## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 02/01/10

TO SPE OF : ART UNIT 1792

SUBJECT : Request for Certificate of Correction for Appl. No 10/514609.: 7615131

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)**

**Should the change(s) Be made?**

**RoChaun Johnson**
**Certificates of Correction Branch**
**571 272-0470**

**Thank You For Your Assistance**

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

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

**Comments:** approved, all changes to be entered.

/Parviz Hassanzadeh/
**SPE**

1792
**Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

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JUN 24 2010

OFFICE OF PETITIONS

In re Patent No. 7,615,131
Issued: November 10, 2009
Application No. 10/514,609
Filed: November 16, 2004
Attorney Docket No: 18490-0002US1

: DECISION ON REQUEST
: FOR RECONSIDERATION
: OF PATENT TERM ADJUSTMENT
: AND
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d) filed on January 11, 2010, requesting that the patent term adjustment indicated on the above-identified patent be corrected from 331 days to 563 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 five hundred sixty-three (563) days is **GRANTED**.

It is undisputed that the period of examination delay, "A" delay", pursuant to 37 CFR 1.702(a)(1) is 424 days. As well, 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 November 16, 2004, the date the national stage commenced under 35 U.S.C. 371(f), and ends on July 8, 2008, the day before the RCE was filed, the B delay is 235 days. See 35 U.S.C. 154(b)(1)(B)(i).

Applicants direct the office to the Information Disclosure Statement filed on January 17, 2008, subsequent to a reply filed on January 14, 2008. and argue that there should have been a 3 day deduction for applicant delay.

The Information Disclosure Statement filed January 17, 2008 was filed after the filing of a response to the non-Final Office Action on January 14, 2008. In this instance, the filing of the Information Disclosure Statement on January 17, 2008 is considered a failure to engage under 1.704(c)(8). The IDS was not expressly requested by the examiner nor did the IDS include a 1.704(d) statement.

37 CFR 1.704(c)(8) provides that:

> the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

Pursuant to 37 CFR 1.704(c)(8) a period of reduction of 3 days counting the number of days in the period beginning on the day after the initial reply was filed, January 14, 2008 and ending on the date of filing of the last supplemental paper, the IDS filed January 17, 2008. Accordingly, a period of reduction of 3 days is being entered.

As such, the patent term adjustment is 563 (424 "A delay days" + 235 "B delay days"-96 applicant delay days) 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 **five hundred sixty-three (563)** days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,615,131 B2

DATED : November 10, 2009

INVENTOR(S) : Dong-Soo Lim

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 (331) days

Delete the phrase "by 331 days" and insert – by 563 days--

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United States Patent and Trademark Office
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DALY, CROWLEY, MOFFORD & DURKEE, LLP
SUITE 301A
354A TURNPIKE STREET
CANTON, MA 02021-2714

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Jerome L. Ackerman | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7574248 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/11/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/514,616 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/16/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1241** 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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Steinberg & Raskin
1140 Avenue of the Americas, 15th Floor
New York, NY 10036-5803

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MAR 12 2008

OFFICE OF PETITIONS

In re Application of :
Jose Antonio Lozano Teruel *et al.* :
Application No. 10/514,620 : DECISION ON PETITION
Filed: November 16, 2004 :
Attorney Docket No. 932.1275 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed 18 December 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliant Amendment mailed 09 April 2007, which set a one-month period for reply. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on 10 May 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 corrected amendment, (2) the petition fee of $770.00, and (3) a proper statement of unintentional delay.

The request to change the correspondence address filed 18 December 2007 has not been entered as it is not signed by an attorney or agent or record. See 37 CFR 1.33.

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 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 intentional, petitioner must notify the Office.

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

Telephone inquiries concerning this decision should be directed to Allen C. Ho at (571) 272-6052.

This application is being referred to Technology Center AU 3643 for appropriate action by the Examiner in the normal course of business on the reply received

David Bucci
Petitions Examiner
Office of Petitions

Cc:
WOLF, BLOCK, SHORR AND SOLIS-COHEN LLP
250 Park Avenue, 10th Floor
New York, NY 10177

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FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON DC 20007

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MAY 22 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Aurelie Mousnier et al | : | |
| Application No. 10/514,631 | : | DECISION GRANTING PETITION |
| Filed: November 17, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 017317-0108 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed May 20, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on February 7, 2008 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 1617 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

Karen Creasy
Petitions Examiner
Office of Petitions

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

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17 JAN 2006

Heller Ehrman White & McAuliffe, LLP
1717 Rhode Island Avenue, NW
Washington, D.C. 20036

RECEIVED
JAN 19 2006

In re Application of
GOLDENBERG et al.
U.S. Application No.: 10/514,632
PCT No.: PCT/GB03/02110
Int. Filing Date: 16 May 2003
Priority Date: 17 May 2002
Attorney Docket No.: 40923-0074US10
For: DRUG PRE-TARGETING BY MEANS OF BI-SPECIFIC ANTIBODIES AND HAPTEN CONSTRUCTS. . . .

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This decision is in response to applicants' "Petition under 37 CFR 1.47(a)" filed 12 September 2005 to accept the application without the signature of joint-inventor, Shui-on Leung. The $200 petition fee has been submitted.

## BACKGROUND

On 16 May 2003, applicants filed international application PCT/GB03/02110 which claimed a priority date of 17 May 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 27 November 2003. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 17 November 2004.

On 17 November 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 an application data sheet.

On 11 May 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 12 September 2005, applicants filed the present petition under 37 CFR 1.47(a).

## DISCUSSION

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

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

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

Regarding item (2) above, a review of the present petition reveals that petitioner has not satisfied item (2) above, in that, petitioner has not provided sufficient proof that the inventor refuses to execute the application. The "Declaration of Paul M. Booth" outlines the efforts to reach Mr. Leung and copies of the letters sent to Mr. Leung. However, the statements made with regards to the efforts to reach Mr. Leung constitutes secondhand

knowledge, at best, in that the majority of the actions to which declarant is averring to were conducted by Tatiana Brener.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, and drawings) were sent to Shui-on Leung, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

## CONCLUSION

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

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

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

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

09 MAR 2006

#6

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Heller Ehrman White & McAuliffe, LLP
1717 Rhode Island Avenue, NW
Washington, D.C. 20036

In re Application of
GOLDENBERG et al.
U.S. Application No.: 10/514,632
PCT No.: PCT/GB03/02110
Int. Filing Date: 16 May 2003
Priority Date: 17 May 2002
Attorney Docket No.: 40923-0074US10
For: DRUG PRE-TARGETING BY MEANS OF BI-SPECIFIC ANTIBODIES AND HAPTEN CONSTRUCTS. . . .

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This decision is in response to applicants' "Renewed Petition under 37 CFR 1.47(a)" filed 06 February 2006 to accept the application without the signature of joint-inventor, Shui-on Leung.

## BACKGROUND

On 16 May 2003, applicants filed international application PCT/GB03/02110 which claimed a priority date of 17 May 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 27 November 2003. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 17 November 2004.

On 17 November 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 an application data sheet.

On 11 May 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 12 September 2005, applicants filed "Petition under 37 CFR 1.47(a)." In a decision dated 17 January 2006, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 06 February 2006, applicants filed "Renewed Petition under 37 CFR 1.47(a)."

## DISCUSSION

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

Concerning item (1), the requisite petition fee has been submitted.

A review of the present petition reveals that applicants have satisfied item (2), in that applicants have shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Shui-on Leung. The steps taken by Tatiana Brener are sufficient to show that Shui-on Leung has refused to execute the application.

Regarding item (3), a statement of the last known address of the non-signing inventor has been provided.

As to item (4), the declaration filed on 12 September 2005 is in compliance with 37 CFR 1.497.

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
Tel: (571) 272-3298
Fax: (571) 273-0459

09 MAR 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Shui-on Leung
Room 305
40 Constitution Way
Porte Liberte
Jersey City, New Jersey 07930

In re Application of
GOLDENBERG et al.
U.S. Application No.: 10/514,632
PCT No.: PCT/GB03/02110
Int. Filing Date: 16 May 2003
Priority Date: 17 May 2002
Attorney Docket No.: 40923-0074US10
For: DRUG PRE-TARGETING BY MEANS OF BI-SPECIFIC ANTIBODIES AND HAPTEN CONSTRUCTS PEPTIDE AND THE ACTIVE AGENT(S)

Dear Shui-on Leung:

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

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

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

Counsel of Record:
Heller Ehrman White & McAuliffe, LLP
1717 Rhode Island Avenue, NW
Washington, D.C. 20036

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**MINNEAPOLIS MN 55402-3901**

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JUN 20 2007

OFFICE OF PETITIONS

n re Application of
David M. Goldenberg et al.
Application No. 10/514,632
Filed: September 12, 2005
Attorney Docket No. 329523

DECISION ON PETITION
TO MAKE SPECIAL UNDER
37 CFR 1.102(c)(1)

This is a decision on the petition under 37 CFR 1.102(c)(1), filed April 12, 2007, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section IV: Applicant's Age must be accompanied by evidence showing that at least one of the applicants is 65 years of age, or more, such as a birth certificate or a statement by applicant. No fee is required

The instant petition includes a statement from the applicant David M. Goldenberg declaring that he is 65 years of age or older. Accordingly, the above-identified application has been accorded "special" status.

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

All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

The application is being forwarded to the Technology Center Art Unit 1618 for action on the merits commensurate with this decision.

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

17 MAR 2005

#3

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Blakely, Sokoloff, Taylor & Zafmann LLP
12400 Wilshire Boulevard, 7th Floor
Los Angeles, CA 90025

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Cho et al | : | |
| Application No.: 10/514,641 | : | |
| PCT No.: PCT/KR03/00982 | : | |
| Int. Filing Date: 16 May 2003 | : | PETITION UNDER |
| Priority Date: 16 May 2002 | : | |
| Attorney's Docket No.: 3364P200 | : | |
| For: Program recommendation device and method | : | |
| Rough fuzzy multi layer perception (mlp) | : | |
| In electronic program guide (epg) application | : | 37 CFR 1.10 (c) |

This decision is in response to applicants' "PETITION PURSUANT TO 37 C.F.R. 1.10(c)" filed on 01 February 2005, requesting that the filing date of 17 November 2004 be changed to 15 November 2004 for the national stage submission for the above identified application. No fee is required for this petition.

## BACKGROUND

On 15 November 2004, petitioner purportedly filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). However, no executed oath or declaration was filed at such time.

On 01 February 2005, applicants filed the present petition stating that the application was in fact deposited with the USPS on November 15, 2004 as evidenced by the "date in" box on the "Express Mail" Label no. EV372845552US instead of November 17, 2004 as specified on the stamped postcard receipt.

## DISCUSSION

37 CFR 1.10(c) provides:

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

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

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

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

The petition was filed promptly. 37 CFR 1.10(c)(1). In addition, a review of the application papers reveals that "Express Mail" Label No. EV 372845552US was placed on the "Transmittal Letter" prior to the original mailing by "Express Mail." CFR 1.10(c)(2). Finally, the copy of the customer receipt of "Express Mail" Label No. EV 372845552US filed with the present petition identifies the day of deposit as "15 November 2005." 37 CFR 1.10(c)(3). Accordingly, the requirements under 37 CFR 1.10(c) have been satisfied.

## CONCLUSION

For reasons above, the petition under 37 CFR 1.10(c) is **GRANTED.**

The National Stage papers were received by the USPTO on 15 November 2004.

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

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6312
Fax: (703) 308-6459

Richard Cole
PCT Legal Examiner
PCT Legal Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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ILYA ZBOROVSKY
6 SCHOOLHOUSE WAY
DIX HILLS, NY 11746

**COPY MAILED**

APR 21 2009

**OFFICE OF PETITIONS**

In re Application of :
Andrey Igorevich Akaro et al :
Application No. 10/514,654 : DECISION ON PETITION
Filed: November 13, 2004 :
Attorney Docket No. :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 23, 2009, to revive the above-identified application.

The petition is **DISMISSED.**

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

The above-identified application became abandoned for failure to reply in a timely manner to the Office action mailed September 26, 2006, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). Accordingly, the above-identified application became abandoned on October 27, 2006.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lack items (3).

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

(1) the delay in reply that originally resulted in the abandonment;

(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and

(3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of $500 or a fee of $50 would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay (2 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 October 27, 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, as Ilya Zborovsky was counsel of record at the time of abandonment, Ilya Zborovsky should explain why this application became abandoned while it was under his control and what efforts he made to further reply of itself and with whom this matter was discussed outside of Ilya Zborovsky. 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), Ilya Zborovsky and whoever else was involved with this application at the time of abandonment. Statements are required from any and all persons responsible for handling this application, and the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, over 2 years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005);

Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any and all persons handling this application and the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

> (A) the date that the applicant first became aware of the abandonment of the application; and
> (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. See also New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S.District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

Any renewed petition may be addressed as follows:

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

By hand:
U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

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

Irvin Dingle
Petitions Examiner
Office of Petitions

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**220 Fifth Avenue**
**16TH Floor**
**NEW YORK NY 10001-7708**

| | | |
|---|---|---|
| In re Application of | : | |
| Okada et al. | : | |
| Application No. 10/514,668 | : | DECISION ON PETITION |
| Filed: January 4, 2005 | : | |
| Attorney Docket No. 04802/HG | : | |

This is a decision on the petition under 37 CFR 1.59(b), filed April 11, 2008, to expunge information from the above identified application.

The petition is **DISMISSED**.

Petitioner requests that a portion of the Remarks/Arguments to the amendment, filed December 14, 2007, be expunged from the record. Petitioner asserts that this information is trade secret material but was not submitted in accordance with MPEP 724.02

However, as noted in MPEP 724.03, "If any trade secret, proprietary, and/or protective order materials are submitted in amendments, arguments in favor of patentability, or affidavits under 37 CFR 1.131 or 1.132, they will be made of record in the file and will not be given any special status." Moreover, these arguments in favor of patentability were considered by the examiner, were not found persuasive, and were followed by a final rejection. After the arguments did not persuade the examiner, the claims were amended numerous times and the application ultimately allowed. Therefore, the information that petitioner requests to expunge is considered to be material to the determination of patentability, where "materiality" is defined as any information which the examiner considers as being important to a determination of patentability of the claims. Accordingly, the information will remain on the record.

Telephone inquiries concerning this communication should be directed to the undersigned at (571) 272-6692.

Christopher Bottorff
Petitions Examiner
Office of Petitions

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OFFICE OF PETITIONS

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NEW YORK NY 10001-7708

In re Application of :
Okada et al. :
Application No. 10/514,668 : DECISION ON PETITION
Filed: January 4, 2005 :
Attorney Docket No. 04802/HG :

This is a decision on the renewed petition under 37 CFR 1.59(b), filed November 20, 2009, to expunge information from the above identified application.

The petition is **DISMISSED**.

Petitioner requests that a portion of the Remarks/Arguments to the amendment, filed December 14, 2007, be expunged from the record. Petitioner asserts that this information is trade secret material but was not submitted in accordance with MPEP 724.02

The renewed petition does not address the portion of MPEP 724.03 that states:

> If any trade secret, proprietary, and/or protective order materials are submitted in amendments, arguments in favor of patentability, or affidavits under 37 CFR 1.131 or 1.132, they will be made of record in the file and will not be given any special status.

Applicants' inclusion of the trade secret, proprietary, and/or protective order material in the arguments in favor of patentability precludes expunging the material from the record without regard to the actions of the examiner.

The renewed petition speculates that the examiner "appears" to have dismissed the information. However, the lack of an explicit discussion of this material in the examiner's Response to Arguments does not support the conclusion that the examiner considered the material to be "not relevant" to patentability. The failure of these arguments to persuade the examiner was followed by numerous amendments that focused the claims enough to satisfy the examiner's standard of patentability, which standard was shaped in part by the materials previously presented by applicants' on the record.

Since the information to be expunged was presented by applicants in arguments in favor of patentability and was considered by the examiner in the determination of patentability, the information will remain on the record.

Telephone inquiries concerning this communication should be directed to the undersigned at (571) 272-6692.

Christopher Bottorff
Petitions Examiner
Office of Petitions

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/514,674 | 09/02/2005 | Manoj Kumar | RLL-153.2CIPUS | 6317 |

7590 02/13/2008

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| EXAMINER | |
|---|---|
| FUBARA, BLESSING M | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1618 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 02/13/2008 | PAPER |

## DECISION DISMISSING PETITION UNDER 37 CFR 1.138(d)

*The declaration of express abandonment will not be recognized*

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

The petition is dismissed.

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

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

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

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

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

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

Patent Publication Branch
Office of Data Management

27 APR 2005

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One Health Plaza, Building 104
East Hanover, NJ 07936-1080

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Califf et al | : | |
| PCT No.: PCT/EP03/05198 | : | |
| Application No: 10/514,681 | : | |
| Int. Filing Date: 16 May 2003 | : | PETITION UNDER |
| Priority Date: 17 May 2002 | : | |
| Attorney's Docket No.: PC/4-32497A | : | |
| For: COMBINATION OF ANGIOTENSIN... | : | |
| OF MYOCARDIAL INFARCTION | : | 37 CFR 1.47(a) |

This is in response to the "STATEMENT REGARDING REFUSAL TO SIGN DOCUMENTS" filed on 16 November 2004, which is being treated as a petition under 37 CFR 1.47(a). The $130.00 petition fee has been charged to Petitioner's Deposit Account 19-01345 as indicated in the transmittal letter of 16 November 2004.

## BACKGROUND

On 16 May 2003, applicants filed international application PCT/EP03/05198, which claimed priority of an earlier application filed 17 May 2002. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 17 November 2004. A copy of the intentional application was transmitted on 27 November 2003 to the USPTO from the International Bureau.

On 16 November 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, a petition under 1.47(a) and an executed Declaration without the signature of two of the four inventors, i.e., without the signatures of Robert M. CALIFF and John JV MCMURRAY.

## DISCUSSION

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

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

**REFUSAL TO JOIN:**

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

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

reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has satisfied requirements (1), and (4) of 37 CFR 1.47(a). However, requirements (2) and (3) have not been satisfied.

Regarding requirement (1), petitioner has been charged the petition fee to Deposit Account 19-0134.

Regarding requirement (2), the averments of Maureen McGee, Benard A. Marsh and Gregory D. Ferraro are not sufficient to support a finding that the nonsigning inventors refuse to sign because it is unclear if 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 inventors for their signature, and that they refused. Moreover, the statements appear to be inconsistent since Ferraro indicates that Dr. Pfeffer's signature would not be able to be obtained but Dr. Pfeffer signed the declaration.

Also, no documentary evidence to support these assertions have been provided such as a copy of the registered returned envelope, a certified mail return receipt, and a copy of the cover letter instructing the nonsigning inventors to sign the required papers, which shows that the application was sent to them. In addition, no copies of the emails sent to them or dates and times of the conversations with them have been provided. Consequently, it is unclear if they actually received the documents, and referred to sign it.

Moreover, it is noted that facts recited such as mailing the papers and contacting the nonsigning inventors must be from persons who performed such actions and have first hand knowledge of those facts as required by MPEP Section 409.03(d).

Regarding requirement (3), petitioner has not provided a statement of the last known address of the missing inventors.

Regarding requirement (4), petitioner has provided an executed declaration signed by Malcolm MACNAB and Marc A. PFEFFER on their behalf and on the behalf of the nonsigning joint inventors Robert M. CALIFF and John JV MCMURRAY.

Consequently, the current record does not sufficiently establish inventors refusal to join in the application because no evidentiary documents have been submitted to show that a *bona fide* attempt was made to deliver the complete application to them and that they refused to sign the required papers.

## CONCLUSION

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

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition

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

12 SEP 2005

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NOVARTIS
Corporate Intellectual Property
One Health Plaza, Building 104
East Hanover, New Jersey 07936-1080

In re Application of: CALIFF, et al.
U.S. Application No.: 10/514,681
PCT No.: PCT/EP03/05198
Int'l Filing Date: 16 May 2003
Priority Date: 17 May 2002
Attorney's Docket No.: PC/4-32497A
For: COMBINATION OF ANGIOTENSIN II RECEPTOR BLOCKER AND BETA-BLOCKER FOR SECONDARY PREVENTION OF MYOCARDIAL INFARCTION

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

In a decision mailed by this Office on 27 April 2005, applicants' petition under 37 CFR 1.47(a) was dismissed for failure to satisfy all the requirements of a grantable petition. Specifically, applicants had failed to provide: (1) an express statement of the last known address of the nonsigning inventors; or (2) adequate proof that the inventors refused to execute the application or cannot be reached after diligent effort.

On 19 July 2005, applicants filed the renewed petition considered herein (with required extension fee). The renewed petition includes an express statement of the last known addresses of the nonsigning inventors, satisfying this requirement.

The renewed petition also includes additional evidence relating to the inventors' refusal to execute the application. The additional material includes evidence that the nonsigning inventors have been provided with copies of the complete application papers, have failed to respond to the requests for their signatures included therewith, and have failed to respond to subsequent attempts at communication. These materials, in combination with the previously submitted materials, are accepted as demonstrating that the nonsigning inventors have refused to execute the application.

Based on the above, applicants have now satisfied all the requirements for a grantable petition.

## CONCLUSION

Applicants' renewed petition under 37 CFR 1.47(a) for acceptance of the application without the signature of Robert M. CALIF and John McMURRAY is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventors at the last known addresses set forth in the petition materials, 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 Office of PCT Operations for further processing in accord with this decision. The date under 35 U.S.C. 371 (c)(1), (c)(2), and (c)(4) is 14 March 2005 (the filing date of the partially executed declarations).

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

12 SEP 2005

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Robert M. CALIFF
3917 Colorado Street
Durham, North Carolina 27707

In re Application of: CALIFF, et al.
U.S. Application No.: 10/514,681
PCT No.: PCT/EP03/05198
Int'l Filing Date: 16 May 2003
Priority Date: 17 May 2002
Attorney's Docket No.: PC/4-32497A
For: COMBINATION OF ANGIOTENSIN II RECEPTOR BLOCKER AND BETA-BLOCKER FOR SECONDARY PREVENTION OF MYOCARDIAL INFARCTION

Dear Mr. CALIFF:

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

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

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

Counsel Of Record:
Gregory D. Ferraro
NOVARTIS
Corporate Intellectual Property
One Health Plaza, Building 104
East Hanover, New Jersey 07936-1080

12 SEP 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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John McMurray
5 Thorn Drive
Bearsden
Glasgow, SCOTLAND

In re Application of: CALIFF, et al.
U.S. Application No.: 10/514,681
PCT No.: PCT/EP03/05198
Int'l Filing Date: 16 May 2003
Priority Date: 17 May 2002
Attorney's Docket No.: PC/4-32497A
For: COMBINATION OF ANGIOTENSIN II RECEPTOR BLOCKER AND BETA-BLOCKER FOR SECONDARY PREVENTION OF MYOCARDIAL INFARCTION

Dear Mr. McMurray:

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

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

Richard M. Ross
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Counsel Of Record:
Gregory D. Ferraro
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600 Atlantic Avenue
BOSTON, MA 02210-2206

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Fabio Pisoni | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7623578 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/24/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/514,690 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/17/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **455** 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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**JONES & SMITH, LLP**
**2777 ALLEN PARKWAY, SUITE 800**
**HOUSTON, TX 77019-2141**

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OCT 2 0 2008

**OFFICE OF PETITIONS**

In re Application of :
Ira Sommer :
Application No. 10/514,698 : ON PETITION
Filed: November 17, 2004 :
Attorney Docket No. 016273-00310 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 22, 2008, to revive the above-identified application.

The petition is not signed by the attorney of record. Nevertheless, in accordance with 37 CFR 1.34, the signature of Mr. John Wilson Jones appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, August 10, 2006, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on November 11, 2006. A Notice of Abandonment was mailed February 20, 2007.

This application has been abandoned for an extended period of time. The U.S. Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." See Changes to Patent Practice and Procedure, 62 Fed. Reg., at 53160 and 53178; 1203 Off. Gaz. Pat. Office, at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the U.S. Patent and Trademark Office).

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment and corrected formal drawings, (2) the petition fee of $770, and (3) an adequate statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Alicia Kelley at (571) 272-6059.

This matter is being referred to Technology Center 3749 for further examination on the merits.

/SDB/

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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390 NORTH ORANGE AVENUE
SUITE 2500
ORLANDO FL 32801

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AUG 13 2007

**OFFICE OF PETITIONS**

In re Application of :
Maglione et al. :
Application No. 10/514,707 : DECISION ON PETITION
Filed: January 7, 2005 :
Attorney Docket No.:10500-010 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 2, 2007, to revive the above-identified application. This decision also treats the petition and petition fee for expedited treatment received on July 19, 2007.

This above-identified application became abandoned for failure to file a proper reply to the final Office Action of December 14, 2006. The final Office Action set a three (3) month shortened statutory period for reply. An amendment after final Office Action and three month extension of time were filed on June 11, 2007. An Advisory Action mailed on June 21, 2007 informed petitioner the application was not placed in condition for allowance. Accordingly, this application became abandoned on June 15, 2007. A Notice of Abandonment was mailed on July 3, 2007.

The requirements for a grantable petition under 37 CFR §1.137(b) have been met. This petition is hereby **Granted**.

The amendment submitted with the instant petition will be forwarded to Technology Center 1600 for further processing.

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

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/514,712 | 11/23/2004 | Uwe Numrich | 261473US0PCT | 9331 |

22850 7590 07/19/2010

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

| EXAMINER |
|---|
| SCHATZ, CHRISTOPHER T |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1791 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 07/19/2010 | 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):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

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JUL 19 2010

Mailed:

| | | |
|---|---|---|
| In re application of | : | |
| Numrich et al. | : | DECISION ON |
| Serial No. 10/514,712 | : | PETITION |
| Filed: November 23, 2004 | : | |
| For: METHOD FOR THE PRODUCTION OF LOW ORIENTATION THERMOPLASTIC FILM, THE FILM PRODUCED THUS AND USE THEREOF | | |

This is a response to Applicants' Petition under 37 CFR 1.103(a) filed May 27, 2010 to request a suspension of action of six months. The suspension of action is necessary because Applicants are in the process of preparing comparative data. It is noted that this is Applicants second request for a six month extension.

**DECISION**

The Petition is **GRANTED**.

/W. GARY JONES/
W. Gary Jones, Director
Technology Center 1700
Chemical and Materials Engineering

Kirsten A. Grueneberg, Ph.D.
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 22314

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 7/21/08

Paper No.: —

TO SPE OF : ART UNIT 2815

SUBJECT : Request for Certificate of Correction for Appl. No.: 14/514721 Patent No: 7345326 B2

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

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

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

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

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

*VIRGINIA TOLBERT*
**Certificates of Correction Branch**
**703-308-9390 ext. 113**

**Thank You For Your Assistance**

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

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

**Comments:** Enter the Certificate of Correction filed on 4/2/08. /C.C./

Kenneth Parker
**SPE**

2815
**Art Unit**



PAGE 1/1 * RCVD AT 4/22/2009 12:56:34 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/1 * DNIS:2709892 * CSID: * DURATION (mm-ss):00-44

03 JUN 2005

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#5

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ALEXANDRIA, VA 22314

In re Application of YAMASAKI et al :
U.S. Application No.: 10/514,728 :
PCT Application No.: PCT/JP03/06528 :
Int. Filing Date: 26 May 2003 :
Priority Date Claimed: 28 May 2002 : DECISION
Attorney Docket No.: 259655US3PCT :
For: DLC FILM COATED PLASTIC :
CONTAINER, AND DEVICE AND :
METHOD FOR MANUFACTURING THE :
PLASTIC CONTAINER :

This is in response to applicant's "Petition Under 37 C.F.R. § 1.47(a)" filed 24 November 2004.

## BACKGROUND

On 26 May 2003, applicant filed international application PCT/JP03/06528, which claimed priority of an earlier Japan application filed 28 May 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 11 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 28 November 2004.

On 24 November 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 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 Hideyasu Ando cannot be found. However, the petition has not sufficiently established that a diligent effort was made to locate Ando. Specifically, petition has provided evidence of only a single attempt to reach Ando by mail (see affidavit of Takaaki Kawano). However, the petition does not include details of any other attempts, including trying to reach Ando by telephone, by electronic mail, by obtaining a forwarding address, by searching directories, and through Ando's co-workers, employer, family, and friends. Thus, it would not be reasonable to conclude at the present time that Ando cannot be found.

With regard to item (3) above, applicant is advised that effective 22 November 2004, the fee for a petition under 37 CFR 1.47 increased to $200.00. Any deficiency in the petition fee will be charged to Deposit Account No. 15-0030 as authorized by applicant.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

#8

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12 DEC 2005

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1940 DUKE STREET
ALEXANDRIA VA 22314

| | | |
|---|---|---|
| In re Application of | : | |
| YAMASAKI et al. | : | |
| Application No.: 10/514,729 | : | DECISION |
| PCT No.: PCT/JP03/06529 | : | |
| Int. Filing Date: 26 May 2003 | : | |
| Priority Date: 28 May 2002 | : | |
| Attorney Docket No.: 259654US3PCT | : | |
| For: APPARATUS FOR MANUFACTURING A DLC FILM COATED PLASTIC CONTAINER | : | |

This is a decision on applicants' "Petition Under 37 CFR §1.47(a)" filed 24 November 2004 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 26 May 2003, applicants filed international application PCT/JP03/06529, which designated the United States and claimed a priority date of 28 May 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 11 December 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 29 November 2004 (28 November 2004 being a Sunday).

On 24 November 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a petition under 37 CFR 1.47(a).

On 28 July 2005, applicants submitted a declaration of inventors executed by all of the inventors.

## DISCUSSION

Since a 37 CFR 1.497 declaration has been executed by all the joint inventors, the petition for status under 37 CFR 1.47(a) is moot. The application need not be returned to the Office of PCT Legal Affairs for any further consideration of the status under 37 CFR 1.47 and no such status should be indicated on this application file.

The declaration of inventors filed 28 July 2005 is not in compliance with 37 CFR 1.69(b), specifically applicants have not used one of the pre-approved foreign language forms nor have

applicants furnished the requisite statement attesting to the accuracy of the translation.

**CONCLUSION**

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** as **MOOT**.

Since the reply filed 28 July 2005 appears to have been bona fide, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to provide (1) a pre-approved foreign language declaration in compliance with 37 CFR 1.497(a)-(b) or (2) the requisite statement under 37 CFR 1.69(b) that the translation is accurate. Failure to timely file a proper reply will result in abandonment of the application.

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

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

01 MAY 2006

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| | | |
|---|---|---|
| In re Application of | : | |
| YAMASAKI et al. | : | |
| Application No.: 10/514,729 | : | DECISION |
| PCT No.: PCT/JP03/06529 | : | |
| Int. Filing Date: 26 May 2003 | : | |
| Priority Date: 28 May 2002 | : | |
| Attorney Docket No.: 259654US3PCT | : | |
| For: APPARATUS FOR MANUFACTURING A DLC FILM COATED PLASTIC CONTAINER | : | |

This is a decision on applicants' "RESPONSE TO DECISION" filed 10 January 2006 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 26 May 2003, applicants filed international application PCT/JP03/06529, which designated the United States and claimed a priority date of 28 May 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 11 December 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 29 November 2004 (28 November 2004 being a Sunday).

On 24 November 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a petition under 37 CFR 1.47(a).

On 28 July 2005, applicants submitted a declaration of inventors executed by all of the inventors.

On 12 December 2005, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a) as moot and indicating that the declaration of inventors filed 28 July 2005 was not in compliance with 37 CFR 1.69(b). Applicant was required to provide either a pre-approved foreign language declaration in compliance with 37 CFR 1.497(a)-(b) or the requisite statement under 37 CFR 1.69(b) that the translation is accurate.

On 10 January 2006, applicants submitted the instant "RESPONSE TO DECISION" which includes a statement attesting to the accuracy of the translation of the declaration filed 28 July 2005.

## DISCUSSION

The declaration filed 28 July 2005 and the statement attesting to the accuracy of the translation filed 10 January 2006 satisfy 37 CFR 1.497(b) and 37 CFR 1.69(b).

## CONCLUSION

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 **28 July 2005**.

Daniel Stemmer
Legal Examiner
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Office of Patent Cooperation Treaty
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#11

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| | | |
|---|---|---|
| In re Application of | : | |
| YAMASAKI et al. | : | |
| Application No.: 10/514,729 | : | NOTIFICATION |
| PCT No.: PCT/JP03/06529 | : | |
| Int. Filing Date: 26 May 2003 | : | |
| Priority Date: 28 May 2002 | : | |
| Attorney Docket No.: 259654US3PCT | : | |
| For: APPARATUS FOR MANUFACTURING A DLC FILM COATED PLASTIC CONTAINER | : | |

This Notification vacates that portion of the decision mailed 01 May 2006 according the application a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4). The translation filed 24 November 2004 does not appear to be an accurate translation of the international application as filed: Fig. 10 still contains foreign text.

## BACKGROUND

On 26 May 2003, applicants filed international application PCT/JP03/06529, which designated the United States and claimed a priority date of 28 May 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 11 December 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 29 November 2004 (28 November 2004 being a Sunday).

On 24 November 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a petition under 37 CFR 1.47(a).

On 28 July 2005, applicants submitted a declaration of inventors executed by all of the inventors.

On 12 December 2005, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a) as moot and indicating that the declaration of inventors filed 28 July 2005 was not in compliance with 37 CFR 1.69(b). Applicant was required to provide either a pre-approved foreign language declaration in compliance with 37 CFR 1.497(a)-(b) or the requisite statement under 37 CFR 1.69(b) that the translation is accurate.

On 10 January 2006, applicants submitted a"RESPONSE TO DECISION" which included a statement attesting to the accuracy of the translation of the declaration filed 28 July 2005.

On 01 May 2006, a decision was mailed indicating that the statement attesting to the accuracy of the translation filed 10 January 2006 satisfied 37 CFR 1.497(b) and 37 CFR 1.69(b). The decision also indicated that the application be accorded a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of 28 July 2005.

## DISCUSSION

As noted above, the translation filed 24 November 2004 is not an accurate translation of the international application as filed. The translation of text matter in a drawing must be in the form of a copy of the original drawing with the translation pasted on the original text matter or in the form of a drawing executed anew. PCT Rules 76.5 and 49.5(d). The translation filed 24 November 2004 still contains foreign text in Fig. 10. Thus, the translation is defective. An accurate translation of the international application as filed is required in order to comply with 35 U.S.C. 371. Thus, the requirements of 35 U.S.C. 371(c) for entry into the national stage in the United States of America have not yet been completed. Accordingly, the portion of the decision mailed 01 May 2006 according the application a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) of 28 July 2005 is hereby VACATED.

## CONCLUSION

The portion of the decision mailed 01 May 2006 according the application a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) of 28 July 2005 is hereby VACATED.

Applicants are required to file a translation of Fig. 10 as originally filed in the international application without any foreign text and the processing fee under 37 CFR 1.492(h) within a time limit of ONE (1) MONTH from the date of mailing of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper reply will result in abandonment of the application.

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

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

19 MAR 2007



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| In re Application of | : | |
| YAMASAKI et al. | : | |
| Application No.: 10/514,729 | : | NOTIFICATION |
| PCT No.: PCT/JP03/06529 | : | |
| Int. Filing Date: 26 May 2003 | : | |
| Priority Date: 28 May 2002 | : | |
| Attorney Docket No.: 259654US3PCT | : | |
| For: APPARATUS FOR MANUFACTURING A DLC FILM COATED PLASTIC CONTAINER | : | |

This Notification is in response to applicants' submission filed 28 August 2006.

## BACKGROUND

On 26 May 2003, applicants filed international application PCT/JP03/06529, which designated the United States and claimed a priority date of 28 May 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 11 December 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 29 November 2004 (28 November 2004 being a Sunday).

On 24 November 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a petition under 37 CFR 1.47(a).

On 28 July 2005, applicants submitted a declaration of inventors executed by all of the inventors.

On 12 December 2005, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a) as moot and indicating that the declaration of inventors filed 28 July 2005 was not in compliance with 37 CFR 1.69(b). Applicant was required to provide either a pre-approved foreign language declaration in compliance with 37 CFR 1.497(a)-(b) or the requisite statement under 37 CFR 1.69(b) that the translation is accurate.

On 10 January 2006, applicants submitted a"RESPONSE TO DECISION" which included a statement attesting to the accuracy of the translation of the declaration filed 28 July 2005.

On 01 May 2006, a decision was mailed indicating that the statement attesting to the accuracy of the translation filed 10 January 2006 satisfied 37 CFR 1.497(b) and 37 CFR 1.69(b). The decision also indicated that the application be accorded a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of 28 July 2005.

On 07 August 2006, a Notification was mailed vacating the portion of the decision mailed 01 May 2006 according the application a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of 28 July 2005. The Notification indicated that the translation filed 24 November 2004 was not an accurate translation because Fig. 10 still contained foreign text. The Notification set a one month extendable time period for providing a translation of Fig. 10.

On 28 August 2006, applicant filed the instant submission which includes a translation of Fig. 10.

## DISCUSSION

The translation of the international application into English now appears complete.

## CONCLUSION

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 **28 August 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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WASHINGTON, DC 20007

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Robert H Getzenberg | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7598042 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/06/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/514,735 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/20/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **734** 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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APR 4 2006

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| | |
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| In re Application of | : |
| Paul Howley et al | : |
| Serial No.: 10/514,740 | : DECISION ON PETITION |
| Filed: 15 November 2004 | : |
| Attorney Docket No.: 23002 | : |

This letter is in response to the Petition under 37 C.F.R. 1.181, filed 09 February 2006 requesting Director's review of the restriction requirement originally set forth in the communication mailed 25 August 2005 and made FINAL in the first Office action on the merits mailed 10 November 2005.

BACKGROUND

This application was filed under 35 U.S.C. 111 on 15 November 2004, and contained claims 1-26. On 25 August 2005 the examiner mailed to applicants a restriction requirement in which the 26 claims were divided into 8 groups, as follows:

Group I, claims 1 - 8, drawn to a fusion protein comprising at least four HIF proteins selected from Vif, Vpr, Vpu, Vpx, Rev, Tat, and Nef.

Group II, claims 9 - 19, drawn to DNA encoding the fusion of the above fusion protein.

Group III, claim 20, drawn to a method for preparing the above fusion protein.

Group IV, claim 21, drawn to a host cell transfected with the DNA encoding the above fusion protein.

Group V, claim 22, drawn to a medicament comprising the above fusion protein.

Group VI, claims 23 and 24, drawn to a vaccine comprising the above fusion protein or DNA encoding the fusion protein.

Group VII, claim 25, directed to the use of the fusion protein, and DNA or vector encoding said protein, as a vaccine.

Group VIII, claim 26, directed to a method of protecting an animal against HIV infection by administering the fusion protein.

Appropriate arguments for distinctness between groups were set forth. The examiner further required applicants to elect a single species of fusion protein comprising specific defined HIV proteins.

On 16 September 2005 applicants responded to the restriction requirement by provisionally electing with traverse Group II, claims 9 - 18 and arguing that all of the eight Groups should be rejoined because there is a special technical feature common to all of the eight restriction groups. Applicants also elected the fusion protein comprising Vif-Vpr-Vpu-Rev-Tat.

On 10 November 2005 the examiner mailed to applicants a first Office action on the merits and maintaining that the inventions lack a special technical feature common to all sufficient to create unity of invention among all eight Groups. The examiner made the restriction requirement FINAL. The elected claims were rejected on several grounds.

On 09 February 2006 applicants filed an amendment in response to the first Office action. Claims 1 - 8, 22 - 23, and 25 were canceled. New claims 29 - 44 were added.

On 09 February 2006 applicant filed this Petition under 37 CFR 1.181 requesting review of the restriction requirement.

DISCUSSION

In the restriction requirement of 15 August 2005 the examiner argued that the claims are not directed to a single inventive concept as required by PCT 13.1 because the claims lack the same or common technical feature in all groups involving the fusion protein. The basis for the examiner's position that the claims lack a common special technical feature is that Ayyavoo et al. in view of Hinkula et al. and/or Amara et al. and Ayyavoo et al. (1999) together render the alleged common technical feature obvious, i.e., a fusion protein comprising at least 4 HIV proteins wherein the are no cellular protease cleavage sites between the proteins.

Applicants rebut the examiner's position that Ayyavoo et al. in view of Hinkula et al. renders obvious the alleged common technical feature. (1) Applicants explain that either the combination of Ayyavoo et al. with Hinkula et al. or Amara et al. in view of Ayyavoo et al. fail to render obvious a fusion protein comprising at least 4 HIV proteins linked together by connections having no proteolytic cleavage sites. While Hinkula et al. may teach the advantage of combining HIV-1 regulatory genes (Nef, Rev and Tat) with two structural proteins, Env and Gag, and Ayyavoo et al. teaches the advantages of combining the accessory proteins--Vif, Vpu,and Nef--neither of these references teaches a fusion protein wherein the proteins are joined without a proteinase cleavage site. The same problem is found with the combination of Amara et al. in view of Ayyavoo et al. It is not enough to document that the prior art teaches a fusion protein having at least four HIV proteins selected from Vif, Vpr, Vpu, Vpx, Rev, Tat, and Nef. The examiner must also establish the obviousness of said fusion protein possessing no connecting proteolytic cleavage sites.

Applicants' arguments have been fully considered and are found persuasive. It is acknowledged that the examiner has not established a prima facie case of obviousness of the claimed HIV fusion protein comprising at least 4 HIV proteins prepared without connecting proteolytic cleavage sites.

However, applicants' claimed fusion protein and DNA encoding same would have been obvious over Weiner et al. WO 02/06303 in view of Ayyavoo et al. Weiner et al. teaches a fusion protein comprising three HIV proteins (Vif-Vpu-Nef) wherein there are no proteolytic cleavage sites between said proteins (page 30, lines 7ff). Weiner et al. tested this fusion protein with no proteolytic sites (VVN) versus the same fusion protein but with protéolytic cleavage sites (VVN-P). Both fusion proteins could generate an immune response when injected into mice. However, in several immune response assays, the VVN-P protein usually was somewhat more effective than the VVN. Applicants argue that because the VVN fusion protein gave better results in most of the immune response assays, that this represents a teaching away from HIV fusion proteins without proteolytic sites. This argument has been fully considered but is not deemed persuasive. Even though the VVN-P protein gave somewhat better immune response when injected into mice, this does not obviate the putative usefulness of the VVN because of the critical importance of safety provided by attenuated or ineffective proteins tied together in a fusion protein without proteolytic cleavage sites. In view of the teachings of Amara et al. about the value of both regulatory genes (Tat and Rev) as well as accessory genes (Nef, Vif, Vpr, Vpu, and Vpx) the person of skill in the art would have found it obvious to have prepared and used fusion proteins comprising four or more HIV proteins comprising both regulatory and accessory genes for the purpose of obtaining even better immune stimulatory properties.

Therefore, in conclusion, the combination of Weiner et al. (WO/02/06403) and Amara et al. renders obvious applicants' claimed fusion proteins with four or more HIV proteins having no proteolytic cleavage sites between said proteins. Consequently, the combination of at least four proteins selected from Vif, Vpr, Vpu, Vpx, Rev. Tat, and Nef without proteolytic cleavage sites fails to provide a common technical feature or inventive concept uniting all possible HIV fusion protein combinations and all eight of the original restriction groupings.

DECISION

For all of the above reasons, the Petition is **GRANTED-IN-PART.**
The restriction requirement set forth is modified, as follows:

The examiner's restriction requirement setting forth eight separate groupings is revised as follows:

> Group I, claims 1-8, drawn to a fusion protein comprising the aminoacid sequence of at least four HIV proteins (as set forth in original Group I);

Group II, claims 9-21, drawn to a DNA encoding the fusion protein, the method of making the fusion protein, the viral vector and the host cell transfected therewith;
Group III – claims 22-26, drawn to the fusion protein, nucleic acid or vector used as a medicament, vaccine, method of making the vaccine and administering the vaccine.

Applicants have elected Group II, drawn to a DNA encoding the fusion protein comprising Vif-Vpr-Vpu-Rev-Tat, and said election remains in effect with regard to the expanded Group II. The examiner will therefore examine claims 9 – 21 and any other added claims that fall within this Group.

