title: HARVESTER OF OLIVES

Attention: PCT Legal Staff
Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The above-identified application became abandoned as to the United States because the fees and documents required by 35 U.S.C. 371(c) were not filed prior to the expiration of the time set in 37 CFR 1.495(b) or (c) as applicable. The date of abandonment is the day after the date on which the 35 U.S.C. 371(c) requirements were due. See 37 CFR 1.495(h).

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee
(2) Proper reply
(3) Terminal disclaimer with disclaimer fee which is required for all international applications having an international filing date before June 8, 1995; and
(4) Statement that the entire delay was unintentional.

1. Petition fee

[X] Small entity - fee $ 750.00 (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 paperwork + basic national fee (identify type of reply):

[X] has been filed previously on 23 June 2004.

[ ] is enclosed herewith.

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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

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01 FC:2453 750.00 OP

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.

N. Marakis — Signature

March 9, 2005 — Date

MARAKIS Nikolaos — Typed or Printed Name

Registration Number, if applicable

10 M. ODIGITRIAS STR., — Address

+30210-3608 138 — Telephone Number

GR-71201 HERAKLION, GREECE — Address

Enclosures:
☐ Response
☐ Fee Payment
☐ Terminal Disclaimer
☒ Other (please identify): ACCOMPANYING LETTER

12 JAN 2005

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Marakis Nikolaos
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In re Application of
NIKOLAOS, Marakis
U.S. Application No.: 10/499,845
PCT No.: PCT/GR02/00009
Int. Filing Date: 19 February 2002
Priority Date: 20 February 2001
Attorney Docket No.: None
For: HARVESTER OF OLIVES

DECISION

This is a decision in response to the "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unavoidable Under 37 CFR 1.137(a)" filed with the national stage papers on 23 June 2004.

BACKGROUND

On 23 June 2004, applicant submitted paperwork to enter the national stage for PCT/GR02/00009 which was accompanied by, *inter alia*, an executed declaration, the basic national fee, a petition under 37 CFR 1.137(a) and the $55.00 petition fee.

DISCUSSION

Applicant included the subject petition to revive under 37 CFR 1.137(a) with the national stage papers because the thirty-month period had expired.

A petition to revive an abandoned application pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply; (2) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; (3) any terminal disclaimer required pursuant to 37 CFR 1.137(c); and (4) the petition fee.

Filing the national stage papers is an acceptable reply. The $55.00 petition fee has been paid. A terminal disclaimer is not required. Thus, items (1), (3) and (4) are complete.

However, applicant has not satisfied item (2). Applicants argue that the abandonment in the above-captioned application was unavoidable because the Greek Industrial Property Organization erroneously informed applicant that the deadline for entrance into the national phase was 20 August 2004.

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This claim does not meet the unavoidable standard of 37 CFR 1.137(a). An applicant for patent is solely responsible for meeting all applicable deadlines. Relying on inaccurate advice does not make this mistake unavoidable. Applicant should have verified that the advice was accurate.

CONCLUSION

For the reason discussed above, applicants' petition for revival pursuant to 37 CFR 1.137(a) is **DISMISSED** without prejudice.

The above-captioned application remains **ABANDONED**.

Any renewed petition under 37 CFR 1.137(a) or petition to revive under 37 CFR 1.137(b) must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Applicants may also wish to consider filing a petition under 37 CFR 1.137(b) requesting that the application be revived under the unintentional standard.

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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14 APR 2005

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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www.uspto.gov

Marakis Nikolaos
10 M. Odigitrias Str.,
GR-71201
Heraklion, Greece

In re Application of :
NIKOLAOS, Marakis :
U.S. Application No.: 10/499,845 :
PCT No.: PCT/GR02/00009 : **DECISION**
Int. Filing Date: 19 February 2002 :
Priority Date: 20 February 2001 :
Attorney Docket No.: None :
For: HARVESTER OF OLIVES :

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 09 March 2005 is hereby **GRANTED** as follows:

The petition fee for a small entity of $750.00 has been paid. The basic national fee was previously submitted. 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 surcharge fee of $65.00 for late filing of the declaration pursuant to 37 CFR 1.492(h) is required

This application is being forwarded to the United States Designated/Elected Office for further processing including mailing a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) indicating that a surcharge fee is required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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HOWSON & HOWSON LLP
501 OFFICE CENTER DRIVE
SUITE 210
FORT WASHINGTON, PA 19034

Mail Date: 04/20/2010

Applicant	: Robert Casper	: DECISION ON REQUEST FOR
Patent Number	: 7625752	: RECALCULATION of PATENT
Issue Date	: 12/01/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/499,849	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 11/23/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **769** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

19 APR 2005
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#4

Timothy E. Nauman
FAY, SHARPE, FAGAN
MINNICH & MCKEE LLP
1100 SUPERIOR AVENUE
7TH FLOOR
CLEVELAND, OH 44114-2579

In re Application of FARANT et al.	
Application No.: 10/499,856	
PCT Application No.: PCT/CA02/01915	DECISION ON PETITION
Int. Filing Date: 11 December 2002	UNDER 37 CFR 1.137(b)
Priority Date Claimed: 19 December 2001	
Attorney Docket No.: CLWZ 2 00154	
For: ADSORPTION OF CONTAMINANTS FROM GASEOUS STREAM AND IN SITU REGENERATION OF SORBENT	

Applicants' "Petition For Revival Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office (PTO) on 02 December 2004 is GRANTED.

BACKGROUND

On 11 December 2002, applicants filed international application PCT/CA02/01915. The international application claims a priority date of 19 December 2001 and designates the United States. A copy of the international application was communicated from the International Bureau to the United States Patent and Trademark Office on 26 June 2003. The deadline to pay the basic national fee was thirty months from the priority date, that is 19 June 2004. The application became abandoned at midnight 19 June 2004 for failure to pay the basic national fee.

On 21 June 2004, applicants filed a transmittal letter for entry into the US national stage under 35 U.S.C. 371, which was accompanied by, inter alia, a copy of the International Application.

On 02 December 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) and the petition fee of $1370.

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 filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3). The 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.

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

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Amy Vanatta
Detailee
PCT Legal Administration
Telephone: 571-272-6095
Facsimile: 571-273-0459

23 JUN 2005

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#6

Louis M. Heidelberger
Intellectual Property Group Reed Smith
2500 One Liberty Place
1650 Market Street
Philadelphia, PA 19103-7301

In re Application of	:
PARSONS, John David	: DECISION ON
US Application No.: 10/499,862	:
PCT Application No.: PCT/GB02/05793	: PETITION UNDER
Int. Filing Date: 19 December 2002	:
Priority Date: 21 December 2001	: 37 CFR 1.37(b)
Attorney's File Reference: 04-40209-US	:
For: ANTENNA MEASUREMENT SYSTEM	:

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 05 January 2005. The petition is **GRANTED**.

BACKGROUND

On 19 December 2002, applicants filed international application PCT/GB02/05793. The international application designated the United States and did claim priority to an earlier filed application. The deadline for paying the basic national fee in the United States was thirty months from the priority date, which was 21 June 2004.

On 21 June 2004, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia,* a Transmittal Letter, a substitute application (consisting of 22 pages specification, five pages of claims, a one page abstract and 8 sheets of drawings), a copy of the International Application, and an unexecuted declaration and power of attorney. The Transmittal Letter did not authorize the Basic National Fee or the $130 surcharge for furnishing the oath or declaration later than 30 months from the earliest claimed priority date.

On 04 January 2005, 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 provide the full basic national filing fee by 30 Months.

On 05 January 2005, applicants filed the instant petition for revival accompanied by, *inter alia,* a credit card payment form for payment of the basic national filing fee and the petition fee.

The cover sheet for the petition authorized charging or crediting additional fees to Deposit Account 18-0586.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper reply, (2) the petition fee required by law, (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995). Payment of the basic national fee constitutes a proper reply for entry into the national stage.