Since claims 9 and 20 are genus claims encompassing all of the possible fusion protein combinations of at least four proteins from the group consisting of Vif, Vpr, Vpu, Vpx, Rev, Tat, and Nef, if the above identified elected fusion is determined to be allowable, the examination will be conducted in accordance with M.P.E.P. 803.02 and determination of the allowability of a reasonable number of other fusion proteins will be determined in order to determine the patentability of the entire group of fusion proteins.

Any request for reconsideration of this decision must be filed within two (2) months of the mailing date of this decision in order to be considered timely.

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

John L. LeGuyader
Director, Technology Center 1600
wrd/gk

26 APR 2005

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New York, NY 10018

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|---|---|---|
| In re Application of | : | DECISION ON |
| Ceasar et al | : | |
| Application No.: 10/514,751 | : | |
| PCT No.: PCT/EP03/02499 | : | |
| Int. Filing Date: 12 March 2003 | : | PETITION UNDER |
| Priority Date: 15 May 2002 | : | |
| Attorney's Docket No.: 331.1079 | : | |
| For: FILTER SYSTEM | : | 37 CFR 1.137(b) |

This decision is in response to applicants' "Petition For Revival Of An International Application For Patent Designating The U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)," filed on 17 November 2004.

## BACKGROUND

On 12 March 2003, this international application was filed, claiming an earliest priority date of 15 May 2002.

The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 15 November 2004.

On 17 November 2004, applicants filed the instant petition under 37 CFR 1.137(b) and Transmittal letter for entry into the national stage in the United States, which was accompanied by, basic national fee. No executed or oath was submitted at such time.

## DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Petitioner has provided: (1) the proper reply by submitting the basic national filing fee, (2) the petition fee set forth in §1.17(m) and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Accordingly, the petition is deemed to satisfy requirements (1), (2), (3), and (4) under 37 CFR 1.137(b).

## DECISION

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

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

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

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OFFICE OF PETITIONS

In re Patent No. 7,393,831
Issue Date: July 1, 2008
Application No. 10/514,762
Filed: November 16, 2004
Attorney Docket No. 50540/002001

DECISION ON PETITION

This is a decision on the Request for Certificate of Correction under 37 CFR 1.323, filed December 2, 2008, requesting that the name of the co-assignee be added to the Title Page of the above-identified patent. The Request is being treated as a Petition under 37 CFR 3.81. A completed form PTP-1050 accompanied the petition.

The petition under 37 CFR 3.81 is **GRANTED**.

Petitioner requests that the Title page of the above-identified patent be corrected via issuance of a Certificate of Correction to add the name of the assignee as follows:

--INSERM (Institut National de la Sante et de la Recherche Medicale)--

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

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

The petition was accompanied by a Certificate of Correction and the fees required by 37 CFR 3.81(b). As such, the requisite $100.00 fee (Fee Code 1811) as set forth under 37 CFR 1.20(a), and the requisite $130.00 processing fee (Fee Code 1464) as set forth under 37 CFR 1.17(i) have been submitted. Further, Office assignment records are consistent with the

requested correction. Accordingly, as the Petition complies with the provisions of 37 CFR 3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the Form PTO-1050 that accompanied the present Petition.

Inquiries related this communication should be directed to Cheryl Gibson-Baylor at (571)272-3213.

Any questions concerning the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,393,831.

Brian W. Brown
Petitions Examiner
Office of Petitions

PATENT
ATTORNEY DOCKET NO. 50540/002001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|---|---|---|---|
| Applicant: | Fournillier et al. | Confirmation No.: | 6698 |
| Serial No.: | 10/514,762 | Art Unit: | 1654 |
| Filed: | November 16, 2004 | Examiner: | Julie Ha |
| Patent No.: | 7,393,831 | Customer No.: | 21559 |
| Issued: | July 1, 2008 | | |
| Title: | Peptide Compositions and Their Use Against HCV | | |

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Attention: Certificate of Correction Branch

REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 C.F.R. § 1.323

Applicants hereby request that a Certificate of Correction be issued in the patent identified above. The error to be corrected is of a minor, typographical nature, occurred in good faith, and is described in detail on the enclosed PTO Form 1050.

Applicants authorize the Office to charge $100.00 to deposit account no. 03-2095 in payment of the fee set forth in 37 C.F.R. § 1.20(a).

Adjustment date: 07/14/2009 LDIEP1
12/02/2008 INTEFSW 00007255 032095 10514762
02 FC:1808 130.00 CR

07/14/2009 LDIEP1 00000007 032095 10514762
01 FC:1464 130.00 DA

If there are any other charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: December 2, 2008

Susan M. Michaud

Susan M. Michaud, Ph.D.
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Clark & Elbing LLP
101 Federal Street
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07 DEC 2006

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| | |
|---|---|
| In re Application of<br>BARBAS<br>Application No.: 10/514,763<br>PCT No.: PCT/US03/17946<br>Int. Filing: 06 June 2003<br>Priority Date: 11 June 2002<br>Attorney Docket No.: 8098-008-US<br>For: ARTIFICIAL TRANSCRIPTION FACTORS | DECISION ON<br><br>PETITION UNDER<br><br>37 CFR 1.181 and 1.10 |

This is a decision on applicants' "Request for Reconsideration of Holding of Abandonment" treated as a Petition under 37 CFR 1.181, requesting that the Notification of Abandonment mailed 17 July 2006 be vacated. The petition was filed in the United States Patent and Trademark Office (USPTO) on 27 July 2006. No petition fee is required.

This is also in response to applicant's petition under 37 CFR 1.10, filed via facsimile on 30 November 2006.

## BACKGROUND

On 06 June 2003, applicant filed international application PCT/US03/17946, claiming a priority date of 11 June 2002 in the English language.

On 16 November 2004, applicant 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.

On 13 May 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), and an English translation of the international application along with the processing fee for filing the translation and the surcharge for filing the oath or declaration after the thirty month period, was required. The Notification set a two month period for reply or by 13 July 2005, with extensions of time available under 37 CFR 1.136(a).

On 24 May 2005, applicant filed a response to the Notification of Missing Requirements, which allegedly included, *inter alia*, a copy of the declaration. Applicant informed the Office that an English translation of the international application was not required because the international application was filed in the English language. The $130 surcharge for filing the declaration after the thirty month period was paid at this time.

On 17 July 2006, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant indicating that applicant had failed to respond to the 905.

On 27 July 2006, applicant filed the instant Request for Reconsideration of Holding of

Abandonment.

On 8 September 2006, a Notification of Acceptance was mailed to applicant indicating that the 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date was 27 July 2006.

## DISCUSSION

A review of the application file reveals that the declaration was filed on 24 May 2005 and was found in USPTO files along with the earlier filed, unexecuted declaration (dated 11/16/05). Thus, applicant did provide a timely response to the Notification of Missing Requirements. As for the English translation, the international application was filed in the English language and thus, an English translation is not necessary.

Since applicant did respond in a timely manner to the Notification of Missing Requirements, the 17 July 2006 Notification of Abandonment was sent in error and is hereby VACATED.

The Notification of Acceptance mailed on 8 September 2006 is hereby VACATED. A new Notification of Acceptance will be issued indicating that the 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is 24 May 2005.

## CONCLUSION

Applicant's request to withdraw the Notification of Abandonment is **GRANTED**. The petition under 37 CFR 1.10 is **MOOT**.

For the reasons set forth above, the Notification of Acceptance mailed on 8 September 2006 is hereby **VACATED**. The 17 July 2006 Notification of Abandonment was sent in error and is hereby **VACATED**.

The application will be forward to the United States Designated/Elected Office for further processing. A new Notification of Acceptance will be issued. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is **24 May 2005.**

Cynthia M. Kratz
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#5

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22 AUG 2006

Oleg F. Kaplun
Fay Kaplun & Marcin, LLP
150 Broadway, Suite 702
New York, NY 10038

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Jose Manuel CUEZVA MARCOS: | : | |
| Application No. 10/514,771 | : | |
| PCT No.: PCT/ES2003/00228 | : | |
| Int. Filing Date: 20 May 2003 | : | |
| Priority Date: 24 May 2002 | : | PETITION UNDER |
| Attorney's Docket No.: 40140/00601 | : | |
| For: METHOD FOR CANCER... | : | |
| MARKERS OF THE CELL | : | 37 CFR 1.137 (b) |

This decision is in response to applicant's' "PETITION FOR REVIAVAL OF UNINTENTIONALLY ABANDONED APPLICATION," filed on 21 June 2006.

## BACKGROUND

On 20 May 2003, this international application was filed, claiming an earliest priority date of 24 May 2002. The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 24 November 2004.

On 17 November 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 07 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 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

On 06 June 2006, the USPTO mailed applicant a Notification of Abandonment (Form PCT/DO/EO/909) indicating the application was abandoned because applicant failed to respond to the notification of Missing Requirements (Form PCT/DO/EO/905), mailed 04/07/2005 within the time period set therein.

On 21 June 2006, applicant filed the instant petition under 37 CFR 1.137(b).

## 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).

## 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 **21 June 2006.**

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NEW YORK, NY 10038

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NOV 19 2008

In re Application of :
Jose Manuel Cuezva Marcos :
Application No. 10/514,771 : ON PETITION
Filed: June 21, 2006 :
Attorney Docket No. 40140/00601 :

This is a decision on the petition under 37 CFR 1.137(b), filed on September 22, 2008, to revive the above-identified application.

The above application became abandoned for failure to file a proper reply to the final Office action mailed September 2, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) under 37 CFR 1.114, with the $810 filing fee; (2) the petition fee of $1,540; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED.**

This application is being revived for consideration of the RCE filed on September 22, 2008.

The application file is being referred to Technology Center Art Unit 1642 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment filed February 28, 2008.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

05 OCT 2005

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PHILADELPHIA PA 19102

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|---|---|---|
| In re Application of | : | |
| SMITHSON, Anthony James | : | |
| Application No.: 10/514,789 | : | DECISION |
| PCT No.: PCT/GB03/02232 | : | |
| Int. Filing Date: 22 May 2003 | : | ON PETITION UNDER |
| Priority Date: 24 May 2002 | : | |
| Attorney Docket No.: 1052.059 | : | 37 CFR 1.181 |
| For: PREDISTORTION CONTROL | : | |

This decision is in response to applicant's request for refund filed in the United States Patent and Trademark Office on 20 July 2005. It has been treated as a petition under 37 CFR 1.181.

## BACKGROUND

On 22 May 2003, applicant filed international application PCT/GB03/02232, which claimed a priority date of 24 May 2002. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 04 December 2003. The deadline for entry into the national stage in the United States was midnight on 24 November 2004.

On 18 November 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, an international preliminary examination report without annexes and an unexecuted declaration.

On 19 May 2005, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required and indicating that the unexecuted declaration spelled the inventor's name differently from what was listed on the international application.

On 20 July 2005, applicant filed a petition under 37 CFR 1.181 for a refund and a copy of the corrected preliminary examination report including annexes.

## DISCUSSION

Applicant supplied a copy of the corrected IPER with annexes. Applicant asks for a refund of claim fees charged because in light of the annexes, the preliminary amendment could be entered. Applicant's petition is granted. This Office has no record of deposit account fees charged. A request for a refund of the deposit account service charge must be taken up with the Office of Finance.

Applicant indicates that the declaration correctly lists the inventor's name as "Antony" and that the international publication listing it as "Anthony" is in error. This is accepted as a statement that the international publication contained a typographical error. MPEP 201.03. The declaration complies with 37 CFR 1.497(a)-(b).

**CONCLUSION**

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

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision. The application has a date of 20 July 2005 under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4).

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
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Facsimile: (571) 273-0459

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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** | : Ralf Schaefer | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7627762 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/01/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/514,796 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/18/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1212** 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.

#3

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15 DEC 2005

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Andrew Douglas
Knobbe Martens Olson and Bear LLP
620 Newport Center Dr Ste 1600
Newport, CA 92660

| | |
|---|---|
| In re Application of | |
| DAVISON, et al. | |
| Application No.: 10/514,797 | |
| PCT No.: PCT/US01/23999 | DECISION ON PETITION |
| Int. Filing Date: 31 July 2001 | |
| Priority Date: 01 August 2000 | UNDER 37 CFR 1.137(b) |
| Atty. Docket No.: ENDIUS.005APC | |
| For: METHOD AND APPARATUS FOR SECURING VERTEBRAE | |

The petition to revive under 37 CFR 1.137(b) filed 18 November 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the above-identified U.S. national stage application from the 30 months deadline until the filing of a grantable petition under 37 C.F.R. § 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National Fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

The application has an international filing date of 31 July 2001 under 35 U.S.C. 363 and will be given a date of **18 November 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

10 MAY 2005

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Ronald E. Greigg
Greigg & Greigg, PLLC
1423 Powhatan Street
Suite One
Alexandria, VA 22314

| | | |
|---|---|---|
| In re Application of | : | |
| POTZ (Deceased), et al. | : | |
| U.S. Application No.: 10/514,827 | : | |
| PCT No.: PCT/DE03/00973 | : | DECISION ON PAPERS |
| Int. Filing Date: 25 March 2003 | : | |
| Priority Date: 18 March 2002 | : | UNDER 37 CFR 1.42 |
| Attorney Docket No.: R.302521 | : | |
| For: FUEL INJECTION VALVE FOR INTERNAL COMBUSTION ENGINE | : | |

This is a decision on the papers filed in United States Patent and Trademark Office (USPTO) on 17 November 2004, which are being treated as a request for acknowledgment of status under 37 CFR 1.42. No petition fee is required.

## BACKGROUND

On 25 March 2003, applicant filed international application PCT/DE03/00973 which claimed priority of an earlier application filed 18 March 2002. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 18 November 2004.

On 17 November 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an executed combined declaration and power of attorney; an English translation of the international application and a First Preliminary Amendment.

## DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

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

The declaration filed 17 November 2004 is properly executed by joint inventors Thomas

Kuegler, Andreas Koeninger and Predrag Nunic and details their residences, post office addresses and countries of citizenship. In addition, the declaration is executed by Maike Sander-Potz on her own behalf and on the behalf of her minor child, Wendelin Potz as the sole legal heirs to estate of deceased joint inventor, Detlev Potz. The declaration provides the residence, post office address and country of citizenship for both the deceased inventor and his heirs. The declaration states that Maike Sander-Potz and Wendelin Potz are the sole heirs to the estate.

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

As detailed above, it is proper to grant applicant's petition at this time.

## CONCLUSION

Applicant's petition under 37 CFR 1.42 is **GRANTED**.

This application will be given an international application filing date of 25 March 2003 and a date of **17 November 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the DO/EO/US for processing in accordance with this decision.

Derek A. Putonen
Attorney Advisor
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Tel: (571) 272-3294
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STEVEN C. BAUMAN
HENKEL CORPORATION
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ROCKY HILL, CT 06067

In re Application of GAN et al :
U.S. Application No.: 10/514,838 :
PCT Application No.: PCT/JP03/05691 :
Int. Filing Date: 07 May 2003 : DECISION
Priority Date Claimed: 08 May 2002 :
Attorney Docket No.: ICC-254/PCT/US :
For: PHOTO-INDUCED CATION CURABLE :
EPOXY RESIN COMPOSITION :

This is in response to applicant's "Petition for Revival of Application Abandoned Unintentionally Under 37 C.F.R. § 1.137(b)" filed 18 November 2004.

## BACKGROUND

On 07 May 2003, applicant filed international application PCT/JP03/05691, which claimed priority of an earlier Japan application filed 08 May 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 20 November 2003. The thirty-month period for paying the basic national fee in the United States expired on 08 November 2004.

International application PCT/JP03/05691 became abandoned as to the United States for failure to timely pay the basic national fee.

On 18 November 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), the petition states, "the entire delay in filing the documents noted above from the due date for submission (November 8, 2004) until the filing of a grantable petition was unintentional." This statement is interpreted as a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. If this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

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

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 07 May 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 18 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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Houston, TX 77252-2469

| | | |
|---|---|---|
| In re Application of AMUNDSEN et al | : | |
| U.S. Application No.: 10/514,858 | : | |
| PCT Application No.: PCT/GB03/02305 | : | DECISION |
| Int. Filing Date: 27 May 2003 | : | |
| Priority Date Claimed: 28 May 2002 | : | |
| Attorney Docket No.: 57.0574-PCT-US | : | |
| For: PROCESSING SEISMIC DATA | : | |

This is in response to the correspondence filed 21 July 2005.

## BACKGROUND

On 27 May 2003, applicant filed international application PCT/GB03/02305, which claimed priority of an earlier United Kingdom application filed 28 May 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 04 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 28 November 2004.

On 15 November 2004, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 11 July 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 21 July 2005, applicant filed an executed declaration.

## DISCUSSION

A review of the application file reveals that the given name of the fourth inventor is listed in the international application as "Ed" while the given name is listed in the declaration as

"Julian". In that this is clearly more than a mere typographical error or transliteration error, a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of $400.00 as well as a statement from the inventor and statements from any other persons having firsthand knowledge of the error. These statements must set forth the specific circumstances as to how and when the error was made and discovered and must also set forth that the mistake was an inadvertent error without deceptive intent.

## CONCLUSION

A proper response must be filed within TWO (2) MONTHS from the mail date of this decision. A proper response would include an appropriate petition under 37 CFR 1.182 along with the requisite petition fee. 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), but applicant may not exceed the deadline set forth in the Notification of Missing Requirements mailed 11 July 2005.

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

Bryan Tung
PCT Legal Examiner
Office of PCT Legal Administration

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Facsimile: 571-273-0459

#8

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30 NOV 2005

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|---|---|---|
| In re Application of AMUNDSEN et al | : | |
| U.S. Application No.: 10/514,858 | : | |
| PCT Application No.: PCT/GB03/02305 | : | DECISION |
| Int. Filing Date: 27 May 2003 | : | |
| Priority Date Claimed: 28 May 2002 | : | |
| Attorney Docket No.: 57.0574-PCT-US | : | |
| For: PROCESSING SEISMIC DATA | : | |

This is in response to the "Petition Under Rule 182" filed 16 November 2005.

## BACKGROUND

On 27 May 2003, applicant filed international application PCT/GB03/02305, which claimed priority of an earlier United Kingdom application filed 28 May 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 04 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 28 November 2004.

On 15 November 2004, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 11 July 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 21 July 2005, applicant filed an executed declaration.

## DISCUSSION

A review of the application file reveals that the given name of the fourth inventor is listed in the international application as "Ed" while the given name is listed in the declaration as

"Julian". Applicant has submitted a proper petition under 37 CFR 1.182 including statements from the inventor and the person having firsthand knowledge of the error. These statements set forth the specific circumstances as to how and when the error was made and discovered and that the mistake was an inadvertent error without deceptive intent.

## CONCLUSION

The petition under 37 CFR 1.182 is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 27 May 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 21 July 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
Office of PCT Legal Administration

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

26 SEP 2006

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Polster, Lieder, Woodruff & Lucchesi
12412 Powerscourt Drive
Suite 200
St. Louis, MO 63131-3615

In re Application of
VARONIS et al.
Application No.: 10/514,872
PCT No.: PCT/US03/15494
Int. Filing Date: 15 May 2003
Priority Date: 15 May 2002
Attorney Docket No.: TIMK 8385U1
For: EDDY CURRENT SENSOR ASSEMBLY FOR SHAFT TORQUE MEASUREMENT

DECISION

This decision is issued in response to applicant's "Request for Corrected Filing Receipt" filed in the United States Patent and Trademark Office (USPTO) on 07 March 2006. Applicant's request is being treated under 37 CFR 1.181.

The Request for Corrected Filing Receipt states that "[o]n September 8, 2005, applicant incorrectly enclosed a check for $65 rather than $130 for the missing parts surcharge. . . Rather than deducting the additional $65 from the deposit account, the PTO refunded 50% of applicant's filing fee and issued a filing receipt indicating small entity status." Applicant is correct in its assertion that the USPTO mistakenly treated the above-identified application as a "small entity." The USPTO record has been corrected to indicate that this application is considered a large entity.

Further, a review of the application file (Image File Wrapper) and finance record reveals that the following fees have been submitted: Basic National fee - $960.00 (fee code 1613); surcharge for submitting an Oath or Declaration after thirty months from priority date - $130.00 (fee code 1617); and Assignment Recordation fee - $40.00 (fee code 8021). Therefore, applicant's request under 37 CFR 1.181 is **GRANTED**.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

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

**ATTACHMENT**: Corrected Filing Receipt

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101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Stefan Werner | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7642404 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/05/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/514,905 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/17/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **521** 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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ALSTON & BIRD LLP
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101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Mail Date: 05/18/2010

**Applicant** : Stefan Werner
**Patent Number** : 7642404
**Issue Date** : 01/05/2010
**Application No**: 10/514,905
**Filed** : 11/17/2004

: 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 **598** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of patent term adjustment (PTA) days determined by the recalculation.

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

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

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

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MONROE, CT 06468

Mail Date: 04/27/2010

| | | |
|---|---|---|
| **Applicant** | : Anders Sundgren | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7591453 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/514,908 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/05/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **86** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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**WASHINGTON DC 20037-3213**

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JAN 24 2008

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|---|---|---|
| In re Application of | : | |
| Akira Hatai et al | : | |
| Application No. 10/514,914 | : | DECISION GRANTING PETITION |
| Filed: November 17, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. Q84861 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed January 23, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on January 9, 2008 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 2838 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Karen Creasy
Petitions Examiner
Office of Petitions

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

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ROSHARON TX 77583

In re Application of :
Hadley, et al. : DECISION ON PETITION
Application No. 10/514,919 :
Filed: November 15, 2004 :
Docket No.: 101.0051 :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed October 2, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the non-final Office action mailed February 9, 2006. The Notice set a three (3) month shortened statutory period of time for reply. No extensions of time in accordance with 37 C.F.R. § 1.136 were timely requested. Notice of Abandonment was mailed August 24, 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 non-final Office action is accepted as having been unintentionally delayed.

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.

This application is being forwarded to Technology Center 2800 for further processing.

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

CC: WAYNE KANAK
Schlumberger Sensa
Sensor Highway Limited
Gamma House, Enterprise Road
Chilworth Science Park
Southhampton, S016 -7NS

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14910 AIRLINE ROAD
ROSHARON, TX 77583

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APR 26 2007

OFFICE OF PETITIONS

In re Application of :
Maxwell R. Hadley :
Application No. 10/514,920 : DECISION GRANTING PETITION
Filed: November 15, 2004 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 101.0018US/PCT :

This is a decision on the petition, filed April 24, 2007, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on December 5, 2006 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

It does not appear that the instant petition is signed by an attorney of record. However, in accordance with 37 CFR 1.34(a), the signature of Mr. Fred G. Pruner, Jr., appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. Therefore, if Mr. Pruner desires to receive correspondence regarding this file, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision is being mailed to Mr. Pruner, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

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

---

[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.*

This matter is being referred to Technology Center AU 2863 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

cc:

Fred G. Pruner, Jr.
1616 S. Voss Road, Suite 750
Houston, TX 77057

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12 JUL 2005

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AMERSHAM BIOSCIENCES CORPORATION
Patent Department
800 Centennial Avenue
Piscataway, NJ 08855

In re Application of :
RAMM, Peter *et al* :
Application No.: 10/514,925 :
PCT No.: PCT/IB03/01821 : **DECISION**
Int. Filing Date: 09 May 2003 :
Priority Date: 14 May 2002 :
Attorney Docket No.: P10253 :
For: SYSTEM AND METHODS FOR RAPID AND AUTOMATED SCREENING OF CELLS :

This is a decision on the declaration filed with the national stage papers on 12 November 2004 which has been treated as a petition under 37 CFR 1.42. No fee is required.

## BACKGROUND

On 12 November 2004, applicants filed papers to enter the national stage of PCT/DE03/01887 which were accompanied by, *inter alia*, a declaration executed by five of the six joint inventors. The third inventor was listed as "deceased."

## DISCUSSION

The declaration filed with the national stage papers is executed by five of the six named inventors. Jurich Cybuch is listed only as deceased.

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

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

In this case, a legal representative or heir(s) of the deceased inventor must execute the declaration for the deceased inventor. Thus, the declaration does not comply with 37 CFR 1.497(a) & (b).

It is also noted that the citizenship, residence and address of the legal representative (or heir) must be recorded on the declaration pursuant to 37 CFR 1.497(b)(2), along with the required information for the other four inventors (including

the deceased inventor).

## CONCLUSION

For the reason listed above, applicants' petition under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants are required to provide an oath or declaration in compliance with 37 CFR 1.497(a) and (b) within a time limit of **TWO (2) MONTHS** from the mail date of this decision. Extension of time may be granted under 37 CFR 1.136(a).

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

11 OCT 2005

#6

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AMERSHAM BIOSCIENCES CORPORATION
Patent Department
800 Centennial Avenue
Piscataway, NJ 08855

In re Application of :
RAMM, Peter *et al* :
Application No.: 10/514,925 :
PCT No.: PCT/IB03/01821 : **DECISION**
Int. Filing Date: 09 May 2003 :
Priority Date: 14 May 2002 :
Attorney Docket No.: P10253 :
For: SYSTEM AND METHODS FOR RAPID AND AUTOMATED SCREENING OF CELLS :

This is a decision on the applicants' "Request for Reconsideration of Petition Under 37 C.F.R. 1.47(a)" ("Ren.Pet.") filed on 12 September 2005.

## BACKGROUND

On 12 July 2005, a decision dismissing the papers filed under 37 CFR 1.42 was mailed. Applicants were given two months to respond.

On 12 September 2005, applicants filed the subject request for reconsideration which was accompanied by, *inter alia*, Exhibits 1 - 7.

## DISCUSSION

Applicants request reconsideration of the decision mailed 12 July 2005 and to treat the renewed petition under 37 CFR 1.47, not 37 CFR 1.42. Applicants explain their rationale for the change in paragraph ten of the renewed petition and state:

> Despite the statements made by the bailiff, Petitioners do not aver that inventor Cybuch is deceased. Indeed, petitioners are unsure as to whether the inventor has passed away or merely moved and remains unreachable. While as described in paragraph seven above, the new owner of the last known residence of the inventor Cybuch stated that Cybuch had passed away, this information is presented herein because it is contained in the affidavit of the Bailiff who went to the address in an attempt to contact Inventor Cybuch. However, Petitioners do not know whether this information is accurate and, indeed, only know that Inventor Cybuch vacated his last known residence without leaving a forwarding

address. That he may have passed away is a possibility; however, petitioners have not been able to substantiate this report. Accordingly, Petitioners respectfully assert that this should be retreated as a petition under Rule 47, as there is no definitive evidence of a deceased inventor.

Applicants request to treat the above-captioned petition under 37 CFR 1.47(a) is declined at this time. In the renewed petition, applicants presented no evidence showing that any attempt was made to determine whether Mr. Cybuch is deceased. Conversely, there is evidence indicating that Mr. Cybuch may be deceased.

While the statement about Mr. Cybuch by the Bailiff in exhibit five is not definitive, applicants are obligated to determine the accuracy of this information. A search of public death records in Ontario is required. Petitioners should also determine whether the sale of the residence at 7 Westfield Avenue, St. Catherines, Ontario Canada was made as part of an estate sale.

If Mr. Cybuch is determined to be deceased the declaration should be signed by his legal representative. If the legal representative refuses to cooperate or cannot be located, a petition under 37 CFR 1.47 (for the legal representative) may be appropriate.

## CONCLUSION

For the reasons noted above, applicants' renewed petition under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants are required to provide an acceptable response within a time limit of **TWO (2) MONTHS** from the mail date of this decision with extensions available.

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

James Thomson
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Tel.: (571) 272-3302

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28 DEC 2005

AMERSHAM BIOSCIENCES CORPORATION
Patent Department
800 Centennial Avenue
Piscataway, NJ 08855

In re Application of :
RAMM, Peter *et al* :
Application No.: 10/514,925 :
PCT No.: PCT/IB03/01821 :
Int. Filing Date: 09 May 2003 : **DECISION**
Priority Date: 14 May 2002 :
Attorney Docket No.: P10253 :
For: SYSTEM AND METHODS FOR RAPID AND AUTOMATED SCREENING OF CELLS :

This is a decision on the applicants' "Request for Reconsideration of Petition Under 37 C.F.R. 1.47(a)" ("2d.Ren.Pet.") filed on 12 December 2005.

## BACKGROUND

On 11 October 2005, a decision dismissing applicant's request to treat the petition under 37 CFR 1.47(a) was dismissed until such time as petitioner's determine whether the nonsigning inventor was deceased. Applicants were given two months to respond.

On 12 December 2005, applicants filed the subject request for reconsideration which was accompanied by, *inter alia*, Exhibits 1 - 9.

## DISCUSSION

In the prior decision, it was requested that petitioners conduct a search of public death records in Ontario to determine if the nonsigning inventor had passed. It was also requested that petitioners determine whether the sale of the former residence of Mr. Cybuch was made as part of an estate sale.

In the renewed response, upon close examination of the letter from the Bailiff, petitioners determined that the sale of the former residence of the nonsigning inventor was not made as part of an estate sale but sold by the owner of the house, Ms. Turczyn. This explanation is acceptable and is treated as a bona fide response.

However, petitioners explanation as to why a search of death records for Mr. Cybuch was not conducted in Ontario Canada is <u>not</u> acceptable.

Petitioners assert that it is impossible to determine whether Mr. Cybuch was deceased at this point. 2d.Ren.Pet. at ¶ 14. Petitioners claim that "[a]s Petitioners do not know to which country inventor Cybuch went, Petitioners cannot search the death records to substantiate or refute his death. . . " Id. at ¶ 17.

The decision dated 11 October 2005 specifically requested that petitioners check only the public death records in Ontario, Canada. This request is not unreasonable in light of the information provided by the Bailiff (Exhibit 6) and will be required for a grantable petition.

## CONCLUSION

For the reasons noted above, applicants' renewed petition is **DISMISSED** without prejudice.

Applicants are required to provide an acceptable response within a time limit of **TWO (2) MONTHS** from the mail date of this decision with extensions available.

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

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27 JUL 2006

AMERSHAM BIOSCIENCES CORPORATION
Patent Department
800 Centennial Avenue
Piscataway, NJ 08855

In re Application of :
RAMM, Peter *et al* :
Application No.: 10/514,925 :
PCT No.: PCT/IB03/01821 :
Int. Filing Date: 09 May 2003 : **DECISION**
Priority Date: 14 May 2002 :
Attorney Docket No.: P10253 :
For: SYSTEM AND METHODS FOR RAPID AND AUTOMATED SCREENING OF CELLS :

This is a decision on the papers filed on 26 May 2006.

## BACKGROUND

On 28 December 2005, a decision dismissing applicant's request to treat the petition under 37 CFR 1.47(a) was mailed. Applicants were requested to determine if the nonsigning inventor had deceased as indicated on certain evidence submitted. Applicants were given two months to respond with extensions available.

On 26 May 2006, applicants filed a request for reconsideration which was accompanied by, *inter alia*, a three-month extension and fee and a letter from the Ontario government.

## DISCUSSION

In the prior decision, it was requested that petitioners conduct a search of public death records in Ontario to determine if the nonsigning inventor had passed before considering the petition under 37 CFR 1.47.

In the response, applicants submitted a letter from the Office of the Registrar General in Ontario indicating that there is no record of the death of J. Cybuch in the province of Ontario. This is an acceptable response. This application will be considered under 37 CFR 1.47(a) using the evidence submitted previously.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventors cannot be located or refuse to cooperate; (3) a statement of the last known addresses of the nonsigning joint inventors; (4) and an oath

or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

Concerning item (1), the fee for a petition under 37 CFR 1.47 changed to $200.00 on 08 December 2004. This fee has been charged to Deposit Account No. 50-2590 as authorized.

Regarding item (2), applicants' burden in showing that an inventor cannot be located is explained in section 409.03(d) of the MPEP which 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 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 . . .

In this case, petitioners have submitted declarations by Royal N. Ronning on 12 September 2005 and 12 December 2005 explaining the attempts to locate the nonsigning inventor. A review of the evidence submitted in U.S. application No. 10/817,213 was also performed. These attempts include contacting the inventor's previous employer, mailing letters to the last known address via Federal Express, attempted service by the City of Niagara falls Ontario Bailiff and emails. Petitioners also provided the requisite documentary evidence in the form of copies of the letters, emails and postal receipts to substantiate their claim.

This evidence is sufficient to show that a diligent effort was made to locate the nonsigning inventor and meet the requirements of the MPEP. Item (2) of 37 CFR 1.47(a) is satisfied.

With regards to item (3), the last known address of Jurich Cybuch is listed as:

7 Westfield Avenue
St. Catherines, Ontario

Canada L2S 5Z5

Concerning item (4), the 37 CFR 1.47(a) applicant submitted a declaration on 12 November 2004 signed by five of six co-inventors on behalf of themselves and the nonsigning joint inventor. This declaration meets the requirements of section 409.03(a) and is in compliance with 37 CFR 1.497(a) and (b).

All requirements of 37 CFR 1.47(a) are complete.

## CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 09 May 2003 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 12 November 2004.

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

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

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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27 JUL 2006

J. Cybuch
7 Westfield Avenue
St. Catherines, Ontario
Canada L2S 5Z5

In re Application of
RAMM, Peter *et al*
Application No.: 10/514,925
PCT No.: PCT/IB03/01821
Int. Filing Date: 09 May 2003
Priority Date: 14 May 2002
Attorney Docket No.: P10253
For: SYSTEM AND METHODS FOR RAPID AND AUTOMATED SCREENING OF CELLS

Dear Mr. Cybuch:

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

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

AMERSHAM BIOSCIENCES CORPORATION
Patent Department
800 Centennial Avenue
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26 JUN 2006

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HOUSTON TX 77251-1212

| | | |
|---|---|---|
| In re Application of | : | |
| DELVES, James Edwards et al. | : | DECISION ON |
| Application No.: 10/514,960 | : | |
| PCT No.: PCT/GB03/02370 | : | PETITION |
| Int. Filing Date: 30 May 2003 | : | |
| Priority Date: 31 May 2002 | : | UNDER 37 CFR 1.47(a) |
| Attorney Docket No.: KCC-030804 (PET-1008US) | : | |
| For: FLUIDISING APPARATUS | : | |

This is a decision on applicants' "Petition In Support of Application Filed Under 37 CFR §1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 30 November 2005.

## BACKGROUND

On 30 May 2003, applicants filed international application PCT/GB03/02370, which claimed a priority date of 31 May 2002. A copy of the international application was transmitted to the Office on 11 December 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 30 November 2004.

On 18 November 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 01 July 2005, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required.

On 30 November 2005, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration of inventorship, a supporting declaration and the fee for a 3-month extension of time.

## DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the non-signing applicant.

Items (1), (3) and (4) have been satisfied. The balance of the $200 petition fee will be charged to deposit account no. 13-0010, as authorized. Applicant states the last known address of inventor Neil Keith Young as 2 Beryl Road; Bedminster, Bristol BS3 3DH; Great Britain and for inventor David Oliver Drew as 35 Dragon Road; Winterbourne, Bristol BS17 1BQ; Great Britain. The declaration complies with 37 CFR 1.497(a)-(b) and 37 CFR 1.47(a).

Item (2) has not been satisfied. Applicants have not furnished evidence of receipt of the complete copy of the application papers, including the declaration, by the non-signing inventors. Christian Ziar has no first-hand knowledge of the presentation of the application papers to the non-signing inventors. A declaration from someone who spoke with the inventors confirming their receipt of the papers or other supporting documentation, or other evidence supporting applicants' allegation of refusal to join after presentation with a complete copy of the application papers should be included. MPEP 409.03(d).

## CONCLUSION

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

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

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

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

#9

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01 NOV 2006

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| | |
|---|---|
| In re Application of | |
| DELVES, James Edwards et al. | |
| Application No.: 10/514,960 | DECISION ON |
| PCT No.: PCT/GB03/02370 | |
| Int. Filing Date: 30 May 2003 | PETITION |
| Priority Date: 31 May 2002 | |
| Attorney Docket No.: KCC-030804 (PET-1008US) | UNDER 37 CFR 1.47(a) |
| For: FLUIDISING APPARATUS | |

This is a decision on applicants' "Renewed Petition Under 37 CFR §1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 25 August 2006.

## BACKGROUND

On 26 June 2006, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 25 August 2006, applicants filed this renewed petition under 37 CFR 1.47(a), accompanied by a declaration signed by one of the previously non-signing inventors.

## DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the non-signing applicant.

Items (1), (3) and (4) were previously satisfied. However, if applicants obtain a current last known address for Mr. Young, it should be provided. This petition is now moot as to inventor David Oliver Drew.

Item (2) has not been satisfied. Applicants have now furnished evidence of receipt of the complete copy of the application papers, including the declaration, by the non-signing inventor. However, it appears from the email correspondence that Mr. Young only received the copy of the international application on 21 August 2006. This renewed petition was filed on 25 August 2006. This is not an adequate period of time to allow for response. At least two weeks is expected.

## CONCLUSION

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

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

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

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Attorney Advisor
PCT Legal Administration

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Facsimile: 571-273-0459

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|---|---|---|
| In re Application of | : | |
| DELVES, James Edwards et al. | : | |
| Application No.: 10/514,960 | : | DECISION ON |
| PCT No.: PCT/GB03/02370 | : | |
| Int. Filing Date: 30 May 2003 | : | PETITION |
| Priority Date: 31 May 2002 | : | |
| Att. Docket No.: KCC-030804 (PET-1008US) | : | UNDER 37 CFR 1.47(a) |
| For: FLUIDISING APPARATUS | : | |

This is a decision on applicants' "Second Renewed Petition Under 37 CFR §1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 01 December 2006.

## BACKGROUND

On 01 November 2006, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 01 December 2006, applicants filed this renewed petition under 37 CFR 1.47(a).

## DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the non-signing applicant.

Items (1), (3) and (4) were previously satisfied.

Item (2) has now been satisfied. Applicants have furnished evidence of receipt of the complete copy of the application papers, including the declaration, by the non-signing inventor and have provided sufficient opportunity for reply.

## CONCLUSION

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

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventors at their last known addresses.

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

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including accordation of a 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) date of **25 August 2006**.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

12 JAN 2007

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Neil Keith Young
2 Beryl Road
Bedminster, Bristol BS3 3DH
United Kingdom

In re Application of
DELVES, James Edwards et al.
Application No.: 10/514,960
PCT No.: PCT/GB03/02370
Int. Filing Date: 30 May 2003
Priority Date: 31 May 2002
Att. Docket No.: KCC-030804 (PET-1008US)
For: FLUIDISING APPARATUS

Dear Mr. Young:

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

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

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

cc: Neil Keith Young
DPS (Bristol) Ltd.
Serbert Way
Portishead, Bristol BS20 7GF
United Kingdom

CAMERON INTERNATIONAL CORPORATION
PO BOX 1212
HOUSTON TX 77251-1212

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

DATE : 3/26/07

Paper No.: _____

TO SPE OF : ART UNIT 2855

SUBJECT : Request for Certificate of Correction on Patent No.: 7185535

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***

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**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:

EDWARD LEFKOWITZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

2855
Art Unit

29 AUG 2005

#4

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ABACO Machines
Attn: Hoa Nhon Nguyen
4855 Marine Avenue, #E
Lawndale, CA 90260

| | |
|---|---|
| In re Application of | |
| NGUYEN, et al. | |
| Application No.: 10/514,967 | |
| PCT No.: PCT/AU03/00032 | DECISION ON PETITION |
| Int. Filing Date: 14 January 2003 | |
| Priority Date: 14 January 2002 | UNDER 37 CFR 1.137(b) |
| Atty. Docket No.: ABACO | |
| For: CLAMPING DEVICE FOR LIFTING SLAB, PANEL, OR SHEET MATERIAL | |

The petition to revive under 37 CFR 1.137(b) filed 18 November 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National Fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America. 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 14 January 2003 under 35 U.S.C. 363 and will be given a date of **18 November 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

22 SEP 2005

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Steven H. Noll
Schiff, Hardin, LLP
Patent Department
6600 Sears Tower
Chicago, IL 60606-6473

In re Application of :
HORNFELDT, et al. : DECISION ON PETITION
Application No.: 10/514,969 :
PCT No.: PCT/SE03/00513 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 28 March 2003 :
Priority Date: 30 April 2002 :
Atty. Docket No.: P04.0464 :
For: IMPLANTABLE HEART STIMULATOR :

The petition to revive under 37 CFR 1.137(b) filed 18 November 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National Fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America. 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 28 March 2003 under 35 U.S.C. 363 and will be given a date of **18 November 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

28 FEB 2006

#7

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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 OSHIMA et al | : | |
| U.S. Application No.: 10/514,988 | : | |
| PCT Application No.: PCT/JP03/06275 | : | |
| Int. Filing Date: 20 May 2003 | : | DECISION |
| Priority Date Claimed: 21 May 2002 | : | |
| Attorney Docket No.: 3462.1012-000 | : | |
| For: METHODS FOR IDENTIFYING NUCLEIC ACIDS | : | |

This is in response to applicant's "Petition Under 37 C.F.R. § 1.47(a) and Transmittal of Declaration" filed 30 January 2006.

## BACKGROUND

On 20 May 2003, applicant filed international application PCT/JP03/06275, which claimed priority of an earlier Japan application filed 21 May 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 27 November 2003. The thirty-month period for paying the basic national fee in the United States expired on 21 November 2004.

On 18 November 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 30 June 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 30 January 2006, applicant filed the present petition under 37 CFR 1.47(a).

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventor on his/her own behalf and on behalf of the nonsigning inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Ken Nemoto refuses to sign the application papers. However, the petition does not adequately demonstrate that a bona fide attempt was made to present a complete copy of the application papers to Nemoto for signature. Although the letter dated 14 December 2004 and the electronic mail message dated 15 December 2004 state that declaration and assignment forms were sent to Nemoto, neither communication indicates that the specification, claims, and drawings were ever presented to Nemoto. The directive in the 14 December 2004 letter stating that the inventor should read the patent application before signing the declaration does not establish that a copy of the patent application was included in the mailing. Furthermore, it is unclear whether Nemoto was actually presented with a copy of the application papers for review during the meeting held on 27 January 2006. In addition, the petition does not sufficiently establish that Nemoto refuses to sign. In particular, the meeting notes indicate that Nemoto was not prepared to sign at the meeting but would reply after consultation with his attorney. Thus, it would not be reasonable to conclude at the present time that Nemoto refuses to join in the application.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

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

20 JUN 2006

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P.O. BOX 9133
CONCORD, MA 01742-9133

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|---|---|---|
| In re Application of OSHIMA et al | : | |
| U.S. Application No.: 10/514,988 | : | |
| PCT Application No.: PCT/JP03/06275 | : | |
| Int. Filing Date: 20 May 2003 | : | COMMUNICATION |
| Priority Date Claimed: 21 May 2002 | : | |
| Attorney Docket No.: 3462.1012-000 | : | |
| For: METHODS FOR IDENTIFYING NUCLEIC ACIDS | : | |

This is in response to applicant's "Reply to Decision on Applicant's Petition Under 37 C.F.R. § 1.47(a) and Transmittal of Signed Declaration by Mr. Ken Nomoto" filed 25 April 2006.

The response is a proper reply to the decision mailed 28 February 2006.

The application has an International Filing Date under 35 U.S.C. 363 of 20 May 2003 and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 25 April 2006.

The application will be forwarded to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this communication.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

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UNITED STATES DEPARTMENT OF COMMERCE
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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Cornelius Hahlweg | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7593813 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/514,997 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/19/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **44** 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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FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Herbert Hommer | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7655710 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,004 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/25/2006 | : 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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OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA VA 22320-4850

9/11/08

In re Application of:
KOBAYASHI, HITOSHI
Serial No. 10/515,010
Filed: Nov. 22, 2004
Docket: 121816
Title: MONITORING SYSTEM, GAME MACHINE AND DEVICE MANAGEMENT SYSTEM

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition filed on Aug. 28, 2008 to request a new office action be mailed and re-set the response period. The petition is being considered as a petition pursuant to 37 CFR 1.181(a). No fee is required.

The petition is **GRANTED.**

The Office contended that the above-identified application became abandoned for failure to timely reply to the Non-final Office action mailed Jun. 4, 2008, which set a period for reply of one month. Having received no reply, the Office considered the application abandoned on Jul. 7, 2008. A Notice of Abandonment has not been mailed.