The payment of the national fee satisfies the requirement under 37 CFR 1.137(b)(1). The payment of the petition fee satisfies the requirement under 37 CFR 1.137(b)(2). Applicant's statement in the petition that " [t]he entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 C.F.R. § 1.137(b) was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3). A terminal disclaimer is not required because the application was filed after 08 June 1995, which satisfies the requirements of 37 CFR 1.137 (b)(4). Therefore the requirements of 37 CFR 1.137(b) have been met.

CONCLUSION

Applicant's petition to revive under 37 CFR 1.137(b) is hereby **GRANTED**.

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 Notification of Missing Requirements (PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) is required.

Craig Thompson
PCT Legal Administration Detailee
Office of PCT Legal Administration
Telephone: 571-272-6094
Facsimile: 571-272-0459

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

03 MAR 2005

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Horst S. Kasper
13 Forest Drive
Warren, NJ 07059

In re Application of: BRETTSCHNEIDER, Hartmut	
U.S. Application No.: 10/499,864	DECISION ON PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137(b)
PCT No.: PCT/EP01/04047	
International Filing Date: 09 April 2001	
Priority Date: 07 April 2000	
Attorney's Docket No.:MSA259PR	
For: METHOD FOR PRODUCING A SLEEVE THAT HAS A GREATER LENGTH AND IS USED FOR FOOD	

The petition to revive under 37 CFR 1.137(b) filed 21 June 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "A delay in entering the national phase in the United States within a statutory period of 30 months from a priority date was unintentional" is being 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 this statement, applicant **must** contact this Office immediately. Based on this interpretation of the statement in the petition, 37 CFR 1.137(b)(3) is satisfied.

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

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LUNDBECK RESEARCH USA, INC.
ATTENTION: STEPHEN G. KALINCHAK, LEGAL
215 COLLEGE ROAD
PARAMUS NJ 07652

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APR 2 8 2008

OFFICE OF PETITIONS

In re Application of :
Jan KEHLER et al. :
Application No. 10/499,880 : DECISION ON PETITION
Filed: October 28, 2004 :
Attorney Docket No. **386-US-PCT** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 14, 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 March 13, 2008, as required by the Notice of Allowance and Fee(s) Due, mailed December 13, 2007. Accordingly, the date of abandonment of this application is March 14, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $1440 and the publication fee of $300, (2) the petition fee of $1540; and (3) a proper statement of unintentional delay. Accordingly, the Issue Fee and the Publication Fee are accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at (571) 272-2783.

This application is being referred to Publishing Division for processing into a patent.

David Bucci
Petitions Examiner
Office of Petitions

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SQUIRE, SANDERS & DEMPSEY L.L.P
PATENT DEPARTMENT
ONE MARITIME PLAZA
SUITE 300
SAN FRANCISCO, CA 94111-3492

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JUN 13 2007

OFFICE OF PETITIONS

In re Application of	:	
Gerhard Hartwich, et al.	:	
Application No. 10/499,887	:	DECISION ON PETITION
Filed: March 1, 2005	:	TO WITHDRAW
Attorney Docket No. 59693.00007	:	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 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 Aaron Wininger on behalf of all attorneys of record who are associated with customer No. 30256.

All attorneys/agents associated with the Customer Number302560 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). The power of attorney filed on January 16, 2007 does not include a proper chain of title or a proper 3.73(b) statement.

There are no pending Office actions at the present time.

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: GERHARD HARTWICH
NIBELUNGENSTR. 10
MUNCHEN 80639
GERMANY

cc: CROCKET & CROCKET
24012 CALLE DE LA PLATA
SUITE 400
LAGUANA HILLS, CA 92653

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
10/499,887	03/01/2005	Gerhard Hartwich	59693.00007

CONFIRMATION NO. 5758

OC000000024317125

30256
SQUIRE, SANDERS & DEMPSEY L.L.P
PATENT DEPARTMENT
ONE MARITIME PLAZA, SUITE 300
SAN FRANCISCO, CA 94111-3492

Date Mailed: 06/12/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/29/2006.

- 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.

Office of Initial Patent Examination (571) 272-4000, or 1-800-PTO-9199
FORMER ATTORNEY/AGENT COPY

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SUITE 400
LAGUANA HILLS, CA 92653

In re Application of :
Gerhard Hartwich, et al. :
Application No. 10/499,887 : DECISION ON REQUEST FOR
Filed: March 1, 2005 : REVOCATION OF POWER
Attorney Docket No. 212/954US : OF ATTORNEY
:

This is a decision on the Request to Revoke the attorney or agent of record under 37 C.F.R. § 1.36(a), filed January 16, 2007.

The request is **NOT APPROVED**.

A power of attorney, pursuant to § 1.32(b), may be revoked at any stage in the proceeding of a case by an applicant for patent (§ 1.41(b)) or an assignee of the entire interest of the applicant under § 3.71(b). Fewer than all of the applicants (or by fewer than the assignee of the entire interest of the applicant) may only revoke the power of attorney upon a showing of sufficient cause, and payment of the petition fee set forth § 1.17(h). For the assignee to take action a proper statement under § 3.73(b) is required.

The request cannot be approved because a proper statement under 3.73(b) was not filed or no statement under 3.73(b) was filed.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

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

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CROCKETT & CROCKETT, P.C.
26020 ACERO
SUITE 200
MISSION VIEJO, CA 92691

Mail Date: 04/21/2010

Applicant	: Gerhard Hartwich	: DECISION ON REQUEST FOR
Patent Number	: 7601848	: RECALCULATION of PATENT
Issue Date	: 10/13/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/499,887	: OF WYETH
Filed	: 03/01/2005	:
		:

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

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

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

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

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

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

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

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

or

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

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

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

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

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

10 JAN 2005

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ALEXANDRIA, VA 22313-1450
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Adriane M. Antler
JONES DAY
222 East 41st Street
New York, New York 10017

In re Application of	: DECISION ON
KENSIL, Charlotte A.	:
US Application No.: 10/499,890	:
PCT Application No.: PCT/US02/40910	: PETITION UNDER
Int. Filing Date: 20 December 2002	:
Priority Date: 21 December 2001	:
Attorney's File Reference: 8449-196-999	: 37 CFR 1.137 (b)
For: COMPOSITIONS COMPRISING IMMUNOREACTIVE REAGENTS AND SAPONINS, AND METHODS OF USE THEREOF	

Applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office (USPTO) on 22 June 2004 is **GRANTED**.

BACKGROUND

On 20 December 2002, applicant filed international application PCT/US02/40910. The international application claims a priority date of 21 December 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 21 June 2004. Applicant missed this deadline.

On 22 June 2004, applicant 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) (including a Transmittal Letter and a Preliminary Amendment), an unexecuted declaration, and the petition fee for a small entity of $665.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper reply, (2) the petition fee required by law, (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995). A payment of the basic national fee constitutes a proper reply for entry into the national stage. A proper reply requires payment of the basic

national fee and submission of a copy of the international application, if such a copy has not already been communicated by the International Bureau

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). Applicant's statement in the petition 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). A terminal disclaimer is not required because the application was filed on or after 08 June 1995, which satisfies the requirements of 37 CFR 1.137 (b)(4). 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.

Ula Ruddock
PCT Legal Administration Detailee
PCT Special Programs Office
Telephone: 571-272-3279

Richard Cole
PCT Legal Examiner
PCT Legal Office

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/06/09

TO SPE OF : ART UNIT 1625

SUBJECT : Request for Certificate of Correction for Appl. No.: 10499893 Patent No.: 7462644 B2

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580
You can fax the Directors/SPE response to 571-270-9990

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

Thank You For Your Assistance

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

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

Comments: _____

_____

_____

/Janet L. Andres/ 1625

SPE Art Unit

20 SEP 2005

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

Karin H. Butchko
Carlson, Gaskey & Olds, P.C.
400 W. Maple
Suite 350
Birmingham, MI 48009

In re Application of	
RANALLI, et al.	
Application No.: 10/499,897	
PCT No.: PCT/EP03/12614	DECISION ON PETITION
Int. Filing Date: 12 November 2003	
Priority Date: 05 December 2002	UNDER 37 CFR 1.181
Atty. Docket No.: 60130-2165	
For: MOTOR VEHICLE PROVIDED WITH A DIESEL PROPULSION ENGINE	

This decision is in response to applicant's "Response to Missing Parts" filed 11 May 2005 in the United States Patent and Trademark Office (USPTO). The response is being treated as a petition under 37 CFR 1.181. No petition fee is required.