A review of the application file reveals that the Jun. 4, 2008 non-final Office action was returned to the Office on Jun. 6, 2008. It is apparent that the Jun. 4, 2008 non-final Office action was not delivered to the correspondence address of record. Therefore, the petition under 37 CFR 1.181 is granted and the holding of abandonment is withdrawn. No petition fee has been or will be charged in connection with this matter.

In view of the above, the application is being forwarded to the examiner in Art Unit 3714 for re-mailing the non-final Office action and a new period to respond will be re-set.

Robert Olszewski, Director
Technology Center 3700

23 MAY 2006

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Commissioner for Patents
United States Patent and Trademark Office
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Roberte M. D. Makowski, Ph.D.
Connolly Bove Lodge & Hutz, LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

In re Application of :
PLESCH, et al. :
Serial No.: 10/515,020 :
PCT No.: PCT/EP03/05668 : DECISION ON PETITION
Int. Filing Date: 30 May 2003 :
Priority Date: 04 June 2002 : UNDER 37 CFR 1.181
Atty Docket No.: 53262-20096.00 :
For: METHOD FOR THE STABLE EXPRESSION OF NUCLEIC ACIDS IN TRANSGENIC PLANTS, CONTROLLED BY A PARSLEY-UBIQUITIN PROMOTER :

This is a decision on applicant's facsimile filing of 22 May 2006 in the United States Patent and Trademark Office (USPTO). The filing is being treated as a petition to withdraw holding of abandonment under 37 CFR 1.181. No petition fee is due.

## BACKGROUND

On 30 May 2003, applicant filed international application PCT/EP03/05668, which claimed priority of an earlier application filed 04 June 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 December 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was set to expire 30 months from the priority date, 04 December 2004.

On 22 November 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an executed declaration and power of attorney; an assignment document; an English translation of the international application and a preliminary amendment.

On 06 June 2005, applicant filed a new power of attorney and change of correspondence address.

On 02 November 2005, applicant was mailed a "Notification to Comply With Requirements For Patent Application Containing Nucleotide And/Or Amino Acid Sequence Disclosures" (Form PCT/DO/EO/922) informing applicant that a copy of the "Sequence Listing"

in computer readable form has not been submitted. Applicant was afforded two months to file a proper response. The form was mailed to the original correspondence address

On 22 March 2006, applicant filed a status inquiry.

On 22 May 2006, applicant filed the present petition under 37 CFR 1.181.

## DISCUSSION

A review of the application file finds applicant's original 06 June 2005 filing contained therein. As such the Form PCT/DO/EO/922 mailed 02 November 2005 should have been mailed to the correspondence address identified in the 06 June 2005 mailing.

Applicant's petition and accompanying papers satisfy the requirements for granting applicant's petition. The holding of abandonment in this application is withdrawn.

## CONCLUSION

Applicant's Petition Under 37 CFR 1.181 is **GRANTED**.

The "Notification to Comply With Requirements For Patent Application Containing Nucleotide And/Or Amino Acid Sequence Disclosures" (Form PCT/DO/EO/922) mailed 02 November 2005 is hereby **VACATED**.

This application is being returned to the DO/EO/US for processing in accordance with this decision including 1) changing the correspondence address for the application to the address above and 2) the re-issuance of a new "Notification to Comply With Requirements For Patent Application Containing Nucleotide And/Or Amino Acid Sequence Disclosures" (Form PCT/DO/EO/922) to the new address.

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

02 AUG 2005



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Jacques L. Etkowicz
RATNERPRESTIA
P.O. BOX 980
VALLEY FORGE, PA 19482-0980

In re Application of LAGARES COROMINAS
Application No.: 10/515,040
PCT Application No.: PCT/ES03/00229
Int. Filing Date: 20 May 2003
Priority Date Claimed: 20 May 2002
Attorney Docket No.: TJA-107US
For: FOOD COOKING INSTALLATION

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

Applicant's "Petition For Revival Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office (PTO) on 26 April 2005 is GRANTED.

## BACKGROUND

On 20 May 2003, applicant filed international application PCT/ES03/00229. The international application claims a priority date of 20 May 2002 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 27 November 2003. The deadline to pay the basic national fee was thirty months from the priority date, that is 20 November 2004. The application became abandoned at midnight 20 November 2004 for failure to pay the basic national fee.

On 19 November 2004, applicant 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 and the payment of the basic national fee of $475.

On April 19, 2005, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant, indicating that the full basic national fee was not paid by the expiration of the thirty months deadline from the priority date claimed of 20 May 2002.

On 26 April 2005, applicant filed the instant petition for revival accompanied by, *inter alia*,: the requisite additional basic national fee of $80 as required by 35 U.S.C. 371(c)(1) and the petition fee of $750 to be charged onto the credit card provided.

BEST AVAILABLE COPY

## 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 satisfies 37 CFR 1.137(b)(1). In this regard, applicant should note that the required basic national fee amount has changed as a consequence of the consolidated appropriations Act, 2005 (CAA). 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.

Applicant's prior payment of $475 on 19 November 2004 for the basic national fee is in excess of that required under the CAA. This difference will be applied toward the instant petition fee, and the balance of such petition fee charged to applicant's credit card as authorized.

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

Helen Kwok
Detailee
PCT Legal Administration
Telephone: 571-272-6095
Facsimile: 571-273-0459

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**PYLE & PIONTEK**
**ATTN: THOMAS R. VIGIL**
**221 N LASALLE STREET, ROOM 2036**
**CHICAGO IL 60601**

COPY MAILED

OCT 25 2007

OFFICE OF PETITIONS

In re Application of :
Peter Metz-Stavenhagen :
Application No. 10/515,043 : DECISION ON PETITION
Filed: November 19, 2004 :
Attorney Docket No. 8034-93360 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 11, 2007 and resubmitted on July 30, 2007, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before May 2, 2007, as required by the Notice of Allowance and Fee(s) Due, mailed February 2, 2007. Accordingly, the date of abandonment of this application is May 3, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $700 and the publication fee of $300, (2) the petition fee of $750; and (3) a proper statement of unintentional delay.

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

This application is being referred to Publishing Division for processing into a patent.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

Mail Date: 04/26/2010

| | | |
|---|---|---|
| **Applicant** | : Pierre Doublet | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7632380 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/515,059 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/19/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **892** 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.

31 MAR 2006

UNITED STATES PATENT and TRADEMARK OFFICE

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

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

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| KARSTEN Petrus J.A., et al | : | |
| Application No.: 10/515,061 | : | |
| PCT No.: PCT/EP03/04953 | : | |
| Int. Filing Date: 12 May 2003 | : | PETITION UNDER |
| Priority Date: 21 May 2002 | : | |
| Attorney Docket No.: 262140US0PCT | : | |
| For: POLYMER COMPOSITION INCLUDING | : | |
| A CYCLIC OLEFIN COPOLYMER | : | 37 CFR 1.181 |

This decision is in response to the "REQUEST FOR CORRECTED NOTICE OF ACCEPTANCE" filed 12 January 2006, which is being treated as a petition under 37 CFR 1.181 requesting that the correct date of completion of all USC 371 requirements be changed from 15 April 2005 to 19 November 2004.

## BACKGROUND

On 12 May 2003, this international application was filed, claiming an earliest priority date of 21 May 2002. The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 21 May 2002.

On 19 November 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 as required by 35 U.S.C. 371(c)(2). Also submitted was an executed declaration under PCT Rule 4.17(iv) at such time.

On 15 April 2005, applicants filed a second transmittal letter, which was accompanied by, inter alia, an executed declaration.

On 13 July 2005, the USPTO mailed a "NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 C.F.R. 1.495 (Form PCT/DO/EO/903)," indicating that date of receipt of 35 U.S.C. 371 (c)(1), (c)(2), and (c)(4) requirements is 15 April 2005, and a date of completion of all 35 USC 371 requirements is 15 April 2005.

On 17 January 2005, applicants filed the current petition pursuant 37 CFR 1.181 requesting a corrected filing receipt, stating that the date of completion of all 35 USC 371 requirements and 35 U.S.C. 371 (c)(1), (c)(2), and (c)(4) date is 19 November 2004.

Applicants state this is the correct date because the declaration was filed in the international application under PCT Rule 4.17(iv).

## DISCUSSION

In general, the requirement for an oath or declaration in compliance with 37 CFR **1.497**(a)-(b) will have been previously satisfied if a declaration in compliance with PCT Rule **4.17** (iv) and executed by all the inventors was submitted within the time limits provided in PCT Rule **26*ter*.1** in the international phase.

The date that applicants competed the requirements under section (c) of 35 USC 371 is 15 April 2005, which is the date that an executed declaration was filed with the Office. A review of the file reveals that declaration submitted under PCT Rule 4.17 was not properly executed. The declaration filed with PCT Request was not executed. The later submitted executed declaration to the PCT request, however, did not list the international application number as required, note section VIII-4-1 of the PCT Request. Therefore, the declaration was not in compliance with 37 CFR 1.497(a)-(b).

Accordingly, the date of receipt of 35 U.S.C. 371 (c)(1), (c)(2), and (c)(4) requirements is 15 April 2005, and a date of completion of all 35 USC 371 requirements is 15 April 2005, which the date that a proper executed declaration was filed in the application.

## DECISION

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

If reconsideration of the merits of the petition under 37 CFR 1.181 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 1.181." 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

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

| U.S. APPLICATION NUMBER NO. | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|---|---|---|
| 10/515,061 | Petrus J.A. Karsten | 262140US0PCT |

| INTERNATIONAL APPLICATION NO. | |
|---|---|
| PCT/EP03/04953 | |
| I.A. FILING DATE | PRIORITY DATE |
| 05/12/2003 | 05/21/2002 |

22850
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

**CONFIRMATION NO. 1979**

**371 ACCEPTANCE LETTER**

*OC000000016477004*

Date Mailed: 07/13/2005

## 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:

| 04/15/2005 | 04/15/2005 |
|---|---|
| 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 11/19/2004
- Copy of the International Search Report filed on 11/19/2004
- Copy of IPE Report filed on 11/19/2004
- Preliminary Amendments filed on 11/19/2004
- Information Disclosure Statements filed on 12/08/2004
- Oath or Declaration filed on 04/15/2005
- Request for Immediate Examination filed on 11/19/2004
- U.S. Basic National Fees filed on 11/19/2004
- Priority Documents filed on 11/19/2004
- Power of Attorney filed on 04/15/2005

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)

SHAKEEL AHMED
Telephone: (703) 308-9140 EXT 208

PART 3 - OFFICE COPY

FORM PCT/DO/EO/903 (371 Acceptance Notice)

DT03 Rec'd PCT/PTO 19 NOV 2004

FORM PTO-1390 (Modified) (REV. 07-2004) U.S. PATENT AND TRADEMARK OFFICE; U.S. DEPARTMENT OF COMMERCE

# TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A SUBMISSION UNDER 35 U.S.C. 371

| ATTORNEY'S DOCKET NUMBER | U.S. APPLICATION NO. (If known, see 37 CFR 1.5) |
|---|---|
| 262140US0PCT | 10/515061 |

| INTERNATIONAL APPLICATION NO. | INTERNATIONAL FILING DATE | PRIORITY DATE CLAIMED |
|---|---|---|
| PCT/EP03/04953 | 12 MAY 2003 | 21 MAY 2002 |

TITLE OF INVENTION
**POLYMER COMPOSITION INCLUDING A CYCLIC OLEFIN COPOLYMER**

APPLICANT(S) FOR DO/EO/US
**KARSTEN Petrus J.A., et al.**

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☒ This is a **FIRST** submission of items concerning a submission under 35 U.S.C. 371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a submission under 35 U.S.C. 371.
3. ☒ 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 (24) indicated below.
4. ☒ The US has been elected (Article 31).
5. ☒ A copy of the International Application as filed (35 U.S.C. 371 (c) (2))
   a. ☐ 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. ☐ An oath or declaration of the inventor(s) (35 U.S.C. 371 (c)(4)).
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)).
11. ☒ A copy of the International Preliminary Examination Report (PCT/IPEA/409).
12. ☒ A copy of the International Search Report (PCT/ISA/210).

**Items 13 to 23 below concern document(s) or information included:**

13. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
14. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
15. ☒ A **FIRST** preliminary amendment.
16. ☐ A **SECOND** or **SUBSEQUENT** preliminary amendment.
17. ☐ A substitute specification.
18. ☐ A power of attorney and/or change of address letter.
19. ☐ A computer-readable form of the sequence listing in accordance with PCT Rule 13*ter*.2 and 37 CFR 1.821 - 1.825.
20. ☐ A second copy of the published International Application under 35 U.S.C. 154(d)(4).
21. ☐ A second copy of the English language translation of the International Application under 35 U.S.C. 154(d)(4).
22. ☐ Express Mail Label No.
23. ☒ Other items or information:

**Application Data Sheet/Request for Priority/PCT/IB/304**
**Request for Consideration of Documents Cited in International Search Report**
**Declaration of Inventorship filed under PCT Rule 4.17**

| U.S. APPLICATION NO (if known, see 37 CFR 1.5) | INTERNATIONAL APPLICATION NO. | ATTORNEY'S DOCKET NUMBER |
|---|---|---|
| 10/515061 | PCT/EP03/04953 | 262140US0PCT |

| 24. The following fees are submitted: | | CALCULATIONS PTO USE ONLY | |
|---|---|---|---|
| **BASIC NATIONAL FEE (37 CFR 1.492(a)(1)-(5)) :** | | | |
| ☐ 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 | $1110.00 | | |
| ☒ International preliminary examination fee (37 CFR 1.482) not paid to USPTO but International Search Report prepared by the EPO or JPO | $950.00 | | |
| ☐ International preliminary examination fee (37 CFR 1.482) not paid to USPTO but international search fee (37 CFR 1.445(a)(2)) paid to USPTO | $790.00 | | |
| ☐ International preliminary examination fee (37 CFR 1.482) paid to USPTO but all claims did not satisfy provisions of PCT Article 33(1)-(4) | $750.00 | | |
| ☐ International preliminary examination fee (37 CFR 1.482) paid to USPTO and all claims satisfied provisions of PCT Article 33(1)-(4) | $100.00 | | |
| **ENTER APPROPRIATE BASIC FEE AMOUNT =** | | $950.00 | |
| Surcharge of **$130.00** for furnishing the oath or declaration later than ☐ 20 ☐ 30 months from the earliest claimed priority date (37 CFR 1.492(e)). | | $0.00 | |

| CLAIMS | NUMBER FILED | NUMBER EXTRA | RATE | | |
|---|---|---|---|---|---|
| Total claims | 10 - 20 = | 0 | x $18.00 | $0.00 | |
| Independent claims | 1 - 3 = | 0 | x $88.00 | $0.00 | |
| Multiple Dependent Claims (check if applicable). | | | ☐ | $0.00 | |
| **TOTAL OF ABOVE CALCULATIONS =** | | | | $950.00 | |
| ☐ Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above are reduced by 1/2. | | | | $0.00 | |
| **SUBTOTAL =** | | | | $950.00 | |
| Processing fee of **$130.00** for furnishing the English translation later than ☐ 20 ☐ 30 months from the earliest claimed priority date (37 CFR 1.492(f)). | | | + | $0.00 | |
| **TOTAL NATIONAL FEE =** | | | | $950.00 | |
| Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31) (check if applicable). ☐ | | | | $0.00 | |
| **TOTAL FEES ENCLOSED =** | | | | $950.00 | |
| | | | | Amount to be: refunded | $ |
| | | | | charged | $ |

a. ☐ A check in the amount of _____ to cover the above fees is enclosed.

b. ☐ Please charge my Deposit Account No. _____ in the amount of _____ to cover the above fees.

c. ☒ The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. **15-0030**

d. ☒ Fees are to be charged to a credit card. **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.

**NOTE: Where an appropriate time limit under 37 CFR 1.494 or 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the International Application to pending status.**

SEND ALL CORRESPONDENCE TO:

Surinder Sachar
Registration No. 34,423

**CUSTOMER NUMBER 22850**

Surinder Sachar
SIGNATURE

**Norman F. Oblon**
NAME

**24,618**
REGISTRATION NUMBER

Nov. 19 2004
DATE

10/515061

DT[redacted]ec'd PCT/PTO 19 NOV 2004

Docket No. 262140US0PCT

IN RE APPLICATION OF: Petrus J.A. KARSTEN et al.

SERIAL NO: New U.S. PCT Application Based on PCT/EP03/04953

FILED: HEREWITH

FOR: POLYMER COMPOSITION INCLUDING A CYCLIC OLEFIN COPOLYMER

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:
Transmitted herewith is an amendment in the above-identified application.

■ No additional fee is required

☐ Small entity status of this application under 37 C.F.R. §1.9 and §1.27 is claimed.

■ Additional documents filed herewith: PCT Transmittal Letter/PCT/IB/304/Application Data Sheet/Notice of Priority
Copy of Declaration of Inventorship filed under PCT Rule 4.17
International Search Report/International Preliminary Examination Report
Credit Card Payment Form for $950.00

The Fee has been calculated as shown below:

| CLAIMS | CLAIMS REMAINING | | HIGHEST NUMBER PREVIOUSLY PAID | NO. EXTRA CLAIMS | RATE | CALCULATIONS |
|---|---|---|---|---|---|---|
| TOTAL | 10 | MINUS | 10 | 0 | x $18 = | $0.00 |
| INDEPENDENT | 1 | MINUS | 1 | 0 | x $88 = | $0.00 |
| | | ☐ MULTIPLE DEPENDENT CLAIMS | | | + $300 = | $0.00 |
| | | TOTAL OF ABOVE CALCULATIONS | | | | $0.00 |
| | | ☐ Reduction by 50% for filing by Small Entity | | | | $0.00 |
| | | ☐ Recordation of Assignment | | | + $40 = | $0.00 |
| | | | | | TOTAL | $0.00 |

☐ A check in the amount of **$0.00** is attached.

☐ Credit card payment form is attached to cover the fees in the amount of **$0.00**

■ Please charge any additional Fees for the papers being filed herewith and for which no check or credit card payment is enclosed herewith, or credit any overpayment to deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

■ If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. §1.136 for any necessary extension of time may be charged to Deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Surinder Sachar

Norman F. Oblon
Registration No. 24,618

Surinder Sachar
Registration No. 34,423

Customer Number
22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 05/03)

JC07 Rec'd PCT/PTO 15 APR 2005

FORM PTO-1390 (Modified) U.S. PATENT AND TRADEMARK OFFICE; U.S. DEPARTMENT OF COMMERCE
(REV. 12-2004)

# TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A SUBMISSION UNDER 35 U.S.C. 371

| ATTORNEY'S DOCKET NUMBER | |
|---|---|
| 262140US0PCT | |
| U.S. APPLICATION NO. (If known, see 37 CFR 1.5) | |
| 10/515,061 | |

| INTERNATIONAL APPLICATION NO. | INTERNATIONAL FILING DATE | PRIORITY DATE CLAIMED |
|---|---|---|
| PCT/EP03/04953 | 12 MAY 2003 | 21 MAY 2002 |

TITLE OF INVENTION
**POLYMER COMPOSITION INCLUDING A CYCLIC OLEFIN COPOLYMER**

APPLICANT(S) FOR DO/EO/US
**Petrus J.A. KARSTEN, et al.**

OIPE APR 15 2005 JC25 PATENT & TRADEMARK OFFICE

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☐ This is a **FIRST** submission of items concerning a submission under 35 U.S.C. 371.
2. ☒ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a submission under 35 U.S.C. 371.
3. ☐ 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 (24) indicated below.
4. ☐ The US has been elected (Article 31).
5. ☐ A copy of the International Application as filed (35 U.S.C. 371 (c)(2))
   a. ☐ 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. ☐ An oath or declaration of the inventor(s) (35 U.S.C. 371 (c)(4)).
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)).
11. ☐ A copy of the International Preliminary Examination Report (PCT/IPEA/409).
12. ☐ A copy of the International Search Report (PCT/ISA/210).

**Items 13 to 23 below concern document(s) or information included:**

13. ☐ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
14. ☐ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
15. ☐ A **FIRST** preliminary amendment.
16. ☐ A **SECOND** or **SUBSEQUENT** preliminary amendment.
17. ☐ A substitute specification.
18. ☒ A power of attorney and/or change of address letter.
19. ☐ A computer-readable form of the sequence listing in accordance with PCT Rule 13*ter*.2 and 37 CFR 1.821 - 1.825.
20. ☐ A second copy of the published International Application under 35 U.S.C. 154(d)(4).
21. ☐ A second copy of the English language translation of the International Application under 35 U.S.C. 154(d)(4).
22. ☐ Express Mail Label No.
23. ☐ Other items or information:

07/08/2005 SAHMED1 00000001 150030 10515061
01 FC:1617 130.00 DA

PTO-1390 (Rev. 12-2004)
Approved for use through 3/31/2007. OMB 0651-0021
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| U.S. APPLICATION NO (if known, see 37 CFR 1.5) | INTERNATIONAL APPLICATION NO. | ATTORNEY'S DOCKET NUMBER |
|---|---|---|
| 10/515,061 | PCT/EP03/04953 | 262140US0PCT |

| 24. The following fees are submitted: | | Applicant use | Office use |
|---|---|---|---|
| ☐ a) Basic national fee | $300.00 | $ $0.00 | |
| ☐ b) Examination fee | $200.00 | $ $0.00 | |
| ☐ c) Search fee | $500.00 | $ $0.00 | |
| **TOTAL OF ABOVE CALCULATIONS =** | $1000.00 | $ $0.00 | |
| ☐ Additional fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing or computer program listing filed in an electronic medium). The fee is $250 for each additional 50 sheets of paper or fraction thereof. | | | |

| Total Sheets | Extra Sheets | Number of each additional 50 or fraction thereof (round up to a whole | RATE | | |
|---|---|---|---|---|---|
| - 100 = | /50 = | | x $250.00 | $ $0.00 | |
| Surcharge of $130.00 for furnishing the oath or declaration later than months from the earliest claimed priority date (37 CFR 1.492(e)). | | | | $ | |

| CLAIMS | NUMBER FILED | NUMBER EXTRA | RATE | | |
|---|---|---|---|---|---|
| Total claims | - 20 = | 0 | x $50.00 | $ $0.00 | |
| Independent claims | - 3 = | 0 | x $200.00 | $ $0.00 | |
| MULTIPLE DEPENDENT CLAIMS (if applicable) | ☐ | | + $360.00 | $ $0.00 | |
| **TOTAL OF ABOVE CALCULATIONS =** | | | | $ $0.00 | |
| ☐ Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above are reduced by 1/2. | | | | $ $0.00 | |
| **SUBTOTAL =** | | | | $ $0.00 | |
| Processing fee of $130.00 for furnishing the English translation later than 30 months from the earliest claimed priority date (37 CFR 1.492(f)). | | | | $ $0.00 | |
| **TOTAL NATIONAL FEE =** | | | | $ $0.00 | |
| Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). $40 per property + | | | | $ $0.00 | |
| **TOTAL FEES ENCLOSED =** | | | | $ $0.00 | |
| **Amount to be refunded:** | | | | | $ |
| **Amount to be charged:** | | | | | $ |

a. ☐ A check in the amount of $ _____ to cover the above fees is enclosed.

b. ☐ Please charge my Deposit Account No. _____ in the amount of _____ to cover the above fees. A duplicate copy of this sheet is

c. ☒ The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 15-0030 . A duplicate copy of this sheet is enclosed.

d. ☒ Fees are to be charged to a credit card. **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.

**NOTE: Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the International Application to pending status.**

SEND ALL CORRESPONDENCE TO:

**Customer Number 22850**

Corwin Paul Umbach

SIGNATURE

**Norman F. Oblon**

NAME Corwin P. Umbach, Ph.D.

24,618 Registration No. 40,211

REGISTRATION NUMBER



PCTUS1/REV05

**The PTO did not receive the following listed item(s)** NO CREDIT CARD Revision

# Declaration, Power of Attorney and Petition



WE (I) the undersigned inventor(s), hereby declare(s) that:

My residence, post office address and citizenship are as stated below next to my name,

We (I) believe that we are (I am) the original, first and joint (sole) inventor(s) of the subject matter which is claimed and for which a patent is sought on the invention entitled

**Polymer composition including a cyclic olefin copolymer**

the specification of which

- ☐ is attached hereto.
- ☐ was filed on _____ as
  Application Serial No. _____
  and amended on _____
- ☒ was filed as PCT international application
  Number PCT/ EP03/04953
  on May, 12, 2003,
  and was amended under PCT Article 19
  on _____ (if applicable).

We (I) hereby state that we (I) have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

We (I) acknowledge the duty to disclose information known to be material to the patentability of this application as defined in Section 1.56 of Title 37 Code of Federal Regulations.

We (I) hereby claim foreign priority benefits under 35 U.S.C. § 119(a)-(d) or § 365(b) of any foreign application(s) for patent or inventor's certificate, or § 365(a) of any PCT International application which designated at least one country other than the United States, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or PCT International application having a filing date before that of the application on which priority is claimed. Prior Foreign Application(s)

| Application No. | Country | Day/Month/Year | Priority Claimed |
|---|---|---|---|
| 02.04644 | France | 21/05/2002 | ☒ Yes ☐ No |
| | | | ☐ Yes ☐ No |
| | | | ☐ Yes ☐ No |
| | | | ☐ Yes ☐ No |

We (I) hereby claim the benefit under Title 35, United States Code, § 119(e) of any United States provisional application(s) listed below.

(Application Number) (Filing Date)

(Application Number) (Filing Date)

We (I) hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s), or under § 365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR § 1.56 which became available between the filing date of the prior application and the national or PCT International filing date of this application.

| **Application Serial No.** | **Filing Date** | **Status (pending, patented, abandoned)** |
|---|---|---|
| | | |
| | | |
| | | |

And we (I) hereby appoint the following registered practitioner(s):

as our (my) attorneys, with full powers of substitution and revocation, to prosecute this application and to transact all business in the Patent Office connected therewith; and we (I) hereby request that all correspondence regarding this application be sent to

We (I) declare that all statements made herein of our (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 issuing thereon.

1-00. KARSTEN Petrus J.A.
NAME OF FIRST SOLE INVENTOR

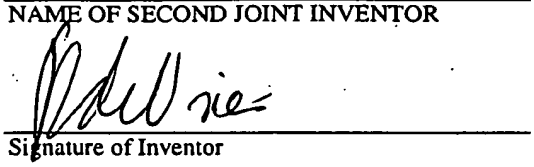
Signature of Inventor

16 March 2005
Date

Residence: Prior 14
1613 DH Grootebroek NLX
(Netherlands)
Citizen of: NETHERLANDS
Mailing Address: Same as above

2 – ∞

DE VRIES Piet
NAME OF SECOND JOINT INVENTOR



Signature of Inventor

16 Mard 2005
Date

Residence: Maelsonweg, 20
NL-1601 NS ENKHUIZEN NLX
(Netherlands)
Citizen of: NETHERLANDS
Mailing Address: Same as above

NAME OF THIRD JOINT INVENTOR

Signature of Inventor

Date

Residence:
Citizen of:
Mailing Address:

NAME OF FOURTH JOINT INVENTOR

Signature of Inventor

Date

Residence:
Citizen of:
Mailing Address:

NAME OF FIFTH JOINT INVENTOR

Signature of Inventor

Date

Residence:
Citizen of:
Mailing Address:

| | | |
|---|---|---|
| VIII-4-1-2-1 | Name: | DE VRIES, Piet |
| VIII-4-1-2-2 | Residence: (city and either US State, if applicable, or country) | ENKHUIZEN, RA, Netherlands |
| VIII-4-1-2-3 | Mailing address: | Lindenlaan, 17 |
| VIII-4-1-2-4 | Citizenship: | NL |
| VIII-4-1-2-5 | Inventor's Signature: (if not contained in the request, or if declaration is corrected or added under Rule 26ter after the filing of the international application. The signature must be that of the inventor, not that of the agent) | |
| VIII-4-1-2-6 | Date: (of signature which is not contained in the request, or of the declaration that is corrected or added under Rule 26ter after the filing of the international application) | |

T/EP03/04953

PCT REQUEST

S 2001/10

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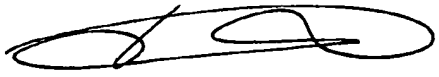
| IX | Check list | number of sheets | electronic file(s) attached |
|---|---|---|---|
| IX-1 | Request (including declaration sheets) | 10 | - |
| IX-2 | Description | 10 | - |
| IX-3 | Claims | 2 | - |
| IX-4 | Abstract | 1 | EZABST00.TXT |
| IX-5 | Drawings | 0 | - |
| IX-7 | TOTAL | 23 | |
| | **Accompanying items** | paper document(s) attached | electronic file(s) attached |
| IX-8 | Fee calculation sheet | ✓ | - |
| IX-11 | Copy of general power of attorney | reference no. 46764 | - |
| IX-17 | PCT-EASY diskette | - | Diskette |
| IX-19 | **Figure of the drawings which should accompany the abstract** | | |
| IX-20 | **Language of filing of the international application** | English | |
| X-1 | **Signature of applicant, agent or common representative** |  | |
| X-1-1 | Name (LAST, First) | JACQUES, Philippe | |

## FOR RECEIVING OFFICE USE ONLY

| | | | |
|---|---|---|---|
| 10-1 | **Date of actual receipt of the purported international application** | 12.05.2003 | 12 MAY 2003 |
| 10-2 | **Drawings:** | | |
| 10-2-1 | Received | | |
| 10-2-2 | Not received | | |
| 10-3 | **Corrected date of actual receipt due to later but timely received papers or drawings completing the purported international application** | | |
| 10-4 | **Date of timely receipt of the required corrections under PCT Article 11(2)** | | |
| 10-5 | **International Searching Authority** | ISA/EP | |
| 10-6 | **Transmittal of search copy delayed until search fee is paid** | | |

## FOR INTERNATIONAL BUREAU USE ONLY

| | | |
|---|---|---|
| 11-1 | **Date of receipt of the record copy by the International Bureau** | |

| | | |
|---|---|---|
| VIII-4-1 | **Declaration: Inventorship (only for the purposes of the designation of the United States of America)**<br>Declaration of inventorship (Rules 4.17(iv) and 51bis.1(a)(iv)) for the purposes of the designation of the United States of America: | I hereby declare that I believe I am the original, first and sole (if only one inventor is listed below) or joint (if more than one inventor is listed below) inventor of the subject matter which is claimed and for which a patent is sought.<br>This declaration is directed to the international application of which it forms a part (if filing declaration with application).<br>I hereby declare that my residence, mailing address, and citizenship are as stated next to my name.<br>I hereby state that I have reviewed and understand the contents of the above-identified international application, including the claims of said application. I have identified in the request of said application, in compliance with PCT Rule 4.10, any claim to foreign priority, and I have identified below, under the heading "Prior Applications," by application number, country or Member of the World Trade Organization, day, month and year of filing, any application for a patent or inventor's certificate filed in a country other than the United States of America, including any PCT international application designating at least one country other than the United States of America, having a filing date before that of the application on which foreign priority is claimed. |
| VIII-4-1-1 | Prior applications: | 02.04644, FR, 21 May 2002 (21.05.2002) |

| | | |
|---|---|---|
| | | I hereby acknowledge the duty to disclose information that is known by me to be material to patentability as defined by 37 C.F.R. § 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the PCT international filing date of the continuation-in-part application.<br>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. |
| VIII-4-1-1-1 | Name: | KARSTEN, Petrus, J.A. |
| VIII-4-1-1-2 | Residence:<br>(city and either US State, if applicable, or country) | ENKHUIZEN, DL, Netherlands |
| VIII-4-1-1-3 | Mailing address: | Havikshoek, 27 |
| VIII-4-1-1-4 | Citizenship: | NL |
| VIII-4-1-1-5 | Inventor's Signature:<br>(if not contained in the request, or if declaration is corrected or added under Rule 26ter after the filing of the international application. The signature must be that of the inventor, not that of the agent) | |
| VIII-4-1-1-6 | Date:<br>(of signature which is not contained in the request, or of the declaration that is corrected or added under Rule 26ter after the filing of the international application) | |

PCT REQUEST

S 2001/10

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| | | |
|---|---|---|
| 0 | For receiving Office use only | |
| 0-1 | International Application No. | PCT/EP 03 / 0 4 9 5 3 |
| 0-2 | International Filing Date | (12 05. 2003) 12 MAY 2003 |
| 0-3 | Name of receiving Office and "PCT International Application" | OFFICE EUROPEEN DES BREVETS<br>DEMANDE INTERNATIONALE PCT |

| | | |
|---|---|---|
| 0-4 | Form - PCT/RO/101 PCT Request | |
| 0-4-1 | Prepared using | PCT-EASY Version 2.92<br>(updated 01.04.2003) |
| 0-5 | Petition<br>The undersigned requests that the present international application be processed according to the Patent Cooperation Treaty | |
| 0-6 | Receiving Office (specified by the applicant) | European Patent Office (EPO) (RO/EP) |
| 0-7 | Applicant's or agent's file reference | S 2001/10 |
| I | Title of invention | POLYMER COMPOSITION INCLUDING A CYCLIC OLEFIN COPOLYMER |
| II | Applicant | |
| II-1 | This person is: | applicant only |
| II-2 | Applicant for | all designated States except US |
| II-4 | Name | SOLVAY (Société Anonyme) |
| II-5 | Address: | Rue du Prince Albert, 33<br>B-1050 BRUSSELS<br>Belgium |
| II-6 | State of nationality | BE |
| II-7 | State of residence | BE |
| II-8 | Telephone No. | (32-2) 509 6111 |
| II-9 | Facsimile No. | (32-2) 509 6617 |
| III-1 | Applicant and/or Inventor | |
| III-1-1 | This person is: | applicant and inventor |
| III-1-2 | Applicant for | US only |
| III-1-4 | Name (LAST, First) | KARSTEN, Petrus, J.A. |
| III-1-5 | Address: | Havikshoek, 27<br>NL-1602 ENKHUIZEN, DL<br>Netherlands |
| III-1-6 | State of nationality | NL |
| III-1-7 | State of residence | NL |

**PCT REQUEST**

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| | | |
|---|---|---|
| III-2 | **Applicant and/or inventor** | |
| III-2-1 | This person is: | applicant and inventor |
| III-2-2 | Applicant for | US only |
| III-2-4 | Name (LAST, First) | DE VRIES, Piet |
| III-2-5 | Address: | Lindenlaan, 17<br>NL-1602 ENKHUIZEN, RA<br>Netherlands |
| III-2-6 | State of nationality | NL |
| III-2-7 | State of residence | NL |
| IV-1 | **Agent or common representative; or address for correspondence**<br>The person identified below is hereby/has been appointed to act on behalf of the applicant(s) before the competent International Authorities as: | agent |
| IV-1-1 | Name (LAST, First) | JACQUES, Philippe |
| IV-1-2 | Address: | SOLVAY (Société Anonyme)<br>Département de la Propriété Intellectuelle<br>Rue de Ransbeek, 310<br>B-1120 BRUSSELS<br>Belgium |
| IV-1-3 | Telephone No. | (32-2) 264 2111 |
| IV-1-4 | Facsimile No. | (32-2) 264 2955 |
| IV-2 | Additional agent(s) | additional agent(s) with same address as first named agent |
| IV-2-1 | Name(s) | DECAMPS, Alain; GRANVILLE, Maryse; SERRIER, Jean-François; VANDE GUCHT, Anne |
| V | **Designation of States** | |
| V-1 | Regional Patent<br>(other kinds of protection or treatment, if any, are specified between parentheses after the designation(s) concerned) | AP: GH GM KE LS MW MZ SD SL SZ TZ UG ZM ZW and any other State which is a Contracting State of the Harare Protocol and of the PCT<br>EA: AM AZ BY KG KZ MD RU TJ TM and any other State which is a Contracting State of the Eurasian Patent Convention and of the PCT<br>EP: AT BE BG CH&LI CY CZ DE DK EE ES FI FR GB GR HU IE IT LU MC NL PT RO SE SI SK TR and any other State which is a Contracting State of the European Patent Convention and of the PCT<br>OA: BF BJ CF CG CI CM GA GN GQ GW ML MR NE SN TD TG and any other State which is a member State of OAPI and a Contracting State of the PCT |

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| | | |
|---|---|---|
| V-2 | National Patent (other kinds of protection or treatment, if any, are specified between parentheses after the designation(s) concerned) | AE AG AL AM AT AU AZ BA BB BG BR BY BZ CA CH&LI CN CO CR CU CZ DE DK DM DZ EC EE ES FI GB GD GE GH GM HR HU ID IL IN IS JP KE KG KP KR KZ LC LK LR LS LT LU LV MA MD MG MK MN MW MX MZ NI NO NZ OM PH PL PT RO RU SC SD SE SG SK SL TJ TM TN TR TT TZ UA UG US UZ VC VN YU ZA ZM ZW |
| V-5 | **Precautionary Designation Statement**<br>In addition to the designations made under items V-1, V-2 and V-3, the applicant also makes under Rule 4.9(b) all designations which would be permitted under the PCT except any designation(s) of the State(s) indicated under item V-6 below. The applicant declares that those additional designations are subject to confirmation and that any designation which is not confirmed before the expiration of 15 months from the priority date is to be regarded as withdrawn by the applicant at the expiration of that time limit. | |
| V-6 | **Exclusion(s) from precautionary designations** | NONE |
| VI-1 | **Priority claim of earlier national application** | |
| VI-1-1 | Filing date | 21 May 2002 (21.05.2002) |
| VI-1-2 | Number | 02.04644 |
| VI-1-3 | Country | FR |
| VII-1 | **International Searching Authority Chosen** | European Patent Office (EPO) (ISA/EP) |
| VII-2 | **Request to use results of earlier search; reference to that search** | |
| VII-2-1 | Date | 21 May 2002 (21.05.2002) |
| VII-2-2 | Number | FA 617751 |
| VII-2-3 | Country (or regional Office) | EP |

| | | Number of declarations | |
|---|---|---|---|
| VIII | Declarations | | |
| VIII-1 | Declaration as to the identity of the inventor | - | |
| VIII-2 | Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent | 1 | |
| VIII-3 | Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application | 2 | |
| VIII-4 | Declaration of inventorship (only for the purposes of the designation of the United States of America) | 1 | |
| VIII-5 | Declaration as to non-prejudicial disclosures or exceptions to lack of novelty | - | |

| | | |
|---|---|---|
| VIII-2-1 | **Declaration: Entitlement to apply for and be granted a patent**<br>Declaration as to the applicant's entitlement, as at the international filing date, to apply for and be granted a patent (Rules 4.17(ii) and 51bis.1(a)(ii)), in a case where the declaration under Rule 4.17(iv) is not appropriate:<br>Name: | in relation to this international application<br><br>SOLVAY (Société Anonyme) is entitled to apply for and be granted a patent by virtue of the following: |
| VIII-2-1 (ii) | | SOLVAY (Société Anonyme) is entitled as employer of the inventor, KARSTEN, Petrus, J.A. |
| VIII-2-1 (ii) | | SOLVAY (Société Anonyme) is entitled as employer of the inventor, DE VRIES, Piet |
| VIII-2-1 (ix) | This declaration is made for the purposes of: | all designations except the designation of the United States of America |

| | | |
|---|---|---|
| VIII-3-1 | **Declaration: Entitlement to claim priority**<br>Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application specified below, where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the filing of the earlier application (Rules 4.17(iii) and 51bis.1(a)(iii)):<br>Name: | in relation to this international application<br><br>KARSTEN, Petrus, J.A.<br>is entitled to claim priority of earlier application No. 02.04644 by virtue of the following: |
| VIII-3-1<br>(i) | | the applicant is the inventor of the subject matter for which protection was sought by way of the earlier application |
| VIII-3-1<br>(ix) | This declaration is made for the purposes of: | US |

| | | |
|---|---|---|
| VIII-3-2 | **Declaration: Entitlement to claim priority**<br>Declaration as to the applicant's entitlement, as at the international filing date, to claim the priority of the earlier application specified below, where the applicant is not the applicant who filed the earlier application or where the applicant's name has changed since the filing of the earlier application (Rules 4.17(iii) and 51bis.1(a)(iii)):<br>Name: | in relation to this international application<br><br>DE VRIES, Piet<br>is entitled to claim priority of earlier application No. 02.04644 by virtue of the following: |
| VIII-3-2<br>(i) | | the applicant is the inventor of the subject matter for which protection was sought by way of the earlier application |
| VIII-3-2<br>(ix) | This declaration is made for the purposes of: | US |

OBLON
SPIVAK
MCCLELLAND
MAIER
&
NEUSTADT
P.C.

ATTORNEYS AT LAW

NORMAN F. OBLON
(703) 413-3000
NOBLON@OBLON.COM

SURINDER SACHAR
(703) 413-3000
SSACHAR@OBLON.COM

SENT BY FAX
JANUARY 12, 2006
NO OF PAGES: 6
FAX #: 571-273-0459

Docket No.: 262140US0PCT

RECEIVED
12 JAN 2006
Legal Staff
International Division

COMMISSIONER FOR PATENTS
Mail Stop PCT – Office of Legal Administration
ALEXANDRIA, VIRGINIA 22313

RE: Application Serial No.: 10/515,061
Applicants: Petrus J.A. KARSTEN, et al.
Filing Date: November 19, 2004
For: POLYMER COMPOSITION INCLUDING A CYCLIC OLEFIN COPOLYMER
Group Art Unit: 1772
Examiner:

SIR:

Applicants wish to supplement their request for a Corrected Notice of Acceptance which was filed on August 17, 2005. A copy of the documents filed on August 17, 2005 is attached for your convenience including:

**Copy of Date –Stamped Filing Receipt of 08/17/05**
**Copy of Request for Corrected Notice of Acceptance**

The undersigned attorney of record hereby states that the copies being provided herewith are in fact true copies of the papers filed on August 17, 2005.

Applicants are also providing a copy of the executed declaration of inventorship under rule 4.17(iv) which has been obtained from the PCT Online File Inspection at www.wipo.int/pct/en/index.jsp. An early reply to this request is hereby earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Surinder Sachar
Registration No. 34,423

Docket No: 262140US0PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION: Petrus J.A. KARSTEN et al.

SERIAL NUMBER: 10/515,061

FILED: November 19, 2004

FOR: POLYMER COMPOSITION INCLUDING A CYCLIC OLEFIN COPOLYMER

**REQUEST FOR CORRECTED NOTICE OF ACCEPTANCE**

Commissioner for Patents
Mail Stop PCT
Alexandria, Virginia 22313

The U.S. PCT Receiving Branch is requested to provide a corrected Notification of Acceptance under 35 USC 371 for the following reasons:

The Date of Receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements is incorrect.
AND
The Date of Receipt of all 35 U.S.C. 371 requirements is incorrect.

Applicant believes that the correct date is November 19, 2004, the date of filing of the application under 35 U.S. C. 371. Further, the applicants wish to point out that a declaration of Inventorship was filed under PCT Rule 4.17 (iv) in the International Application. A copy of the PCT Publication evidencing that the Declaration was received is also attached.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

COPY

Richard L. Treanor
Attorney for Applicant
Reg. No. 36,379

**CUSTOMER NUMBER**
**22850**

TEL: (703) 413-3000

Due Date None

OSMM&N File No. 262140US0PCT By RLT/lit/FF

Serial No. 10/515,061

In the matter of the Application of Petrus J.A. KARSTEN, et al.