BACKGROUND

On 12 November 2003, applicant filed international application PCT/EP03/12614, which claimed priority of an earlier application filed 05 December 2002. A copy of the international application was communicated to the United States Patent and Trademark Office form the International Bureau on 17 June 2004. 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, 05 June 2005.

On 23 June 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and an information disclosure statement.

On 08 December 2004, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide a signed oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date, as well as, an English translation of the international application.

On 11 May 2005, applicant filed the present petition under 37 CFR 1.181 indicating that the Form PCT/DO/EO/905 was never received accompanied by an executed declaration of the inventors and an English translation of the international application.

DISCUSSION

As stated above, the deadline for payment of the basic national fee was set to expire 30 months from the priority date, or at midnight on 05 June 2005. On 23 June 2004, applicant submitted a transmittal letter for entry into the national stage in the United States. Applicant did not request early examination pursuant o 35 U.S.C. 371(f). In addition, all the requirements under 35 U.S.C. 371(c) were not met, therefore national stage processing should not have commenced until the expiration of 30 months from the priority date, 05 June 2004. Therefore, the Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) was mailed in error and is hereby vacated. A review of the application file finds that with the current submission applicant has satisfied all of the 35 U.S.C. 371 (c) requirements.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **DISMISSED as moot**.

The Form PCT/DO/EO/905 mailed 08 December 2004 is hereby **VACATED**.

This application will be given an international application filing date of 12 November 2003 and a date of **11 May 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
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

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CARLSON, GASKEY & OLDS, P.C.
400 WEST MAPLE ROAD
SUITE 350
BIRMINGHAM, MI 48009

Mail Date: 04/21/2010

Applicant	: Marco Ranalli	: DECISION ON REQUEST FOR
Patent Number	: 7581386	: RECALCULATION of PATENT
Issue Date	: 09/01/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/499,897	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/06/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1122** 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

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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May 11, ~~March 30~~, 2009

Celine Jimenez Crowson
Hogan & Hartson, LLP
555 Thirteenth Street, N.W.
Washington, DC 20004

Patent No.: 7,507,753 B2
Application No.: 10/499,903
Inventor(s): Nobuo Cho, et al.
Issued: March 24, 2009
Title: **BIARYL COMPOUND AND USE THERE OF**

Re: Request for Certificate of Correction

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

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

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

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

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

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

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

By mail:	Mail Stop PETITIONS Commissioner for Patents Post Office Box 1450 Alexandria, VA 22313-1450
By hand:	Customer Service Window Mail Stop Petitions Randolph Building 401 Dulany Street Alexandria, VA 22314
By fax:	(571) 273-0025 ATTN: Office of Petitions

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

Virginia Tolbert
For Mary Diggs, Supervisor
Decisions & Certificate of Correction Branch
(703) 305-8309 or (703) 756-1591

vt

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Alexandria, VA 22313-1450
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HOGAN & HARTSON L.L.P.
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES CA 90067

COPY MAILED

SEP 29 2009

OFFICE OF PETITIONS

In re Patent No. 7,507,753 :
Issue Date: 24 March, 2009 :
Application No. 10/499,903 : ON PETITION
Filed: 23 June, 2004 :
Attorney Docket No. 29522-0013 :

This is a decision on the petition filed on 1 June, 2009, resubmitted on 23 July, 2009, under 37 C.F.R. §3.81(b) to correct, *inter alia*, the name of the assignee on the front page of the above-identified patent by way of a certificate of correction under 37 C.F.R. §1.323.

The request is **GRANTED**— upon the instant showing of the recordation of the assignment on 2 June, 2005, and the location of recordation as Reel/Frame 018917/0406.

Petitioner requests issuance of a certificate of correction the identification of the Assignee(s) to "**TAKEDA PHARMACEUTICAL COMPANY LIMITED (Osaka, JP)**" of the substance and in the form of that submitted therewith.

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

Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[1]) regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

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

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

§1.2 Business to be transacted in writing.

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

29 MAR 2005

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Kent E. Baldauf
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

In re Application of CHOI et al	:	
U.S. Application No.: 10/499,908	:	
PCT Application No.: PCT/KR02/02396	:	
Int. Filing Date: 20 December 2002	:	
Priority Date Claimed: 22 December 2001	:	DECISION
Attorney Docket No.: 1455-044338	:	
For: AN APPARATUS FOR CONTROLLING GAS LAYER THICKNESS ON THE SURFACE OF CASTING ROLL IN TWIN ROLL STRIP CASTER	:	

This is in response to the declaration filed 22 June 2004, which is being treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 20 December 2002, applicant filed international application PCT/KR02/02396, which claimed priority of an earlier Korea application filed 22 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 10 July 2003. The thirty-month period for paying the basic national fee in the United States expired on 22 June 2004.

On 22 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) 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 22 June 2004 does not state the citizenship of the legal representative as required by 37 CFR 1.497(b)(2).

CONCLUSION

For the reasons above, the request for status under 37 CFR 1.42 is DISMISSED without prejudice.

If reconsideration on the merits of the request is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the present application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Request for Status Under 37 CFR 1.42".

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

25 MAY 2005

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#5

Kent E. Baldauf
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219-1818

In re Application of CHOI et al	:	
U.S. Application No.: 10/499,908	:	
PCT Application No.: PCT/KR02/02396	:	
Int. Filing Date: 20 December 2002	:	
Priority Date Claimed: 22 December 2001	:	DECISION
Attorney Docket No.: 1455-044338	:	
For: AN APPARATUS FOR CONTROLLING GAS LAYER THICKNESS ON THE SURFACE OF CASTING ROLL IN TWIN ROLL STRIP CASTER	:	

This is in response to the papers filed 19 May 2005, which is being treated as a renewed request for status under 37 CFR 1.42.

BACKGROUND

On 20 December 2002, applicant filed international application PCT/KR02/02396, which claimed priority of an earlier Korea application filed 22 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 10 July 2003. The thirty-month period for paying the basic national fee in the United States expired on 22 June 2004.

On 22 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) and a request for status under 37 CFR 1.42.

On 29 March 2005, this Office mailed a decision dismissing the 22 June 2004 request for status.

On 19 May 2005, applicant filed the present renewed request for status under 37 CFR 1.42 along with an executed declaration.

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 19 May 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 20 December 2002, and a date under 35 U.S.C. 371(c) of 19 May 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

15 NOV 2004

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Richard H. Tushin
DYKEMA GOSSETT PLLC
1300 I Street, N.W., Third Floor West
Washington, DC 20005-3353

In re Application of
NEUMANN, Joachim *et al*
U.S. Application No.: 10/499,915
PCT No.: PCT/DK02/0422
Int. Filing Date: 21 June 2002
Priority Date: 28 June 2001
Attorney Docket No.: 66722-054-7
For: METHOD FOR NOISE REDUCTION AND MICROPHONE ARRAY FOR PERFORMING NOISE REDUCTION

DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)

Applicants' "Petition Under 37 C.F.R. §1.137(b)" filed with the national stage papers on 22 June 2004 is hereby **GRANTED** as follows:

The basic national fee and petition fee of $1,330.00 have been paid. Applicants state that "[t]he entire delay in commencing U.S. national stage processing between the due date (December 28, 2003) and the date of filing a grantable petition under 37 C.F.R. § 1.137(b) was unintentional" has been interpreted as meeting the requirements of 37 CFR 1.137(b)(3). If this interpretation is incorrect, applicants should immediately notify the Office. A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A declaration in compliance with 37 CFR 1.497(a) and (b) and a $130.00 surcharge fee was filed 26 October 2004. Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 21 June 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 26 October 2004.

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

UNITED STATES PATENT AND TRADEMARK OFFICE

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

Mail Date: 04/22/2010

Applicant	: Christopher John Greenwood	: DECISION ON REQUEST FOR
Patent Number	: 7632208	: RECALCULATION of PATENT
Issue Date	: 12/15/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/499,925	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/17/2004	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **740** 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

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CHARMASSON, BUCHACA & LEACH, LLP
2635 CAMINO DEL RIO SOUTH
SUITE 102
SAN DIEGO CA 92108

MAILED

MAY 25 2010

OFFICE OF PETITIONS

In re Application of :
Murphy et al. :
Application Number: 10/499931 : ON PETITION
Filing Date: 11/22/2004 :
Attorney Docket Number: 040500 :
:

This is a decision in response to the petition under 37 CFR 1.137(b)[1] filed on March 4, 2010, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on July 21, 2009, for failure to file timely submit a response to the non-final Office action mailed on April 20, 2009, 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 November 25, 2009.

---

[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)).

Receipt of the amendment filed on March 4, 2010 is acknowledged.

The application will be referred to Technology Center Art Unit 1619 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

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PAULA D. MORRIS
THE MORRIS LAW FIRM, P.C.
10260 WESTHEIMER, SUITE 360
HOUSTON TX 77042-3110

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MAR 2 8 2007

OFFICE OF PETITIONS

In re Application of
Lakahmi Putcha et al.
Application No. 10/499,996
Filed: June 22, 2004
Attorney Docket Number: SWRI-2929-05

ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed, September 8, 2006, to change the name of inventor "Niraj Vasishtha" to –Niraj Vasisht --.

The petition is **GRANTED**.

Office records have been updated to reflect the inventor's change of name. A corrected filing receipt is included with this decision and this matter is being referred to Technology Center 1618 for examination in due course.

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPL NO.	FILING OR 371(c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	TOT CLMS	IND CLMS
10/499,996	06/22/2004	1618	1270	SWRI-2929-05	97	10

CONFIRMATION NO. 5864

CORRECTED FILING RECEIPT

OC000000023140194

23770
PAULA D. MORRIS
THE MORRIS LAW FIRM, P.C.
10260 WESTHEIMER, SUITE 360
HOUSTON, TX 77042-3110

Date Mailed: 03/28/2007

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Lakahmi Putcha, Houston, TX;
Joe McDonough, Helotes, TX;
Edward J. Boland, San Antonio, TX;
Hong Dixon, Helotes, TX;
Joseph T. Persyn, Lakehills, TX;
Niraj Vasisht, San Antonio, TX;

Power of Attorney: The patent practitioners associated with Customer Number **23770**.

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/US03/02797 01/31/2003
which claims benefit of 60/353,633 01/31/2002
and claims benefit of 60/353,766 01/31/2002 *
(*)Data provided by applicant is not consistent with PTO records.

Foreign Applications

If Required, Foreign Filing License Granted: 03/27/2007

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/499,996

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****

Title

Controlled release compositions and methods for using same

Preliminary Class

424

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where

the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

Mail Date: 04/21/2010

Applicant	: Jonas Salomonson	: DECISION ON REQUEST FOR
Patent Number	: 7600398	: RECALCULATION of PATENT
Issue Date	: 10/13/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 10/500,003	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 06/24/2005	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **100** 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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VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

Mail Date: 05/18/2010

Applicant : Jonas Salomonson
Patent Number : 7600398
Issue Date : 10/13/2009
Application No: 10/500,003
Filed : 06/24/2005

: 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 **203** 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).

18 NOV 2004

#5

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Mark M. Friedman
Discovery Dispatch
9003 Florin Way
Upper Marlboro, MD 20772

In re Application of
PINES et al.
Serial No.: 10/500,013
PCT App. No.: PCT/IL02/00085
Int'l Filing Date: 30 January 2002
Priority Date: 30 January 2001
Attorney Docket No.: 2388/3
For: SYSTEM AND METHOD FOR ELECTRICAL STIMULATION OF SALIVATION

DECISION ON

PETITION UNDER

37 CFR 1.137(b)

This is responsive to applicant's Status Inquiry filed in the United States Patent and Trademark Office on 27 October 2004. The petition to revive under 37 CFR 1.137(b) filed 23 June 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that the "entire delay in filing from July 30, 2003 to the instant filing attached herewith was unintentional" has been interpreted as meaning that "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3) at the time of filing this petition. If this is an incorrect interpretation in view of the rules, petitioner is required to promptly notify this office.

A review of the application file reveals that the basic national fee of $50 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 $65 surcharge for filing the declaration after the thirty month will be charged to applicant's deposit account per his authorization. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is **23 June 2004.**

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

02 DEC 2004

#3

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
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Scott M. Daniels
Westerman, Hattori, Daniels & Adrain LLP
1250 Connecticut Avenue N.W.
Washington, D.C. 20036

In re Application of	:	NOTIFICATION REGARDING
NOMURA, Syuushi	:	DEFECTIVE DECLARATION
Application No.: 10/500,042	:	
PCT No.: PCT/JP02/13473	:	AND
Int. Filing Date: 24 December 2002	:	
Priority Date: 25 December 2001	:	REQUIREMENT FOR NEW
Attorney Docket No.: 04449	:	DECLARATION OR REQUEST
For: FIELD CONVERTER AND FLUID PROCESSING DEVICE UTILIZING SAID CONVERTER		UNDER 37 CFR 1.497(d)

This is to notify applicant that the declaration filed on 23 June 2004 in the above-captioned application is not in compliance with 37 CFR 1.497(a) and that a new declaration or submission under 37 CFR 1.497(d) is required.

BACKGROUND

On 24 December 2002, applicant filed the above-captioned international application, which claimed a priority date of 25 December 2001 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 2003. The international application named Syuushi Nomura as applicant/inventor. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 25 June 2004.

On 23 June 2004, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a basic national fee, a translation of the international application, a preliminary amendment; and a declaration executed by: Syuuish Nomura and Aoi Kawasaki.

DISCUSSION

The declaration filed 23 June 2004 is not acceptable. Specifically, the declaration sets forth an additional inventor (Aoi Kawasaki) who has not been named in the international application.

In that an acceptable declaration of the inventor(s) has not been submitted, the application cannot be accepted into the national stage at this time.

Applicant must submit either: 1) a submission under 37 CFR 1.497(d) requesting correction of the inventors named in the international application to include Aoi Kawasaki, (2) a new declaration naming and signed by only Syuuish Nomura accompanied by an acceptable explanation of the misnaming of the inventor on the present declaration, or (3) a showing that a 92bis change was made prior to the National stage filing. A proper response must be filed within **TWO (2) MONTH** from the mail date of this notification. Extensions of time are available under 37 CFR 1.136.

A submission under 37 CFR 1.497(d) to correct an error in naming inventorship requires:

(1) a petition including 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 1.63;
(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).

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
Facsimile: 571-273-0459

13 JAN 2005

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Scott M. Daniels
Westerman, Hattori, Daniels & Adrian LLP
1250 Connecticut Avenue N.W.
Washington, D.C. 20036

In re Application of :
NOMURA, Syuushi :
Application No.: 10/500,042 :
PCT No.: PCT/JP02/13473 : COMMUNICATION
Int. Filing Date: 24 December 2002 :
Priority Date: 25 December 2001 :
Attorney Docket No.: 042449 :
For: FIELD CONVERTER AND FLUID PROCESSING DEVICE UTILIZING SAID CONVERTER

This communication is in response to applicant's "Response to Notification Regarding Defective Declaration" filed 09 December 2004 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 02 December 2004, applicant was mailed a Notification informing applicant that the declaration filed 23 June 2004 was defective as the declaration set forth an additional inventor (Aoi Kawasaki) who has not been named in the international application. Applicant was afforded two months to file either: 1) a submission under 37 CFR 1.497(d) requesting correction of the inventors named in the international application to include Aoi Kawasaki, (2) a new declaration naming and signed by only by Syuuish Nomura accompanied by an acceptable explanation of the misnaming of the inventor on the present declaration, or (3) a showing that a change under PCT Rule 92bis was made prior to the National stage filing.