For POLYMER COMPOSITION INCLUDING A CYCLIC OLEFIN COPOLYMER

The following has been received in the U.S. Patent Office on the date stamped hereon:

- Copy of Notice of Acceptance
- Request for Corrected Notice of Acceptance
- Copy of Date -Stamped Filing Receipt
- Copy of PCT Publication

DATE RECEIVED _____

COPY

OIPE JC11
AUG 17 2005
PATENT & TRADEMARK OFFICE

**PCT REQUEST**

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| | | |
|---|---|---|
| VIII-4-1 | Declaration: Inventorship (only for the purposes of the designation of the United States of America)<br>Declaration of inventorship (Rules 4.17(iv) and 51bis.1(a)(iv)) for the purposes of the designation of the United States of America: | I hereby declare that I believe I am the original, first and sole (if only one inventor is listed below) or joint (if more than one inventor is listed below) inventor of the subject matter which is claimed and for which a patent is sought.<br>This declaration is directed to the international application of which it forms a part (if filing declaration with application).<br>I hereby declare that my residence, mailing address, and citizenship are as stated next to my name.<br>I hereby state that I have reviewed and understand the contents of the above-identified international application, including the claims of said application. I have identified in the request of said application, in compliance with PCT Rule 4.10, any claim to foreign priority, and I have identified below, under the heading "Prior Applications," by application number, country or Member of the World Trade Organization, day, month and year of filing, any application for a patent or inventor's certificate filed in a country other than the United States of America, including any PCT international application designating at least one country other than the United States of America, having a filing date before that of the application on which foreign priority is claimed. |
| VIII-4-1-1 | Prior applications: | 02.04644, FR, 21 May 2002 (21.05.2002) |

**PCT REQUEST**

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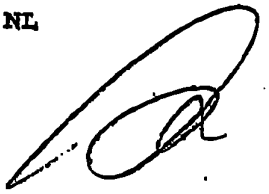
| | | |
|---|---|---|
| | | I hereby acknowledge the duty to disclose information that is known by me to be material to patentability as defined by 37 C.F.R. § 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the PCT international filing date of the continuation-in-part application.<br>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. |
| VIII-4-1-1-1 | Name: | KARSTEN, Petrus, J.A. |
| VIII-4-1-1-2 | Residence:<br>(city and either US State, if applicable, or country) | ENKHUIZEN, DL, Netherlands |
| VIII-4-1-1-3 | Mailing address: | Havikshoek, 27<br>NL |
| VIII-4-1-1-4 | Citizenship: | |
| VIII-4-1-1-5 | Inventor's signature:<br>(if not contained in the request, or if declaration is corrected or added under Rule 26ter after the filing of the international application. The signature must be that of the inventor, not that of the agent) |  |
| VIII-4-1-1-6 | Date:<br>(of signature which is not contained in the request, or of the declaration that is corrected or added under Rule 26ter after the filing of the international application) | 15/06/2003 |

**PCT REQUEST**

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| | | |
|---|---|---|
| VIII-4-1-2-1 | Name: | DE VRIES, Piet |
| VIII-4-1-2-2 | Residence: (city and either US State, if applicable, or country) | ENKHUIZEN, ~~XXX~~ NS, Netherlands |
| VIII-4-1-2-3 | Mailing address: | ~~[illegible]~~ Maelsonweg, 20 |
| VIII-4-1-2-4 | Citizenship: | NL |
| VIII-4-1-2-5 | Inventor's Signature: (if not contained in the request, or if declaration is corrected or added under Rule 26ter after the filing of the international application. The signature must be that of the inventor, not that of the agent) | [signature] |
| VIII-4-1-2-6 | Date: (of signature which is not contained in the request, or of the declaration that is corrected or added under Rule 26ter after the filing of the international application) | 15-6-03 |

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DICKSTEIN SHAPIRO LLP
1825 EYE STREET NW
Washington, DC 20006-5403

Mail Date: 04/21/2010

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|---|---|---|
| **Applicant** | : Shintaro Hata | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7582018 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/01/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,065 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/20/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **346** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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

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| In Re Application of | : | |
| MILLS et al. | : | |
| Application No.: 10/515,073 | : | DECISION |
| PCT No.: PCT/US04/24235 | : | |
| Int. Filing Date: 28 July 2004 | : | |
| Priority Date: 26 September2003 | : | |
| Attorney Docket No.: 2512.0270001(121013-WO-US) | : | |
| For: METHODS FOR SUBSTANTIALLY SIMULTANEOUS EVALUATION OF A SAMPLE CONTAINING A CELLULAR TARGET AND A SOLUBLE ANALYTE | : | |

This is a decision on applicant's "Petition to Correct Filing Date and Request for Correction of Official Filing Receipt" filed in the United States Patent and Trademark Office (USPTO) on 15 September 2008.

On 28 July 2004, applicant filed international application No. PCT/US04/26235 which claimed a priority date of 26 September 2003 and which designated the United States. Thereafter, on 17 November 2004, before the expiration of the thirty month period (26 March 2006), applicant filed, *inter alia*, a transmittal letter for entry into the national stage and the basic national stage filing fee.

A Notification of Missing Requirements (Form PCT/DO/EO/905) was issued on 11 April 2005, indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b) was required.

On 10 May 2005, applicant responded with a declaration. On 19 May 2005, a Notification of Acceptance Under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) was mailed, indicating a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 10 May 2005.

On 15 September 2008, applicant filed a Request for a Corrected Filing Receipt to correct the filing date to 17 November 2004.

## DISCUSSION

Section MPEP 1893.03(b) states "An international application designating the U.S. has

two stage (international and national) with the filing date being the same in both stages. Often the entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application." *See* 35 U.S.C. 363 and PCT Treaty Article 11(3) (which provides that an international filing date shall be considered the actual filing date in each designated State).

It is further stated in section 1893.03(b) that the Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) indicates the date of receipt of the 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4) requirements and it indicates the date of completion of all 35 U.S.C. 371 requirements. Filing receipts are mailed concurrently with the mailing of the Form PCT/DO/EO/903. Applicants are quite often confused as to the true filing date and will ask for corrected filing receipts thinking that the information thereon is wrong. This explanation should offer some clarity. For most legal purposes, the filing date is the PCT international filing date.

The Notification of Missing Requirements advised applicant of the deficiency-a declaration in compliance with 37 CFR 1.497(a) and (b) was required.[1] Applicants responded to the Notification of Missing Requirements, on 10 May 2005, with such declaration. Thus, on 10 May 2005, all of the 35 U.S.C. 371 requirements were complete. The 19 May 2005 Notification of Acceptance correctly indicated a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 10 May 2005, the date of receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements and date of completion of all 35 U.S.C. 371 requirements.

The Notification of Acceptance mailed on 19 May 2005 correctly indicated a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 10 May 2005 and remains in effect.

## CONCLUSION

For the reasons set forth above, the Request to Correct the Filing Receipt is **DISMISSED**.

The Notification of Acceptance (Form PCT/DO/EO/903) mailed on 19 May 2005 remains in effect, as it correctly indicates a 35 U.S.C. 371(c) (1), (c)(2) and (c)(4) date of 12 May 2005.

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

[1]As stated in MPEP 1893.01(d), applicants entering the national stage in the U.S. are required to file an oath or declaration, in compliance with 37 CFR 1.497(a). *See* 35 U.S.C. 371(a)(2) and 37 CFR 1.495(c).

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**OFFICE OF PETITIONS**

In re Application of
Denis Reibel, et. al.
Application No. 10/515,086
Filed: September 13, 2005
Attorney Docket No. 331.1080

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 28, 2009, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37CFR 41.20(b)(2) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed May 22, 2008, and no extension of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.1997(b). As no claim was allowed, the application became abandoned on July 23, 2008. See MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Appeal Brief and $540; (2) the petition fee of $1620; and (3) a proper statement of unintentional delay.

In addition to receiving the petition, the United States Patent and Trademark Office received a payment of $2,350 for a five month extension of time on January 28, 2009.

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 $2,350 extension of time fee was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be refunded to the petitioner's deposit account.

Telephone inquiries concerning this decision should be directed to Denise Williams at (571) 272-8930.

This application is being referred to Technology Center AU 2831 for appropriate action by the Examiner in the normal course of business.

Andrea Smith
Petitions Examiner
Office of Petitions

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Tim Tingkang Xia, Esq.
MORRIS, MANNING & MARTIN, LLP
1600 ATLANTA FINANCIAL CENTER
3343 PEACHTREE STREET, N.E.
ATLANTA, GA 30326-1044

| | |
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| In re Application of GOMEZ ANDREU et al | : |
| Application No.: 10/515,090 | : |
| PCT Application No.: PCT/EP03/05176 | : |
| Int. Filing Date: 16 May 2003 | : DECISION ON PETITION |
| Priority Date Claimed: 17 May 2002 | : UNDER 37 CFR 1.137(b) |
| Attorney Docket No.: 14836-47600 | : |
| For: METHOD FOR THE CATALYST-FREE PRODUCTION OF ALKOXYBENZONITRILES | : |

Applicants' Petition For Revival Under 37 CFR 1.137(b), filed in the United States Patent and Trademark Office on 18 November 2004, is DISMISSED.

## BACKGROUND

On 16 May 2003, applicant filed international application PCT/EP03/05176. The international application claims a priority date of 17 May 2002 and designates the United States. The deadline for paying the basic national fee in the United States was thirty months from the priority date, that is 17 November 2004. Applicant missed this deadline.

On 18 November 2004, applicant filed the instant petition for revival accompanied by, *inter alia*, a basic national fee of $790, a copy of the international application as required by 35 U.S.C. 371(c)(2), an executed declaration as required by 35 U.S.C. 371(c)(4), 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.

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 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.

With regard to 37 CFR 1.137(b)(1), a copy of the international application has been filed, however the required basic national fee has not been paid. A basic national fee of $790 was received, however the required basic national fee which is due by applicant is $950; see Fee Code 1613, filing with EPO, effective 01 October 2004. Thus, applicant has not met the requirements under 37 CFR 1.137(b)(1).

## CONCLUSION

For the above reasons, the petition filed on 18 November 2004 under 37 CFR 1.137(b) is DISMISSED without prejudice.

The application remains ABANDONED.

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. Any reconsideration request should include a cover later entitled "Renewed Submission Under 37 CFR 1.137(b)." Extensions of time may be obtained under 37 CFR 1.136(a).

Amy Vanatta
PCT Legal Administration Detailee
Telephone: 571-272-6095
Facsimile: 571-273-0459

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

30 SEP 2005
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1600 ATLANTA FINANCIAL CENTER
3343 PEACHTREE STREET, N.E.
ATLANTA, GA 30326-1044

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|---|---|
| In re Application of GOMEZ ANDREU et al | : |
| Application No.: 10/515,090 | : |
| PCT Application No.: PCT/EP03/05176 | : |
| Int. Filing Date: 16 May 2003 | : DECISION ON PETITION |
| Priority Date Claimed: 17 May 2002 | : UNDER 37 CFR 1.137(b) |
| Attorney Docket No.: 14836-47600 | : |
| For: METHOD FOR THE CATALYST-FREE PRODUCTION OF ALKOXYBENZONITRILES | : |

Applicants' renewed Petition For Revival Under 37 CFR 1.137(b), filed in the United States Patent and Trademark Office on 30 June 2005, is **GRANTED**.

## BACKGROUND

On 16 May 2003, applicants filed international application PCT/EP03/05176. The international application claims a priority date of 17 May 2002 and designates the United States. The deadline for paying the basic national fee in the United States was thirty months from the priority date, that is 17 November 2004. Applicants missed this deadline.

On 18 November 2004, applicants filed a petition for revival accompanied by, *inter alia*, a basic national fee of $790, a copy of the international application as required by 35 U.S.C. 371(c)(2), an executed declaration as required by 35 U.S.C. 371(c)(4), and the petition fee of $1370.

On 30 June 2005, applicants filed the instant renewed submission under 37 CFR 1.137(b) accompanied by a fee of $160 for the fee deficiency of the required basic national filing fee submitted with the initial petition.

## 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 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.

Applicants' petition filed on 18 November 2004 was dismissed because the requirements under 37 CFR 1.137(b)(1) were not satisfied since the required basic national fee was not paid. A basic national fee of $790 was submitted with the initial petition, however the required basic national fee due by applicants is $950. The renewed submission filed on 30 June 2005 includes a fee of $160 for the fee deficiency of the required basic national fee submitted with the initial petition. Thus, the required basic national fee of $950 has now been received and the requirements under 37 CFR 1.137(b)(1) have been satisfied.

## CONCLUSION

For the above reasons, the renewed petition filed on 30 June 2005 under 37 CFR 1.137(b) is GRANTED as to the National Stage in the United States of America.

Applicants have satisfied the requirements for acceptance under 35 U.S.C. 371. The application has an international filing date of 16 May 2003 under 35 U.S.C. 363 and a date of 30 June 2005 under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4).

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

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Amy Vanatta
PCT Legal Administration Detailee
Telephone: 571-272-6094
Facsimile: 571-273-0459

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William T Christiansen
Seed Intellectual Property Law Group
701 5th Avenue
Suite 6300
Seattle, WA 98104-7092

Mail Date: 04/23/2010

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| **Applicant** | : Setsuko Komatsu | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7605303 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/20/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,095 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 08/08/2005 | : ISSUE CERTIFICATE OF CORRECTION |
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The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1077** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

29 NOV 2005

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Kenneth E. Jenkins
Townsend and Townsend and Crew LLP
Two Embarcadero Center, Eight Floor
San Francisco, CA 94111

In re Application of BURBULIS et al :
U.S. Application No.: 10/515,108 :
PCT Application No.: PCT/US03/12797 :
Int. Filing Date: 23 April 2003 :
Priority Date Claimed: 23 April 2002 : DECISION
Attorney Docket No.: 021763000220 :
For: FORMATION AND USE OF SITE SPECIFIC :
NUCLEIC ACID COUPLED BINDING :
POLYPEPTIDES :

This is in response to applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 19 November 2004.

## BACKGROUND

On 23 April 2003, applicant filed international application PCT/US03/12797, which claimed priority of an earlier United States application filed 23 April 2002. The thirty-month period for paying the basic national fee in the United States expired on 23 October 2004.

International application PCT/US03/12797 became abandoned as to the United States for failure to timely pay the basic national fee.

On 19 November 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 basic national fee under 35 U.S.C. 371.

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

With regard to item (3), applicant has provided the required statement.

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

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 23 April 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 19 November 2004.

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

Bryan Tung
PCT Legal Examiner
Office of PCT Legal Administration

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

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OFFICE OF PETITIONS

In re Application of :
JAMIESON et al. : DECISION ON PETITION
Application No. 10/515,110 :
Filed: 11/24/2004 :
Attorney Docket No. GB03 0005 US :

This is a decision on the petition under 37 CFR 1.137(b), filed February 18, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to file a timely and proper response to the nonfinal Office action mailed December 27, 2007, which set a three-month shortened statutory period to reply. The above-identified application became abandoned on March 28, 2008. A Notice of Abandonment was mailed July 9, 2008.

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

This application is being referred to Technology Center AU 2619 for appropriate action by the Examiner in the normal course of business on the reply received on February 18, 2009.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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220 MASSACHUSETTS AVENUE
CAMBRIDGE, MA 02139

Mail Date: 04/21/2010

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| **Applicant** | : Andreas Floersheimer | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7652022 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,113 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/08/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **902** 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 JUN 2006

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KING OF PRUSSIA PA 19406-0939

In re Application of
JEONG et al.
Application No.: 10/515,115
PCT No.: PCT/US03/16046
Int. Filing Date: 21 May 2003
Priority Date: 22 May 2002
Attorney Docket No.: P51350
For: PROTEASE INHIBITORS

DECISION ON REQUEST

This application is before the Office of PCT Legal Administration for issues arising under 35 U.S.C. 371. On 16 May 2006, applicant filed a petition requesting correction of the international application number in the United States Patent and Trademark Office (USPTO) records.

On 18 November 2004, applicant filed a Transmittal Letter (Form PTO-1390) for entry into the national stage in the United States which misidentified the international application as PCT/US03/16043. Based on applicant's error, a national stage application file was created for PCT/US03/16043, rather than for PCT/US03/16046.

On 08 June 2005, a Notification of Acceptance (FORM PCT/DO/EO 903) was mailed to applicant identifying the international application number as PCT/US03/16043.

On 16 May 2006, applicants filed the instant petition requesting rectification of incorrect international application number, identifying the correct international application number as PCT/US03/14046.

Applicant's request to correct the international application number in the USPTO records is **GRANTED**. The Notification of Acceptance (FORM PCT/DO/EO 903) mailed on 08 June 2005 is hereby **VACATED**.

U.S. serial number **10/515,115** is the national stage of PCT/US03/14046, which will be reflected in the USPTO PALM record.

Cynthia M. Kratz
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**ARTHUR FREILICH**
**9045 CORBIN AVE, #260**
**NORTHRIDGE CA 91324-3343**

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SEP 0 6 2006

OFFICE OF PETITIONS

In re Application of :

**LORD**, et al. :
Application No. 10/515,152 : DECISION ON PETITION
Filed: December 19, 2005 : TO WITHDRAW
Attorney Docket No. 202/517 PCT: MA-112 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 2, 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 Arthur Freilich on behalf of all attorneys of record. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor or the assignee of the entire interest at the first copied address below until otherwise properly notified by the applicant.

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

Amelia Au
Petitions Examiner
Office of Petitions

cc: Peter C. Lord
25505 Old Course Way
Valencia, CA 91355

cc: Advanced Bionics Corporation
ATTN: BRYANT R. GOLD
25129 Rye Canyon Loop
Valencia, CA 91355

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UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/515,178 | 11/26/2004 | Hiroaki Kato | 262219US26XPCT | 2093 |

22850 7590 05/07/2008

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

| EXAMINER | |
|---|---|
| TRAN, DALENA | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3661 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 05/07/2008 | ELECTRONIC |

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

The time period for reply, if any, is set in the attached communication.

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

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

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MAY 06 2008
TECHNOLOGY CENTER 3600

Oblon, Spivack, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

Inventor: Hiroaki Kato et al.
Application No. 10/515,178
Filed: November 26, 2004

Attorney Docket No.: 262219US26XPCT
For: STEERING DEVICE

: PETITION TO HAVE EXAMINER CONSIDER REFERENCES ON AN INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. 1.181

This is in response to applicant's petition filed on June 7, 2007 to have the examiner consider the references on the Information Disclosure Statement filed May 8, 2007.

The petition is **DISMISSED AS MOOT.**

A review of the file record indicates that the examiner considered the Information Disclosure Statement on June 5, 2007, and an initialed 1449 form was mailed June 12, 2007, crossing in the mail with applicant's petition.

Any questions regarding this decision should be directed to SPE Thomas Black at (571) 272-6956.

Donald Hajec, Director
Patent Technology Center 3600
(571)-272-5150

Tb/snm: 4/28/08

#6

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13 SEP 2006

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

In re Application of :
MELNYK, Oleg et al. :
Application No.: 10/515,190 :
PCT No.: PCT/FR03/01471 : DECISION ON
Int. Filing Date: 15 May 2003 :
Priority Date: 28 May 2002 : PETITION
Attorney Docket No.: 262467US0X PCT :
For: DEVICE FOR THE PRESENTATION OF PEPTIDES OR PROTEINS, METHOD FOR THE PREPARATION AND USE THEREOF : UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Petition Under 37 C.F.R. §1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 20 March 2006.

## BACKGROUND

On 15 May 2003, applicants filed international application PCT/FR03/01471, claiming a priority date of 28 May 2002. A copy of the international application was transmitted to the Office on 04 December 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 29 November 2004 (28 November 2004 was a Sunday).

On 29 November 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 19 December 2005, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors was required.

On 20 March 2006, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration of inventorship and a supporting declaration. The petition included the fee for a one month extension of time (19 March 2006 was a Sunday).

## DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the non-signing applicant.

Items (1) and (3) have been satisfied. The balance of the $200 petition fee will be charged to deposit account no. 15-0030, as authorized. Applicants list Fengling Zhou's address as 16, rue Gantois, Lille 59000, France.

Item (2) has not been satisfied. Applicants have not demonstrated a diligent effort to locate the non-signing inventor and to obtain his signature. Applicants indicate that they mailed the declaration to his last known address. (Had this petition been based upon a refusal to join, applicants would have been required to demonstrate that a complete copy of the application papers were sent to the non-signing inventor and not just a copy of the declaration.) The mailing to the inventor was returned indicating that the inventor is no longer at that address. Applicants believe that the inventor has returned to China. However, applicants have not detailed efforts, including internet searches, to locate a current address for the inventor. Copies of documentary evidence should be submitted.

Item (4) has not been satisfied. The foreign language declaration supplied by the applicants is not a USPTO form and is not accompanied by a statement that the translation is accurate. 37 CFR 1.69(b). As such, the declaration does not satisfy 37 CFR 1.47 and 37 CFR 1.497(a)-(b).

## CONCLUSION

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

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

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
Attorney Advisor
PCT Legal Administration

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

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1940 DUKE STREET
ALEXANDRIA, VA 22314

| | | |
|---|---|---|
| In re Application of | : | |
| MELNYK, Oleg et al. | : | |
| Application No.: 10/515,190 | : | |
| PCT No.: PCT/FR03/01471 | : | DECISION ON |
| Int. Filing Date: 15 May 2003 | : | |
| Priority Date: 28 May 2002 | : | PETITION |
| Attorney Docket No.: 262467US0X PCT | : | |
| For: DEVICE FOR THE PRESENTATION OF PEPTIDES OR PROTEINS, METHOD FOR THE PREPARATION AND USE THEREOF | : | UNDER 37 CFR 1.47(a) |

This is a decision on applicants' renewed petition under 37 C.F.R. §1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 13 February 2007.

## BACKGROUND

On 13 September 2006, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 13 February 2007, applicants submitted this renewed petition, accompanied by an executed declaration and the fee for a three month extension of time.

## DISCUSSION

Applicants have provided a declaration executed by the inventors in compliance with 37 CFR 1.497(a)-(b). Additionally, applicants have provided a statement in accordance with 37 CFR 1.69(b) that the English language text of the declaration is an accurate translation of the French language text.

## CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**.

This application is being forwarded to the national stage processing branch of the Office of PCT Operations for further action consistent with this decision, including the mailing of a

Notification of Acceptance, indicating that the application has a 35 USC 371(c)(1), (c)(2) and (c)(4) date of 13 February 2007.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

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OCT 17 2006

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MERCK & CO., Inc
P. O. BOX 2000
RAHWAY, NEW JERSEY 07065-0907

| | |
|---|---|
| In re Application of | : |
| Weirong Chen, et al | : |
| Serial No.: 10/515,192 | : PETITION DECISION |
| Filed: November 19, 2004 | : |
| Attorney Docket No.: 21120P | : |

This is in response to the petition under 37 CFR 1.144, filed July 24, 2006, requesting withdrawal of the restriction requirement.

**BACKGROUND**

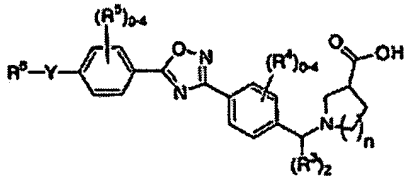
A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted for examination on November 19, 2004, and contained claims 1-36.

The examiner mailed Lack of Unity to the applicants on May 24, 2006, in which claims1-36 were divided into nine groups, as follows:

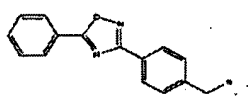
> Group I, claims 1-12 and 26(in part), drawn to products of Formula I where n is 0, Y is a bond and $R^6$ is halo, cyano, alkyl, alkenyl, alkynyl, cycloalkyl or phenyl;
> Group II, claims 1-12 and 26(in part), drawn to products of Formula I where n is 1, Y is a bond and $R^6$ is halo, cyano, alkyl, alkenyl, alkynyl, cycloalkyl or phenyl;
> Group III, claims 1-12 and 26(in part), drawn to products of Formula I where n is 0, Y is a bond and $R^6$ is HET;
> Group IV, claims 1-12 and 26(in part), drawn to products of Formula I where n is 0, Y is O or S(O) and $R^6$ is halo, cyano, alkyl, alkenyl, alkynyl, cycloalkyl or phenyl;
> Group V, claims 1-12 and 26(in part), drawn to products of Formula I where n is 0, Y is O or S(O) and $R^6$ is HET;
> Group VI, claims 13-25 and 27-28(in part), drawn to a method of treating immunoregulatory abnormality by administering a compound of Formula I where n is 0, Y is a bond and $R^6$ is halo, cyano, alkyl, alkenyl, alkynyl, cycloalkyl or phenyl;
> Group VII, claims 13-25 and 27-28(in part), drawn to a method of treating immunoregulatory abnormality by administering a compound of Formula I where n is 1, Y is a bond and $R^6$ is halo, cyano, alkyl, alkenyl, alkynyl, cycloalkyl or phenyl;
> Group VIII, claims 13-25 and 27-28(in part), drawn to a method of treating immunoregulatory abnormality by administering a compound of Formula I where n is 0, Y is a bond and $R^6$ is HET;

Group IX, claims 29-36(in part) drawn to a method of treating an immunoregulatory abnormality by administering an agonist of the $S1P_1$/Edg1 receptor which is not a compound of Formula I.

Formula I is shown in claim 1 as follows:



The examiner determined that the only structure common to all of the compounds claimed



did not qualify as a special technical feature as it does not define over the prior art as evidenced by Rice et al., Bioorganic Medicinal Chemistry letters, vol. 11, pp 753-755, 2001. The examiner also stated that the variables of the claimed Markush group were extensively diverse and when taken as a whole would result in vastly different compounds that would impose a serious burden on the search and examination process. The examiner also stated that the processes claimed were directed to different disease and condition treatments and thus lacked Unity. Election of a species was also requested.

Applicants replied on June 19, 2006, electing Group I and a species and also traversing the Lack of Unity requirement. Claims 29-36 were also canceled.

In response to the requirement, applicants made the following arguments:

First, applicants argued that the groups are properly linked to form a single general inventive concept because all compounds share a significant common chemical structure, 1-((5-phenyl-1,2,4-oxadiazol-3-yl)benzyl)(azetidine or pyrrolidine)-3-carboxylate, this significant structural element is shared by all the alternatives and the claimed compounds also possess the same utility as the Edg receptor agonists and for treating diseases or conditions mediated by that receptor.

Second, applicants argued that the Examiner failed to properly define the common structural moiety and even if properly defined, such moiety is nowhere described in Rice et al. Thus, applicants argued that the Rice et al. reference does not teach the moiety described. The azetidine or the pyrrolidine group is absent in the compounds of the reference. Applicants also argue that the examiner failed to show that the technical feature does not make a contribution over Rice et al .

Third, applicants argued that the Examiner's rationale with respect to the "vastness of the claimed subject matter" is inapposite to a Unity of Invention determination.

Fourth, applicants argued that the Examiner's restriction of the product and method claims was improper.

Fifth, applicants argued that the Examiner's separate standard for Unity of Invention under 37 CFR §§ 1.475(b) and 1.475(c) is improper and requested further clarification from the examiner as to exactly how the pending claims are drawn to more than one product, process and method of use.

The examiner mailed a non-final Office action to applicants on July 17, 2006, which responded to applicants' traversal arguments, maintained the requirement, but did not make it final either. The elected group was examined on the merits and it was expressed that the method claims would be rejoined if the elected group was allowable. No determination of allowability of the elected Group was set forth, but no rejection of the claims was made either, only an objection to the claims as containing non-elected subject matter.

In response the applicants filed this petition under 37 CFR 1.144, filed July 24, 2006, requesting withdrawal of the restriction requirement.

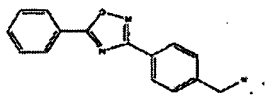
**DISCUSSION**

Although the Lack of Unity requirement has not been made Final, the requirement has been repeated by the examiner and is thus properly petitioned.

Applicants' petition sets forth the same arguments as above:

First, that the groups are properly linked to form a single general inventive concept because all compounds share a significant common chemical structure, 1-((5-phenyl- 1,2,4-oxadiazol-3-yl)benzyl)(azetidine or pyrrolidine)-3-carboxylate, and this significant structural element is shared by all the alternatives and the claimed compounds also possess the same utility as Edg receptor agonists and for treating diseases or conditions mediated by that receptor.

Regarding the significant common structure, applicants are partially correct. The compounds do possess a significant common structure:



But this structure, as set forth by the examiner, does not include the azetidine- or pyrrolidine-3-carboxylate (n is 0 or 1) nor the Y-$R^6$ portions of the structure upon which the above restriction requirement is based. The examiner alleges this structure is shown in the prior art and applicants disagree. A review of the reference cited by the examiner would appear to support applicants' position.

Second, applicants argue that the examiner failed to properly define the common structural moiety and even if properly defined, such moiety is nowhere described in Rice. The azetidine or the pyrrolidine group (n is 0 or 1) is suggested by applicants as part of the common structure

and is clearly absent in the compounds of the reference. Applicants also argue the examiner failed to show that the technical feature does not make a contribution over Rice et al. Applicants' arguments are found not to be completely correct. The common core is defined as that which does not vary. As the nitrogen containing carboxylate ring does vary in size (4 or 5 members) it would not be considered a part of the significant structural element except in that instance where there is a determination that there are multiple significant structural elements present, as here. As defined by applicants, there are actually two significant structural elements, based on the variable size nitrogen containing ring, upon which Lack of Unity may be based and an election of one of them required.

Third, applicants argue that the Examiner's rationale with respect to the "vastness of the claimed subject matter" is inapposite to a Lack of Unity determination. Applicants are correct in stating that the examiner's statement that "the variables of the claimed Markush group varied extensively and when taken as a whole, result in vastly different compounds that imposes a serious burden on the examination process" is not a consideration under Lack of Unity guidelines.

Fourth, applicants argue that the examiner's division of the product and method of use claims was improper. This is also correct when it can be shown that the product and process claims share a special technical feature which makes a contribution over the art. However, it does not extend to the claiming of more than one method of use. A careful reading of the Lack of Unity requirement shows that the examiner suggested to applicant that a single method of use be elected and the claims be limited thereto. Applicants did identify a single method of use consonant with the species elected.

Fifth, applicants argue that the Examiner's separate standard for unity of invention under 37 CFR §§ 1.475(b) and 1.475(c) is improper and requested further clarification from the examiner as to exactly how the pending claims are drawn to more than one product, process and method of use. Although the examiner did not articulate the reasons why, it is clear from a review of the method of use claims that they are directed to a large number of unrelated diseases or conditions, such as diabetes, cirrhosis, multiple sclerosis, asthma, graft-vs-host disease, pollen allergies, eczema, etc. Well over one hundred different diseases and conditions are listed. It is folly to expect the same compound or compounds would provide effective treatment for all. Further, PCT guidelines clearly state that where a product and methods of use of the product are claimed, only the first method of use will be joined with the product claims.

In summary, the examiner's initial Lack of Unity with regard to the compound and composition claims was not properly set forth as it failed to properly identify the significant structural element or elements. Applicants' identification of a significant structural element on which Lack of Unity should be based is proper with the understanding that two elements are identified, not one, and applicants' prior election of example 1, an azetidine-carboxylate, has been elected and will control further prosecution. The examiner's requirement of restricting the method of treatment to one disease or condition was proper and applicants' election of organ or tissue transplantation will continue to be examined with the elected azetidine compounds upon determination of allowability thereof.

**DECISION**

The petition is withdraw the Lack of Unity is **GRANTED-IN-PART** as set forth in the preceding paragraph.

**Applicants remain under obligation to reply to the Office action mailed July 17, 2006, within the time period set therein, but should reply taking into account the above decision.**

**The examiner will conduct further prosecution of this application in accordance with the above decision.**

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

George C. Elliott

George C. Elliott
Director, Technology Center 1600

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BRINKS, HOFER, GILSON & LIONE
P.O. BOX 1340
MORRISVILLE, NC 27560

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Stefaan Verheyen | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7591112 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,194 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/14/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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**MORRISON & FOERSTER LLP**
**12531 HIGH BLUFF DRIVE, SUITE 100**
**SAN DIEGO CA 92130-2040**

**COPY MAILED**

NOV 29 2006

**OFFICE OF PETITIONS**

In re Application of :
**MINNAARD**, et al. :
Application No. 10/515,195 : DECISION ON PETITION
Filed: May 31, 2005 : TO WITHDRAW
Attorney Docket No. 246152024000 : 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 30, 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. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

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

Mónica A. Graves
Petitions Examiner
Office of Petitions

cc: **ADRIAAN J. MINNAARD**
**BOLTSLAAN 1A**
**ZUIDHORN, NL 9801BB**
**THE NETHERLANDS**

cc: **BRYAN H. DAVIDSON**
**NIXON & VANDERHYE PC**
**901 NORTH GLEBE ROAD, 11TH FLOOR**
**ARLINGTON, VA 22203-1808**

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**ADRIAAN J. MINNAARD**
**BOLTSLAAN 1A**
**ZUIDHORN, THE NETHERLANDS 9801 BB**

| | | |
|---|---|---|
| In re Application of | : | |
| **MINNAARD**, et al. | : | |
| Application No. 10/515,195 | : | DECISION ON REQUEST FOR |
| Filed: May 31, 2005 | : | REVOCATION OF POWER |
| Attorney Docket No. 246152024000 | : | 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 October 18, 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.

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **BRYAN H. DAVIIDSON**
**NIXON & VANDERHYE PC**
**901 NORTH GLEBE RAOD, 11TH FLOOR**
**ARLINGTON, VA 22203-1808**

06 JUL 2005

#3

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250 Plaza, Suite 1030
250 East Wisconsin Ave.
Milwaukee, WI 53202

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|---|---|---|
| In re Application of | : | |
| DIEDRICH, Thomas J. | : | |
| Application No.: 10/515,200 | : | DECISION |
| PCT No.: PCT/US02/19211 | : | |
| Int. Filing Date: 14 June 2002 | : | ON PETITION UNDER |
| Priority Date: 15 June 2001 | : | |
| Docket No.: 1335.187 | : | 37 CFR 1.137(b) |
| For: RELEASABLE CHAIR SECTION SECURING ASSEMBLY | : | |

Applicants' "Petition Under 37 C.F.R. §1.137(b) for Revival of an Application For Patent Abandoned Unintentionally," filed in the above-captioned application on 22 November 2004 is **GRANTED**.

Applicants state that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A declaration in compliance with 37 CFR 1.497(a)-(b) has been submitted. The fee for late filing of the oath or declaration has been paid.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision. The application has a date of 22 November 2004 under 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4).

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

22 APR 2005

#3

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QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.
P O BOX 458
ALAMEDA, CA 94501

| | | |
|---|---|---|
| In re Application of | : | |
| KOURAKINE, Alexei et al. | : | |
| Application No.: 10/515,210 | : | DECISION |
| PCT No.: PCT/US02/31349 | : | |
| Int. Filing Date: 01 October 2002 | : | ON PETITION UNDER |
| Priority Date: 01 October 2001 | : | |
| Docket No.: 314-300310US | : | 37 CFR 1.137(b) |
| For: TARGET ASSISTED ... MOLECULAR REPERTOIRES | : | |

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 17 November 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
Attorney Advisor
PCT Legal Administration

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

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OFFICE OF PETITIONS

QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.
P O BOX 458
ALAMEDA, CA 94501

In re Application of :
Alexei Kourakine, et al. :
Application No. 10/515,210 : DECISION ON PETITION
Filed: November 17, 2004 : TO WITHDRAW
Attorney Docket No. 314-300310US : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 19, 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 Jonathan A. Quine on behalf of all attorneys of record who are associated with customer No. 22798.

All attorneys/agents associated with the Customer Number 22798 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 November 25, 2005 does not include a copy of the assignment or the reel and frame number on the 3.73(b) statement.

The application became abandoned for failure to timely reply to the Office action mailed April 2, 2007.

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: ALEXEI KOURAKINE
1721 NOVATO BOULVARD
APARTMENT 13
NOVATO, CA 94947

cc: BEYER WEAVER, LLP
PO BOX 70250
OAKLAND, CA 94612-0250

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/515,210 | 11/25/2005 | Alexei Kourakine | 314-300310US |

**CONFIRMATION NO. 4320**

22798
QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.
P O BOX 458
ALAMEDA, CA 94501

**POWER OF ATTORNEY NOTICE**

*OC000000030829068*

Date Mailed: 07/07/2008

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 12/19/2007.

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

/amwise/

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

09 SEP 2005

#8

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PO Box 14300
Washington DC 20044-4300

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Hermann BOSCH et al | : | |
| PCT No.: PCT/EP03/04021 | : | |
| Application No.: 10/515,231 | : | |
| Int. Filing Date: 17 April 2003 | : | |
| Priority Date: 24 May 2002 | : | PAPERS FILED |
| Attorney's Docket No.: 095309.55624US | : | |
| For: DRIVE SYSTEM FOR A MOTOR VEHICLE COMPRISING AN INTERNAL COMBUSTION ENGINE AND AN ELECTRIC MOTOR | : | UNDER 37 CFR 1.42 |

This is a decision on the declaration filed 28 July 2005, which has been treated as a request for status under 37 CFR 1.42.

## BACKGROUND

On 25 November 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). Applicants, however, did not satisfy the requirement set forth by 35 U.S.C. 371(c)(4) because an executed oath or declaration was not provided at such time.

On 09 June 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by International application number and international filing date" must be submitted within two months from 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.

To satisfy the requirements of 35 U.S.C. 371(c)(4) that an oath or declaration of the inventor be submitted, applicants submitted on 28 July 2005 a declaration signed by Irmgard Heni, Simon Heni, Cornelius Heni, and Jonathan Heni as legal representatives of deceased inventor, Anton Heni.

## DISCUSSION

The aforementioned international application may not commence entry to the national stage phase because the declaration does not comply 37 CFR 1.497(a)(3). A Declaration, under 37 CFR 1.497(a)(3), must identify each inventor. In this instance the deceased inventor, Anton HENI is not listed on the declaration. See MPEP § 602.

In addition, the residences and mailing addresses of the of the legal representatives must be listed on the declaration submitted. In this instance, the residences and mailing addresses of the legal representatives have not been provided as required under 37 C.F.R. §1.497(b)(2). See MPEP § 409.01.

Furthermore, the declaration provided has an alteration on it, which appears to be in German, and it is unclear what it conveys. Any alternation made after the signing of an oath or declaration must be supported by a supplemental oath or declaration under §1.67. Note 37 CFR §1.52.

Consequently, applicants have not satisfied the requirements under 37 CFR 1.42.

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **not accepted**.

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

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3276
Fax: (571) 272-0459

22 MAY 2007

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Intellectual Property Group
PO Box 14300
Washington DC 20044-4300

| | | |
|---|---|---|
| In re Application of | : | DECISION ON RENEWED |
| Hermann BOSCH et al | : | |
| PCT No.: PCT/EP03/04021 | : | |
| Application No.: 10/515,231 | : | |
| Int. Filing Date: 17 April 2003 | : | |
| Priority Date: 24 May 2002 | : | PAPERS FILED |
| Attorney's Docket No.: 095309.55624US | : | |
| For: DRIVE SYSTEM FOR A MOTOR VEHICLE | : | |
| COMPRISING AN INTERNAL COMBUSTION | : | |
| ENGINE AND AN ELECTRIC MOTOR | : | UNDER 37 CFR 1.42 & 1.181 |
| | : | |

This is a decision on the "REQUEST TO WITDRAW NOTIFICATION OF ABANDONMENT" filed on 25 January 2006 and a "Renewed Submission Under 37 CFR 1.42," which was allegedly filed on 15 November 2005.

## BACKGROUND

In a decision from this Office on 09 September 2005, the request filed on 28 July 2005 was not accepted under 37 CFR 1.42.

On 25 January 2006, applicants filed the present petition, which also included a renewed submission under 37 CFR § 1.42 accompanied with a declaration, and a copy of the USPTO stamped postcard dated 15 November 2005.

## DISCUSSION

**37 CFR 1.181:**

Applicants indicate that the supplemental declaration, *inter alia*, was submitted on 15 November 2005 as indicated by postcard, which lists:

(1) Supplemental Declaration (2 Pages)
(2) Supplemental Application Data Sheet (4 pages)

The postcard lists the above item and bears a USPTO date of stamp as 15 November 2005.

MPEP 503 provides:

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

Applicant's postcard is accepted as *prima facie* that the renewed petition under 37 CFR 1.42 and the Supplemental Declaration were deposited with the U.S. Patent and Trademark Office on 15 November 2005.

Accordingly, the date of the renewed petition under 37 CFR 1.42 and the receipt for the Declaration is 15 November 2005.

**37 CFR 1.42:**

Applicants have provided a supplemental executed declaration, which sets forth that Irmgard HENI is the legal representative of the deceased inventor Anton HENI, and it also sets forth their citizenship and residence.

However, the executed declaration is defective because it is missing the signatures of the inventors, and only has the signatures of the legal representatives. The previous executed declaration did have their signatures but it was defective and any new submitted declaration must also have their signatures on it.

Moreover, the supplemental declaration provided has alterations on the date sections. Any alternation made after the signing of an oath or declaration must be supported by a supplemental oath or declaration under §1.67. Note 37 CFR §1.52.

Consequently, applicants have not satisfied the requirements under 37 CFR 1.42.

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **not accepted**.

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

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Accordingly, the requirements under 37 CFR 1.42 are not satisfied and the declaration is not acceptable at this time.

## DECISION

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

For the above reasons, the request for status under 37 CFR 1.42 is **not accepted**.

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

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, 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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PCT Legal Office
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| | | |
|---|---|---|
| In re Application of | : | DECISION ON RENEWED |
| Hermann BOSCH et al | : | |
| PCT No.: PCT/EP03/04021 | : | |
| Application No.: 10/515,231 | : | |
| Int. Filing Date: 17 April 2003 | : | |
| Priority Date: 24 May 2002 | : | PAPERS FILED |
| Attorney's Docket No.: 095309.55624US | : | |
| For: DRIVE SYSTEM FOR A MOTOR VEHICLE | : | |
| COMPRISING AN INTERNAL COMBUSTION | : | |
| ENGINE AND AN ELECTRIC MOTOR | : | UNDER 37 CFR 1.42 |

This is a decision on the "RENEWED SUBMISSION UNDER 37 CFR 1.42" filed on 24 August 2007.

## BACKGROUND

In a decision from this Office on 22 May 2007, the request filed on 15 November 2005 (re-filed on 25 January 2006 was not accepted under 37 CFR 1.42.

On 24 August 2007, applicants filed the present renewed petition, which also included a renewed submission under 37 CFR § 1.42 accompanied with an executed declaration.

## DISCUSSION

**37 CFR 1.42:**

Applicants have provided a supplemental executed declaration, which sets forth that Irmgard HENI is the legal representative of the deceased inventor Anton HENI, and it also sets forth their citizenship and residence.

Accordingly, the requirements under 37 CFR 1.42 are satisfied and the declaration is acceptable at this time.

## DECISION

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

The renewed submission filed under 37 CFR 1.42 is **ACCEPTED**.

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision. The 35 U.S.C.§ 371(c)(1), (c)(2), and (c)(4) date of this application as **24 August 2007**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3276
Fax: (571) 273-0459

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

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NOV 13 2006

**OFFICE OF PETITIONS**

In re Application of :
TENEMBAUM, et al. :
Application No. 10/515,256 : DECISION ON PETITION
Filed: February 07, 2006 : TO WITHDRAW
Attorney Docket No. 691/10 : 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 09, 2006.

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

A review of the file record indicates that the power of attorney to DARBY & DARBY P.C. has been revoked by the assignee of the patent application on August 24, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

A Review of the file discloses that a non-final Office action was mailed on September 22, 2006, which set forth a three month shortened statutory period for reply. Extensions of time under 37 CFR 1.136(a) are available. To date, there is no indication that a reply to the Office action of September 22, 2006 has been received.

Telephone inquires concerning this decision should be directed to Patricia Volpe at 571-272-6825.

Patricia Volpe
Petitions Examiner
Office of Petitions

cc: KAPLAN GILMAN GIBSON & DERNIER L.L.P.
900 ROUTE 9 NORTH
WOODBRIDGE, NJ 07095

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UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/515,256 | 02/07/2006 | Samuel S Tenembaum | 04224/100L461-US1 |

**CONFIRMATION NO. 9339**

07278
DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK, NY 10150-5257

*OC000000021189094*

Date Mailed: 11/13/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/24/2006.

- 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).

---

PVolpe

PATRICIA A VOLPE
OP (571) 272-6825

FORMER ATTORNEY/AGENT COPY

23 SEP 2005
United States Patent and Trademark Office

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Steinberg & Raskin, P.C.
1140 Avenue of the Americas, 15th Floor
New York, NY 10036-5803

In re Application of
Suarez et al.
Application No. 10/515,266
PCT No.: PCT/IT03/00775
Int. Filing Date: 25 November 2003
Priority Date: 27 November 2002
Atty. Docket No.: 741014.1041
For: Method For The Production Of A Shock Absorbing Heel For Footwear And The Heel Produced Thereby

DECISION

This is in response to the "Response To Notification of Missing Requirements" filed on 01 August 2005.