On 09 December 2004, applicant filed the present response which included a copy of Form PCT/IB/306 showing that the status of applicant Aoi Kawasaki had been changed pursuant to PCT Rule 92bis to applicant/inventor for the US only.

DISCUSSION

Applicant has presently provided evidence that Aoi Kawasaki is an applicant/inventor for the United States only. As such it is proper to find the declaration filed on 23 June 2004 as compliant with 37 CFR 1.497(a)-(b). Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

CONCLUSION

Applicant has made a sufficient showing such that the declaration filed 23 June 2004 is held to be a proper reply to the Notification Regarding Defective Declaration and Requirement for New Declaration or Request Under 37 CFR 1.497(d) mailed 02 December 2004.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this communication. The 35 U.S.C. 371(c) date is **23 June 2004**.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 571-272-3298
Facsimile: 571-273-0459

08 JUL 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
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Jerome J. Smith
Polsinelli Shalton Welte Suelthaus PC
700 W. 47th Street, Suite 1000
Kansas City, MO 64112

In re Application of	:	
SATT et al.	:	
Application No.: 10/500,052	:	DECISION ON PETITION
PCT No.: PCT/GB01/05784	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 27 December 2001	:	
Priority Date: 27 December 2000	:	
Attorney Docket No.:68649	:	
For: RESOURCE ALLOCATION IN CELLULAR TELEPHONE NETWORKS	:	

The petition to revive under 37 CFR 1.137(b) filed 24 June 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

10 DEC 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Phillip E. Decker
Decker Law Office
One New Hampshire Avenue, Suite 125
Portsmouth, NH 03801

In re Application of
BONERB
U.S. Application No.: 10/500,057
PCT No.: PCT/US02/38207
Int. Filing Date: 26 November 2002
Priority Date: 26 November 2001
Attorney Docket No.: BON.US.58
For: UNLOADER FOR DISCHARGING DRY MATERIALS FROM BULK BAGS

DECISION ON PETITION

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 24 June 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

The application has an international filing date of 26 November 2002 under 35 U.S.C. 363 and will be given a date of **24 June 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

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OFFICE OF PETITIONS

Haynes and Boone, LLP
901 Main Street, Suite 310
Dallas, TX 75202

In re Application of :
Kevin Karl Waddell et al. :
Application No. 10/500,063 : DECISION ON PETITION
Filed: June 24, 2004 : TO WITHDRAW
Attorney Docket No. 25791.68.05 : 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 2, 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 Terri Williams at 571-272- 2991.

Terri Williams
Petitions Examiner
Office of Petitions

cc: **King & Spalding, L.L.P.**
Todd Mattingly
1100 Louisiana Street, Suite 4000
Houston, TX 77002

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PRICE HENEVELD COOPER DEWITT & LITTON, LLP
695 KENMOOR, S.E.
P O BOX 2567
GRAND RAPIDS MI 49501

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FEB 25 2010

In re Patent of Busse	:	
Patent No. 7,552,697	:	
Issued: June 30, 2009	:	NOTICE
Application No. 10/500,078	:	
Filed: November 26, 2004	:	
Attorney Docket No. BIG007 P301	:	

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed December 10, 2009 (certificate of mailing date December 7, 2009).

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

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

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

01 NOV [redacted]

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John B. Conklin
LEYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, IL 60601-6780

In re Application of
BELLEZZA, Massimo
U.S. Application No.: 10/500,095
PCT No.: PCT/IT02/00821
Int. Filing Date: 23 December 2002
Priority Date: 27 December 2001
Attorney Docket No.: 229618
For: INTEGRATED CONVEYOR SYSTEM FOR MOVING LOADS, IN PARTICULAR VEHICLES ALONG A PRODUCTION LINE

DECISION

This is a decision on the documents filed via facsimile on 26 October 2005 which are treated as a petition to withdraw the holding of abandonment. No fee is required.

BACKGROUND

On 01 October 2004, a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) was mailed indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond.

On 30 November 2004, applicant purportedly filed a response which was accompanied by, *inter alia*, a declaration. These papers were not located in the file.

On 01 August 2005, a status inquiry request was filed.

On 25 August 2005, a response to the status inquiry was mailed indicating that a response to the Form PCT/DO/EO/905 mailed 01 October 2004 was not in the file, therefore, the above-captioned application was abandoned.

On 02 September 2005, applicant purportedly filed papers which included the subject petition. This petition is not located in the file.

On 21 October 2005, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed for failing to respond to the Form PCT/DO/EO/905 mailed 01 October 2004

within the time period set therein.

On 26 October 2005, applicant resubmitted the subject petition along with a copy of the date-stamped postcard receipts for the 30 November 2004 response and the 02 September 2005 petition.

DISCUSSION

The response to the Form PCT/DO/EO/905 mailed 01 October 2004 purportedly filed 30 November 2004 was not located in the file. In addition, the petition submitted 02 September 2005 also could not be located.

Nevertheless, MPEP § 503 lists procedures to ensure receipt of any paper filed in the USPTO. Applicant must enclose a self-addressed postcard identifying all of the papers filed. The USPTO will stamp the receipt date on the card and place it on the outgoing mail. The identifying data on the card must clearly identify the paper for which receipt is requested. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

Here, applicant provided a copy of the date-stamped postcard receipt for documents submitted on 30 November 2004 and 02 September 2005. Both postcard receipts identified the application by the application number, docket number and title. On the papers purportedly filed 30 November 2004, the postcard receipt indicates that a "Response to Notice to File Missing Parts Transmittal" and "Executed Declaration" were received in the USPTO. The postcard receipt is stamped "DT03 Rec'd PCT/PTO 30 NOV 2004" across its face. The second postcard receipt also indicates that the subject petition was initially filed 02 September 2005 and is stamped "JC07 Rec'd PCT/PTO 02 SEP 2005" across its face. Moreover, USPTO financial records also show that a $65.00 surcharge fee was received on 02 September 2005.

Accordingly, applicant has provided *prima facie* evidence that a response to the Form PCT/DO/EO/905 mailed 01 October 2004 was filed 30 November 2004 and that the subject petition was initially filed 02 September 2005.

With regards to applicant's request for a refund of the $400.00 petition fee, there is no record that such a fee was charged in this case. Hence, no refund is possible.

CONCLUSION

In view of the above, applicant's petition to withdraw the holding of abandonment is hereby **GRANTED**.

The Form PCT/DO/EO/909 mailed 21 October 2005 is **VACATED**.

The declaration initially filed 30 November 2004 is in compliance with 37 CFR 1.497(a) and (b).

Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 23 December 2002, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 30 November 2004.

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

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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MAY 22 2007

MICHAEL DAVID, ESQ.
FRIED, FRANK, HARRIS, SHRIVER & JACOBSON LLP
1001 PENNSYLVANIA AVENUE, NW
SUITE 800
WASHINGTON, DC 2004-2505

In re Application of	:
Anne D. Frame	:
Serial No.: 10/500,098	: PETITION DECISION
Filed: June 24, 2004	:
Attorney Docket No.: 94756/5	:

This is in response to the petition under 37 CFR 1.144, filed March 16, 2007, requesting review and withdrawal of the restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed on June 24, 2004, under 35 U.S.C. 371 as the national filing of PCT/US01/50502. The examiner mailed to applicants on July 13, 2006, a lack of unity determination, wherein three inventions (Groups I-III) were identified and rationale set forth establishing the examiner's position.