## BACKGROUND

This international application was filed on 25 November 2003, designated the United States, and claimed an earlier priority date of 27 November 2002. The International Bureau transmitted a copy of the published international application to the USPTO on 10 June 2004. Accordingly, the 30 month time period for paying the basic national fee in the United States expired at midnight on 27 May 2005. Applicants filed *inter alia* the basic national fee on 16 November 2004.

On 19 May 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b), and stating that "Inventors name written as Javier Adolfo Suarez on Declaration and Adolfo Javier Suarez on International Application. Please clarify."

## DISCUSSION

Inspection of the declaration filed on 16 November 2004 reveals that it names a joint inventor, Javier Adolfo Suarez, whose name differs from a similar name appearing on the published international application, Adolfo Javier Suarez. Counsel's explanation of this discrepancy is that

> based on the information available for our consideration, it is understood that Applicant Adolfo Javier SUAREZ goes by his middle name, Javier. In such cases, it is not considered uncommon, we respectfully submit, for a name to be signed, as it is used, or printed in a format that corresponds to the signature.

Since the discrepancy in inventorship represents more than a mere typographic error or phonetic misspelling of applicant's name, a proper petition and fee under 37 CFR 1.182 are required. Counsel's explanation is not sufficient because the basis for the explanation is not clear (for instance, it is not clearly made on the basis of first-hand knowledge), nor is it clear whether deceptive intent was present. Moreover, counsel's explanation admits that the name appearing on

the declaration differs from the joint inventor's full given name. *See* MPEP § 605.04(b). It is also noted that the declaration is not self-consistent because the first page names "Adolfo Javier Suarez" while the second page nominates "Javier Adolfo Suarez."

## CONCLUSION

The declaration filed on 01 August 2005 is **NOT ACCEPTED**, without prejudice.

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

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

Richard Cole
PCT Legal Examiner
PCT Legal Office

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

15 JUN 2006

United States Patent and Trademark Office

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POLLACK, P.C.
THE CHRYSLER BUILDING
132 EAST 43RD STREET, SUITE 760
NEW YORK NY 10017

In re Application of
Suarez et al.
Application No. 10/515,266
PCT No.: PCT/IT03/00775
Int. Filing Date: 25 November 2003
Priority Date: 27 November 2002
Atty. Docket No.: 1014.1041
For: Method For The Production Of A Shock Absorbing Heel For Footwear And The Heel Produced Thereby

DECISION

This is in response to the "Reply To Decision..." filed on 30 December 2005.

## DISCUSSION

In a decision mailed on 23 September 2005, the declaration filed on 16 November 2004 was not accepted, without prejudice, because

> Inspection of the declaration filed on 16 November 2004 reveals that it names a joint inventor, Javier Adolfo Suarez, whose name differs from a similar name appearing on the published international application, Adolfo Javier Suarez. Counsel's explanation of this discrepancy is that
>
> > based on the information available for our consideration, it is understood that Applicant Adolfo Javier SUAREZ goes by his middle name, Javier. In such cases, it is not considered uncommon, we respectfully submit, for a name to be signed, as it is used, or printed in a format that corresponds to the signature.
>
> Since the discrepancy in inventorship represents more than a mere typographic error or phonetic misspelling of applicant's name, a proper petition and fee under 37 CFR 1.182 are required. Counsel's explanation is not sufficient because the basis for the explanation is not clear (for instance, it is not clearly made on the basis of first-hand knowledge), nor is it clear whether deceptive intent was present. Moreover, counsel's explanation admits that the name appearing on the declaration differs from the joint inventor's full given name. *See* MPEP § 605.04(b). It is also noted that the declaration is not self-consistent because the first page names "Adolfo Javier Suarez" while the second page nominates "Javier Adolfo Suarez."

In response, counsel has filed inter alia a declaration naming and newly executed by Adolfo Javier Suarez, Antonio Puccioni and Simone Pezzuolo, who constitute the inventive entity nominated by the published international application. However, as applicant has neither paid the

surcharge under 37 CFR 1.492(h) nor authorized it to be charged to a Deposit Account, it would not be appropriate to accept the declaration at this time.

It is noted that the submission of 30 December 2005 changed the correspondence address of record to the address corresponding with customer number 41226, and appointed the attorneys corresponding with that customer number. However, the "Revocation And New Power Of Attorney" document filed therewith is not given effect because it has not been signed with a person having apparent authority to revoke the previous power of attorney. Therefore, counsel named on that "Revocation..." also continues to enjoy authority to act in this case.

## CONCLUSION

The declaration filed on 30 December 2005 is **NOT ACCEPTED** ,without prejudice.

Applicant is required to respond within **TWO (2) MONTHS** of the mailing date of this decision, extendable under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT**.

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

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

George M. Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
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28 SEP 2006

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NEW YORK NY 10017

In re Application of
Suarez et al.
Application No. 10/515,266
PCT No.: PCT/IT03/00775
Int. Filing Date: 25 November 2003
Priority Date: 27 November 2002
Atty. Docket No.: 1014.1041
For: Method For The Production Of A Shock Absorbing Heel For Footwear And The Heel Produced Thereby

DECISION

This is in response to the "Response..." filed on 24 July 2006.

## DISCUSSION

In a decision mailed on 15 June 2006, the declaration filed on 30 December 2005 was treated as follows:

> ... counsel has filed inter alia a declaration naming and newly executed by Adolfo Javier Suarez, Antonio Puccioni and Simone Pezzuolo, who constitute the inventive entity nominated by the published international application. However, as applicant has neither paid the surcharge under 37 CFR 1.492(h) nor authorized it to be charged to a Deposit Account, it would not be appropriate to accept the declaration at this time.
>
> It was also
>
> noted that the submission of 30 December 2005 changed the correspondence address of record to the address corresponding with customer number 41226, and appointed the attorneys corresponding with that customer number. However, the "Revocation And New Power Of Attorney" document filed therewith is not given effect because it has not been signed with a person having apparent authority to revoke the previous power of attorney. Therefore, counsel named on that "Revocation..." also continues to enjoy authority to act in this case.

Regarding the issue of the surcharge under 37 CFR 1.492(h), applicants have submitted payment of $120.00 of the $130.00 total surcharge via a credit card payment authorization. Review of the fee records of this application reveals that a further $120.00 has been applied to "undetermined claims" fees. To complete the full surcharge under 37 CFR 1.492(h), $10.00 of the "undetermined claims" amount is being applied to the surcharge.

Regarding the issue of the "Revocation and New Power of Attorney," counsel asserts that it "was executed, as indicated therein, by the head of the Legal Department for Assignee... Such Legal Department head, we respectfully submit, has not only apparent, but also clear authority to

act on behalf of the subject Assignee." Counsel's attention is respectfully directed to MPEP 324, which states in part that:

> (A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. 37 CFR 3.73(b)(2)(ii). An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are accept –able, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. >In foreign countries, a person who holds the title "Manager " or "Director" is normally an officer and is presumed to have the authority to sign on behalf of the organization.< A person having a title (** administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. A power of attorney ** >(37 CFR 1.32(b)(4)) to a patent practitioner to prosecute a patent application executed by the applicant or the assignee of the entire interest does not make that <practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee.
>
> (B) The submission may be signed by any person, if the submission sets forth that the person signing is authorized (or empowered) to act on behalf of the assignee, i.e., to sign the submission on behalf of the assignee. 37 CFR 3.73(b)(2)(i).
>
> (C) The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record.
>
> Where a submission does not comply with (A), (B), or (C) above, evidence of the person's authority to sign will be required.

In the instant case, the position of "head of the Legal Department" does not suggest apparent authority in the sense that it does not imply that the individual is an officer of the organization. Although counsel asserts that the "head of the Legal Department" in fact does enjoy such authority, this assertion has not been made by the person seeking to assert the authority. Moreover, no other documentation of authority has been provided. Therefore, the "Revocation and New Power of Attorney" is not given effect. *See also* MPEP 402.07.

## CONCLUSION

The declaration filed on 30 December 2005 is **ACCEPTED**.

This application is being forwarded to the National Stage Processing Branch for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **30 December 2005**.

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

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

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SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
SOUTH WACKER DRIVE STATION, WILLIS TOWER
CHICAGO, IL 60606

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Virginia M. Ursin | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7622632 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/24/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,283 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/31/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **837** 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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01 FEB 2006

RONALD E. GREIGG
GREIGG & GREIGG P.L.L.C.
1423 POWHATAN STREET, UNIT ONE
ALEXANDRIA VA 22314

In re Application of
FRANK (Deceased)
Application No.: 10/515,293
PCT No.: PCT/DE03/00486
Int. Filing Date: 18 February 2003
Priority Date: 23 May 2002
Attorney Docket no.: R-302448
For: HIGH PRESSURE RESERVOIR FOR FUEL INJECTION SYSTEMS WITH INTEGRATED PRESSURE CONTROL VALVE

DECISION ON
REQUEST
UNDER 37 CFR 1.42
and 1.43

This is a decision on applicant's submission under 37 CFR 1.42 and 1.43 filed in the United States Patent and Trademark Office (USPTO) on 22 November 2004.

## BACKGROUND

On 22 November 2005, prior to the expiration of the thirty month period, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee. With the national stage filing, applicant also submitted a declaration identifying Claudia Ester Frank, Simone Christel Frank and Verena Andrea Frank as the heirs of deceased inventor Kurt Frank.

## DISCUSSION

Applicant has provided a declaration executed by joint inventor Werner Wagner and by Claudia Frank, identifying her as the heir of deceased inventor Kurt Frank and as legal guardian of minor children Simone Christel Frank and Verena Andrea Frank. The declaration identifies the deceased inventor and provides the citizenship, residency and mailing address for both the deceased inventor and his heirs as well as that of the joint inventor Werner Wagner.

Accordingly, it is appropriate, at this time, to accord the application status under 37 CFR 1.42 and 1.43

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 and 1.43 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 **22 November 2004.**

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

Telephone: 571-272-3286

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FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

Mail Date: 05/19/2010

| | | |
|---|---|---|
| **Applicant** | : Timothy Fisher-Jeffes | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7665010 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/515,301 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/26/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1056** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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OFFICE OF PETITIONS

SMITHKLINE BEECHAM CORPORATION
CORPORATE INTELLECTUAL PROPERTY
US, UW 220
P.O. BOX 1539
KING OF PRUSSIA, PA 19406-0939

In re Patent No. 7,547,719 : DECISION ON REQUEST FOR
Stephen Moore : RECONSIDERATION OF
Issue Date: June 16, 2009 : PATENT TERM ADJUSTMENT
Application No. 10/515,304 : AND NOTICE OF INTENT TO
Filed: November 2, 2004 : ISSUE CERTIFICATE
Attorney Docket No. P51352 : OF CORRECTION

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM UNDER 37 CFR §1.705(d)", filed August 11, 2009. Patentees request that the determination of patent term adjustment for the above-identified patent be corrected from two hundred eighty-eight (288) days to seven hundred eighty-five (785) 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 **five hundred seventy (570) days**.

Patentees are given **THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer**, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

On June 16, 2009, the above-identified application matured into U.S. Patent No. 7,547,719 with a patent term adjustment of 288 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

Initially, petitioners argue that the Office incorrectly calculated the patent term adjustment under 35 U.S.C. 154(b)(1)(B) since the period of adjustment is defined as "the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued.

A review of the record indicates that the Office did not use the 35 U.S.C. 371(b) national stage commencement date of November 22, 2004, in calculating the period of adjustment under 37 CFR 1.703(b). As stated in 37 CFR 1.703(b), the period of adjustment under § 1.702(b) is the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued. While the date of completion of all 35 U.S.C. 371 requirements, February 22, 2006, is the date used in calculation of the examination delay under 37 CFR 1.703(a), the date the national stage commenced under 35 U.S.C. 371(b) or (f), November 22, 2004, is used to determine the Three Year Delay under 37 CFR 1.703(b).

Pursuant to 37 CFR 1.703(b), the period of adjustment under 37 CFR 1.702(b) should be 572 days, counting the number of days beginning on the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(b), November 23, 2007, and ending on the date the patent issued, June 16, 2009.

Further, 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 aver that the correct number of days of Patent Term Adjustment is 785 days under the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentees assert that pursuant to Wyeth, a PTO delay under 35 U.S.C. 154(b)(1)(A) overlaps with a delay under 35 U.S.C. 154(b)(1)(B) only if the delays "occur on the

same day." Patentees contend that the periods of delay attributable to grounds specified under 35 U.S.C. 154(b)(1)(A) and 35 U.S.C. 154(b)(1)(B) overlap by 76 days as they occur on the same calendar days in both periods. It appears that patentees maintain that this overlapping period is the 76 days running from November 22, 2007 to February 5, 2008. Patentees assert that the total non-overlapping PTO delay under 35 U.S.C. 154(b)(1)(A) and 35 U.S.C. 154(b)(1)(B) is 787 days as these periods do not occur on the same days. Given the 2 days of applicant delay, patentees assert entitlement to 785 days of patent term adjustment.

Patentees' interpretation of the period of overlap has been considered, but found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

> to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*[1] *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

---

[1] 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.

> 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding 37 CFR 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the date

of national stage commencement under 35 U.S.C. 371(b) or (f) on November 22, 2004, and ending on the date of issuance of the patent on June 16, 2009 (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1),[2] 290 days[3] of patent term adjustment were accorded during the pendency of the application for Office delay prior to the issuance of the patent. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b),[4] 572 days of patent term adjustment accrued for Office issuance of the patent more than three years after the national stage commencement date of the application.

All of the 572 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 290 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 572 days and the 290 days is neither permitted nor warranted. 572 days is the actual number of days issuance of the patent was delayed. Accordingly, an additional period of adjustment of 282 days will

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[2] The Office did not mail a Non-Final Office Action until February 6, 2008, 14 months and 290 days after the fulfillment of the requirements under 35 U.S.C. 371 on February 22, 2006.

[3] 37 CFR 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

> (a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:
> (1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

[4] Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

> Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application.

be entered for the Office failing to issue the patent within three years after the application commenced under 35 U.S.C. 371 (b).

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

The patent 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 570 days.

Telephone inquiries specific to this matter should be directed to Gay Ann Spahn at (571) 272-8011.

Christina Tartera Donnell for

David A. Bucci
Petitions Examiner
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**DRAFT COPY**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,547,719 B2

DATED : June 16, 2009

INVENTOR(S) : Moore

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 288 days.

Delete the phrase "by 288 days" and insert --by 570 days--.

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SPRINKLE IP LAW GROUP
1301 W 25TH STREET, SUITE 408
AUSTIN, TX 78705

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JUL 13 2006

OFFICE OF PETITIONS

In re Application of :
Stuart A. Tison et al :
Application No. 10/515,328 : DECISION ON PETITION
Filed: November 22, 2004 : TO WITHDRAW
Attorney Docket No. MYKR1380-US : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) or 37 C.F.R. § 10.40 filed February 27, 2006.

The request is **APPROVED**.

A review of the file record indicates that Mr. Steven Sprinkle and/or the attorneys associated with Customer Number 44654: (1) do not have power of attorney in this patent application; and (2) have been employed or otherwise engaged in the proceedings in this patent application. In view of the present decision, Mr. Steven Sprinkle and the attorneys associated with Customer Number 44654 have been withdrawn from the present application and may not prepare or submit papers under 37 C.F.R. § 1.34, or correspond in any manner in this application unless appointed in an acceptable power of attorney under 37 C.F.R. § 1.32(b).

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) the intervening assignee of the entire interest. Office records indicate that Mykrolis Corporation is the assignee of the entire right, title and interest in this application. Therefore, all future communications from the Office will be directed to Mykrolis as the assignee of the entire interest under 37 C.F.R. §3.71 at the first copied address below until otherwise properly notified by the assignee. A courtesy copy of this decision is being mailed to the correspondence address noted on the request to withdraw. However, if the law firm of Lowrie, Lando & Anastasi LLP desires to represent the assignee in this case, the proper power of attorney documents (and 37 CFR 3.73(b) certification) must be submitted. Currently, there are no attorneys of record in this application.

The file record discloses that a final Office action was mailed on January 18, 2006 and a proposed rely (from the firm of Lowrie, Lando & Anastasi) was received on April 24, 2006, along with a one month extension of time fee. Accordingly, this case will be taken up for action by the Examiner of Technology Center AU 2855 in due course. It is noted that a request to change the attorney docket number was submitted with the reply of April 24, 2006. As there does not appear that a power of attorney from the assignee has been submitted, it would be

improper to change the docket number. However, it would be appropriate to delete the docket number in view of the withdrawal from representation of previous counsel.

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

Frances Hicks
Petitions Examiner
Office of Petitions

cc:

Mykrolis Corporation
129 Concord Road
Billerica, MA 01821-4600

Robert A. Skrivanek, Jr.
Lowrie, Lando & Anastasi, LLP
Riverfront Office Park, 11th Floor
One Main Street
Cambridge, MA 01242

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1-14-09

Patent No. : 7,507,802
Ser. No. : 10/515,353
Inventor(s) : Bo- Young Ahn, et. al.
Issued : March 24, 2009

Re: Request for Certificate of Correction

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

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

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

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

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

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

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

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

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

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

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

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

Kongsik Kim
Edwards Angell Palmer & Dodge LLP
P.O. Box 55874
Boston, Mass. 02205

ej

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

In re Patent No. 7,507,802

Issue Date: March 24, 2009

Application No. 10/515,353

Filed: November 18, 2004

Attorney Docket No. 69113 (303198)

ON PETITION

This is a decision on the petition filed December 14, 2009, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee data on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **granted**.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3222. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

The file is being forwarded to the Certificate of Correction Branch for issuance of the requested Certificate of Correction.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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

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ONE COMMERCE SQUARE
2005 MARKET STREET
SUITE 2200
PHILADELPHIA, PA 19103

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| | | |
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| In re Application of | : | |
| Kimiya Ikushima, et al. | : | |
| Application No. 10/515,359 | : | DECISION GRANTING PETITION |
| Filed: November 22, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 10407-117US | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed November 2, 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 29, 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 regarding this decision should be directed to April Wise at (571) 272-1642.

This application is being referred to Technology Center AU 2891 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

Frances M. 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.*

21 APR 2005

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ELMAN TECHNOLOGY LAW, P.C.
P. O. BOX 209
SWARTHMORE PA 19081-0209

In re Application of :
MAUREEN A. MCKENZIE :
Serial No.: 10/515,363 : DECISION ON
PCT App. No.: PCT/US03/10200 :
Int'l Filing Date: 03 April 2003 : PETITION UNDER
Priority Date: 03 April 2002 :
Attorney Docket No.: DEN2.001-US : 37 CFR 1.137(b)
For: VACCINIUM SPECIES COMPOSITIONS :
WITH NOVEL BENEFICIAL PROPERTIES :

The petition to revive under 37 CFR 1.137(b) filed 22 November 2004 in the above-captioned application is hereby **GRANTED** as follows:

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

A review of the application file reveals that the basic national fee of $395 has been provided. The required petition fee of $685 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. Applicant's deposit account will be charged the $65 surcharge for filing the oath or declaration after the thirty month period. The 35 U.S.C. 371(c)(1), (2) and (4) date is 22 November 2004.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

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SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, WILLIS TOWER
CHICAGO IL 60606-1080

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|---|---|---|
| In re Application of | : | |
| Maureen A. McKenzie | : | |
| Application No. 10/515,363 | : | DECISION ON PETITION |
| Filed: November 22, 2004 | : | TO WITHDRAW |
| Attorney Docket No. **40000157-0002** | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed November 10, 2009.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond , pursuant to 37 CFR 10.40.

The request was signed by David R. Metzger on behalf of all attorneys of record who are associated with Customer Number 26263.

All attorneys/agents associated with Customer Number 26263 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the first named inventor Maureen A. McKenzie at the address list listed in the request.

There is an outstanding Office action mailed August 20, 2009, that requires a reply from the applicant.

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

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Maureen A. McKenzie
14898 Kenai Spur Highway, 2nd Floor
Kenai, AZ 99611

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Technology Center 2100

RATNERPRESTIA
P O BOX 980
VALLEY FORGE PA 19482-0980

In re Application of:
**HAJIME MAEKAWA**
Application No. **10/515,364**
Filed: **May 20, 2005**
For: **INFORMATION PROCESSING SYSTEM**

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition, filed August 24, 2006 under M.P.E.P. § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

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

(A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i);

(B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;

(C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

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

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

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

renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

Applicant's submission is deficient in that it does not comply with item (E) above. That is, no clear indication is given specifically pointing out how the language of, at least, claims 1, 19, and 20 patentably distinguishes from the references.
First, it is noted that Claims 2 and 3, referred to on pages 3 of 4 and 4 of 4 of the petition, have been canceled. These claims are no longer pending in the present application (see preliminary amendment filed on August 29, 2006).
The petition fails to provide a discussion of how claims 1, 19 and 20 are "patentable over the references."
The petition merely includes a general recitation of the claimed features of the claims without any explanation or discussion of how these claims distinguish over the references. That is, there is no "detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references." For example, there is no detailed discussion of references JP 2001-189740A, JP 2003-134172A and JP 2003-046530 listed in the IDS.

Accordingly, the Petition is **DISMISSED**. The application file is being forwarded to Central Files to await examination in its proper turn based on its effective filing date.

Any request for reconsideration must be filed within two months of the mailing date of this decision.

John Follansbee
WQAS
Technology Center 2100
571-272-3964

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RATNERPRESTIA
P O BOX 980
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In re Application of:
**HAJIME MAEKAWA**
Application No. **10/515,364**
Filed: **May 20, 2005**
For: **INFORMATION PROCESSING SYSTEM**

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition, filed August 24, 2006 under M.P.E.P. § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

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

(A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i);

(B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;

(C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

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

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

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

renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

Applicant's submission is deficient in that it does not comply with item (E) above. That is, no clear indication is given specifically pointing out how the language of, at least, claims 1, 19, and 20 patentably distinguishes from the references.

First, it is noted that Claims 2 and 3, referred to on pages 3 of 4 and 4 of 4 of the petition, have been canceled. These claims are no longer pending in the present application (see preliminary amendment filed on August 29, 2006).

The petition fails to provide a discussion of how claims 1, 19 and 20 are "patentable over the references."

The petition merely includes a general recitation of the claimed features of the claims without any explanation or discussion of how these claims distinguish over the references. That is, there is no "detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references." For example, there is no detailed discussion of references JP 2001-189740A, JP 2003-134172A and JP 2003-046530 listed in the IDS.

Accordingly, the Petition is **DISMISSED**. The application file is being forwarded to Central Files to await examination in its proper turn based on its effective filing date.

Any request for reconsideration must be filed within two months of the mailing date of this decision.

John Follansbee
WQAS
Technology Center 2100
571-272-3964

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Technology Center 2100

RATNERPRESTIA
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VALLEY FORGE PA 19482-0980

In re Application of: MAEKAWA
Application No. 10/515,364
Filed: May 20, 2005
For: INFORMATION PROCESSING SYSTEM

DECISION ON PETITION
TO MAKE SPECIAL
(ACCELERATED EXAMINATION)
UNDER M.P.E.P. §708.02 (VIII)

This is a decision on the Request for Reconsideration filed April 30, 2007 on the petition to make special under 37 C.F.R. §102(d) and M.P.E.P. §708.02(VIII): Accelerated Examination, filed on August 29, 2006.

The Petition is **GRANTED**.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

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

(a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);

(b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;

(c) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement;

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

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

Petition to Make Special **GRANTED** since all of the requirements for special status under MPEP § 708.02(VIII) have been met.

In reference to the petition, it is noted that JP 2004-507205 is a prior foreign application number of the current patent application (10/515,364).

The application file is being forwarded to the Examiner for accelerated examination in accordance with M.P.E.P. §708.02, Section VIII. If the application is subsequently allowed, it will be given priority for printing. See M.P.E.P. §1309.

John Follansbee
WQAS
Technology Center 2100
571-272-3964

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LAW OFFICES OF JAMES E. WALTON, PLLC
1169 N. BURLESON BLVD.
SUITE 107-328
BURLESON, TX 76028

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : David F Haynes | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7650819 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,391 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/22/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1143** 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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11 JUL 2008

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00757
BRINKS HOFER GILSON & LIONE
P.O. Box 10395
Chicago. IL 60610

In re Application of
KAMIYA *et al*
Application No.: 10/515,395
PCT No.: PCT/JP2003/006218
Int. Filing Date: 19 May 2003
Priority Date: 20 May 2002
Attorney Docket No.: 9683/214
For: PORTABLE TERMINAL, METHODS, PROGRAMS AND STORAGE MEDIA FOR PROGRAM STARTUP MANAGEMENT

**DECISION**

The papers filed on 28 November 2006 requesting a correction of the filing receipt are treated as a petition under 37 CFR 1.181 and hereby **GRANTED** as follows:

The Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) mailed 23 January 2006 recorded the date of receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements as 09 December 2005. The filing receipt mailed 23 January 2006 indicated a "Filing or 371(c) Date" of 09 December 2005. However, a review of the application shows that a declaration in compliance with 37 CFR 1.497(a) and (b) was not provided until 09 January 2006.

As such, the Notice of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) and filing receipt mailed 23 January 2006 both contain erroneous information and are hereby **VACATED**.

This application is being forwarded to the DO/EO/US to mail a corrected Form PCT/DO/EO/903 and filing receipt indicating the date of receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements and "Filing or 371(c) Date" of 09 January 2006.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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ELI LILLY & COMPANY
PATENT DIVISION
P.O. BOX 6288
INDIANAPOLIS, IN 46206-6288

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Karl Robert Dahnke | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7601850 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/13/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,403 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/25/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **552** 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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FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

| | | |
|---|---|---|
| In re Patent No. 7,560,471 | : | |
| Fonquerna Pou, et al. | : | |
| Issue Date: July 14, 2009 | : | DECISION ON REQUEST FOR |
| Application No. 10/515,407 | : | RECONSIDERATION OF |
| Filed: July 11, 2005 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. 09605.00006 | : | |

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT -POST GRANT" filed August 25, 2009, which is properly treated under 37 CFR 1.705(d). Patentees request that the determination of patent term adjustment for the above-identified patent be corrected from six hundred thirteen (613) days to nine hundred eighty-one (981) days.

The request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. 154(b) of 613 days.

This application was filed on July 11, 2005. On July 14, 2009, the application matured into U.S. Patent No. 7,560,471, with a revised patent term adjustment of 613 days. The Office determined that the 593 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b)[1,2] overlaps with the 613

[1] Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

> Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application.

days of Office delay pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1)[3,4] accorded prior to the issuance of the patent. As such, the Office allowed only entry of the adjustment of 613 days. No additional days of patent term adjustment were entered at issuance under the three-year pendency provision. Given the applicant delay of 0 days, the patent issued with a revised patent term adjustment of 613 (613 - 0) days.

On August 25, 2009, patentees timely submitted this request for reconsideration of patent term adjustment within two months of the issue date of the patent. See 37 CFR 1.705(d). Patentees aver that the correct number of days of patent term adjustment is 981 days under the court's interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q.2d 1538 (D.D.C. 2008). Specifically, patentees state:

> Under *Wyeth v. Dudas*, the period of patent term extension under 35 U.S.C. § 154(b)(1)(B) begins to toll three years after filing the application. Thus, the period of patent term extension under 35 U.S.C. § 154(b)(1)(B) began on July 11, 2008, and ended with the issuance of the patent on July 14, 2009. The USPTO delay during that time period amounts to 368 days, (i.e., the number of days between July 11, 2008, and July 14, 2009). See 37 C.F.R. § 1.703(b)(4).

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[2] The application was pending three years and 613 days.

[3] 37 CFR § 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

> (a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:
> (1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

[4] A first Office action was not mailed until May 16, 2008, fourteen months and 613 days after the date of completion of all 35 U.S.C. 371 requirements on July 11, 2005.

> *Wyeth v. Dudas* instructs that the USPTO delay of 368 days under the 3-year pendency rule provided by 35 U.S.C. § 154(b)(1)(B) should be counted in addition to the 613 days USPTO delay under the 14 month delay provided by 35 U.S.C. § 154(b)(1)(A)that occurred during prosecution of the application because the periods of time corresponding to these two types of delay did not overlap in time. Thus, the total USPTO adjustment is 981 days (613 + 368 = 981).

*Excerpt taken from "Application for Patent Term Adjustment-Post Grant", 08/25/2009, pgs.2-3*

At the outset, the Office notes that period of delay of 368 days, pursuant to 37 CFR 1.702(b), as set forth by patentees, for the Office taking in excess of three years to issue the patent is incorrect as patentees did not use the correct 35 U.S.C. 371(b) national stage commencement date of Monday, November 29, 2004, in calculating the period of adjustment under 37 CFR 1.703(b). As stated in 37 CFR 1.703(b), the period of adjustment under § 1.702(b) is the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) in an international application and ending on the date a patent was issued. While the date of completion of all 35 U.S.C. 371 requirements, July 11, 2005, is the date used in calculation of the examination delay under 37 CFR 1.703(a), the date the national stage commenced under 35 U.S.C. 371(b), Monday, November 29, 2004, is used to determine the Three Year Delay under 37 CFR 1.703(b).

Pursuant to 37 CFR 1.703(b), the period of adjustment under 37 CFR 1.702(b) should be 593 days, counting the number of days beginning on the day after the date that is three years after the date on which the national stage commenced under 35 U.S.C. 371(b), November 30, 2007, and ending on the date the patent issued, July 14, 2009.

The Office has considered patentees' interpretation of the period of overlap, but finds it inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

> to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*[5] *and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

> If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any 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*

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[5] Likewise, 37 CFR 1.703(f) provides that:

> To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

*Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding 37 CFR 1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office (not including any periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), 613 days of patent term adjustment were accorded during the pendency of the application for Office delay prior to the issuance of the patent. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 593 days of patent term adjustment accrued for Office issuance of the patent more than three years after the date the national stage commenced under 35 U.S.C. 371(b).

All of the 593 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 613 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 613 days and the 593 days is neither permitted nor warranted. 613 days is the actual number of days issuance of the patent was delayed.

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment.

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent is 613 days.

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

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Silvia Fonquerna Pou | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7560471 | : RECALCULATION of PATENT |
| **Issue Date** | : 07/14/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,407 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/11/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1037** 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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SUITE 900
WASHINGTON, DC 20004-2128

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SEP 19 2008

**OFFICE OF PETITIONS**

In re Application of :
Yair Shimansky :
Application No. 10/515,425 : ON PETITION
Filed: December 9, 2005 :
Attorney Docket No. 743464-4 :

This is a decision on the petition, filed June 6, 2008, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

A review of the record discloses that the application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, October 31, 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 February 1, 2008. On June 6, 2008, the present petition was filed. While no response was actually filed in the present application to continue prosecution, petitioner indicates the reply to the outstanding Office action is the filing of Continuation Application No. 12/112,824 on April 30, 2008. Further, the petition is not accompanied by a statement of express abandonment in favor of the filing of the continuing application. On September 12, 2008 a Notice of Abandonment was subsequently mailed.

In order to facilitate action, the petition to revive should include reference to the filing of a continuing application and a letter of express abandonment, conditional upon the granting of the petition and of a filing date to the continuing application. Nevertheless, in view of the statement that the reply is the filing of a continuing application, the statement will be construed as a request to expressly abandon this application in favor of the continuing application. If this was not the intent of applicant, the Office should be promptly notified.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application under 37 CFR 1.53(b); (2) the petition fee of $770; and (3) an adequate statement of unintentional delay.

This application is being revived solely for the purpose of continuity with the Application No. 12/112,824. As continuity has been established by revival of this application, this application is again abandonment in favor of continuing Application No. 12/112,824, filed April 30, 2008.

It is noted that a petition for extension of time was filed on August 4, 2008 for the purpose of maintaining copendency with the continuing application. However, 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 petition for extension of time was subsequent to March 1, 2008, the maximum extendable period for reply, it is unnecessary and the $525 fee will be credited to petitioner's deposit account.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

16 AUG 2005

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Cohen & Pokotilow, Ltd.
12th Floor, Seven Penn Center
1635 Market Street
Philadelphia, PA 19103-2212

| | | |
|---|---|---|
| In re Application of | : | |
| Haycock | : | |
| Application No.: 10/515,446 | : | DECISION |
| PCT No.: PCT/GB03/00888 | : | |
| Int. Filing Date: 4 March 2003 | : | ON |
| Priority Date: 4 March 2002 | : | |
| Attorney Docket No.: S1011-20178 | : | PETITION |
| For: Escalator Chain Drive Mechanism | : | |

The petition to revive under 37 CFR 1.137(b) filed 22 November 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant states that "the entire period of abandonment through the date of this reply was unintentional." This is being construed as a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that the basic national fee of $475.00 was provided. The required petition fee of $685.00 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.

The $65.00 surcharge under 37 CFR 1.492(h) is being charged to counsel's Deposit Account No. 03-0075, as authorized by the transmittal letter.

This application is being forwarded to the United States Designated/Elected Office for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **22 November 2004**.

Boris Milef
PCT Legal Examiner
PCT Legal Office

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

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OFFICE OF PETITIONS

In re Application of :
Baruh Hason et al :
Application No. 10/515,448 : DECISION GRANTING PETITION
Filed: November 22, 2004 : UNDER 37 CFR 1.137(b)
Attorney Docket No. CM01081S :

This is a decision on the petition under 37 CFR 1.137(b), filed March 15, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an RCE and an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Final Rejection of June 5, 2006, is accepted as having been unintentionally delayed.

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

This matter is being referred to Technology Center AU 2617.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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dss

11-27-06

In re Application of
Weekamp et al..
Serial No. 10/515,470
Filed: November 22, 2004
For: METHOD SUITABLE FOR TRANSFERRING A COMPONENT SUPPORTED BY A CARRIER TO A DESIRED POSTION ON A SUBSTRATE, ANDA DEVICE DESIGNED FOR THIS

DECISION
ON
PETITION

This is a decision on the PETITON UNDER 37 C. F. R. 1.181 TO WITHDRAW FINALITY OF REJECTION filed October 20, 2006, requesting the withdrawal of the finality of the Office action mailed September 19, 2006.

Applicants provide the following arguments
1. Applicants petition to reverse finality of the Office Action mailed September 19, 2006 in the instant application because the Office Action introduces new grounds of rejection as described below. The Office Action withdraws previous rejections under 35 U.S.C. §112 ¶2 and further under 35 U.S.C. § 103(a) in view of the combination of U.S. patent numbers 5,941,674 and 4,978,835, which withdrawals are noted with appreciation. Claims 1 and 8 were amended in Applicants' response dated June 20, 2006 merely to address issues under 35 U.S.C. § 112 ¶2 regarding claim form.
2. In the Office Action, claims 1-9 are rejected under 35 U.S.C. § 102(b) in view of two newly cited references, U.S. patent numbers 5,055,652 and 5,847,356. Therefore, Applicants - petition for a first opportunity to respond to the new grounds of rejection.
3. Finality of the rejection is improper, according to MPEP §706.07(a), because any subsequent action on the merits in any application will not be made final if it includes a rejection on newly cited art. Applicants' amendments previously made to the claims are not material to the newly cited art
4. For these reasons, Applicants respectfully request reversal of finality of the Office Action to respond to the new grounds of rejection. Applicants believe that no fee is due with this petition, and authorize any fee that may be due to be charged to Deposit Account Number 503344, Ref. No. 30368-022.

**DECISION**

A review of the application indicates that applicant's request has merit. A review of the application history reveals the following facts An Office action was mailed in which all examined claims were rejected under 35 USC 112 , second paragraph and under 35 USC 103 as being obvious over Applicants Admitted Prior Art (AAPA) in view US Patent No. 4,978,835. A response was filed June 20, 2006. which included amendments to the existing claims.. An Office action was mailed September 19, 2006 in which all claims were rejected as being anticipated by either US Patent No. 5,055,652 and US Patent No. 5,847,356. The Office action was made FIANL stating that applicant's amendment necessitated the new grounds of rejection.

Although the claims contain amendments as result of the response filed June 20, 2006, There is nothing evident in the rejection of September 19, 2006 which points to amendatory subject matter thereby causing the necessity of the new rejection of claims 1-9. It is also noted that such amendment to the claims only corrected issues under 35 U.S.C. §112 ¶2 and thus did not substantially change the issues requiring a new search or consideration by the examiner. Thus no clear issue has been developed between the examiner and applicant per MPEP 706.07 and thus the FINAL rejection of September 19, 2006 was inappropriate.

Since the Office action of September 19, 2006 includes a new rejection not necessitated by amendment, the finality of the Office action of September 19, 2006 is withdrawn, however, the period for response continues to run three (3) months from the mailing date of September 19, 2006.

The petition is **GRANTED**.

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

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
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BRIARCLIFF MANOR NY 10510

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OCT 0 2 2007

**OFFICE OF PETITIONS**

In re Application of :

**STEINBERG,** Amiram :
Application No. 10/515,486 : DECISION ON PETITION
Filed: July 07, 2006, 2004 : TO WITHDRAW
Attorney Docket No. **ACIM-101(US)** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed 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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ALEXANDRIA VA 22313-1404

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JAN 30 2006
OFFICE OF PETITIONS

Applicant: Pazenok
Appl. No.: 10/515,507
International Filing Date: May 9, 2003
Title: PREPARATION OF 4-HALOALKYLNICOTINAMIDES
Attorney Docket No.: 03447-004
Pub. No.: US 2005/0176734 A1
Pub. Date: August 11, 2005

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), filed on October 11, 2005, for the above-identified application.

The request is granted.

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

The reference, which was scanned into this application and published, has been relabeled as a foreign reference.

It would greatly benefit the Office if applicant did not provide a complete copy of the application as filed and a copy of the pregrant publication, as it unnecessarily increases the cost to the Office. See 37 CFR 1.4(b). A request for corrected publication need only point out what was printed incorrectly in the application, where the error occurs in the publication and where the correct text is found in the application papers. Marked up relevant copies of the applications papers and the pre-grant publication may facilitate processing of the request, where it is not readily apparent. If it is not clear why the error is a material error, further explanation may be warranted.

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

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

Enclosure: Corrected Filing Receipt

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| APPL NO. | FILING OR 371 (c) DATE | ART UNIT | FIL FEE REC'D | ATTY.DOCKET NO | DRAWINGS | TOT CLMS | IND CLMS |
|---|---|---|---|---|---|---|---|
| 10/515,507 | 11/24/2004 | 1625 | 950 | 034477-004 | | 18 | 1 |

**CONFIRMATION NO. 5566**

**CORRECTED FILING RECEIPT**

*OC000000017934260*

21839
BUCHANAN INGERSOLL PC
(INCLUDING BURNS, DOANE, SWECKER & MATHIS)
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

Date Mailed: 01/30/2006

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)**

Sergiy Pazenok, Solingen, GERMANY;

**Power of Attorney:**

M Baumeister--26254

**Domestic Priority data as claimed by applicant**

This application is a 371 of PCT/EP03/04869 05/09/2003

**Foreign Applications**

GERMANY 10223274.1 05/24/2002

**If Required, Foreign Filing License Granted:** 01/27/2006

**The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/515,507**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

Preparation of 4-haloalkylnicotinamides

**Preliminary Class**

546

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

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## Title 35, United States Code, Section 184
## Title 37, Code of Federal Regulations, 5.11 & 5.15

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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).

27 JUN 2005

#3

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Thomas J. Edgington
Kirkpatrick & Lockhart LLP
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Pittsburgh, PA 15222-2312

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Flaherty et al | : | |
| PCT No.: PCT/US03/17107 | : | |
| Application No: 10/473,451 | : | |
| Int. Filing Date: 30 May 2003 | : | PETITION UNDER |
| Priority Date: 30 May 2002 | : | |
| Attorney's Docket No.: 020820PCTUS | : | |
| For: CNC Slitter Machine | : | 37 CFR 1.47(a) |

This is in response to the "PETITION FOR STATUS UNDER 37 CFR 1.47(a)" filed on 23 May 2005. The petition fee of 200.00 has been paid.

## BACKGROUND

On 30 May 2003, petitioner filed international application PCT/US03/17107, which claimed priority to an earlier application filed 30 May 2002.

On 23 November 2004, petitioner filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.SC. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed declaration or oath accompanied the above papers.

On 23 May 2005, petitioner filed, *inter alia*, the present petition in support of filing an executed Declaration without the signatures of Rick L. Ahrms and Kenneth A. Balster.

## 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.

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

**REFUSAL TO JOIN:**

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

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

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

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

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

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

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Regarding requirement (2), the declarations by Messrs. Thomas J. Edgington and Robert A. Muha are sufficient to support a finding that the nonsigning inventors, Mr. Rick L. Ahrms and Kenneth A. Balster refuse to sign the required papers because a copy of the PCT application papers including a Declaration was mailed to them, Mr. Ahrms and Mr. Balster, for their execution on December 2, 2004 and to this date they have not responded. Petitioner has provided a copy of the cover letters and the registered mail return receipts confirming that package was received. In addition, the evidence provided states that there were telephone discussions with them about the above application with respect to signing the declaration and they expressly refused.

Accordingly, the steps enumerated in the declarations are sufficient to establish that the nonsigning inventors refuse to sign the declaration.

Regarding requirement 3, petitioner has provided a statement of the last known address of the missing inventors.

Regarding requirement 4, petitioner has provided an executed declaration signed by Patrick M. Flaherty, Charles G. Rutschilling and XngYun, Qu on their behalf and on the behalf of the nonsigning joint inventors Mr. Rick L. Ahms and Kenneth A. Balster.

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

## CONCLUSION

The petition under 37 CFR 1.47(a) is **GRANTED**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing. The application will be given a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of **23 May 2005.**

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

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

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371.

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

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27 JUN [redacted]5

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Rick L. Ahms
63 Rummel Creek Drive
New Bremen, Ohio 45869

In re Application of
Flaherty et al
PCT No.: PCT/US03/17107
Application No: 10/473,451
Int. Filing Date: 30 May 2003
Priority Date: 30 May 2002
Attorney's Docket No.: 020820PCTUS
For: CNC Slitter Machine

Dear Mr. Ahms:

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

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

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
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Kirkpatrick & Lockhart LLP
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27 JUN 20[redacted]

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Kenneth A. Balster
3940 Forest Lane
New Bremen, Ohio 45869

In re Application of
Flaherty et al
PCT No.: PCT/US03/17107
Application No: 10/473,451
Int. Filing Date: 30 May 2003
Priority Date: 30 May 2002
Attorney's Docket No.: 020820PCTUS
For: CNC Slitter Machine

Dear Mr. Balster:

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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OFFICE OF PETITIONS

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

In re Application of :
Coral et al. :
Application No. 10/515,539 : DECISION ON PETITION
Filed: 06/10/2005 :
Attorney Docket No. 01213/0202149-US0 :

This is a decision on the petition under 37 CFR.1.181, filed April 6, 2009, to withdraw the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to respond in a timely manner to the nonfinal Office action, mailed on September 12, 2008, which set a three-month shortened statutory period for reply. Extensions of this period were available under 37 CFR 1.136(a). On March 17, 2009, the Office mailed a Notice of Abandonment.

Petitioners stated that they filed a timely reply in the form of an amendment and a request for an extension of time for response within the third month (and fee) on March 11, 2009.

Upon further review of the record, the reply and the request for an extension of time for response within the third month, filed March 11, 2009, were located among the papers in the Image File Wrapper for the above-identified application.

In view of the above, the reply is considered timely filed on March 11, 2009, with the request for an extension of time for response within the third month (and fee). See 37 CFR 1.8(a) and 1.136(a).

Accordingly, the petition under 37 CFR 1.181 is granted. The holding of abandonment is hereby withdrawn. The application is restored to pending status in view of the fact that petitioner filed a timely response to the nonfinal Office action.

This matter is being referred to Technology Center Art Unit 3632 for further action on the reply filed on March 11, 2009.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3211. All other questions regarding the status of the application or the examination procedures should be directed to the Technology Center.

Christina T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Arne Friedrichs | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7620492 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/17/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,544 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/07/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **809** 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.

#5

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REED SMITH, LLP
ATTN: PATENT RECORDS DEPARTMENT
599 LEXINGTON AVENUE, 29TH FLOOR
NEW YORK, NY 10022-7650

| | | |
|---|---|---|
| In re Application of KOENIG | : | |
| U.S. Application No.: 10/515,558 | : | |
| PCT Application No.: PCT/DE03/01708 | : | |
| Int. Filing Date: 22 May 2003 | : | |
| Priority Date Claimed: 23 May 2002 | : | DECISION |
| Attorney Docket No.: GK-OEH-190 / 500814.20092 | : | |
| For: METHOD FOR TRANSFERRING MOLECULES IN VITAL CELLS BY MEANS OF LASER BEAMS. . . | : | |

This is in response to applicant's "Declaration" filed 23 November 2004, which is being treated as a petition under 37 CFR 1.47(a).

## BACKGROUND

On 22 May 2003, applicant filed international application PCT/DE03/01708, which claimed priority of an earlier Germany application filed 23 May 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 04 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 23 November 2004.

On 23 November 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 a declaration signed by the available inventor on his own behalf and on behalf of the nonsigning inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

The petition states that joint inventor Uday Tirlapur cannot be reached. However, the petition does not sufficiently demonstrate that a bona fide attempt was made to locate Tirlapur. Specifically, petitioner has not furnished copies of documentary evidence of attempts to find Tirlapur, such as a certified mail return receipt, cover letter of instructions, telegram, electronic mail message, facsimile, etc. Furthermore, the petition does not contain any evidence of attempts to reach Tirlapur by obtaining a forwarding address, by searching telephone and Internet directories, and by contacting Tirlapur's former employer and co-workers. Additionally, although the affidavit of Karsten Koenig states that a law firm made attempts to contact Tirlapur, such purported attempts must be supported by an affidavit signed by the person with firsthand knowledge of the attempts. Thus, it would not be reasonable to conclude at the present time that Tirlapur cannot be located.

With regard to item (3) above, the requisite petition fee will be charged to Deposit Account No. 50-1529.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

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In re Application of KOENIG :
U.S. Application No.: 10/515,558 :
PCT Application No.: PCT/DE03/01708 :
Int. Filing Date: 22 May 2003 :
Priority Date Claimed: 23 May 2002 : DECISION
Attorney Docket No.: GK-OEH-190 / 500814.20092 :
For: METHOD FOR TRANSFERRING :
MOLECULES IN VITAL CELLS BY :
MEANS OF LASER BEAMS. . . :

This is in response to applicant's "Renewed Petition Under 37 CFR 1.47(a)" filed 12 December 2005.

## BACKGROUND

On 22 May 2003, applicant filed international application PCT/DE03/01708, which claimed priority of an earlier Germany application filed 23 May 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 04 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 23 November 2004.

On 23 November 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 11 October 2005, this Office mailed a decision dismissing the 23 November 2004 petition.

On 12 December 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 Uday Tirlapur cannot be reached. However, the petition does not sufficiently demonstrate that a bona fide attempt was made to locate Tirlapur. Specifically, petitioner has furnished documentary evidence of attempts to reach Tirlapur by postal mail (see Exhibits A-C). However, since apparently none of the mailings have been refused or returned to sender, it would seem logical to conclude that the address for Tirlapur is still valid. Moreover, the petition does not contain any evidence of attempts to reach Tirlapur by other methods such as telephoning the address of record, sending electronic mail, and by contacting Tirlapur's former employer and co-workers. Thus, it would not be reasonable to conclude at the present time that Tirlapur cannot be located.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

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

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

Bryan Tung
PCT Legal Examiner
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OFFICE OF PETITIONS

In re Application of
Milan Jelinek, et al.
Application No.: 10/515,569
Filed: November 23, 2004
Attorney Docket No.: BKP-018

ON PETITION

This is a decision on the petition, filed November 13, 2009, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on October 28, 2009, cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

The application is being referred to Technology Center AU 2626 for further processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement (IDS).

/SDB/

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

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20 DEC 2006

Michael N. Haynes
1341 Huntersfield Close
Keswick, VA 22947

In re Application of :
EDWARDS *et al* :
Application No.: 10/515,571 :
PCT No.: PCT/US2004/039386 :
Filing Date: 23 November 2004 : DECISION
Atty. Docket No.: 1022-008 :
For: DEVICES, SYSTEMS, AND :
METHODS FOR MEDICAMENT :
DELIVERY

This is a decision on applicant's "REQUEST FOR CORRECTION OF FILING DATE" filed in the U.S. Patent and Trademark Office (USPTO) by fax transmission on 22 February 2006.

## BACKGROUND

On 23 November 2004, applicants filed international application No. PCT/US2004/039386 which designated the United States.

At the same time, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia,: authorization to charge the basic national fee to counsel's deposit account and a declaration of the inventors.

Subsequent thereto, the USPTO mailed applicants a return receipt postcard which indicated that the national stage papers were received on 22 November 2004.

On 22 February 2006, applicant filed the present "REQUEST FOR CORRECTION OF INTERNATIONAL FILING DATE" which has been treated as a petition under 37 CFR 1.10(c). The request was accompanied by, *inter alia*, a copy of the customer receipt for "Express Mail" label No. ED144345952US.

## DISCUSSION

A review of the application file reveals that applicant has satisfied the requirements of 37 CFR 1.10(c) for correction of the filing date. Specifically, the originally filed application papers included an indication of the Express Mail Label no., and the copy of the Express Mail label

shows a "Date In" of "11/23/04". Therefore, correction of the international filing date as requested is warranted.

Further, a review of the application file reveals that the requirements for entry into the national stage under 35 USC 371 have been satisfied.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.10(c) is **GRANTED**.

The application has an international filing date under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (2), and (4) date of **23 November 2004**.

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

Richard R. Cole
PCT Legal Examiner
Office of PCT Legal Administration

(571) 272-3281
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#7

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19 SEP 2006

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San Francisco, CA 94111-4187

In re Application of :
NAUGLER *et al* :
U.S. Application No.: 10/515,575 :
PCT No.: PCT/US2005/003622 : **DECISION ON**
Int. Filing Date: 17 June 2004 : **PETITION FOR REVIVAL**
Priority Date: 18 June 2003 : **UNDER 37 CFR 1.137(b)**
Attorney Docket No.: A-34133/US/3-RMA :
For: PASSIVE MATRIX EMISSION :
STABILIZED FLAT PANEL DISPLAY :

Applicants' petition to revive under 37 CFR 1.137(b) filed on 10 August 2006 is hereby **GRANTED** as follows:

The additional claim fees and the petition fee for a small entity have been paid. A signed oath or declaration in compliance with 37 CFR 1.497(a) and (b) was provided. 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.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 19 November 2004, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 10 August 2006.

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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05 OCT 2006

HOWREY LLP
c/o IP Docketing Dept.
2941 Fairview Park Drive, Suite 200
Falls Church, VA 22042-2924

In re Application of
NAUGLER *et al*
U.S. Application No.: 10/515,575
PCT No.: PCT/US2005/003622
Int. Filing Date: 17 June 2004
Priority Date: 18 June 2003
Attorney's Docket No.: A-34133/US/3-RMA
For: PASSIVE MATRIX EMISSION . . .

**DECISION**

Applicants' petition to revive under 37 CFR 1.137(b) filed on 10 August 2006 is hereby **GRANTED** as follows:

The basic national fee and the petition fee for a small entity 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 signed oath or 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 17 June 2004, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 10 August 2006. This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

It is noted that this decision was originally mailed on 19 September 2006 to Dorsey & Whitney at the correspondence address of record but was Returned to Sender as undeliverable by the USPS.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

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SEP 23 2009

OFFICE OF PETITIONS

**Howrey, LLP – CA**
**c/o IP Docketing Department**
**2941 Fairview Park Drive, Suite 200**
**Falls Church, VA 22042-2924**

In re Application of
W. Edward Naugler, Jr. et al.
Application No. 10/515,575
Filed: August 10, 2006
Attorney Docket No. 05149.0008.NPUS04

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 20, 2009.

The request is **NOT APPROVED**.

A review of the file record indicates that Michael J. Bell and attorneys/agents associated with customer number 27194: (1) do not have power of attorney in this patent application; and (2) have been employed or otherwise engaged in the proceedings in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

All future communications from the Office will be directed to the address copied below.

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

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Leadis Technology, Inc.
800 W. California Avenue, Suite 200
Sunnyvale, CA 94041

03 OCT 20

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2040 Main Street
Fourteenth Floor
Irvine, CA 92614

| | | |
|---|---|---|
| In re Application of | : | |
| Nurcombe, et al. | : | |
| Serial No.: 10/515,579 | : | DECISION |
| PCT No.: PCT/AU03/00666 | : | |
| Int. Filing Date: 30 May 2003 | : | |
| Priority Date: 31 May 2002 | : | |
| Attorney's Docket No.: DAVI165.001NP | : | |
| For: A METHOD OF CELL THERAPY USING FUSED CELL HYBRIDS | : | |

This decision is in response to applicant's request for refund filed 26 July 2005.

## BACKGROUND

On 30 May 2003, applicants filed international application PCT/AU03/00666, which claimed priority of several earlier applications, the earliest of which was filed 31 May 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 December 2003. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 30 November 2004.

On 23 November 2004, applicants filed a transmittal letter for entry into the national stage in the United States. The transmittal letter was accompanied by, *inter alia*, a preliminary amendment and a check for the basic national fee. These papers were assigned Application No. 10/515,579.

On 25 May 2005, the United States Patent and Trademark Office in its capacity as an Elected Office mailed out 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 applicant was required to file an oath/declaration, a late Oath or declaration surcharge fee, a paper copy of the sequence listing, the CRF and a statement regarding the sequence listing. The notice set a response period of two (2) months.

BEST AVAILABLE COPY

On 22 July 2005, applicants filed a declaration signed by the inventors, a power of attorney, an assignment and a request for refund. Applicant indicated that the specification does not included polypeptide or polynucleotide sequences, and therefore, no sequence listing is required.

## DISCUSSION

Applicant has requested a refund based on establishment of small entity status.

MPEP § 505 states, in part:

> (a) Refunds based on later establishment of small entity status. A refund pursuant to § 1.26, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under § 1.27(c) and a request for a refund of the excess amount are filed within three months of the date of the timely payment of the full fee. The three-month time period is not extendable under § 1.136. Status as a small entity is waived for any fee by the failure to establish the status prior to paying, at the time of paying, or within three months of the date of payment of, the full fee.
>
> (b) Date of payment.
>
> (1) The three-month period for requesting a refund, pursuant to paragraph (a) of this section, starts on the date that a full fee has been paid.

The basic national fee had to be paid by the end of November to be timely. Applicant did not file the request for refund until 22 July 2005. The three-month period is not extendable. Therefore, the request for refund was not timely filed.

A review of the application file, including the applicant's present response, reveals that the middle name of applicant Priest is listed in the priority applications and the international application as "Daniel" while the middle name is listed in the declaration as "David." In that this is clearly more than a mere typographical error or phonetic misspelling of applicant's middle name, a proper petition under 37 CFR 1.182 is required in order to resolve this matter. Such a petition must be accompanied by the requisite petition fee of $130 as well as statements from the inventor and any other person having firsthand knowledge of the error. These statements must set forth the specific circumstances as to how and when the error was made and discovered, and must also set forth that the mistake was an inadvertent error without deceptive intent.

Further, the declaration submitted contained two identical sheets of page 2. The first page 2 is signed by Victor Nurcombe, while the second page 2 is signed David Robert James Monaghan. The declaration is not properly executed. It appears that the attorney pieced together two separate complete declarations into one composite declaration or an inventor was 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 have not been met and the declaration is unacceptable

## CONCLUSION

The request for refund is **REFUSED**.

With respect to the defective declaration, a proper response must be filed within ONE (1) MONTH from the mail date of this decision or within the extendable period for response set in the form PCT/DO/EO/905. The one-month response period is NON-EXTENDABLE under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Petition Under 37 CFR 1.182," and must include the requisite petition fee and an acceptable explanation of the facts as discussed above. Failure to file a proper response in a timely manner will result in ABANDONMENT of the application.

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 Brittingham
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Richard Cole
PCT Legal Examiner
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31 JAN 2006

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Fourteenth Floor
Irvine, CA 92614

| | | |
|---|---|---|
| In re Application of | : | |
| Nurcombe, et al. | : | |
| Serial No.: 10/515,579 | : | DECISION |
| PCT No.: PCT/AU03/00666 | : | |
| Int. Filing Date: 30 May 2003 | : | |
| Priority Date: 31 May 2002 | : | |
| Attorney's Docket No.: DAVI165.001NP | : | |
| For: A METHOD OF CELL THERAPY USING FUSED CELL HYBRIDS | : | |

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.182" filed 31 October 2005.

## BACKGROUND

On 30 May 2003, applicants filed international application PCT/AU03/00666, which claimed priority of several earlier applications, the earliest of which was filed 31 May 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 December 2003. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 30 November 2004.

On 23 November 2004, applicants filed a transmittal letter for entry into the national stage in the United States. The transmittal letter was accompanied by, *inter alia*, a preliminary amendment and a check for the basic national fee. These papers were assigned Application No. 10/515,579.

On 25 May 2005, the United States Patent and Trademark Office in its capacity as an Elected Office mailed out 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 applicant was required to file an oath/declaration, a late Oath or declaration surcharge fee, a paper copy of the sequence listing, the CRF and a statement regarding the sequence listing. The notice set a response period of two (2) months.

On 22 July 2005, applicants filed a declaration signed by the inventors, a power of attorney, an assignment and a request for refund. Applicant indicated that the specification does not included polypeptide or polynucleotide sequences, and therefore, no sequence listing is required.

On 03 October 2005, a decision was mailed to applicant indicating that applicant was not entitled to a refund, that a petition under 37 CFR 1.182 was required to explain the discrepancy in applicant Priest's middle name and that the declaration was not properly executed.

On 31 October 2005, applicant filed the current petition which includes a statement from inventor Priest and a declaration that has been signed by all of the applicants.

## DISCUSSION

MPEP § 605.04 states, in part:

> 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 37 CFR 1.182 together with an appropriate petition fee.

Applicant has provided a statement from applicant Priest indicating that the error in his middle name occurred without deceptive intent on his part.

Further, applicants submitted a new declaration which now complies with 37 CFR 1.497.

## CONCLUSION

The petition under 37 CFR 1.182 is hereby **GRANTED**.

This application is being forwarded to the national stage office for preparation 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) showing a 35 U.S.C. 371 date of **31 October 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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Leonard Smith
PCT Legal Examiner
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UNITED STATES PATENT AND TRADEMARK OFFICE
31 AUG 2005

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Friedrich Kueffner
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New York, NY 10017

In re Application of :
Litzenberg et al. :
Application No. 10/515,606 :
PCT No.: PCT/DE03/01501 :
Int. Filing Date: 09 May 2003 : DECISION
Priority Date: 24 May 2002 :
Atty. Docket No.: HKH-11PCT :
For: Method And Device For :
Plasma Treating Workpieces :

This is in response to the "Response To Notification of Missing Requirements" and the accompanying executed declaration of the inventors filed on 01 August 2005.

## BACKGROUND

This international application was filed on 09 May 2003, designated the United States, and claimed an earliest priority date of 24 May 2002. The International Bureau transmitted a copy of the published international application to the USPTO on 04 December 2003. Accordingly, the 30 month time period for paying the basic national fee in the United States expired at midnight on 24 November 2004. Applicants filed *inter alia* the basic national fee on 23 November 2004.

On 11 July 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration of the inventors and a surcharge under 37 CFR 1.492(h).

## DISCUSSION

Inspection of the declaration filed on 01 August 2005 reveals that it names a joint inventor, Michael Lizenberg, whose name differs from a similar name appearing on the published international application, Michael Litzenberg. Review of the application file reveals no explanation of this discrepancy. Counsel is required to explain this discrepancy or provide a new, executed oath or declaration naming the same inventive entity as named in the published international application. In the event that this discrepancy represents more than a mere typographic error or phonetic misspelling of applicant's name, a proper petition and fee under 37 CFR 1.182 would be required. *See* MPEP § 605.04(b) and MPEP § 201.03(b).

## CONCLUSION

The declaration filed on 01 August 2005 is **NOT ACCEPTED**, without prejudice.

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

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

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PCT Legal Examiner
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27 DEC 2005

Friedrich Kueffner
317 Madison Avenue, Suite 910
New York, NY 10017

In re Application of
Litzenberg et al.
Application No. 10/515,606
PCT No.: PCT/DE03/01501
Int. Filing Date: 09 May 2003
Priority Date: 24 May 2002
Atty. Docket No.: HKH-11PCT
For: Method And Device For Plasma Treating Workpieces

DECISION

This is in response to the "Request For Reconsideration" filed on 24 October 2005.

## DISCUSSION

In a Decision mailed on 31 August 2005, the declaration filed on 01 August 2005 was not accepted, without prejudice, because

> it names a joint inventor, Michael Lizenberg, whose name differs from a similar name appearing on the published international application, Michael Litzenberg. Review of the application file reveals no explanation of this discrepancy. Counsel is required to explain this discrepancy or provide a new, executed oath or declaration naming the same inventive entity as named in the published international application. In the event that this discrepancy represents more than a mere typographic error or phonetic misspelling of applicant's name, a proper petition and fee under 37 CFR 1.182 would be required. *See* MPEP § 605.04(b) and MPEP § 201.03(b).

Counsel responds that

> The spelling of the last name of the first inventor in the Declaration submitted August 1, 2005 contains a typographical error. The correct name of the inventor is Michael Litzenberg, as it appears in the published international application. It should be noted in this connection that the signature in the submitted Declaration of the inventor Litzenberg is spelled with a "tz."

In view of this statement, it would now be appropriate to accept the declaration. The records of the USPTO will be updated to reflect the correct spelling as – Litzenberg –. However, counsel's attention is drawn to MPEP 605.04(b), which states in part that

> When a typographical or transliteration error in the spelling of an inventor's name is discovered during pendency of an application, a petition is not required, nor is a new oath or declaration under 37 CFR 1.63 needed. However, applicants are strongly encouraged to use an application data sheet such that any patent to issue will reflect the correct spelling of the inventor's name. Without an application data sheet with the corrected spelling, any patent to issue is less likely to reflect the correct spelling since the spelling of the inventor's name is taken from the oath or declaration, or any subsequently filed application data sheet.

## CONCLUSION

The declaration filed on 01 August 2005 is **ACCEPTED**.

This application is being forwarded to the National Stage Processing Branch for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **01 August 2005**.

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Chicago, IL 60610

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Mirko VOGT | : | |
| Application No.: 10/515,611 | : | |
| PCT No.: PCT/DE03/01552 | : | |
| Int. Filing Date: 14 May 2003 | : | PETITION UNDER |
| Priority Date: 29 May 2002 | : | |
| Attorney's Docket No.: 10808/191 | : | |
| For: PLASMA-ENHANCED ... ARRANGEMENT | : | 37 CFR 1.137(b) |

This decision is in response to applicant's "Petition Under 37 CFR 1.137(b) To Revive Unintentionally Abandoned Application," filed on 26 April 2005.

## BACKGROUND

On 14 May 2003, this international application was filed, claiming an earliest priority date of 29 May 2002. The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 29 November 2004.

On 23 November 2004, applicant filed in the United States Patent and Trademark Office (PTO) a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, *inter alia*, the copy of the international application. However, the national basic fee and an executed declaration or oath was not provided at such time.

On 15 April 2005, the United States Patent and Trademark Office mailed the Notification of Abandonment (PCT/DO/EO/909) since the application was abandoned for failure to pay the basic national fee by 30 months. It indicated that there was no authorization to charge fees.

On 26 April 2005, applicants filed the instant petition under 37 CFR 1.137(b), which was accompanied by the petition fee.

## DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any

terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Petitioner has provided: (1) the proper reply by submitting the basic national filing fee, (2) the petition fee set forth in §1.17(m) and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Accordingly, the petition is deemed to satisfy requirements (1), (2), (3), and (4) under 37 CFR 1.137(b).

## DECISION

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

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

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#6

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27 JAN 2006

ARENT FOX PLLC
1050 Connecticut Avenue, NW
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Washington, DC 20036-5339

| | | |
|---|---|---|
| In re Aplication of | : | DECISION ON |
| Piero DEL SOLDATO et al | : | |
| PCT No.: PCT/EP2003/006496 | : | |
| Application No: 10/515,621 | : | |
| Int. Filing Date: 20 June 2003 | : | PETITION UNDER |
| Priority Date: 25 June 2002 | : | |
| Attorney's Docket No.: 026220-00057 | : | |
| For: ORAL PHARMECEUTICAL FORMS ... | : | |
| IMPROVED BIOAVAILABILITY | : | 37 CFR 1.47(a) |

This is in response to the "PETITION UNDER 37 CFR 1.47(a)" filed on 12 September 2005. The petition fee is now $200.00 for a petition under 37 CFR 1.47(a) so $70 has been charged to petitioner's deposit account 01-2300 as stipulated in the petition letter filed on 12 September 2005.

## BACKGROUND

On 20 June 2003, petitioner filed international application PCT/EP2003/006496, which claimed priority to an earlier application filed 25 June 2002. A copy of the international application was communicated by the International Bureau to the United States Patent and Trademark Office on 31 December 2003. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 25 December 2004.

On 25 December 2004, petitioner filed in the United States Patent & Trademark Office a transmittal letter for entry into the national stage in the U.S. under 35 U.SC. 371, which was accompanied by, inter alia, the U.S. basic national fee. No executed oath or declaration accompanied the above papers.

On 10 August 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" and to avoid abandonment, a surcharge of $65 for small entity in compliance with 37 CFR 1.27, must be submitted with the missing items identified in this letter. The notice indicated that the items must be submitted within two months from date of mailing or by 32 months from the priority date of the application, in order to avoid abandonment of the national stage application.

On 12 September 2005, petitioner filed the present petition, a declaration in support of filing on behalf of omitted inventor Piero DEL SOLDATO accompanied, inter alia, an executed Declaration without the signature of Piero DEL SOLDATO.

## 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.

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

> REFUSAL TO JOIN:
>
> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part

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

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

Petitioner has satisfied requirements (1) and (3) - (4) of 37 CFR 1.47(a) but not requirement (2).

Regarding requirement (1), petitioner has provided the complete fee of $200.00 under 37 CFR 1.17(g).

Regarding requirement (2), in this case, it has been sufficiently demonstrated that a copy of the application papers were mailed to the non-signing inventor, Piero DEL SOLDATO but it is not clear if he received the papers. Although documentary evidence to support this assertion has been provided such as the postal receipt, the document is in Italian and no English translation has been provided. Also, it is unclear if Piero signed for the papers since his name does not appear on the postal receipts. Accordingly, it is unclear what is said in the postal receipts and whether Piero did receive the application papers.

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

Regarding requirement 4, petitioner has provided an executed declaration signed by Cristina MACELLONI and Giancarlo SANTUS on their behalf and on the behalf of the nonsigning joint inventor Piero DEL SOLDATO.

Consequently, the current record does not sufficiently establish Mr. Piero's refusal to join in the application because no evidentiary documents have been submitted in English to show that a *bona fide* attempt was made to deliver the complete application to him and that he received and signed for the papers.

## CONCLUSION

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

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

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

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

UNITED STATES PATENT and TRADEMARK OFFICE

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www.uspto.gov

ARENT FOX PLLC
1050 Connecticut Avenue, NW
Suite 400
Washington, DC 20036-5339

| | | |
|---|---|---|
| In re Aplication of | : | DECISION ON RENEWED |
| Piero DEL SOLDATO et al | : | |
| PCT No.: PCT/EP2003/006496 | : | |
| Application No: 10/515,621 | : | |
| Int. Filing Date: 20 June 2003 | : | PETITION UNDER |
| Priority Date: 25 June 2002 | : | |
| Attorney's Docket No.: 026220-00057 | : | |
| For: ORAL PHARMECEUTICAL FORMS ... | : | |
| IMPROVED BIOAVAILABILITY | : | 37 CFR 1.47(a) |

This is in response to the "SECOND RENEWED PETITION UNDER 37 CFR 1.47(a)," filed on 03 February 2006.

## BACKGROUND

In a decision from this Office on 27 January 2006, the petition filed on 12 September 2005 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 appeared that Mr. Del Soldato had not received a complete copy of the application papers.

On 03 February 2006, submitted a "Renewed Petition Under 37 CFR 1.47(a)" requesting reconsideration of the Office's decision of 27 January 2006. Petitioner states that Mr. Del Soldato received the application papers via his represented counsel Mr. Fabrizio Conte, who received these papers.

## 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 03 February 2006 has satisfied the requirements under 37 CFR 1.47(a).

Mr. Prakash's averments do 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). In this instance, the application papers were sent to Mr. Del Soldato' counsel Mr. Conte, who acknowledge receipt on May 3, 2005 and on May 25, 2005.

Consequently, the current record does sufficiently establish that Mr. Conte refusal to join in the application because petitioner has shown a *bona fide* attempt was made to deliver the complete application to him and he has refused to sign the 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).

**DECISION**

The petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

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

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing to accept the application as a 37 CFR 1.47(a) application and to mail a filing receipt. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **12 September 2005.**

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3267
Facsimile: (571) 273-0459

12 APR 2006

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O BOX 1450
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Piero DEL SOLDATO
Via Enrico Toti 22
Monza, MI 20052
ITALY

| | | |
|---|---|---|
| In re Aplication of | : | DECISION ON RENEWED |
| Piero DEL SOLDATO et al | : | |
| PCT No.: PCT/EP2003/006496 | : | |
| Application No: 10/515,621 | : | |
| Int. Filing Date: 20 June 2003 | : | PETITION UNDER |
| Priority Date: 25 June 2002 | : | |
| Attorney's Docket No.: 026220-00057 | : | |
| For: ORAL PHARMECEUTICAL FORMS ... | : | |
| IMPROVED BIOAVAILABILITY | : | 37 CFR 1.47(a) |

Dear Mr. Del Soldato:

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

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

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

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1050 Connecticut Avenue, NW
Suite 400
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JUL 14 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

STANLEY H. KREMEN
4 LENAPE LANE
EAST BRUNSWICK NJ 08816

In re Application of
Stanley H. Kremen
Application No. 10/515,640
Filed: December 8, 2004
For: **SYSTEM AND APPARATUS FOR RECORDING, TRANSMITTING, AND PROJECTING THREE-DIMENSIONAL IMAGES**

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition to make special pursuant to 37 C.F.R. §1.102 and MPEP §708.02 (IV) (applicant's age) filed March 24, 2005.

A petition to make special under MPEP §708.02, IV, must show that petitioner is 65 years of age, or more. Acceptable evidence includes a birth certificate, copy of a driver's license, or simply a statement by the applicant. No fee is required.

The petition includes a copy of the inventor's certificate of birth, which reflects a birth date of March 22, 1940, evidencing that the inventor is over 65 years of age.

Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant.

The application file is being forwarded to the examination art unit for expedited prosecution.

Kenneth Wieder
Special Program Examiner
Technology Center 2600
Communications
(571) 272-2986

15 JUN 2006

United States Patent and Trademark Office

d5

Commissioner for Patents
United States Patent and Trademark Office
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www.uspto.gov

Hedman & Costigan, P.C.
1185 Avenue of the Americas
New York, NY 10036-2646

| | | |
|---|---|---|
| In re Application of | : | |
| Bevilacqua | : | |
| Application No.: 10/515,656 | : | DECISION |
| PCT No.: PCT/EP03/05412 | : | |
| Int. Filing Date: 23 May 2003 | : | ON |
| Priority Date: 24 May 2002 | : | |
| Attorney Docket No.: Q84994 | : | PETITION |
| For: A Terpene-Based Composition Of Substances, A Method For Its Preparation And A Method For Its Dispersal Into The Atmosphere | : | |

The petition to revive under 37 CFR 1.137(b) filed 06 March 2006 in the above-captioned application is hereby **GRANTED** as follows:

Petitioner states that "the entire delay in filing the required reply from the due date until the filing of this petition was unintentional." This is being construed as a statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that counsel has filed the required reply to the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed on 29 April 2005 in the form of an executed declaration of the inventor in compliance with 37 CFR 1.497(a) and (b) and the $130.00 surcharge under 37 CFR 1.492(h). It is noted that the signed declaration filed under PCT Rule 4.17(iv) was defective in that it did not identify the application to which it was directed. Applicant has also 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.

This application is being forwarded to the United States Designated/Elected Office for further processing. The date of this application under 35 U.S.C. 371(c)(1), (2) and (4) is **06 March 2006**.

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

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COZEN O'CONNOR, P.C.
1900 MARKET STREET
PHILADELPHIA, PA 19103-3508

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Ned M. Mozier | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7601817 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/13/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,677 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/20/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **908** 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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SOFER & HAROUN LLP.
317 MADISON AVENUE, SUITE 910
NEW YORK NY 10017

In re Patent No. 7,093,752 :
Issued: January 24, 2005 :
Application No. 10/515,701 : ON PETITION
Filed: January 24, 2005 :
Attorney Docket Number: **979-099** :

This is a decision on the petition, filed February 11, 2008 to correct the assignee information on the front of the Patent, which is being treated as a request under 37 CFR 3.81(b)[1]

The petition is **DISMISSED**.

Petitioner states that the assignee's name, PARKEON S.A.S, was inadvertently omitted from the Fee(s) Transmittal form PTOL-85(b) at the time the issue fee was paid. Accordingly, petitioner requests that a certificate of correction be issued to reflect the assignee's name on the front page of the Letters Patent.

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

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

The petition however, is not accompanied by a certificate of correction form (PTO/SB/44) as required by 37 CFR §§ 1.323 and 3.81(b) and thus is not grantable.

---

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

Any request for reconsideration should be filed within **TWO MONTHS** of the date of this decision in order to be considered timely. This time period may not be extended pursuant to 37 CFR 1.136. The application will be retained in the Office of Petitions for **TWO (2) MONTHS** to await petitioner's reply to this decision.

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

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

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

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

05 MAY 2005

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ALEXANDRIA, VA 22313-1450
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Steven H. Noll
Schiff, Hardin, LLP
Patent Department
6600 Sears Tower
Chicago, Illinois 60606-6473

In re Application of :
HORNFELDT, et al. : DECISION ON PETITION
Application No.: 10/515,757 :
PCT No.: PCT/SE03/00636 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 17 April 2003 :
Priority Date: 30 April 2002 :
Atty. Docket No.: P04,0463 :
For: MODULAR IMPLANTABLE MEDICAL DEVICE:
AND MANUFACTURING METHOD THEREFOR:

The petition to revive under 37 CFR 1.137(b) filed 24 November 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National Fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America. 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 17 April 2003 under 35 U.S.C. 363 and will be given a date of **24 November 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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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Rutan & Tucker, LLP
Robert D. Fish
611 ANTON BLVD
SUITE 1400
COSTA MESA CA 92626

In re Application of
Zhen-Hong ZHOU, et al.
Application No. 10/515,771
Filed: September 1, 2005

For: **MOBILE WIRELESS BASE STATION**

DECISION ON PETITION
TO MAKE SPECIAL

This is a decision on the petition filed November 23, 2004 under Manual of Patent Examination Procedure §708.02, section 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
Special Program Examiner
Technology Center 2600

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**Rutan & Tucker, LLP**
**611 Anton Boulevard**
**Suite 1400**
**Costa Mesa, CA 92626**

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SEP 15 2008

In re Application of :
Terry Lee Holcomb-Halstead :
Application No. 10/515,773 : DECISION ON PETITION
Filed: November 23, 2004 : TO WITHDRAW
Attorney Docket No. 100657.0015US1 : 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 18, 2008.

The request is **NOT APPROVED.**

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request cannot be approved because there is no indication that the acts noted in the above-identified certifications have been performed. Refer to Form No. PTO/SB/83 (Updated 4/2008).

The Office cannot further 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).

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

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272- 6735.

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Robert Fish
Fish & Associates, PC
2603 Main Street, Suite 1050
Irvine, CA 92614

UNITED STATES PATENT AND TRADEMARK OFFICE

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**Rutan & Tucker, LLP**
**611 Anton Boulevard**
**Suite 1400**
**Costa Mesa, CA 92626**

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**OFFICE OF PETITIONS**

In re Application of :
Terry Lee Holcomb-Halstead :
Application No. 10/515,773 : DECISION ON PETITION
Filed: November 23, 2004 : TO WITHDRAW
Attorney Docket No. 100657.0015US1 : FROM RECORD
:

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 24, 2008.

The request is **NOT APPROVED.**

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request cannot be approved because there is no indication that the acts noted in the above-identified certifications have been performed. Refer to Form No. PTO/SB/83 (Updated 4/2008).

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

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272- 4618.

Kimberly Inabinet
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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**Rutan & Tucker, LLP**
**611 Anton Boulevard**
**Suite 1400**
**Costa Mesa, CA 92626**

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| | | |
|---|---|---|
| In re Application of | : | |
| Terri Lee et al. | : | |
| Application No. 10/515,773 | : | DECISION ON PETITION |
| Filed: November 23, 2004 | : | TO WITHDRAW |
| Attorney Docket No. 100657.0015US1 | : | FROM RECORD |
| | : | |

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 28, 2008.

The request is **NOT APPROVED.**

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request cannot be approved because there is no indication that the acts noted in the above-identified certifications have been performed. Refer to Form No. PTO/SB/83 (Updated 4/2008).

As stated in previous decisions mailed on September 15, 2008 and October 20, 2008 certifications must be made for a withdrawal of attorney.

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

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272- 4618.

Kimberly Inabinet
Petitions Examiner
Office of Petitions

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Donald Stewart Napier | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7631460 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,790 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 03/13/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **695** 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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MORRISON & FOERSTER LLP
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SAN DIEGO CA 92130-2040

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**OFFICE OF PETITIONS**

In re Application of :
Rudolf F. W. C. Van Beckhoven :
Application No. 10/515,791 : DECISION ON PETITION
Filed: May 28, 2003 : TO WITHDRAW
Attorney Docket No. 246152024100 : 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 30, 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 or the assignee of the entire interest 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 October 19, 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: Rudolf F. W. C. Van Beckhoven
Hofwijkstraat 69
4834 EK BREDA
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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NOV 30 2006

OFFICE OF PETITIONS

In re Application of :
Rudolf F. W. C. Van Beckhoven et al. :
Application No. 10/515,791 :
Filed: November 24, 2004 :
Attorney Docket No. 4662-372 :

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 October 19, 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.

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 October 19, 2006 does not include one of the above two options.

All future communications from the Office will continue to be directed to the address of record 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

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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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OCT 0 2 2006

OFFICE OF PETITIONS

Applicant: Haag
Appl. No.: 10/515,792
International Filing Date: April 30, 2003
Title: SPUTTER METHOD OR DEVICE FOR THE PRODUCTION OF NATURAL VOLTAGE OPTIMIZED COATINGS
Attorney Docket No.: HER07 P-447
Pub. No.: US 2005/0233089 A1
Pub. Date: October 20, 2005

This is a decision on the request for corrected of patent application publication under 37 CFR 1.221(b), received on December 23, 2005, for the above-identified application.

The request is granted.

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

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

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

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HUNTSMAN ADVANCED MATERIALS AMERICAS LLC
10003 WOODLOCH FOREST DRIVE
THE WOODLANDS, TX 77380

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Ranjana C Patel | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7655174 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,793 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/22/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **975** 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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MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

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NOV 29 2006

OFFICE OF PETITIONS

In re Application of :
Wilhelmus H. J. Boesten. Et al. :
Application No. 10/515,800 : DECISION ON PETITION
Filed: July 15, 2005 : TO WITHDRAW
Attorney Docket No. 246152024300 : 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 30, 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 October 3, 2006 does not include the reel and frame number on the statement under 3.76(b).

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: Wilhelmus H. J. Boesten
Brountslaan 9
6132 BJ Sittard
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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NOV 29 2006

**OFFICE OF PETITIONS**

In re Application of
William H. J. Boesten et al.
Application No. 10/515,800
Filed: July 15, 2005
Attorney Docket No. 4662-369

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 October 3, 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.

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 October 3, 2006 does not include the reel and frame number on the statement under 3.73(b).

All future communications from the Office will continue to be directed to the address of record 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

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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/515,800 | 07/15/2005 | Wilhelmus Hubertus Joseph Boesten | 246152024300 |

**CONFIRMATION NO. 8851**

*OC000000021387200*

*OC000000021387200*

25225
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date Mailed: 11/28/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/30/2006.

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

---

April Wise

APRIL M WISE
OP (571) 272-1642

FORMER ATTORNEY/AGENT COPY

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SEP 25 2008

OFFICE OF PETITIONS

In re Application of :
Wilhelmus Hubertus Joseph Boesten et al. :
Application No. 10/515,800 : ON PETITION
Filed: July 15, 2005 :
Attorney Docket No. **4662-369** :

This is a decision on the "Response to the Notice of Abandonment" filed September 12, 2008, which is being treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.

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

This application became abandoned for failure to pay the issue fee on or before June 4, 2007 as was required by the Notice of Allowance mailed March 2, 2007. This application therefore became abandoned on June 5, 2007. Accordingly, a Notice of Abandonment was mailed July 3, 2007.

Petitioner claims that the Notice of Allowance was not received because a previously filed Power of Attorney and Change of Correspondence Address were not processed.

A review of the file reveals however that a power of attorney and address change was filed on December 8, 2006 but that the information was not updated prior to the mailing of the Notice of Allowance and Notice of Allowability on March 2, 2007. Thus, the Notice of Allowance and Notice of Allowability was mailed to the wrong address and as petitioners claim, not received.

In view of the above, no petition fees are due and none have been charged.

The Notice of Abandonment is withdrawn and this matter is being referred to Technology Center 1652 for a re-mailing of the Notice of Allowance and Notice of Allowability.

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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MAR 26 2010

**OFFICE OF PETITIONS**

In re Application of :
Boesten et al. :
Application No. 10/515,800 :
Filed: July 15, 2005 :
Attorney Docket No. 4662-369 :

DECISION ON APPLICATION
FOR PATENT TERM ADJUSTMENT

This is a decision on the "Petition Under 37 CFR § 1.705" filed October 1, 2009. Applicants request the initial determination of patent term adjustment be corrected from zero (0) days to at least one thousand five hundred sixty-four (1,564) days.

The application for patent term adjustment is **granted to the extent indicated herein.**

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 676 days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On April 29, 2009, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b). Applicants were advised of a patent term adjustment to date of 0 days. In response, Applicants timely filed this application for patent term adjustment.[1]

Applicants request the patent term adjustment be corrected to at least 1,564 days.

Issue 1

A reply to an Office action was filed December 14, 2006. A supplemental reply was filed February 22, 2007.

Per 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

> Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days,

[1] Although the issue fee was filed September 29, 2009, and the petition filed October 1, 2009, the petition is timely because the petition includes a certificate of mailing date September 29, 2009.

> if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

The Office entered a 70-day reduction under 37 C.F.R. § 1.704(c)(8) as a result of the filing of the February 22, 2007 reply.

A reduction under 37 C.F.R. § 1.704(c)(8) is unwarranted when a supplemental paper is requested by the examiner. Petitioner asserts the examiner requested the supplemental reply.

The supplemental reply filed February 22, 2007 states,

> On February 7, 2007, the examiner contacted the undersigned to request cancellation of claim 19 because he said that the remaining claims under examination would be allowable pending final approval. He also requested cancellation of non-elected process claims 8-9, 29 and 32. The examiner was advised that the undersigned would need to obtain approval for the amendments from the assignee. This constitutes a statement of the substance of the interview.

Since the February 22, 2007 reply was requested by the examiner, the 70-day reduction under 37 C.F.R. § 1.704(c)(8) is improper.

In view of the prior discussion, the 70-day period of reduction has been removed.

Issue 2

The Office mailed a non-final Office action on July 14, 2006.

A proper request to change the address of record was filed December 8, 2006. The request indicated the address should be changed to the address associated with Customer No. 23117.

A reply to the Office action was filled December 14, 2006. A supplemental reply was filed February 22, 2007.

The Office incorrectly mailed a Notice of Allowance and Notice of Allowability to the former address on March 2, 2007.

The Office mailed a Notice of Abandonment on July 3, 2007.

Applicants filed a "Response to Notice of Abandonment" on September 12, 2008. The Office treated the paper as a petition to withdraw the holding of abandonment. The Office issued a decision granting the petition on September 25, 2008. The decision stated, "The Notice of Abandonment is withdrawn and this matter is being referred to Technology Center 1652 for a re-mailing of the Notice of Allowance and Notice of Allowability."

The Office mailed a new Notice of Allowance and Notice of Allowance on June 29, 2009.

The patent term adjustment mailed with the Notice of Allowance on June 29, 2009, did not include any increase for the Office's delay in the issuance of the June 29, 2009 Notice of Allowance.

Applicants assert the patent term adjustment should include a 942-day increase for the Office's delay in mailing the June 29, 2009 Notice of Allowance. Applicants state the period of delay between the date the Notice of Allowance was mailed to an incorrect address and the date a Notice of Allowance was mailed to the correct address is 942 days. However, the period of Office delay did not begin on the date the Office mailed a Notice of Allowance to the incorrect address. Instead, the period of delay began on the day after the date four months after Applicants filed the December 24, 2006 reply.

37 C.F.R. § 1.703(a)(2) states the period of patent term adjustment includes:

> The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

The number of days beginning on April 15, 2007, the day after the date four months after the December 14, 2006 reply was filed, and ending on June 29, 2009, the date the Office mailed a Notice of Allowance to a correct address, is 746 days.

In view of the prior discussion, the Office has entered an increase in patent term adjustment of 746 days for Office delay under 37 C.F.R. § 1.703(a)(2).

Issue 3

A review of the record indicates the Office did not enter any reduction in patent term adjustment as a result of the filing of the "Response to Notice of Abandonment" on September 12, 2008.

Per 37 C.F.R. § 1.704(c)(4) states,

> [If a party fails] to file a petition to withdraw the holding of abandonment or to revive an application within two months from the mailing date of a notice of abandonment, ... the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date two months from the mailing date of a notice of abandonment and ending on the date a petition to withdraw the holding of abandonment or to revive the application was filed.

The Office mailed a Notice of Abandonment on July 3, 2007. Applicants filed the "Response to Notice of Abandonment" on September 12, 2008. The number of days beginning on September 4, 2007, the day after the date two months after the Office mailed the Notice of Abandonment, and ending on September 12, 2008, is 9 days. Therefore, a reduction of 9 days should have been entered.

In view of the prior discussion, the Office has entered a reduction of 9 days for delay under 37 C.F.R. § 1.704(c)(4).

Issue 4

Applicants state, "Under 37 CFR § 1.702(b), Applicants request that the PTA calculation be at least 683 days with additional days added if the patent does not issue on October 6, 2009."

The request for patent term adjustment under 37 CFR § 1.702(b) is premature.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, an applicant may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee.[2]

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).

---

[2] 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.

## Conclusion

The Office has removed the 70-day reduction entered as a result of the paper filed February 22, 2007.

The Office has entered a 746-day increase in patent term adjustment for Office delay in mailing the June 29, 2009 Notice of Allowance.

The Office has entered a reduction of 9 days under 37 C.F.R. § 1.704(c)(4) for Applicants' delay in filing the Response to Notice of Abandonment.

In addition to the 9 days of delay cited above, Applicants' delay includes a period of delay of 61 days for delay in filing the December 14, 2006 reply. The 61-day reduction is not in dispute. The total period of Applicants' delay is 70 days (9 + 61).