Applicant replied on August 8, 2006, electing Group III (claims 16-25).

The examiner mailed an Office action on November 2, 2006, wherein the election of Group III was acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the lack of unity determination, the election was treated as an election without traverse. The examiner further set forth an election of species requirement wherein applicant was required to elect a single species of Group III (plant source) from the group consisting of *Mammea Americana*, *Callistemon citrinus* and *Marchantia polymorpha*.

Applicant replied to the supplemental election of species requirement on December 28, 2006, electing *Mammea Americana*, with traverse. Applicant argued that there is unity of invention among the pending claims because there is a technical relationship among the inventions (i.e., the plant material is extracted from the plant using the same methodological steps). Applicant further argued that PCT rules do not provide for election of species. Claims 16-25 were canceled and replaced by newly added claims 32-49.

The examiner mailed a non-final Office action on February 23, 2007, acknowledging the election of *Mammea Americana* and the traversal. The examiner maintained the requirement and made it

FINAL. Claims 1-15, 26-31, 34, 35 and 42-46 were withdrawn from consideration as being drawn to a nonelected invention. Claims 36-41 and 47-49 were rejected under 35 U.S.C. 112, first paragraph, for lack of enablement. Claims 36-41 were rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the written description requirement. Claims 36-41 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 32-33 and 48-49 were rejected under 35 U.S.C. 102(b) as being anticipated by Crombie et al.

On March 16, 2007, applicant filed this petition to review and withdrawn the species requirement set forth on November 2, 2006.

DISCUSSION

The petition and filed history have been carefully considered.

Applicant argues that (1) there is unity of invention between the three plants and (2) U.S. patent rules allow for co-prosecution of species in national stage applications.

Independent claim 32 is representative of claimed invention(s). Said claim reads:

> 32. A method of preparing a composition having antimicrobial activity comprising extracting a plant material in an organic solvent to obtain extracted material, contacting the extracted material with a chromatographic separation system, and eluting from the chromatographic separation system with a mobile polar phase to obtain a composition, wherein the plant material is from *Mammea Americana*, *Marchantaceae polymorpha*, or *Callistemon citrinus* and wherein the composition has antimicrobial activity.

1. Applicant argues that the plants have unity of invention.

Applicant's argument has been considered but is not persuasive. Firstly, the plants are not closely related. In fact, they do not belong to the same Family or Order. See table below.

	Mammea Americana	***Marchantaceae polymorpha***	***Callistemon citrinus***
Kingdom	Plantae	Plantae	Plantae
Division	Magnoliophyta	Hepatophyta	Magnoliophyta
Class	Magnoliopsida	Hepatopsida	Magnoliopsida
Order	Malpighiales	Marchantiales	Myrtales
Family	Clusiaceae	Marchantiaceae	Myrtaceae
Genus	*Mammea*	*Marchantia* L.	*Callistemon* R. Br.

As pointed out by the examiner, one of ordinary skill in the art would expect that extracts from these plants would have different anti-microbial activity due to the diversity of their phytochemical constituents. This assertion is supported by applicant's specification. which

teaches that the anti-microbial activity of the extracts depend on the extraction solvent. Pages 7-8 of the specification teach,

> "Initially, *Mammea Americana*, *Marchantaceae polymorpha*, and *Callistemon citrinus* tissue, separately, was extracted with ethanol and the extract was shown to have activity against *E. coli* and *M. smegmatis*. Analysis of Gas Chromatagraphy/Mass Spectroscopy (GC/MS) and comparison of the resultant profile to the profile of known compounds revealed a large set of compounds in the extract...When the same set of extraction and analysis (anti-microbial activity and GC/MS) was performed on additional plant material, but the extraction solvent was methylene chloride, the number of compounds identified in the anti-microbially active extract was smaller (each thus more pure). Most interestingly, despite the fact that the active compound was present in both extracts, there was little overlap between the compounds in the ethanol and the methylene chloride extracts (and for some plants no overlap)...
>
> Methylene chloride extracts from *Mammea Americana*, *Marchantaceae polymorpha*, and *Callistemon citrinus* were separated on a HPLC system. Active fractions were identified. Active compounds were next identified. The compounds from *Mammea Americana* include cobaltocene-octomet, stigmastan-3,5-diene, and friedelin...
>
> The compounds from *Marchantaceae polymorpha* include acetic acid, cobaltocene-octomet, and β-myrceane...
>
> The compounds from *Callistemon citrinus* include galoxilide, benzyl salicylate, eucalyptol, and α-pinene."

Thus, according to the specification, constituents of the instant anti-microbial compositions are dependent on the extraction solvent and plant source.

Applicant argues that the methodological steps (extraction, chromatography, elution and bioassay) are the common technical feature, and thus, there is unity of invention between the three plants. This argument is not persuasive because PCT Rule 13.2 requires that the shared technical feature makes a contribution over the prior art. Bisignano et al. *Letters in Applied Microbiology* (2000), Vol. *30*, pages 105-108 (Bigignano) teaches the anti-microbial activity of *Mitracarpus scaber* extracts and isolated constituents. Air-dried and powdered M. scaber was extracted at room temperature with methanol. The methanol residue was partitioned between water and n-butanol. The n-butanol fraction was chromatographed on a Sephadex LH-20 column eluting with methanol. Active fractions were further separated using reverse phase-HPLC, subjected to bioassays and found to possess antimicrobial activity. Thus, the common technical feature does not make a contribution over the prior art and is not "special". Therefore, unity of invention is lacking among the three species of plant material

Applicant's assertion that PCT Rule 13.4 states because there is a single independent claim there can be no multiple inventions is incorrect. The three separate species of plant material are claimed in the alternative of independent claim 32. 37 CFR 1.475 (e), which provides guidance for this situation, states:

> (e) 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.

Thus the Office may require restriction to a single invention which is recited in the alternative of a claim presented in a national stage application filed under 35 USC 371.

2. Applicant argues that U.S. patent rules allow for co-prosecution of species in national stage applications.

Applicant's argument has been considered but is not persuasive. Applicant cites 37 CFR 1.141(a) to support the argument. 37 CFR 1.141(a) reads:

> (a) Two or more independent and distinct inventions may not be claimed in one national application, except that more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim.

37 CFR 1.141(a) applies to national applications filed under 35 USC 111(a) but not national stage applications filed under 35 USC 371. Thus, 37 CFR 1.141(a) is not applicable to this application.

Additionally, 37 CFR 1.141(a) refers to species which are permitted when encompassed by an allowable generic claim. Independent claim 32, which recites the three species of plant material in the alternative, has not been found allowable. Claims 32-33 and 48-49 are currently rejected under 35 U.S.C. 102(b) as being anticipated by Crombie et al.

PCT Rule 13.2 requires for unity of invention to exist when the shared technical feature makes a contribution over the prior art. Because the elected invention fails to make a contribution over the prior art, as evidenced by Crombie et al, and because the shared technical feature fails to make a contribution over the prior art, in view of Bisignano, unity of invention is lacking. In this situation, the Office is not under obligation to withdraw the lack of unity determination in this application.

DECISION

The petition is **DENIED** for the reasons set forth above.

Applicant remains under obligation to properly respond to the Office action mailed on February 23, 2007 within the time period set forth.

Any request for reconsideration must be filed within two (2) months of the mailing date of this decision.

Should there be any questions about this decision, please contact Quality Assurance Specialist/Program Manager Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Bruce Kisliuk
Director, Technology Center 1600
jb/pl

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OCT 16 2007

In re Application of
Satoshi MORITA et al.
Application No.: 10/500,143
Filed: July 8, 2004
For: ORGANIC LUMINESCENT DISPLAY DEVICE HAVING A SEMICONDUCTOR WITH AN AMORPHOUS SILICON LAYER

NOTICE OF WITHDRAWAL FROM ISSUE UNDER 37 CFR § 1.313

The purpose of this communication is to inform you that the above-identified application is being withdrawn from issue pursuant to 37 CFR 1.313.

The application is being withdrawn from issue because of unpatentability of at least one claim.

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

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

Any question regarding this communication should be directed to Sue Purvis, Supervisory Patent Examiner, at (571) 272-1236.

Richard Seidel, Director
Technology Center 2800

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MAIL

FEB 16 2007

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Craig George Cockerton
Application No. 10/500,158
Filed: January 27, 2005
For: **AUDIO VISUAL MEDIA ENCODING SYSTEM**

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the renewed petition filed August 24, 2006 under MPEP§708.02 VIII requesting accelerated examination.

The petition under Manual of Patent Examination Procedure §708.02, VIII, must:
(1) be filed prior to receiving any examination by the examiner,
(2) be accompanied by the required fee- $130,
(3) the claims should be directed to a single invention (if it is determined that the claims pertain to more than one invention, then applicant will have to make an election without traverse or forfeit accelerated examination status),
(4) state that a pre-examination search was made, and fully discuss the search method employed, such as classes and subclasses searched, publications, Chemical abstracts, patents, etc. A search made by a foreign patent office satisfies this requirement,
(5) be accompanied by a copy of each of the references most closely related to the subject matter encompassed by the claims if said references are not already of record,
(6) fully discuss the references, pointing out with the particularity required by 37 C.F.R. §1.111(b) and (c), how the claimed subject matter is patentable over the references.

The petitioner meets all the above-listed requirements. Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant. The application file is being forwarded to the examiner for appropriate action in due course.

Krista Zele
Quality Assurance Specialist
Technology Center 2600
Communications

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Paper No.

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OFFICE OF PETITIONS

In re Application of :
Genet et al. : DECISION ON PETITION
Application No. 10/500,162 :
Filed: June 25, 2004 :
Attorney Docket No. 0501-1097 :

This is a decision on the PETITION UNDER 37 CFR §1.181 TO WITHDRAW THE HOLDING OF ABANDONMENT filed September 11, 2006.

The petition under § 1.181 is **GRANTED**.

The above-identified application became abandoned for failure to file a timely and proper reply to the non-final Office action mailed January 10, 2006. This Office action set a shortened statutory period for reply of three (3) months, with extensions of time obtainable under § 1.136(a). No reply considered filed and no extension of time considered obtained, the application became abandoned effective April 11, 2006. A courtesy Notice of Abandonment was mailed on July 21, 2006.

Petitioner states that a timely response to the Office action was filed on July 10, 2006. In support thereof, petitioner submits a copy of the response including the extension of time as maintained to have been timely filed.

Petitioner's evidence has been reviewed, and is persuasive. However, consideration of their evidence is unnecessary. Their response, including an extension of time, is present in the application with a date of receipt of July 10, 2006.

Further, the three-month extension of time, required to make the response timely, was previously charged to petitioner's Deposit Account.

Accordingly, the Notice of Abandonment mailed July 21, 2006 is hereby **VACATED**, and the holding of abandonment is hereby **WITHDRAWN**.

The petition under § 1.181 is **GRANTED**.

No fee is required on petition under § 1.181.

Technology Center AU 3737 has been advised of this decision. The application file is, thereby, forwarded to the Technology Center's technical support staff to withdraw the holding of abandonment and for consideration by the examiner of the response shown to have been timely filed on July 10, 2006.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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523 West Sixth Street
Suite 707
Los Angeles CA 90014

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AUG 0 6 2007

OFFICE OF PETITIONS

In re Application of :
Lee :
Application No. 10/500,166 : ON PETITION
Filed: June 23, 2004 :
Attorney Docket No. OS 040517/USA :

This is a decision on the petition under 37 CFR 1.137(b), filed February 16, 2007 certificate of mailing date February 13, 2007), to revive the above-identified application.

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

This application became abandoned for failure to timely pay the issue fee and publication fee within three (3) months of the mailing of the Notice of Allowance and Fee(s) Due, mailed April 19, 2006. Accordingly, this application became abandoned on July 20, 2006. A Notice of Abandonment was mailed on August 22, 2006.

Applicant has submitted a proper reply in the form of the $700.00 issue fee, the $300.00 publication fee and a completed PTOL-85b, an acceptable statement of the unintentional nature of the delay in responding to the April 19, 2006 Notice of Allowance and Fee(s) Due, and the $750.00 petition fee.

Regarding the statement of unintentional delay: The statement of unintentional delay presented in the petition does not comply with the current rule. 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" be submitted. However, the statement presented will be accepted and construed 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 pursuant to 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.

It is noted that a Notice Regarding Drawings was mailed on July 26, 2006 , which set a two month non-extendable period from the mail date of the Notice Regarding Drawings to reply. Petitioner failed to timely respond to this notice, as well. As mentioned above, the application became abandoned on July 20, 2006, so the Notice Regarding Drawings was mailed after abandonment of the application.

Petitioner filed corrected drawings on February 16, 2007.

All requirements under 37 CFR 1.137(b) being met, the petition is granted.

This application is being forwarded to Publishing Division for consideration of the corrected drawings filed February 16, 2007 and processing into a patent.

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

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

03 NOV 2004

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Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Boulevard, 7th Floor
Los Angeles, CA 90025

In re Application of LEE et al	:	
U.S. Application No.: 10/500,168	:	
PCT Application No.: PCT/KR02/01830	:	
Int. Filing Date: 27 September 2002	:	DECISION
Priority Date Claimed: 31 December 2001	:	
Attorney Docket No.: 51876P637	:	
For: APPARATUS AND METHOD FOR ABSTRACTING MOTION PICTURE SHAPE DESCRIPTOR. . . .	:	

This is in response to applicant's "Petition Pursuant to Rule 1.10(c)" filed 07 September 2004.

BACKGROUND

On 27 September 2002, applicant filed international application PCT/KR02/01830, which claimed priority of an earlier Korea application filed 31 December 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 10 July 2003. The thirty-month period for paying the basic national fee in the United States expired on 30 June 2004.

On 22 June 2004, applicant purportedly 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 07 September 2004, applicant filed the present petition under 37 CFR 1.10(c).

On 28 September 2004, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903), which indicated that the application had a receipt date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 23 June 2004.

DISCUSSION

MPEP 1805 states in part, "[T]he 'Express Mail' provisions of 37 CFR 1.10 apply to the filing of all applications and papers filed in the U.S. Patent and Trademark Office, including PCT international applications and related papers and fees."

37 CFR 1.10(c) states,

> Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and
>
> (3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

With regard to item (1) above, the petition was filed promptly after the receipt date of the national stage papers was accorded.

With regard to item (2) above, although the petition states that the Express Mail mailing label number was placed on the correspondence, it is not apparent which document the petition is referring to. Applicant should identify the particular document which purportedly bears the Express Mail mailing label number.

With regard to item (3) above, although the petition states that it is accompanied by a copy of the Express Mail mailing label, such copy does not appear in the application file.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.10(c) is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.10(c)".

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

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In re Application of :
OSTLUND et al. :
Application No.: 10/500, 172 :
PCT No.: PCT/FI02/01037 :
Int. Filing Date: 18 December 2002 :
Priority Date: 28 December 2001 :
Attorney Docket No.: 6009-4711 :
For: A MOULD FOR CONTINUOUS CASTING OR METAL STRIPS

DECISION ON PAPERS UNDER 37 CFR 1.42

This decision is in response to the declarations filed 10 November 2004, which is being treated as a submission under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 18 December 2002, applicants filed international application PCT/FI02/01037, which claimed a priority date of 28 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire on 28 June 2004.

On 24 June 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 copy of the international application; an English translation of the international application; and a preliminary amendment.

On 27 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 10 November 2004, applicants filed separate declarations executed by Sture Ostlund as inventor and Angela Vestman and Susanne Karlsson on behalf of deceased inventor, Bertil Vestman.