The patent term adjustment at the time of mailing of the June 29, 2009 Notice of Allowance is 676 days which is 746 days of Office delay reduced by 70 days of Applicant delay.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Applicants are reminded 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 application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Anthony Knight
Supervisor
Office of Petitions

Enclosure: Copy of REVISED PALM screen

| PTA Calculations for Application: 10/515800 | | | |
|---|---|---|---|
| Application Filing Date: | 07/15/2005 | PTO Delay (PTO): | 0 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 131 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 676 |
| PTO Delay Adjustment: | 807 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 69 | 03/26/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 131 | | |
| 68 | 03/26/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 676 | | |
| 63 | 06/29/2009 | MAIL CORRECTED NOTICE OF ALLOWANCE | | | |
| 62 | 06/29/2009 | CORRECTED NOTICE OF ALLOWANCE | | | |
| 61 | 09/25/2008 | WITHDRAW PUBLICATION/PRE-EXAM ABANDON | | | |
| 60 | 09/25/2008 | MAIL-PETITION TO REVIVE APPLICATION - GRANTED | | | |
| 59 | 09/25/2008 | PETITION TO REVIVE APPLICATION - GRANTED | | | |
| 58 | 09/23/2008 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 57 | 09/12/2008 | PETITION ENTERED | | | |
| 56 | 07/03/2007 | MAIL ABANDONMENT FOR FAILURE TO PAY ISSUE FEE | | | |
| 55 | 07/03/2007 | ABANDONMENT FOR FAILURE TO PAY ISSUE FEE | | | |
| 54 | 03/28/2007 | FINISHED INITIAL DATA CAPTURE | | | |
| 53 | 03/15/2007 | SEQUENCE FORWARDED TO PUBS ON TAPE | | | |
| 52 | 03/05/2007 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 51 | 03/02/2007 | MAIL NOTICE OF ALLOWANCE | | | |
| 50 | 03/01/2007 | DOCUMENT VERIFICATION | | | |
| 49 | 02/22/2007 | ISSUE REVISION COMPLETED | | | |
| 48 | 03/01/2007 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 47 | 02/20/2007 | NOTICE OF ALLOWABILITY | | | |
| 46 | 03/09/2007 | DATE FORWARDED TO EXAMINER | | | |
| 45 | 02/22/2007 | SUPPLEMENTAL RESPONSE | | 70 | 37 |
| 41 | 03/01/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |

| | | | | | |
|---|---|---|---|---|---|
| 38 | 01/08/2007 | DATE FORWARDED TO EXAMINER | | | |
| 37 | 12/14/2006 | RESPONSE AFTER NON-FINAL ACTION | | 61 | 30 |
| 36 | 12/14/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 35 | 12/01/2006 | MAIL-PETITION DECISION - DISMISSED | | | |
| 33 | 11/28/2006 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 32 | 11/28/2006 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 31 | 08/30/2006 | PETITION ENTERED | | | |
| 30 | 07/14/2006 | MAIL NON-FINAL REJECTION | | | |
| 29 | 07/10/2006 | NON-FINAL REJECTION | | | |
| 27 | 05/07/2006 | DATE FORWARDED TO EXAMINER | | | |
| 26 | 04/27/2006 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 25 | 04/27/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 24 | 02/24/2006 | MAIL RESTRICTION REQUIREMENT | | | |
| 23 | 02/21/2006 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 22 | 01/18/2006 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 21 | 01/18/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 20 | 07/15/2005 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | | |
| 16 | 11/17/2005 | CLEARED BY OIPE CSR | | | |
| 15 | 11/17/2005 | CLEARED BY OIPE CSR | | | |
| 14 | 11/17/2005 | CLEARED BY OIPE CSR | | | |
| 13 | 11/17/2005 | CLEARED BY OIPE CSR | | | |
| 12 | 11/17/2005 | CLEARED BY OIPE CSR | | | |
| 11 | 07/15/2005 | 371 COMPLETION DATE | | | |
| 10 | 11/08/2005 | APPLICATION DISPATCHED FROM OIPE | | | |
| 9 | 11/08/2005 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 8 | 10/25/2005 | PCT CLASSIFICATION | | | |
| 7 | 07/15/2005 | ADDITIONAL APPLICATION FILING FEES | | | |
| 5 | 07/15/2005 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |

**Search Another: Application#** [ ] Search

**EXPLANATION OF PTA CALCULATION**

## EXPLANATION OF PTE CALCULATION

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to OASIS | Home page

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

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Eric E. Schadt | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7653491 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,804 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/24/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **886** 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
03 MAR 2006

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United States Patent and Trademark Office
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Blakely Sokoloff Taylor & Zafman
12400 Wilshire Blvd, 7th Floor
Los Angeles, CA 90025

| | | |
|---|---|---|
| In re Application of | : | |
| Ozil | : | |
| Application No.: 10/515,806 | : | DECISION |
| PCT No.: PCT/FR03/01499 | : | |
| Int. Filing Date: 16 May 2003 | : | ON |
| Priority Date: 21 May 2002 | : | |
| Attorney Docket No.: 15675P554 | : | PETITION |
| For: Cell Culture Device | : | |

This is in response to the petition under 37 CFR 1.137(b) filed on 28 October 2005.

## BACKGROUND

This international application was filed on 16 May 2003, claimed an earlier priority date of 21 May 2002, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 27 November 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 21 November 2004. Applicant filed *inter alia* the basic national fee on 19 November 2004.

On 10 May 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant, requiring the submission of an executed oath or declaration and a surcharge under 37 CFR 1.492(e).

On 31 May 2005, applicant filed a response, including the surcharge and a declaration.

On 15 September 2005, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to applicant, stating that the declaration filed on 31 May 2005 was defective because "the 2nd and 3rd inventors are not listed of the published International Application. Please clarify."

## DISCUSSION

The instant petition is accompanied by a "Response To Notification of Defective Response" which states that "the Declaration listing the second and third inventors was submitted in error. Accordingly, submitted herewith is a corrected Declaration listing only the inventor identified in the International application." Review of the declaration filed on 28 October 2005 reveals that nominates the same inventive entity as the published international application, and that it is in compliance with 37 CFR 1.497(a) and (b). As such, counsel has now filed all of the elements required by the Notification of Missing Requirements mailed on 10 May 2005. Counsel's Deposit Account No. 02-2666 is being charged in the amount of $1590.00 for a four-month extension of time under 37 CFR 1.136(a), as authorized by the instant "Response..." Since applicant is deemed to have timely replied to the Notification of Missing Requirements, the petition under 37 CFR 1.137(b) is not necessary, and the $1500.00 petition fee is being refunded to Counsel's Deposit Account.

## DECISION

The petition under 37 CFR 1.137(b) is **DISMISSED AS MOOT**, without prejudice.

This application is being forwarded to the National Stage Processing Branch for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **28 October 2005**.

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

10 MAY 2005

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David Klein
SUGHRUE MION, PLLC
2100 Pennsylvania Ave., N.W.
Washington, DC 20037

In re Application of :
HIRTSIEFER, Artur *et al* :
Application No.: 10/515,835 :
PCT No.: PCT/EP03/00168 :
Int. Filing Date: 21 May 2003 : **DECISION**
Priority Date: 21 May 2002 :
Attorney Docket No.: Q85094 :
For: DOOR SETTING DEVICE :

Applicants' "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed with the national stage papers on 29 November 2004 is hereby **GRANTED** as follows:

The basic national fee and petition fee have been paid. Applicants state that "[t]he entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of $130.00 have been provided.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 21 May 2003, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 22 March 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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FAIRFAX, VA 22030

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OFFICE OF PETITIONS

In re Application of :
Zoran Milijasevic, et al. :
Application No. 10/515,840 : DECISION ON PETITION
Filed: September 14, 2005 : TO WITHDRAW
Attorney Docket No. COCH-0120-US1 : 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 10, 2007.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Jagtiani & Guttag has been revoked by the assignee of the patent application on November 13, 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: JAYNE ANDREWS, PATENT MANAGER
COCHLEAR LIMITED
14-16 MARS ROAD
LANE COVE, NSW 2066
AUSTRALIA

17 MAY 2006



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PATENT GROUP
DLA PIPER RUDNICK GRAY CARY US LLP
1200 Nineteenth Street, N.W.
Washington, D.C. 20036-2412

| | | |
|---|---|---|
| In re Application of: | : | |
| POLLARD, Harvey, B. | : | DECISION ON PETITION TO |
| U.S. Application No.: 10/515,844 | : | CORRECT INVENTORSHIP |
| PCT No.: PCT/US03/17012 | : | |
| International Filing Date: 29 May 2003 | : | |
| Priority Date: 29 May 2002 | : | |
| Attorney's Docket No.: 9551-015-27 NATL | : | |
| For: METHODS OF IDENTIFYING GENOMIC AND PROTEOMIC BIOMARKERS FOR CYSTIC FIBROSIS, ARRAYS COMPRISING THE BIOMARKERS AND METHODS OF USING SAME | : | |

This decision is issued in response to the "Response To Notice To File Missing Parts Of Application" filed 24 April 2006, treated in part herein as a request under 37 CFR 1.497(d) to correct the inventorship of the present national stage application. Deposit Account No. 50-1442 will be charged the required processing fee.

## BACKGROUND

On 29 May 2003, applicant filed international application PCT/US03/17012. The application claimed a priority date of 29 May 2002 and designated the United States. The published international application identified one applicant/inventor for the United States: Harvey B. POLLARD.

The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 29 November 2004.

On 29 November 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 23 November 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration in compliance with 37 CFR 1.497 was required.

On 24 April 2006, applicant filed a response to the Notification Of Missing Requirements (with required three month extension fee) that included a declaration which identified six

additional inventors beyond the sole inventor identified on the international application. The submission of this declaration is treated herein as a request to add the six additional inventors to the present application under 37 CFR 1.497(d).

## DISCUSSION

The declaration filed by applicants on 24 April 2006 identifies and is executed by seven inventors: Harvey B. POLLARD, David JACOBWITZ, Greg MUELLER, Ofer EIDELMAN, Meera SRIVASTAVA, William GUGGINO, and Pamela ZEITLIN. This does not correspond to the inventorship listed on the international application, which listed Harvey B. POLLARD as the sole applicant/inventor.

The present submission is treated as a request to correct the inventorship so as to add the six additional inventors listed on the declaration.

Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

> (d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:
>
> > (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
> >
> > (2) The processing fee set forth in § 1.17(i); and
> >
> > (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).
> >
> > (4) any new oath or declaration required by paragraph (f) of this subsection.[1]

Here, applicant's 24 April 2006 submission included a statement executed by the six added inventors confirming that the error in inventorship occurred without deceptive intent. Item (1) is therefore satisfied.

---

[1] Item (4) does not apply to the present application.

The submission includes an authorization to charge Deposit Account No. 50-1442 for required fees. Pursuant to this authorization, the Deposit Account will be charged the required $130 processing fee. Item (2) is therefore satisfied.

Applicant has not, however, provided the assignee's consent to the request to correct inventorship. Applicant must provide such consent before item (3) can be considered satisfied. Such consent must be accompanied by a statement under 37 CFR 3.73(b) which includes either a copy of the assignment documents or a specific reference to the assignment's recorded location in the USPTO (i.e., reel and frame number) (see 37 CFR 3.73(b)).

Because applicant has not satisfied all the requirements of 37 CFR 1.497(d), the six additional inventors listed on the filed declaration cannot be added to the application on the present record. The declaration filed 24 April 2006 is therefore unacceptable (at present) for failure to properly identify the inventorship of record herein.

## CONCLUSION

Applicant's request to add six additional inventors under 37 CFR 1.497(d) is **DISMISSED** without prejudice. The sole inventor of record remains Harvey B. POLLARD, the inventor named on the international application.

The declaration filed on 24 April 2006 is not acceptable under 37 CFR 1.497 in that the declaration does not properly identify the inventorship of record herein.

Applicant must file a proper response to this decision within **TWO (2) MONTHS** from the mail date indicated above. Any such response must include the consent of the assignee to the requested correct of inventorship (in the form required by 37 CFR 3.73(b)).

Failure to file a timely and 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 the Assistant Commissioner for Patents, Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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

01 AUG 2006

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PATENT GROUP
DLA PIPER RUDNICK GRAY CARY US LLP
1200 Nineteenth Street, N.W.
Washington, D.C. 20036-2412

In re Application of:
POLLARD, Harvey, B.
U.S. Application No.: 10/515,844
PCT No.: PCT/US03/17012
International Filing Date: 29 May 2003
Priority Date: 29 May 2002
Attorney's Docket No.: 9551-015-27 NATL
For: METHODS OF IDENTIFYING GENOMIC AND PROTEOMIC BIOMARKERS FOR CYSTIC FIBROSIS, ARRAYS COMPRISING THE BIOMARKERS AND METHODS OF USING SAME

DECISION ON RENEWED REQUEST UNDER 37 CFR 1.497(d)

This decision is in response to the "Response To Decision On Petition To Correct Inventorship" filed 19 June 2006. No petition fee is required.

## BACKGROUND

The procedural background for this application is set forth in detail in the decision mailed by this Office on 17 May 2006. In that decision, applicant's original request to add six additional inventors to the present application was dismissed without prejudice for failure to satisfy all the requirements of 37 CFR 1.497(d). Specifically, applicant had failed to provide the consent of the assignee to the requested change in inventorship.

On 19 June 2006, applicant filed the "Response To Decision On Petition To Correct Inventorship" considered herein as a renewed request.

## DISCUSSION

Applicant's present submission includes a "Statement Under 37 CFR 3.73(b)" executed on behalf of the assignee by its President, John W. LOWE, accompanied by copies of the relevant Assignments, as required. However, applicant did not submit a statement from Mr. LOWE consenting, on behalf of the assignee, to the requested change in inventorship. Applicant has therefore failed to satisfy the final requirement for a grantable request to correct inventorship under 37 CFR 1.497(d).

In addition, applicant asserts that the $130 processing fee charged to applicant's Deposit Account pursuant to the previous decision was unnecessary, based on applicant's earlier payment of the $130 surcharge for filing the declaration later than thirty months after the priority date. However, the $130 processing fee referred to in the previous decision is the processing fee required under 37 CFR 1.497(d)(2) for correction of inventorship; this processing fee is separate and apart from the $130 surcharge for failure to timely file the declaration. Accordingly, charging applicant the additional $130 processing fee with respect to the request to correct invetorship was appropriate, regardless of applicant's prior payment of the $130 surcharge.

## CONCLUSION

Applicant's renewed request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

The declaration filed 24 April 2006 remains unacceptable for failure to identify the inventors of record herein.

Applicant must file a proper response to this decision within **TWO (2) MONTHS** of the mail date of this decision indicated above. Any such response must include a statement of consent from the assignee to the requested correction of inventorship (in the form required under 37 CFR 3.73(b).

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

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

#13

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1200 Nineteenth Street, N.W.
Washington, D.C. 20036-2412

In re Application of:
POLLARD, Harvey, B., et al.
U.S. Application No.: 10/515,844
PCT No.: PCT/US03/17012
International Filing Date: 29 May 2003
Priority Date: 29 May 2002
Attorney's Docket No.: 9551-015-27 NATL
For: METHODS OF IDENTIFYING GENOMIC AND PROTEOMIC BIOMARKERS FOR CYSTIC FIBROSIS, ARRAYS COMPRISING THE BIOMARKERS AND METHODS OF USING SAME

DECISION ON SECOND RENEWED REQUEST TO CORRECT INVENTORSHIP (37 CFR 1.497(d))

This decision is in response to the correspondence filed by applicants on 28 August 2006, treated herein as a second renewed submission under 37 CFR 1.497(d). No petition fee is required.

## BACKGROUND

The procedural background for this application is set forth in detail in the decisions mailed by this Office on 17 May 2006 and 01 August 2006. Those decisions dismissed applicants' request to add six additional inventors to the present application for failure to satisfy all the requirements of 37 CFR 1.497(d). Specifically, applicant had failed to provide the consent of the assignee, in the required form.

On 28 August 2006, applicant filed the response to the 01 August 2006 submission treated herein as a second renewed request under 37 CFR 1.497(d).

## DISCUSSION

The 28 August 2006 submission includes the required consent of the assignee to the requested addition of David JACOBWITZ, Greg MUELLER, Ofer EIDELMAN, Meera SRIVASTAVA, William GUGGINO, and Pamela ZEITLIN as additional inventors herein. This submission, in combination with the previously filed materials, satisfies the requirements of 37 CFR 1.497(d). Accordingly, the request to add the six additional inventors herein is appropriately granted.

## CONCLUSION

Applicants' renewed request under 37 CFR 1.497(d) is **GRANTED**.

David JACOBWITZ, Greg MUELLER, Ofer EIDELMAN, Meera SRIVASTAVA, William GUGGINO, and Pamela ZEITLIN are added as additional inventors herein.

Taking into consideration the addition of these inventors, the declaration filed 24 April 2006 is now acceptable under 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 24 April 2006.

Richard M. Ross
Attorney Advisor
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624 NINTH STREET, NW
SUITE 300
WASHINGTON DC 20001-5303

**MAILED**

JUL 13 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent of Takahashi et al. | : | DECISION ON REQUEST |
| Patent No. 7,619,092 | : | FOR RECONSIDERATION OF |
| Issue Date: November 17, 2009 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/515,845 | : | AND NOTICE OF INTENT TO |
| Filing Date: June 13, 2005 | : | ISSUE CERTIFICATE OF |
| Attorney Docket No. TAKAHASHI36 | : | CORRECTION |

This is a decision on the petition filed on January 19, 2010, which is being treated as a petition under 37 C.F.R. § 1.705(d) requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by nine hundred twenty (920) days.

The petition to correct the patent term adjustment indicated on the patent to indicate the term of the patent is extended or adjusted by nine hundred twenty (920) days is **GRANTED**.

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 **nine hundred twenty (920)** 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. | : | 7,619,092 B2 |
| APPLICATION NO. | : | 10/515,845 |
| DATED | : | November 17, 2009 |
| INVENTOR(S) | : | Masami Takahashi et al. |

**DRAFT**

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

On the Title page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 559 days.

Delete the phrase "by 559 days" and insert -- by 920 days--

19 SEP 2005

#5

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Alan Zombeck
Mail Stop CO1232
DOW CORNING CORPORATION
2200 West Salzburg Road
P.O. Box 994
Midland, Michigan 48686-0994

In re Application of :
CHORVATH, Igor *et al* :
U.S. Application No.: 10/515,869 :
PCT No.: PCT/US03/17799 :
Int. Filing Date: 06 June 2003 : **DECISION**
Priority Date: 06 June 2002 :
Attorney Docket No.: DC5016PCT1 :
For: FLUOROCARBON ELASTOMER :
SILICONE VULCANIZATES :

This decision is in response to papers filed 23 June 2005.

## BACKGROUND

On 24 November 2004, applicants filed papers to enter the national stage of PCT/US03/17799.

On 26 April 2005, 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 of the inventors and a $130.00 surcharge fee was required.

On 23 June 2005, applicants filed a response which included a petition under 37 CFR 1.47(a) and authorization to charge the $130.00 surcharge fee to Deposit Account No. 04-1250.

## DISCUSSION

A review of the papers filed in the instant petition shows that a declaration executed by all seven joint inventors was submitted with the PCT Request pursuant to PCT Rules 4.17(iv) and *26ter*.

This declaration is in compliance with 37 CFR 1.497(a) and (b). Accordingly, a petition under 37 CFR 1.47(a) is not required.

The surcharge fee of $130.00 will be credited back to applicants' Deposit

Account.

## CONCLUSION

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

The Form PCT/DO/EO/905 mailed 26 April 2005 was sent in error and is hereby **VACATED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 06 June 2003, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 24 November 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

14 AUG 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Midland, MI 48686-0994

| | | |
|---|---|---|
| In re Application of | : | |
| CHORVATH, et al. | : | DECISION ON |
| Application No.: 10/515,876 | : | |
| PCT No.: PCT/US03/17796 | : | REQUEST UNDER |
| Int. Filing Date: 06 June 2003 | : | |
| Priority Date: 06 June 2002 | : | 37 CFR 1.497(d) |
| Attorney Docket No.: DC5016PCT2 | : | |
| For: FLUOROCARBON ELASTOMER SILICONE VULCANIZATES | : | |

This decision is in response to applicant's "Correction of Oath or Declaration Under 37 C.F.R. 1.497(d)" filed 17 February 2006 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 06 June 2003, applicant filed international application PCT/US03/17796, which claimed priority of an earlier application filed 06 June 2002. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 06 December 2004.

On 24 November 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 First Preliminary Amendment.

On 28 July 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 08 August 2005, applicant filed a response containing an executed declaration of the inventors.

On 17 January 2006, applicant was mailed a "Notification of Defective Response" (Form PCT/DO/EO/916) indicating that the filed declaration was defective as it was executed by two individuals, Gerald Gornowicz and Yung Kim, who were not listed as inventors on the published international application. Applicant was afforded one month to file a response.

On 17 February 2006, applicant filed the present petition to delete Gerald Gornowicz and Yung Kim as an inventors in the above-identified application.

## 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:

(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(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).

Applicant has satisfied items (1) and (3) and item (4) does not apply.

As to Item (2), the declaration presently filed does not comply with 37 CFR 1.497(a)-(b) as it does not identify the application to which it is directed. As such, a proper declaration executed by the actual inventors is still required.

In light of the above, it is not possible to grant applicant's petition at this time.

## CONCLUSION

For the reasons above, applicant's request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file any request for reconsideration. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be 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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Office of PCT Legal Administration
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29 SEP 2006

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In re Application of :
CHORVATH, et al. : DECISION ON RENEWED
U.S. Application No.: 10/515,876 :
PCT No.: PCT/US03/17796 : PETITION UNDER
Int. Filing Date: 06 June 2003 :
Priority Date: 06 June 2002 : 37 CFR 1.497(d)
Atty Docket No.: DC5016PCT2 :
For: FLUOROCARBON ELASTOMER SILICONE :
VULCANIZATES :

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.497(d)" filed 23 August 2006 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 14 August 2006, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.497(d). Applicant was afforded two months to file any request for reconsideration.

On 23 August 2006, applicant filed the present renewed petition.

## DISCUSSION

As detailed in the decision mailed 14 August 2006, a request under 37 CFR 1.497(d) [formally, 37 CFR 1.48] 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(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).

The decision mailed 14 August 2006 indicated that applicant previously satisfied items (1) and (3) and that item (4) did not apply. With the present filing; copy of the declaration filed in the international application and explanation from counsel, applicant has satisfied item (2) and it is proper to grant applicant's renewed petition at this time.

## CONCLUSION

For the reasons discussed above, the renewed request under 37 CFR 1.497(d) is **GRANTED**.

A review of the application papers reveals that applicant has now completed all the requirements of 35 U.S.C. 371 for entry into the national stage. This application has an international application filing date of 06 June 2003 and will be given a date of **24 November 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

The application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.

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UNITED STATES DEPARTMENT OF COMMERCE
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700 KOPPERS BUILDING
436 SEVENTH AVENUE
PITTSBURGH, PA 15219

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Jan Roelof Van Der Meer | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7625744 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/01/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,877 | : 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 **862** 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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Mail Date: 05/18/2010

**Applicant** : Jan Roelof Van Der Meer
**Patent Number** : 7625744
**Issue Date** : 12/01/2009
**Application No**: 10/515,877
**Filed** : 06/06/2005

: 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 **897** 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).

28 SEP 2005

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| In re Application of | : | |
| NAKAYAMA, Tatsuo | : | DECISION ON |
| Application No.: 10/515,886 | : | |
| Filing Date: 29 November 2004 | : | PETITION |
| Attorney Docket No.: NEG-287PCT-US | : | |
| For: SEMICONDUCTOR DEVICE | : | UNDER 37 CFR 1.182 |

This decision is in response to applicants' "Petition Under 37 C.F.R. §1.182," filed in the United States Patent and Trademark Office on 28 December 2004.

## BACKGROUND

On 21 May 2003, applicants filed international application PCT/JP03/06315, claiming a priority date of 31 May 2002. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 11 December 2003. The thirty month period for paying the basic national fee in the United States expired on 30 November 2004.

On 29 November 2003, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration, making a claim of priority to PCT/JP03/06315 under 35 U.S.C. §120.

On 28 December 2004, applicants submitted the instant petition accompanied by a preliminary amendment to add the priority claim to the international application to the specification.

## DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

> The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.

The transmittal letter (Form PTO-1390) filed on 29 November 2004 identified the application as "a filing under 35 U.S.C. 371." However, the declaration listed a claim of benefit under 35 U.S.C. §120 to the international application. Applicants' benefit claim under §120 to the international application is inconsistent with a filing under 35 U.S.C. §371. See MPEP 1893.03(a). The $400 fee for the filing of this petition will be charged to Deposit Acct. No. 50-0481, as authorized. Applicants' application will be processed under 35 U.S.C. §111, as requested.

## CONCLUSION

For the above reasons, the petition under 37 CFR 1.182 to convert the national stage filing into a filing under 35 U.S.C. §111 is **GRANTED**.

This application is accepted as an application filed under 35 U.S.C. §111(a) with a filing date of 29 November 2004.

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

This application is being forwarded to the National Stage Processing Branch of the International Division for processing in accordance with this decision, that is for (1) correction of information in PALM (computer database) and (2) correction of fees. Afterwards, the application will be forwarded to the Office of Initial Patent Examination for processing as a national application filed under 35 U.S.C. §111(a) with a filing date of **29 November 2004**.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
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24 JAN 2008

J. Michael Neary
53939 Pine Grove Road
LaPine OR 97739

| | | |
|---|---|---|
| In re Application of | : | |
| Eric Thompson | : | |
| Application No. 10/515,907 | : | DECISION ON PETITION |
| Filed: November 26, 2004 | : | UNDER 37 CFR 1.78(a)(3) AND (a)(6) |
| Attorney Docket No. TH/VDS/US | : | |

This is a decision on the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed 17 October 2007, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of priority to the prior-filed applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000 and after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

**(1)** the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§1.78(a)(2)(i) and 1.78(a)(5)(i) to the prior-filed applications, unless previously submitted;

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

**(3)** a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

Initially, it is noted that the amendment adding references to the prior applications to the specification has been filed under the provisions of 37 CFR 1.116. As such, entry of the amendment is not a matter of right. Entry of such amendments are decided by the examiner. Regardless of whether the amendment is entered, the instant petition cannot be granted because the petition does not comply with item (1) and (2).

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional or international 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 that the application is "related" to a nonprovisional or international application does not comply with 37 CFR 1.78(a)(2)(i). In the present case, the reference fails to identify the proper relationship to PCT/US99/12536 and US application 09/730,141. *See* MPEP Section 201.11 and 1895.

Similarly, petitioner has not provided a proper reference to the provisional application. Merely identifying an application as "related" is not, *ipso facto*, a claim of priority to such application. A proper reference would be, e.g., "This application claims the benefit of U.S. Provisional Application no.: 60/_____ filed _____" *See* MPEP 201.11, section III, B.

Before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition and either an Application Data Sheet or a substitute amendment (complying with the provisions of 37 CFR 1.121 or 37 CFR 1.76(b)(5)) to correct the above matters are required.

In addition, a review of USPTO records indicates that applicant provided a petition fee payment of $1400.00. The required petition fee is $1410.00. As payment was made by credit card and deposit account authorization was not provided it was not possible to charge the additional $10.00.

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

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Alexandria, VA 22313-1450

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

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

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

This application is being forwarded to Group Art Unit 2835 for processing, as deemed appropriate, of the amendment filed under 37 CFR 1.116.

Boris Milef
Legal Examiner
Office of Petitions and PCT Legal Administration

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JUN 2 2008

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J. Michael Neary
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In re Application of:
ERIC THOMPSON
Serial No.: 10/515,907
Filed: 26 November 2004
Docket Number TH/VDS/US
Title: VERTICAL DOCKING STATION

DECISION ON PETITION
TO WITHDRAW HOLDING
OF ABANDONMENT

This is a decision on the petition filed on February 22, 2008, to review the Office actions and withdraw any holding of abandonment of the above-identified application under 37 C.F.R. § 1.181.

The petition is **GRANTED**.

A Final Office action was mailed on May 17, 2007, setting a three-month shortened statutory period for reply. In the Final Office action, claims 1-7, 10-19, 22 and 23 were finally rejected on various grounds, claims 8 and 9 were objected to because they dependent on a rejected base claim but would be allowable if rewritten in independent form and including all the limitations of the base claim and any intervening claims, and claims 20 and 21 were allowed.

A reply to the final Office action was filed on October 17, 2007 along with a petition for extension of time and requisite fee. In the reply, applicant proposed canceling claims 1-6, 8, 10-19, 22 and 23. Claim 7 is amended to incorporate the subject matter of claim 8, claim 9 is amended to be in independent form and to include the subject matter of finally rejected claim 7 that it depended from. Previously allowed claims 20 and 20 remained unchanged.

On February 5, 2008, an Advisory Action was issued indicating that the reply filed October19 [sic, 17], 2007 would not be entered and, for purpose of appeal, claims 1-20, 22 and 23 would be rejected and claim 21 would be objected to. Accompanying the Advisory Action was an Examiner-Initiated Interview Summary wherein it is indicated that claims 7, 9, 20 and 21 and US patent No. 6,256,193 were discussed and "Examiner suggested Examiner's amendment to place case in condition for allowance. Applicant would like to review further options."

The instant petition was filed on February 22, 2008. The examiner held the application abandoned and mailed a Notice of Abandonment on February 25, 2008.

Petitioner asserts that the application should not be held abandoned because the after-final amendment under 37 CFR 1.116 should properly be entered because it incorporated "the subject matter of the allowable claims into all the remaining claims in the application." It is also asserted that after indicating that claim 20 was allowed, the examiner changed his position without entering a rejection of claim 20 and thus denied the applicant an opportunity to prosecute.

Entry of an amendment presented after final rejection is governed by 37 CFR 1.116. 37 CFR 1.116(b)(1) states:

> "An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action."

The right to appeal a rejected claim is provided by 35 USC 134(a) which states as follows:

> "An applicant for a 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."

A review of the prosecution history and the proposed after final amendment filed October 17, 2007, indicates that applicant has addressed all the rejections and objections raised in the Final Office action and did not raise any new issue that required further consideration or search. Pursuant to 37 CFR 1.116(b)(1), the amendment filed October 17, 2008, should be entered because it canceled the finally rejected claims and placed the allowable subject matter of the finally objected claims in independent form. Since the amendment addresses all the rejections and objections raised by the examiner in the Final Office action as specified in 37 CFR 1.113(b), it is a proper reply within the meaning of 37 CFR 1.113(a) and (c) that stops the statutory period set in the Final Office action.

The examiner has denied entry of the after-final amendment without indicating his basis for such denial. Furthermore, in the Advisory Action, it is indicated that claim 20, along with other claims, would be rejected on appeal. However, the file record does not include a rejection of claim 20. It is clear that, pursuant to 35 USC 134, petitioner could not appeal claim 20 since this claim has not been rejected as being unpatentable. On the contrary, the current file record indicates that claim 20 and 21 are allowable. If the examiner withdraws the indication of allowability of claims 20 and 21, he must reopen prosecution and enter his new position of record.

The amendment filed should properly be entered and prosecution should have been re-opened to make any rejection of previously allowed claim 20 of record.

The examiner's denial of entry of the amendment filed October 17, 2007 was not proper and must be reversed. The amendment filed October 17, 2007 will be entered and prosecution will be reopened and an Office action will be issued in due course.

In view of the entry of amendment filed October 17, 2007, the application is not abandoned in fact. The Notice of Abandonment mailed February 25, 2008 is hereby vacated.
The application is being referred to the examiner for further action consistent with this decision. An Office action will be mailed in due course.

Any inquiry regarding this decision should be directed to Hien H. Phan, Quality Assurance Specialist, at (571) 272-1606.

Sharon A. Gibson, Director
Technology Center 2800 - Semiconductors,
Electrical & Optical Systems & Components

03 APR 2009

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| In re Application of | : | |
| Eric Thompson | : | |
| Application No. 10/515,907 | : | DECISION ON PETITION |
| Filed: November 26, 2004 | : | UNDER 37 CFR 1.78(a)(3) AND (a)(6) |
| Attorney Docket No. TH/VDS/US | : | |

This is a decision on the petitions under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed 26 January 2009, to accept an unintentionally delayed claim under 35 U.S.C. §§120, 365(c) and 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3) and 1.78(a)(6).

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

**(1)** the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The petition fails to comply with item (1) above.

It is not proper to have a continuation-in-part of a provisional application. The Manual of Patent Examining Procedure §201.08 states that:

An application claiming the benefit of a provisional application under 35 U.S.C. 119(e) should not be called a "continuation-in-part" of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application.

In addition, applicant cannot claim benefit to application 09/730,141, PCT/US1999/012536 and 60/088,477 because application 09/730,141 issued as a patent on 03 December 2002 and was therefore not copending with the present application which was not filed until 22 May 2003.

Accordingly, before the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) and an appropriate amendment as outlined above must be filed.

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

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

0 3 JUN 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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

J. Michael Neary
53939 Pine Grove Road
LaPine OR 97739

| | | |
|---|---|---|
| In re Application of | : | |
| Eric Thompson | : | |
| Application No. 10/515,907 | : | DECISION ON PETITION |
| Filed: November 26, 2004 | : | UNDER 37 CFR 1.78(a)(3) AND (a)(6) |
| Attorney Docket No. TH/VDS/US | : | |

This is a decision on the petitions under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), filed 04 May 2009, to accept an unintentionally delayed claim under 35 U.S.C. §§120, 365(c) and 119(e) for the benefit of the prior-filed applications set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3) and 1.78(a)(6).

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

**(1)** the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The petition fails to comply with item (1) above.

It is not proper to have a continuation-in-part of a provisional application. The Manual of Patent Examining Procedure §201.08 states that:

An application claiming the benefit of a provisional application under 35 U.S.C. 119(e) should not be called a "continuation-in-part" of the provisional application since an application that claims benefit of a provisional application is a nonprovisional application of a provisional application, not a continuation, division, or continuation-in-part of the provisional application.

Applicant has not submitted a new amendment rectifying the above issue.

As detailed in the decision mailed 03 April 2009, applicant cannot claim benefit to application 09/730,141, PCT/US1999/012536 and 60/088,477 because application 09/730,141 issued as a patent on 03 December 2002 and was therefore not copending with the present application which was not filed until 22 May 2003. Applicant's desired interpretation of 37 CFR 1.78 as submitted in the present renewed petition is incorrect.

35 U.S.C. 120 specifies that an application (e.g. the present application 10/515,907) for patent for an invention disclosed in a previous application (e.g. application 09/730,141) shall have the same effect as though filed on the date of the prior application, if filed before the patenting or abandonment of either: (1) the first application or (2) an application similarly entitled to the benefit of the filing date of the first application.

In the present case, application 09/730,141 was patented on December 3, 2002, prior to May 22, 2003 (i.e. the filing date of the present application.) Therefore, the present application may claim benefit under 35 U.S.C. 120 to application 09/730,141 only if the present application was filed before the patenting or abandonment of an application entitled to the benefit of the filing date of application 09/730,141.

The petition states that provisional application number 60/383,964 should be entitled to the benefit of the filing date of application 09/730,141. However, a provisional application, by law, is not entitled to the benefit of an earlier application. 35 U.S.C. 111(b)(7). Therefore, under 35 U.S.C. 120, the present application is not entitled to the benefit of the filing date of application 09/730,141.

Accordingly, before the petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition under 37 CFR 1.78(a)(3) and 1.78(a)(6) and an appropriate amendment as outlined above must be filed.

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

By mail:
Mail Stop PCT
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

Bryan Lin
Legal Examiner
Office of PCT Legal Administration

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Commissioner for Patents
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Alexandria, VA 22313-1450
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Patent No. : 7,556,828 B2
Ser. No. : 10/515,910
Inventor(s) : Zhang et al.
Issued : Jul. 7, 2009
Title : PHARMACEUTICAL COMPOSITION FOR TREATMENT OF BPH AND PREPARATION THEREOF

Docket No. : 1383-001

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

By fax: (571) 273-0025
ATTN: Office of Petitions

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

**Ennis Young**
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) **756-1542** or (703) 756-1814

10/515910

1383-001

COFC

OIPE IAP10
SEP 11 2009
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK OPERATION

| | | |
|---|---|---|
| U.S. Patent No. | : | 7,556,828 |
| Granted | : | July 7, 2009 |
| Applicant(s) | : | Zhang Zuguang et al. |
| For | : | PHARMACEUTICAL COMPOSITION FOR THE TREATMENT OF BPH AND PREPARATION THEREOF |
| Based on | : | Serial No. 10/515,910 |
| Filed | : | November 24, 2004 |

New York, NY 10036
September 8, 2009

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

## REQUEST FOR A CERTIFICATE OF CORRECTION

Sir:

It is respectfully requested that a Certificate of Correction be issued for Patent No. 7,556,828, issued on July 7, 2009. The patentee encloses herewith two copies of request for a Certificate of Correction with the requested change enclosed.

I hereby certify that this correspondence is being deposited with the United States Postal Service on **September 8, 2009** as first class mail in an envelope addressed to:

Mail Stop Petitions
Commissioner for Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Kenneth F. Florek
Registration No. 33,173

Applicants' failure to include the correct assignee's name on the PTOL-85 submission was inadvertent. Additionally, a copy of the Notice of Recordation of Assignment, showing that assignment to Beijing Wonner Biotech Ltd. Co. of Beijing, P.R. China was recorded at reel 015803/frame 0476, is submitted herewith.

Applicants previously submitted a check for $100.00 toward the fee for this Request for a Certificate of Correction. An additional check for $30.00 is enclosed for the deficiency. Additionally, the Commissioner is authorized to charge any additional fee required or credit any overpayment in connection with this request to Deposit Account No. 08-1540.

Applicants respectfully request that this request be granted and that the file be forwarded to the Certificate of Corrections Branch for entry of the enclosed Certificate of Correction. Favorable consideration and issuance of a Certificate of Correction is respectfully requested.

Respectfully submitted,

Kenneth F. Florek
Reg. No. 33,173

**MAILING ADDRESS:**
HEDMAN & COSTIGAN, P.C.
1185 Avenue of the Americas
New York, NY 10036
(212) 302-8989

Applicants' failure to include the correct assignee's name on the PTOL-85 submission was inadvertent. Additionally, a copy of the Notice of Recordation of Assignment, showing that assignment to Beijing Wonner Biotech Ltd. Co. of Beijing, P.R. China was recorded at reel 015803/frame 0476, is submitted herewith.

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Applicants respectfully request that this request be granted and that the file be forwarded to the Certificate of Corrections Branch for entry of the enclosed Certificate of Correction. Favorable consideration and issuance of a Certificate of Correction is respectfully requested.

Respectfully submitted,

Kenneth F. Florek
Reg. No. 33,173

**MAILING ADDRESS:**
HEDMAN & COSTIGAN, P.C.
1185 Avenue of the Americas
New York, NY 10036
(212) 302-8989

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SEP 11 2009
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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

MARCH 22, 2005

PTAS

*700157684A*

HEDMAN & COSTIGAN, P.C.
ALAN B. CLEMENT, ESQ.
1185 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 02/28/2005

REEL/FRAME: 015803/0476
NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
ZHANG, ZUOGUANG

DOC DATE: 12/20/2004

ASSIGNOR:
WANG, YUFEN

DOC DATE: 12/20/2004

ASSIGNEE:
BEIJING WONNER BIOTECH LTD. CO.
JIA RUN GARDEN, WANG JING
ROOM 406, TOWER B
BEIJING P.R., CHINA 1000102

SERIAL NUMBER: 10515910
PATENT NUMBER:
TITLE: PHARMACEUTICAL COMPOSITION FOR TREATMENT OF EMICITION DISORDERS CAUSED BY...

FILING DATE:
ISSUE DATE:

CASE 1383-001 ATTY KGL
DUE DATE —
STATUTORY DATE —
BY WF

VIOLET MCCOY, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

02/28/2005
700157684

OIPE IAP10 SEP 11 2009 PATENT & TRADEMARK OFFICE

Form PTO-1595 (Rev. 09/04)
OMB No. 0651-0027 (exp. 6/30/2005)

U.S. DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

# RECORDATION FORM COVER SHEET
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To the Director of the U.S. Patent and Trademark Office: Please record the attached documents or the new address(es) below.

**1. Name of conveying party(ies)/Execution Date(s):**

Zhang, Zuoguang
Wang, Yufen

Execution Date(s) December 20, 2004

Additional name(s) of conveying party(ies) attached? ☐ Yes ☑ No

**2. Name and address of receiving party(ies)**

Name: Beijing Wonner Biotech Ltd. Co.

Internal Address: Room 408, Tower B

Street Address: Jia Run Garden, Wang Jing

Chaoyang District

City: Beijing

State:

Country: P.R. China Zip: 1000102

Additional name(s) & address(es) attached? ☐ Yes ☑ No

**3. Nature of conveyance:**

☑ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Government Interest Assignment
☐ Executive Order 9424, Confirmatory License
☐ Other

**4. Application or patent number(s):** ☐ This document is being filed together with a new application.

A. Patent Application No.(s)

Serial No. 10/515,910; Atty. Dkt. No. 1383-001
As described in PCT/CN03/00243, filed on 04/04/03 and claiming a priority date of 03/28/03, based on Chinese patent application no. 03121170.4

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☑ No

**5. Name and address to whom correspondence concerning document should be mailed:**

Name: Alan B. Clement, Esq.

Internal Address: Hedman & Costigan, P.C.

Street Address: 1185 Avenue of the Americas

City: New York

State: NY Zip: 10036

Phone Number: 212/302-8989

Fax Number: 212/302-8998

Email Address:

**6. Total number of applications and patents involved:** 1

**7. Total fee (37 CFR 1.21(h) & 3.41) $**

☐ Authorized to be charged by credit card
☑ Authorized to be charged to deposit account
☐ Enclosed
☐ None required (government interest not affecting title)

**8. Payment Information**

a. Credit Card Last 4 Numbers
Expiration Date

b. Deposit Account Number 08-1540

Authorized User Name Alan B. Clement, Esq.

**9. Signature:**

Signature

3/22/05
Date

Alan B. Clement, Esq., Reg. No. 34,563
Name of Person Signing

Total number of pages including cover sheet, attachments, and documents: 2

Documents to be recorded (including cover sheet) should be faxed to (703) 306-5995, or mailed to:
Mail Stop Assignment Recordation Services, Director of the USPTO, P.O.Box 1450, Alexandria, V.A. 22313-1450

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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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JACOBSON HOLMAN PLLC
400 SEVENTH STREET N.W.
SUITE 600
WASHINGTON, DC 20004

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Kyohei Umetsu | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7654536 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,917 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/12/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **140** 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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Pearl Cohen Zedek Latzer, LLP
1500 Broadway
12th Floor
New York, NY 10036

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Edvardas Narevicius | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7609918 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/27/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,927 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/24/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **0** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

9-12-08

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

Patent No. : 7,345,300
Ser. No. : 10/515,935
Inventor(s) : Dashan Qin, et. al.
Issued : March 18, 2008
Title : PHOSPHORESCENT LIGHT-EMITTING COMPONENT COMPRISING ORGANIC LAYERS
Docket No. : 17346-0012

Re: Request for Certificate of Correction

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

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

In view of the foregoing, your request, 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
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By hand: Customer Service Window
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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) 308-9390 ext.124 or 125

Geoffrey K. Rogers
Sutherland Asbill & Brennan LLP
999 Peachtree Street, N. E.
Atlanta, Georgia 30309-3996

ej

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**SUTHERLAND ASBILL & BRENNAN LLP**
**999 PEACHTREE STREET, N.E.**
**ATLANTA GA 30309**

COPY MAILED
DEC 2 4 2008

In re Patent No. 7,345,300 :
Issued: March 18, 2008 :
Application No. 10/515,935 : ON PETITION
Filed: March 21, 2005 :
Attorney Docket No. 17346-0012 :

This is a decision on the petition, filed November 10, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to change the assignee on the issued patent.

The request is **DISMISSED**.

37 CFR 3.81(a) permits the patent to issue to the assignee, provided that, at the time the issue fee is paid, the name and correct address of an assignee is provided. 37 CFR 3.81(b) permits the patent to issue in the name and correct address of an assignee if the assignment was submitted after payment of the issue fee but ***prior to issuance of a patent***. Patent and Trademark Office assignment records disclose that an assignment correcting the assignee's name from "NOVALED GMBH" to "NOVALED AG" was recorded on October 15, 2008, after the date of issuance of this patent.

Accordingly, since the assignment was not submitted for recordation until after issuance of this patent, issuance of a certificate of correction would not be proper. *See* MPEP Section 307.