DISCUSSION

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

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

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

The declaration submitted on 10 November 2004 was executed by Angela Vestman and Susanne Karlsson on behalf of the deceased inventor, Bertil Vestman. However, the declaration does not state the relationship of Susanne Karlsson to the deceased inventor. Accordingly, the declaration fails to identify the proper relationship to the inventor under 37 CFR 1.497(b)(2).

In addition, it is noted that 37 CFR 1.497(b)(2) states the following:

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

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide residence, citizenship, and post office address for the legal representative. The declaration filed on 10 November 2004 provides this information with respect to Angela Vestman and Susanne Karlsson, but not the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(a)(3) and 37 CFR 1.63.

Additionally, a review of the declarations filed on 10 November 2004 reveals that the declarations are not in an acceptable form. Applicants have provided a defective executed composite declaration. A composite declaration under 37 CFR 1.497(a)-(b) requires that the declaration must be complete and identify each inventor in each set of declarations provided. Specifically, the declarations filed on 10 November 2004 are defective pursuant to 37 CFR 1.497(a)(3) which requires that the declaration "identify each inventor and the residence and country of citizenship of each inventor." Section 201.03 of the Manual of Patent Examining Procedure states, in part,

> While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity . . . For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor . . .

In this case, the declarations filed on 10 November 2004 only identify the individual(s) executing the declaration and does not identify the other inventors listed on the published international application. This is improper as each declaration gives the impression that there is only one inventor. Thus, applicants are required to file a newly executed declaration which complies with 37 CFR 1.497(a) and (b).

CONCLUSION

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

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

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

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01 MAR 2005

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345 Park Avenue
New York, New York 10154

In re Application of :
OSTLUND et al. :
Application No.: 10/500, 172 :
PCT No.: PCT/FI02/01037 :
Int. Filing Date: 18 December 2002 :
Priority Date: 28 December 2001 :
Attorney Docket No.: 6009-4711 :
For: A MOULD FOR CONTINUOUS CASTING OR METAL STRIPS :

DECISION ON PAPERS UNDER 37 CFR 1.42

This decision is in response to applicants' "Renewed Submission under 37 CFR 1.42" filed 15 February 2004. No petition fee is required.

BACKGROUND

On 18 December 2002, applicants filed international application PCT/FI02/01037, which claimed a priority date of 28 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire on 28 June 2004.

On 24 June 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 copy of the international application; an English translation of the international application; and a preliminary amendment.

On 27 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 10 November 2004, applicants filed separate declarations executed by Sture Ostlund as inventor and Angela Vestman and Susanne Karlsson on behalf of deceased inventor, Bertil Vestman. In a decision dated 15 December 2004, applicants' request was dismissed because the declaration was defective under 37 CFR 497(a)-(b).

On 15 February 2005, applicants filed the present renewed request accompanied by a declaration/power of attorney executed by: Sture Ostlund as inventor and Angela Vestman

and Susanne Karlsson on behalf of deceased inventor, Bertil Vestman.

DISCUSSION

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

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

The declaration filed on 15 February 2005 is executed by Angela Vestman and Susanne Karlsson as the "legal representatives" of the deceased inventor, Bertil Vestman. The declaration submitted appears to have been executed by the proper parties under 37 CFR 1.42, however, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

In addition, it is noted that 37 CFR 1.497(b)(2) states the following:

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

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide residence, citizenship, and post office address for the legal representative. The declaration filed on 15 February 2005 provides this information with respect to Angela Vestman and Susanne Karlsson, but not the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(a)(3) and 37 CFR 1.63.

Further, a review of the application file reveals that the declarations filed on 15 February 2005 is defective, in that, the declaration submitted includes alterations that have not been initialed and dated. The second inventor, Sture Ostlund, has not initialed and dated the corrections made to his citizenship. (See 37 CFR 1.52(c) and Manual of Patent Examining Procedure §605.04(a)).

CONCLUSION

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

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

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

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05 JUL 2005

#8

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In re Application of :
OSTLUND et al. :
Application No.: 10/500, 172 :
PCT No.: PCT/FI02/01037 :
Int. Filing Date: 18 December 2002 :
Priority Date: 28 December 2001 :
Attorney Docket No.: 6009-4711 :
For: A MOULD FOR CONTINUOUS CASTING OR METAL STRIPS :

DECISION ON PAPERS UNDER 37 CFR 1.42

This decision is in response to applicants' "Renewed Submission under 37 CFR 1.42" filed 13 June 2005. No petition fee is required.

BACKGROUND

On 18 December 2002, applicants filed international application PCT/FI02/01037, which claimed a priority date of 28 December 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire on 28 June 2004.

On 24 June 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 copy of the international application; an English translation of the international application; and a preliminary amendment.

On 27 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 10 November 2004, applicants filed separate declarations executed by Sture Ostlund as inventor and Angela Vestman and Susanne Karlsson on behalf of deceased inventor, Bertil Vestman. In a decision dated 15 December 2004, applicants' request was dismissed because the declaration was defective under 37 CFR 497(a)-(b).

On 15 February 2005, applicants filed the present renewed request accompanied by a declaration/power of attorney executed by: Sture Ostlund as inventor and Angela Vestman

and Susanne Karlsson on behalf of deceased inventor, Bertil Vestman. In a decision dated 01 March 2005, applicants' request was dismissed because the declaration was defective under 37 CFR 497(a)-(b).

On 13 June 2005, applicants filed the present renewed request accompanied by a declaration/power of attorney executed by: Sture Ostlund as inventor and Angela Vestman and Susanne Karlsson on behalf of deceased inventor, Bertil Vestman.

DISCUSSION

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

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

The declaration filed on 13 June 2005 is executed by Angela Vestman and Susanne Karlsson as the "legal representatives" of the deceased inventor, Bertil Vestman. 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 13 June 2005.

CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

The application has an international filing date of 18 December 2002, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of 13 June 2005.

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

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22 OCT 2003

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In re Application of :
LIU, Peng et al. :
Application No.: 10/500,180 : DECISION
PCT No.: PCT/CN02/00857 :
Int. Filing Date: 29 November 2002 : ON PETITION UNDER
Priority Date: 30 November 2001 :
Docket No.: 514572002400 : 37 CFR 1.137(b)
For: CAPILLARY ELECTROPHORESIS ... :
MONONUCLEOTIDE :

Applicants' "Petition For Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the above-captioned application on 25 June 2004 is **GRANTED**.

Applicants' statement that the delay was unintentional is construed to mean "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," as required by 37 CFR 1.137(b)(3). If this understanding is not correct, applicants must notify the office immediately. The appropriate national fee and petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A 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), an English translation of the international application, the fee for late furnishing of the English translation and the fee 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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18 AUG 2006

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Chicago IL 60610

In re Application of	:	
Diem et al.	:	
Application No.: 10/500,196	:	DECISION
PCT No.: PCT/FR02/04383	:	
Int. Filing Date: 17 December 2002	:	ON
Earliest Priority Date: 28 December 2001	:	
Attorney Docket No.: 9905/23	:	PETITION
For: Method And Zone For Sealing Between Two Microstructure Substrates	:	

The petition to revive under 37 CFR 1.137(b) filed 01 August 2006 in the above-captioned application is hereby **GRANTED** as follows:

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." This statement is accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of the surcharge under 37 CFR 1.492(h) and an executed declaration of the inventors, and has paid the petition fee. 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.

Inspection of the English translation of the international application filed on 24 June 2004 reveals that it appears to be defective at least for the reasons that the section headers ("TECHNICAL FIELD," "BACKGROUND," etc.) do not appear to be present in the original French language description, and because applicants do not appear to have furnished a translation of the claims.

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 a proper English translation of the international application and the processing fee under 37 CFR 1.492(i).

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OFFICE OF PETITIONS

In re Application of :
Kyosuke Kokatsu et al :
Application No. 10/500,220 : ON PETITION
Filed: June 25, 2004 :
Attorney Docket No. 2004-0993A :

This is a decision on the petition, filed April 20, 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 February 22, 2007 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 3611 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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