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

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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2-18-09

Patent No. : 7,345,300
Ser. No. : 10/515,935
Inventor(s) : Dashan Qin, et. al.
Issued : March 18, 2008
Title : PHOSPHORESENT LIGHT-EMITTING COMPONENT COMPRISING ORGANIC LAYERS
Docket No. : 17346-0012

Re: Request for Certificate of Correction

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

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

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

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

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

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

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

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

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

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

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

Sutherland Asbill & Brennan LLP
999 Peachtree Street, N.E.
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**SUTHERLAND ASBILL & BRENNAN LLP**
**999 PEACHTREE STREET, N.E.**
**ATLANTA GA 30309**

**MAILED**

APR 13 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,345,300 | : | |
| Issued: March 18, 2008 | : | |
| Application No. 10/515,935 | : | ON PETITION |
| Filed: March 21, 2005 | : | |
| Attorney Docket No. 17346-0012 | : | |

This is a decision on the renewed petition filed July 29, 2009, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name and address of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **DISMISSED**.

Petitioner states that the correct assignee's name is "NOVALED GMBH, Dresden, Germany" and that assignee's name was not included on the Part B - Fee(s) Transmittal form at the time of payment of the issue fee.

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

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

The request under 37 CFR 3.81(b) was not accompanied by a request for a certificate of correction (fee previously submitted November 10, 2008) as required by 3.81(b). *See also* MPEP 1481.01. As petitioner has failed to comply with the provisions of 37 CFR 3.81(b), the request cannot be granted at this time.

A review of Office database assignment records reflects that an assignment to "NOVALED GMBH, Dresden, Germany" has been recorded on March 18, 2005. Therefore, upon submission of the required proper certificate of correction, it would be

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

appropriate for the Office to issue a certificate of correction to correct the front page of the Letters Patent to reflect that "NOVALED GMBH, Dresden, Germany" was the assignee of record at the time of issuance of the application into a patent. *Note also* 35 U.S.C. § 152.

In view of the above, **the Certificates of Correction Branch is instructed to issue a certificate of correction upon submission by petitioner of a request for a certificate of correction which sets forth** "NOVALED GMBH, Dresden, Germany" **as the assignee**. *No certificate of correction will be issued which sets forth an assignee other than the assignee set forth in this request. A copy of this decision* ***must*** *accompany the request for a Certificate of Correction.*

No further renewed request under 37 CFR 3.81(b) is necessary for consideration by the Office of Petitions for issuance of a certificate of correction in the name of the assignee set forth in this request, since this decision operates as an instruction to the Certificates of Correction Branch to issue the requested certificate of correction.

Further, although the petition is signed by the attorney of record it does not set forth a USPTO registration number. Petitioner should note that all documents submitted before the United States Patent and Trademark Office by a registered patent attorney must contain his/her registration number. However, the original petition documents did include the signature and registration number for Peter G. Pappas, the attorney of record. Therefore, the petition is accepted as being properly signed.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-7751. Inquiries regarding the certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

Joan Olszewski
Petitions Examiner
Office of Petitions

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YOUNG & THOMPSON
209 Madison Street
Suite 500
Alexandria, VA 22314

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Michael Ah Lee | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7629119 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,940 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/09/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1027** 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 3001**
**BRIARCLIFF MANOR NY 10510-8001**

**COPY MAILED**

OCT 27 2008

**OFFICE OF PETITIONS**

In re Application of :
John A. HAROLD-BARRY, et al :
Application No. 10/515,943 : ON PETITION
Filed: November 23, 2003 :
Attorney Docket No. GB02-0078 US :

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

The petition is **DISMISSED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of February 2, 2007. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). *See* MPEP 711.03(c)(III)(A)(2). Since the amendment submitted does not *prima facie* place the application in condition for allowance (see attached Advisory Action), the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b).

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted.

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

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

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

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Telephone inquiries concerning this decision should be directed to Diane Goodwyn at (571) 272-6735.

Thurman Page
Petitions Examiner
Office of Petitions

Attachment: Advisory Action

| **Advisory Action Before the Filing of an Appeal Brief** | **Application No.** 10/515,943 | **Applicant(s)** HAROLD-BARRY ET AL. | |
|---|---|---|---|
| | **Examiner** JOSEPH HALEY | **Art Unit** 2627 | |

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

THE REPLY FILED 08 December 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-6,8-16 and 18*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Joseph H. Feild/
Supervisory Patent Examiner, Art Unit 2627

/Joseph Haley/
Examiner, Art Unit 2627

| | |
|---|---|
| Application Number: | 10/515,943 |
| Filing or 371 (c) Date: | 11-23-2004 |
| Application Type: | Utility |
| Examiner Name: | HALEY, JOSEPH R |
| Group Art Unit: | 2627 |
| Confirmation Number: | 8128 |
| Attorney Docket Number: | GB02 0078 US |
| Class / Subclass: | 369/100 |
| First Named Inventor: | John Harold-Barry , Southampton, (GB) |

Title of Invention: Method and apparatus for processing a digital data stream

**Certificate of Fax/Mailing Under 37 CFR 1.8**

I hereby certify that this correspondence is being faxed to (571) 273-8300 or deposited with the United States Postal Service as first class mail in an envelope addressed to the COMMISSIONER FOR PATENTS, P.O. BOX 1450 ALEXANDRIA, VA 22313 on below date.

Michael Ure
(Name)

(Signature and Date)

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

**Charge Authorization and Extension of Time Statement**

The Commissioner is hereby requested and authorized pursuant to 37 CFR §1.136(a)(3), to treat any concurrent or future reply in this application requiring a petition for extension of time for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. Please charge any additional fees which may now or in the future be required in this application, including extension of time fees, but excluding the issue fee unless explicitly requested to do so, and credit any overpayment, to Deposit Account No. 50-4019.

Respectfully submitted,

John Rehberg, Reg. 29,207

Dated: 11.16.07

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30 SEP 2005

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BOSE MCKINNEY & EVANS LLP
135 N PENNSYLVANIA ST
SUITE 2700
INDIANAPOLIS IN 46204

In re Application of :
PUDNEY, Peter John et al. :
Application No.: 10/515,946 :
PCT No.: PCT/AU03/00604 : DECISION
Int. Filing Date: 20 May 2003 :
Priority Date: 20 May 2002 : ON PETITION UNDER
Docket No.: Shelston-0002 :
For: SYSTEM FOR IMPROVING : 37 CFR 1.137(b)
TIMEKEEPING AND SAVING :
ENERGY ON LONG-HAUL TRAINS :

Applicants' "Petition For Revival Unintentionally Abandoned Application Under 37 C.F.R. §1.137(b)," filed in the above-captioned application on 24 November 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) is required.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

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MARTINE PENILLA & GENCARELLA, LLP
710 LAKEWAY DRIVE
SUITE 200
SUNNYVALE, CA 94085

Mail Date: 05/20/2010

| | | |
|---|---|---|
| **Applicant** | : Ikuo Hayaishi | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7612824 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/03/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/515,948 | : OF WYETH |
| **Filed** | : 07/26/2005 | : |
| | | : |

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.

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Louis Myers
Fish & Richardson
225 Franklin Street
Boston, MA 02110-2804

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Feng Wei | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7641922 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/05/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/515,963 | : 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 **1136** 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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**JACKSON WALKER, L.L.P.**
**112 E. PECAN, SUITE 2400**
**SAN ANTONIO TX 78205**

MAILED

APR 29 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Sierra, Pablo Torre | : | |
| Application No. 10/515,971 | : | ON PETITION |
| Filed: August 5, 2005 | : | |
| Attorney Docket No. P-305769.11.00 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 4, 2010, to revive the above-identified application.

The petition is **GRANTED**.

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

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of continuing application No. 12/660,811.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

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MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON MA 02111

MAILED

JUN 24 2010

OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Lenzini et al. | : | |
| Application No. 10/516022 | : | ON APPLICATION FOR |
| Filing or 371(c) Date: 11/29/2004 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No.: | : | |
| 39700-576N01US/NC23791US | : | |

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b), filed March 16, 2010. Applicant submits that the proper patent term adjustment to be indicated on the patent is 584 days, not 481 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. The application for patent term adjustment is properly treated under 37 C.F.R. § 1.705(b).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and ***must*** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

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

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions

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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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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07 DEC 2006

Robert D. Buyan
STOUT UXA BUYAN & MULLINS
Suite 300, 4 Venture
Irvine, CA 92618

In re Application of
GEORGES *et al*
U.S. Application No.: 10/516,035
PCT No.: PCT/IB03/03073
Int. Filing Date: 23 May 2003
Priority Date: 24 May 2002
Attorney Docket No.: UCIVN-053US
For: IMMUNOGENIC COMPOSITION AND PEPTIDE SEQUENCES FOR PREVENTION AND TREATMENT OF AN HSV CONDITION

**DECISION**

This is a decision on the "Petition Under 37 CFR 1.181(a) for Withdrawal of Erroneous Notification of Abandonment" filed on 03 November 2006.

## BACKGROUND

On 26 April 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(a) and (b) and a surcharge fee must be provided. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 28 October 2005, applicants purportedly filed a response which included, *inter alia*, an executed declaration and a four-month extension and an $860.00 fee. The declaration and fee were not located in the subject application.

On 07 August 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.

On 03 November 2006, applicants filed the subject petition which was accompanied by, *inter alia*, a date-stamped postcard receipt and copies of the documents purportedly filed 28 October 2005.

## DISCUSSION

Applicants request to withdraw the holding of abandonment claiming that a response to the Form PCT/DO/EO/905 was filed on 28 October 2005. In support of this

claim, applicants submitted a copy of a date-stamped postcard receipt indicating that several items were submitted including a declaration, sequence listing and check for $860.00. 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. MPEP § 503.

However, a review of the documents submitted shows that the response identified the U.S. application as **"10/516,335," not "10/516,035."** The subject petition also misidentified the U.S. application number.

37 CFR 1.5 (a) requires that applicants identify on all letters concerning a previously filed application for a patent, the application number consisting of the series code and the serial number, or the serial number and filing date assigned to that application by the Patent and Trademark Office. Moreover, the Form PCT/DO/EO/905 mailed 26 April 2005 states that: "Applicant is reminded that any communication to the United States patent and Trademark Office must . . . include the U.S. application no. shown above."

As such, it is clear that identification of the response to the Form PCT/DO/EO/905 mailed 26 April 2005 was inadequate. Accordingly, a response to the Form PCT/DO/EO/905 was not properly filed in the subject application.

A check of U.S. application No. 10/516,335 verifies that this response was received on 28 October 2005 and the papers are located in U.S. application No. 10/516,335.

Applicants should consider filing a petition under 37 CFR 1.182 to correct the U.S. application number listed on the response filed 28 October 2005 and move it into the above-identified application. A $400.00 petition fee is required. Applicants must show that the response located in U.S. application No. 10/516,335 was intended as a response in the subject application.

## CONCLUSION

In view of the above, the petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

The above-captioned application remains **ABANDONED**.

This application is being held in the Office of PCT Legal Administration to await an appropriate response from applicants. Applicants may contact the undersigned at

the telephone number listed below if they have any questions.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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20 MAR 2007

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STOUT UXA BUYAN & MULLINS
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In re Application of :
GEORGES *et al* :
U.S. Application No.: 10/516,035 :
PCT No.: PCT/IB03/03073 :
Int. Filing Date: 23 May 2003 : **DECISION**
Priority Date: 24 May 2002 :
Attorney Docket No.: UCIVN-053US :
For: IMMUNOGENIC COMPOSITION AND :
PEPTIDE SEQUENCES FOR :
PREVENTION AND TREATMENT OF :
AN HSV CONDITION :

This is a decision on the petition under 37 CFR 1.182 filed on 16 January 2007.

## BACKGROUND

On 07 December 2006, a decision dismissing applicants' petition to withdraw the holding of abandonment was mailed. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 16 January 2007, applicants filed the subject petition along with a $400 petition fee.

## DISCUSSION

The U.S. application number was erroneously identified on the response to the Form PCT/DO/EO/905 mailed 28 October 2005. The U.S. application number was listed as "10/516,335," instead of "10/516,035." As such, the papers and fees were placed in U.S. application number 10/516,335.

Applicants have filed a petition under 37 CFR 1.182 to correct the U.S. application number listed on the response filed 28 October 2005 and move it into the above-identified application. A $400.00 petition fee was also submitted.

A review of the response filed 28 October 2005 clearly shows that it was intended for the above-captioned application, not U.S. Application No. 10/516,335. Accordingly, the papers and fees filed 28 October 2005 have been moved into the above-captioned application.

## DECISION

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

Since a response to the Form PCT/DO/EO/905 mailed 26 April 2005 was timely filed, the Form PCT/DO/EO/909 mailed 07 August 2006 is hereby **VACATED**.

A review of the declaration originally filed 28 October 2005 shows that it is in compliance with 37 CFR 1.497(a) and (b).

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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FULBRIGHT & JAWORSKI, LLP
600 CONGRESS AVE.
SUITE 2400
AUSTIN, TX 78701

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SEP 22 2009

OFFICE OF PETITIONS

In re Application of :
Bernhard Ronacher :
Application No. 10/516,049 : DECISION ON PETITION
Filed: November 29, 2004 :
Attorney Docket No. SONN:062US :

This is a decision on the petition, filed August 5, 2009, which is being treated as petition under 37 CFR 1.181 to withdraw the holding of abandonment.

The petition is GRANTED.

The above-identified application was held abandoned because the period for seeking court review of the decision by the Board of Patent Appeals and Interferences mailed June 23, 2009 had expired and there were no allowed claims. A Notice of Abandonment was mailed July 23, 2009.

Petitioner asserts that the Notice of Abandonment mailed July 23, 2009 be withdrawn as it was premature because the period for seeking court review of the decision by the Board of Patent Appeals and Interferences mailed June 23, 2009 had not expired.

MPEP 1214.06 states:

> The time for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit or the U.S. District Court for the District of Columbia is the same for both tribunals, that is, 2 months, or 2 months with the extension provided by 37 CFR 1.304 in the event a request for rehearing is timely filed before the Board, or as extended by the Director.

As the period for seeking court review of the decision by the Board of Patent Appeals and Interferences had not expired prior to the mailing of the Notice of Abandonment the examiner did not follow the provisions of MPEP 1214.06. Accordingly, the Notice of Abandonment mailed July 23, 2009 is withdrawn as premature.

The application is being referred to the Technology Center AU 1641 for appropriate processing including the re-mailing of the Notice of Abandonment and acknowledging that the correct date of abandonment is August 24, 2009

Telephone inquiries concerning this decision should be directed to April M. Wise at (571) 272-1642. All other inquiries concerning this application should be directed to the Technology Center.

/dab/
David Bucci
Petitions Examiner
Office of Petitions

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KEUSEY, TUTUNJIAN & BITETTO
20 Crossways Park North
Suite 210
Woodbury, NY 11797

| | | |
|---|---|---|
| In re Application of | : | |
| SODERGARD | : | |
| Application No.: 10/516,055 | : | |
| PCT No.: PCT/EP03/05785 | : | **DECISION** |
| Int. Filing Date: 30 May 2003 | : | |
| Priority Date: 29 May 2002 | : | |
| Attorney Docket No.: 253-10 | : | |
| For: HYPERBRANCHED POLYMERS | : | |

This decision is in response to the declaration filed on 27 June 2005.

## BACKGROUND

On 17 June 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 $130.00 surcharge fee must be provided. A two-month time period for response was set with extensions of time available under 37 CFR 1.136(a).

On 27 June 2005, applicants filed a response which included, *inter alia*, an executed declaration listing two inventors.

## DISCUSSION

The declaration filed 27 June 2005 records two inventors for the national stage application of PCT/EP03/05785, *i.e.*, Niels Dan Anders Södergard and Erik Mikael Turko. However, the international publication ("WO 03/099910") lists only Anders Södergard as the sole inventor for PCT/EP03/05785. A review of international records does not indicate that a Form PCT/IB/306 was mailed in the international application.

A Notification of the Recording of a Change (Form PCT/IB/306) from the International Bureau (IB) is required for these changes to have effect in the national stage. The document from the EPO dated 14 January 2005 and filed with the national stage papers on 29 November 2004 is not sufficient to add an inventor and change the first name of Mr. Södergard in the international application.

## DECISION

For the reasons listed above, the declaration filed 27 June 2005 is not in compliance with 37 CFR 1.497(a) and (b).

Applicant must submit a copy of the Notification of the Recording of a Change (Form PCT/IB/306) from the IB showing that an inventor has been added and the name change of the first inventor has been approved, or file a petition under 37 CFR 1.497(d) to add an inventor. An explanation for the discrepancy in the first name of Mr. Södergard would also be required.

Applicant is required to respond to this decision within a time limit of **TWO (2) MONTHS** from the mail date of this decision. Failure to respond will result in the abandonment of the application.

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

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0 8 APR 2008

23720
WILLIAMS, MORGAN & AMERSON
10333 Richmond, Suite 1100
Houston, TX 77042

In re Application of :
SODERGARD :
Application No.: 10/516,055 :
PCT No.: PCT/EP03/05785 : **DECISION**
Int. Filing Date: 30 May 2003 :
Priority Date: 29 May 2002 :
Attorney Docket No.: 2144.000500/KDG :
For: HYPERBRANCHED POLYMERS :

This decision is in response to the declaration filed on 27 June 2005.

## BACKGROUND

On 17 June 2005, the DO/EO/US mailed a 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.

On 27 June 2005, applicants filed a response which included, *inter alia*, an executed declaration listing two inventors. However, the international publication listed only one inventor and there was no record that a second inventor was added in the international application.

On 28 July 2006, a decision indicating that the declaration submitted could not be accepted unless a Form PCT/IB/306 was submitted showing that Erik Mikael Stolt was added as an inventor in the international application. The decision also noted that applicants could submit a petition under 37 CFR 1.497(d). Applicants were given two months to respond.

On 31 July 2006, a power of attorney was provided requesting a change of the correspondence address.

On 11 September 2006, applicants filed the subject petition under 37 CFR 1.497(d) to add an inventor.

On 23 May 2007 and again on 25 January 2008, a status inquiry was filed.

## DISCUSSION

In the petition filed 11 September 2006, applicants request to add Erik Mikael

Stolt as an inventor in the above-captioned 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, 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.

Here, applicants filed a statement by Mr. Stolt who requests to be added as an inventor in the above-captioned application. The statement declares that the omission "occurred without any deceptive intent on my part." The processing fee of $130.00 has been charged to Deposit Account No. 50-0786 as authorized.

Applicants also submitted a document titled ""Consent of Assignee Under 37 C.F.R. § 1.497(D)" signed by Robert Gibber as Company Secretary of the assignee, Tate & Lyle, PLC consenting to the change of inventorship in the above-identified application. Mr. Gibber declares that is authorized to act on behalf of the assignee. The reel and frame number of the assignment was provided.

This is sufficient for a grantable petition under 37 CFR 1.497(d).

## CONCLUSION

Applicants' request under 37 CFR 1.497(d) is **GRANTED**.

Erik Mikael Stolt has been added as an inventor in the subject application. Applicants' also confirm that the name of the first inventor is Niels Dan Anders Södergard and state that the discrepancy in the name was the result of an "inadvertent error by the agent who filed the international application." The international publication lists the name only as Anders Södergard. This is an adequate explanation.

As such, the declaration originally filed 27 June 2005 is now in compliance with 37 CFR 1.497(a) and (b).

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 30 May 2003 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 27 June 2005.

This application is being forwarded to the Office of Patent Application Processing for further processing in accordance with this decision.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

02 JUN 2005



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Justin D.G. Brennan
Morgan, Lewis & Bockius, LLP
1701 Market Street
Philadelphia, PA 19103-2921

In re Application of :
THUROT, et al. : DECISION ON PETITION
Application No.: 10/516,057 :
PCT No.: PCT/FR02/01780 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 28 May 2002 :
Priority Date: 29 May 2001 :
Atty. Docket No.: 027367-5015 :
For: COMPOSITION FOR ORAL OR CORPOREAL :
HYGIENE OR FOR HEALTH COMPRISING :
SEEDS OR GROUND MATERIAL OR PROTEIN :
EXTRACTS BASED ON SEEDS OF A PLANT :
OF THE GENUS MORINGA :

The petition to revive under 37 CFR 1.137(b) filed 29 November 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing 35 U.S.C. 371 (c) requirements from their due date until the filing of a grantable petition under 37 CFR § 1.137(b) was unintentional." and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National Fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for the preparation and mailing of a "Notification of Missing Requirements" (Form PCT/DO/EO/905).

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
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APR 12 2006

Technology Center 2100

Stanley H. Kremen
4 Lenape Lane
East Brunswick, NJ 08816

In re Application of: GANGE, et al.
Application No. 10/516,061
Filed: November 29, 2004
For: SYSTEM, APPARATUS, AND METHOD FOR USER TUNABLE AND SELECTABLE SEARCHING OF A DATABASE USING A WEIGHTED QUANTIZED FEATURE VECTOR

DECISION ON REQUEST FOR EXAMINATION OF INTERNATIONAL APPLICATION IN THE NATIONAL STAGE OUT OF TURN, under 37 C.F.R. § 1.496

This is a response to the petition filed 29 December 2005, under 37 C.F.R. § 1.496: to make the above-identified application special. The petition is being treated as a request for examination of an international application in the national stage out of turn under 37 C.F.R. § 1.496(b).

37 C.F.R. § 1.496 states in relevant part:

> (b) National stage applications having paid therein the search fee as set forth in § **1.492(b)(1)** and the examination fee as set forth in § **1.492(c)(1)** may be amended subsequent to the date of entry into the national stage only to the extent necessary to eliminate objections as to form or to cancel rejected claims. ***Such national stage applications will be advanced out of turn for examination*** [emphasis added].

Accordingly, there is no provision under rule 1.496 to "make the application special" as requested in the instant petition. As identified in the request, the instant application meets the requirements for examination out of turn.

Accordingly, the request is **GRANTED**.

Applicant's attention is directed to M.P.E.P. § 708.02 and 37 C.F.R. § 1.102, which set out the prerequisites for a grantable petition to "make special". Applications that have been made special under these sections will be advanced out of turn for examination and ***will continue to be treated as special throughout the entire prosecution in the Office.***

The application will be forwarded to the Examiner of record for advanced examination out of turn in accordance with 37 C.F.R. § 1.496(b).

Brian L. Johnson
Special Program Examiner
Technology Center 2100
Computer Architecture, Software and Information Security

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Roberte M.D. Makowski
CONNOLY BOVE LODGE & HUTZ LLP
1007 North Orange Street
P.O. Box 2207
Wilmington, DE 19899

In re Application of :
SONNEWALD, Uwe *et al* :
U.S. Application No.: 10/516,075 :
PCT No.: PCT/EP03/07027 :
Int. Filing Date: 02 July 2003 : **DECISION**
Priority Date: 04 July 2002 :
Attorney Docket No.: 53262-20097.00 :
For: METHODS FOR OBTAINING :
PATHOGEN RESISTANCE IN PLANTS :

This is a decision on applicants' "Request for Withdrawal of Holding of Abandonment or in the alternative, Petition to Revive" filed on 17 February 2006.

## BACKGROUND

On 29 November 2004, applicants filed papers to enter the national stage of PCT/EP03/07027 accompanied by a declaration naming Morrison & Foerster LLP as attorney of record.

On 25 February 2005, a "Request for Withdrawal as Attorney or Agent" was filed by Morrison & Foerster LLP requesting transfer to an attorney at Powell Goldstein LLP at the request of the assignee, SunGene GmbH & Co. KGaA.

On 06 May 2005, the United States Designated/Elected Office (DO/EO/US) mailed to Morrison & Foerster LLP a Notification to Comply With Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/922) indicating that a computer readable form sequence listing must be provided. A two-month time period for response was set with extensions of time available under 37 CFR 1.136(a).

On 19 May 2005, a Power of Attorney with change of correspondence address and a Statement Under 37 CFR 3.73(b) along with a copy of an assignment was filed by the assignee appointing Connoly Bove Lodge & Hutz LLP as attorney of record.

On 26 January 2006, a "Status Inquiry" was filed by Connoly Bove Lodge & Hutz LLP.

On 17 February 2006, applicants filed the subject petition requesting to withdraw the holding of abandonment, or in the alternative, a petition to revive.

On 28 March 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) due to a lack of response to the Form PCT/DO/EO/922 filed 06 May 2005. A "Notice Regarding Change of Power of Attorney" was also mailed to Morrison & Foerster LLP informing them that their power of attorney was revoked by applicant on 19 May 2005.

## DISCUSSION

Applicants request that the status of the above-captioned application be reinstated, or in the alternative that the application be revived.

### Withdraw the Holding of Abandonment

Applicants claim that the Form PCT/DO/EO/922 mailed 06 May 2005 was never seen prior to receiving a copy from the PCT Help Desk on 16 February 2005. Applicants assert that the error was caused by the Office mailing the Form PCT/DO/EO/922 to the wrong address. Applicants state that:

> Morrison & Foerster filed a Request for Withdrawal as Attorney or Agent on February 25, 2005, stating that the application was being transferred to another attorney, listing James Remenick at Powell Goldstein LLP as the new attorney of record. Over two months after the Request for Withdrawal, the Notification was sent to Morrison & Foerster instead of James Remenick (i.e. to the wrong address).
>
> Furthermore, Applicants filed . . . a new Power of Attorney for the application on May 16, 2005

A review of the subject application verifies that a "Request for Withdrawal as Attorney or Agent" was filed in the above-captioned application on 25 February 2005 by the former counsel, Morrison & Foerster LLP. Nonetheless, section 402.06 of the MPEP discusses withdrawal of an attorney and states, in part:

> In the event that a notice of withdrawal is filed by the attorney or agent of record, the file will be forwarded to the Technology Center Director where the application is assigned where appropriate procedure will be followed pertaining to the withdrawal. **The withdrawal is effective when approved rather than when received.**
>
> In this case, the request to withdraw as attorney submitted by Morrison &

Foerster LLP on 25 February 2005 was not approved until 28 March 2006.

Accordingly, the address of the original attorney of record at Morrison & Foerster LLP was still effective when the Form PCT/DO/EO/922 was mailed. No mistake was made by the Office. The Form PCT/DO/EO/922 should have been forwarded to the new attorney along with the rest of the file by Morrison & Foerster LLP.

Applicants' request to withdraw the holding of abandonment is declined.

**Petition to Revive Under 37 CFR 1.137(b)**

Applicants request in the alternative to revive the above-captioned application. A petition to revive pursuant to 37 CFR 1.137(b) requires: (1) a proper reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply to the filing of a grantable petition pursuant to this paragraph was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

The proper reply is to provide a copy of the "Sequence Listing" in computer readable form. Applicants provided a computer readable version of the sequence listing that has been processed as good technically and entered into the database by the Scientific and Technical Information Center. The appropriate petition fee of $1,500.00 has been charged to Deposit Account No. 03-2775 as authorized. Applicants state that "the application was unintentionally permitted to become abandoned." This is interpreted 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" as required by 37 CFR 1.137(b)(3). If this is an incorrect interpretation, applicants are requested to notify this office. A terminal disclaimer is not required.

Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

**CONCLUSION**

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

Applicants' petition to revive under 37 CFR 1.137(b) is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 02 July 2003, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 29 November 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

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

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OFFICE OF PETITIONS

In re Application of :
**HERBERS**, et al. :
Application No. 10/516,075 : DECISION ON PETITION
Filed: November 29, 2004 : TO WITHDRAW
Attorney Docket No. **53262-20097.00** : 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 25, 2005.

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 and re-appointed by the assignee of the patent application on May 19, 2005. 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: **CONNOLLY BOVE LODGE & HUTZ, LLP**
**P.O. BOX 2207**
**WILMINGTON, DE 19899**

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**DRINKER BIDDLE & REATH (dc)**
**1500 K STREET, N.W.**
**SUITE 1100**
**WASHINGTON DC 20005-1209**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Haruhisa Saitoh et al | : | |
| Application No. 10/516,076 | : | DECISION GRANTING PETITION |
| Filed: November 29, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 046884_5344_210802 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed January 30, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on December 18, 2007 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 2877 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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

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Alexandria, VA 22313-1450
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**MORGAN LEWIS & BOCKIUS LLP**
**1111 PENNSYLVANIA AVENUE NW**
**WASHINGTON, DC 20004**

MAILED

JUN 0 3 2009

OFFICE OF PETITIONS

In re Application of :
Alvarez et al. :
Application No. 10/516,079 :
Filed: November 2, 2005 :
Attorney Docket No. 2006636-0026 :

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 19, 2006.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to practitioners associated with Morgan Lewis & Bockius LLP has been revoked by the assignee of the patent application on May 15, 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 571-272-6059.

Alicia Kelley
Petitions Examiner
Office of Petitions

cc: CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON, MA 02110

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Marc Maria Leo Jan LaFaille | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7572348 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/11/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/516,081 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/29/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1028** 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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21 JUL 2006

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON DC 20036

| | | |
|---|---|---|
| In re Application of: | : | |
| THENNATI, Rajamannar | : | DECISION ON REQUEST TO |
| U.S. Application No.: 10/516,104 | : | CORRECT INVENTORSHIP |
| PCT No.: PCT/IN2003/000210 | : | |
| International Filing Date: 02 June 2003 | : | |
| Priority Date: 31 May 2002 | : | |
| Attorney's Docket No.: 043045 | : | |
| For: A PROCESS FOR THE PREPARATION OF PHENYLCARBAMATES | : | |

This decision is issued in response to the "Response To Notice To File Missing Parts" filed 08 May 2006, treated herein as a request under 37 CFR 1.497(d) to correct the inventors of record in the present national stage application. Deposit Account No. 50-2866 will be charged the required processing fee.

## BACKGROUND

On 02 June 2003, applicant filed international application PCT/IN2003/000210. The application claimed a priority date of 31 May 2002, and it designated the United States. The published international application identified SUN PHARMACEUTICAL INDUSTRIES LIMITED and Hetalkumar Virendrabhai PATEL as "Applicants (for all designated states except US)" and Rajamannar THENNATI as the sole "Inventor/Applicant (for US only)."

The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 30 November 2004.

On 30 November 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 an executed declaration that identified both Hetalkumar Virendrabhai PATEL and Rajamannar THENNATI as inventors herein.

On 17 April 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the declaration later than thirty months after the priority date was required. The Notification stated that the previously filed declaration was defective in that the first inventor listed on the declaration (PATEL) was not identified as an inventor on the international application.

On 08 May 2006, applicant filed a response to the Notification Of Missing Requirements that included a "Statement Under 37 CFR 1.497(d) executed by Hetalkumar Virendrabhai PATEL stating that any error in inventorship in the international application occurred without deceptive intent.

## DISCUSSION

As noted above, the inventors set forth in the declaration filed 30 November 2004 (PATEL and THENNATI) do not correspond with the international application, which listed THENNATI as the sole inventor and identified PATEL as an applicant for all states other than the United States. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), which states the following:

> (d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:
>
> > (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
> >
> > (2) The processing fee set forth in § 1.17(i); and
> >
> > (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).
> >
> > (4) any new oath or declaration required by paragraph (f) of this subsection.[1]

Here, applicant's 24 April 2006 submission included a statement from Hetalkumar Virendrabhai PATEL stating that any error in inventorship in the international application occurred without deceptive intent. This statement satisfies item (1).

The submission includes an authorization to charge Deposit Account No. 50-2866 for required fees. Pursuant to this authorization, the Deposit Account will be charged the required $130 processing fee. Item (2) is therefore satisfied.

---

[1] Item (4) does not apply to the present application.

Applicant has not, however, provided the assignee's consent to the addition of Hetalkumar Virendrabhai PATEL as an inventor herein. Applicant must provide such consent before item (3) can be considered satisfied. Such consent must be accompanied by a statement under 37 CFR 3.73(b) which includes either a copy of the assignment documents or a specific reference to the assignment's recorded location in the USPTO (i.e., reel and frame number) (see 37 CFR 3.73(b)).

Because applicant has not satisfied all the requirements of 37 CFR 1.497(d), the additional inventor listed on the filed declaration (PATEL) cannot be added to the application on the present record. The declaration filed 30 November 2004 therefore remains defective for failure to properly identify the inventors of record herein.

In addition, the declaration filed 30 November 2004 is also defective in that it fails to set forth the citizenship of inventor Rajamannar THENNATI. Accordingly, a revised declaration is required from this inventor which includes the required citizenship information.

## CONCLUSION

Applicant's request to add Hetalkumar Virendrabhai PATEL as an inventor herein under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

The sole inventor of record remains Rajamannar THENNATI, the inventor named on the international application.

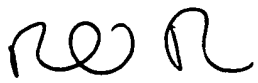
The declaration filed on 30 November 2004 remains defective under 37 CFR 1.497 in that the declaration does not properly identify the inventors of record herein.

The declaration filed 30 November 2004 is also defective for failure to include the citizenship of Rajamannar THENNATI.

Applicant must file a proper response to this decision within **TWO (2) MONTHS** from the mail date indicated above. Any such response must include: (1) the consent of the assignee to the addition of Hetalkumar Virendrabhai PATEL as an inventor herein (in the form required by 37 CFR 3.73(b), as discussed above); (2) a revised declaration executed by Rajamannar THENNATI that includes this inventor's citizenship; and (3) payment of the surcharge for filing the revised declaration later than thirty months after the priority date.

Failure to file a timely and 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 the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
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#8

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23 AUG 2006

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
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WASHINGTON DC 20036

| | | |
|---|---|---|
| In re Application of: | : | |
| PATEL, et al. | : | DECISION ON SECOND REQUEST |
| U.S. Application No.: 10/516,104 | : | TO CORRECT INVENTORSHIP |
| PCT No.: PCT/IN2003/000210 | : | (37 CFR 1.497(d)) |
| International Filing Date: 02 June 2003 | : | |
| Priority Date: 31 May 2002 | : | |
| Attorney's Docket No.: 043045 | : | |
| For: A PROCESS FOR THE PREPARATION OF PHENYLCARBAMATES | : | |

This decision is in response to the "Response To Decision On Request under 37 CFR 1.497(d)" filed 07 August 2006, treated herein as a renewed submission under 37 CFR 1.497(d). No petition fee is required.

## BACKGROUND

The procedural background for this application is set forth in detail in the decision mailed by this Office on 21 July 2006. That decision dismissed applicant's request to change inventorship for failure to satisfy all the requirements of 37 CFR 1.497(d). Specifically, applicant had failed to provide the consent of the assignee, in the required form. The decision also noted that the declaration filed 30 November 2004 was defective for failure to include the citizenship of inventor Rajamannar THENNATI.

On 07 August 2006, applicant filed the "Response To Decision On Request Under 37 CFR 1.497(d)" considered herein.

## DISCUSSION

The 07 August 2006 submission includes the required consent of the assignee to the requested addition of Hetalkumar Virendrabhai PATEL as an inventor herein. This submission, in combination with the previously filed materials, satisfies the requirements of 37 CFR 1.497(d). Accordingly, the request to add Hetalkumar Virendrabhai PATEL as an inventor herein is appropriately granted.

The 07 August 2006 submission included a revised declaration executed by both Hetalkumar Virendrabhai PATEL and Rajamannar THENNATI and including all the information required by 37 CFR 1.497(a) (including the previously missing citizenship of

inventor Rajamannar THENNATI), as well as payment of the surcharge for failure to file this declaration prior to the expiration of thirty months from the priority date. Based on the present addition of Hetalkumar Virendrabhai PATEL as an additional inventor herein, and the inclusion of all required information, the revised declaration submitted by applicants on 07 August 2006 is in compliance with 37 CFR 1.497.

## CONCLUSION

Applicants' renewed request under 37 CFR 1.497(d) is **GRANTED**.

Hetalkumar Virendrabhai PATEL is added as an additional inventor herein.

The revised declaration filed 07 August 2006 is accepted under 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 07 August 2006.

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20 APR 2006

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GRAUER PLLC
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Suite 501
Washington, DC 20036

| | | |
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| In re Application of | : | DECISION ON |
| Tsuyoshi Abe et al | : | |
| PCT No.: PCT/JP03/06957 | : | |
| Application No: 10/516,111 | : | |
| Int. Filing Date: 02 June 2003 | : | PETITION UNDER |
| Priority Date: 31 May 2002 | : | |
| Attorney's Docket No.: OMY-0040 | : | |
| For: CLONING OF TRANSGENIC ANIMALS | : | |
| COMPRISING ARTIFICIAL CHROMOSOMES | : | 37 CFR 1.47(a) |

This is in response to the "PETITION UNDER 37 C.F.R. §1.47 TO ACCEPT DECLARATION WHEN INVENTOR REFUSES TO JOIN IN APPLICATION" filed on 04 August 2005.

## BACKGROUND

On 02 June 2003, applicants filed international application PCT/JP03/06957, which claimed priority to an earlier application filed 31 May 2002.

On 30 November 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.

On 04 May 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 International application number and international filing date" must be submitted within two months from its mailing date or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 04 August 2005, petitioner filed the present petition accompanied, inter alia, an executed Declaration without the signature of one of the two inventors, i.e., without the signature of Tsuyoshi Abe.

## DISCUSSION

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

Petitioner has satisfied requirements (1) and (3) -(4) of 37 CFR 1.47(a) but not requirement (2).

Regarding requirement (2), the averments of Junichi Omori are not sufficient to support a finding that the nonsigning inventor, Abe refuses to sign because the application papers were mailed to him on July 11, 2005 and he was suppose to reply by July 15, 2005. This is a short time period (4 days) to make a determination that Mr. Abe refused to sign the papers because it could be that he was on vacation or out of town during the time the papers were delivered at the address. Especially, in this instance where there is no evidence that he sign for the receipt of the application papers. He should have been given more time to respond.

Where the Office is being asked to accept the silence of the nonsigning inventor's as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant. Absent further firsthand evidence that the application and request for signature were received by the nonsigning inventor, item (2) cannot be considered satisfied.

In addition, it is unclear if Mr. Abe still resides in that address based on the declaration by Mr. Dutton because he states that the Declaration submits proof that the "nonsigning inventor cannot be found or reached after diligent effort." If Mr. Abe dos not reside in address of record, then petitioner is under an obligation to try to find or reach Mr. Abe by doing an internet search and looking for him in the phone directory. Where there is an inability to find or reach a joint inventor "after diligent effort, " petitioner may file a statement of facts that fully describes the exact facts which are relied on to establish that a diligent effort was made under **37 CFR 1.47**.

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

Consequently, the petition does not satisfy all the requirements under 37 CFR 1.47(a).

## CONCLUSION

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

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

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

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
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27 SEP 2006

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GRAUER PLLC
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Suite 501
Washington, DC 20036

| | | |
|---|---|---|
| In re Application of | : | DECISION ON RENEWED |
| Tsuyoshi Abe et al | : | |
| PCT No.: PCT/JP03/06957 | : | |
| Application No: 10/516,111 | : | |
| Int. Filing Date: 02 June 2003 | : | PETITION UNDER |
| Priority Date: 31 May 2002 | : | |
| Attorney's Docket No.: OMY-0040 | : | |
| For: CLONING OF TRANSGENIC ANIMALS | : | |
| COMPRISING ARTIFICIAL CHROMOSOMES | : | 37 CFR 1.47(a) |

This is in response to the " RENEWED PETITION UNDER 37 C.F.R. §1.47(a)" filed on 20 June 2006. The petition fee of $200.00 has been charged to Deposit Account No. 18-0013.

## BACKGROUND

In a decision from this Office on 20 April 2006, the initial petition under 37 CFR 1.47(a) was dismissed. The decision stated that it has not been sufficiently demonstrated that a copy of the application papers (specification, including claims, drawings) were presented to the nonsigning inventor as required by MPEP Section 409.03(d). Accordingly, the petition did not include sufficient factual proof that Mr. Tsuyoshi Abe, refused to sign the required papers.

On 20 June 2006, applicant submitted a "Renewed Petition Under 37 CFR 1.47(a)" requesting reconsideration of the Office's decision of 20 April 2006.

## DISCUSSION

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

The renewed petition of 20 June 2006 has satisfied the requirements under 37 CFR 1.47(a).

Junichi Omori averments do 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 nonsigning inventor for his signature as stipulated under MPEP 409.03(d). In this instance, the application papers were sent to Mr. Abe on July 11, 2005 and on June 7, 2006 another copy of the declaration and he has not responded. The conduct of Mr. Abe is interpreted as a refusal to sign the required papers. Consequently, the current record does sufficiently establish that Mr. Abe 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 filed a properly executed declaration complying with 37 CFR 1.497(a)(3).

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 **04 August 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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27 SEP 2006

Tsuyoshi Abe
Freiru Ayase 3-401
Kosuge, Katsushika-ku
Tokyo 124-0001, Japan

In re Application of
Tsuyoshi Abe et al
PCT No.: PCT/JP03/06957
Application No: 10/516,111
Int. Filing Date: 02 June 2003
Priority Date: 31 May 2002
Attorney's Docket No.: OMY-0040
For: CLONING OF TRANSGENIC ANIMALS COMPRISING ARTIFICIAL CHROMOSOMES

Dear Mr. Abe:

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

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

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

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HAYNES AND BOONE, LLP
901 MAIN STREET
SUITE 3100
DALLAS TX 75202-3789

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OFFICE OF PETITIONS

In re Application of :

RING, Lev :
Application No. 10/516,117 : DECISION ON PETITION
Filed: May 02, 2005 : TO WITHDRAW
Attorney Docket No. **25791.89.05** : 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 02, 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 Tredelle Jackson at 571-272- 2783.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **TODD MATTINGLY**
**KING & SPALDING, L.L.P.**
**1100 LOUISIANA STREET**
**SUITE 4000**
**HOUSTON, TX 77002**

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| | | |
|---|---|---|
| In re Application of | : | |
| ALLEN et al. | : | |
| Application No.: 10/516,119 | : | DECISION |
| PCT No.: PCT/IB02/02025 | : | |
| Int. Filing Date: 15 March 2002 | : | |
| Priority Date: 15 March 2001 | : | |
| Attorney Docket No.: None | : | |
| For: BATTERY PACK FOR AN AUTOMATIC EXTERNAL DEFIBRILLATOR | : | |

This decision is in response to applicant's submission filed via facsimile transmission in the United States Patent and Trademark Office (USPTO) on 19 November 2004, which has been treated as a petition under 37 CFR 1.181. No petition fee is required.

## BACKGROUND

On 15 March 2002, applicants filed international application PCT/IB02/02025, which designated the United States and claimed a priority date of 15 March 2001. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 26 September 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 15 September 2003.

On 19 November 2004, applicant filed the instant submission which was accompanied by, *inter alia*, a copy of a cover letter stating that a filing is being made under 35 U.S.C. 371, a copy of a Deposit Account Authorization, and a copy of a postcard receipt date-stamped 12 September 2003 by the USPTO. The submission has been treated as a petition under 37 CFR 1.181.

## DISCUSSION

The papers originally filed 12 September 2003 have now been located. These papers will be processed as the national stage filing under 35 U.S.C. 371 of international application PCT/IB02/02025. Accordingly, the petition under 37 CFR 1.181 filed 19 November 2004 is moot.

The U.S. Basic National Fee under 37 CFR 1.492(a)(5) has been charged to Deposit Account 16-2326.

It is suggested that for future filings under 35 U.S.C. 371, applicants use the TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A SUBMISSION UNDER 35 U.S.C. 371 (Form PTO-1390) so that the filing may be readily identified as a filing under 35 U.S.C. 371.

**CONCLUSION**

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

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including preparing and mailing a NOTIFICATION OF MISSING REQUIREMENTS (Form PCT/DO/EO/905) requiring 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.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (271) 272-3301
Facsimile: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

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NOV 25 2008

In re Application of :
Martinus Hermanus Wilhelmus Marie VAN :
DELDEN : ON PETITION
Application No. 10/516,147 :
Filed: November 30, 2004 :
Attorney Docket No. NL. 020472

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 6, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to file a complete and proper reply to the Office communication mailed, June 4, 2007, which set a period for reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on July 5, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) a reply to the Office communication, (2) the petition fee of $1540; 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.

This application is being revived solely for purposes of divisional application. As the divisional application has been filed, the application is again abandoned in favor of divisional application No. 12/135,094.

The Request for Refund received with the petition on June 6, 2008, has been considered. A refund of $790 will be credited to petitioner's Deposit Account 50-4019 within the normal course of business.

Telephone inquiries concerning this decision should be directed to Diane Goodwyn at (571) 272-6735.

Thurman Page
Petitions Examiner
Office of Petitions

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P.O BOX 1022
MINNEAPOLIS, MN 55440-1022

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APR 28 2010

OFFICE OF PETITIONS

In re Application of :
Timothy Birkinshaw, et al. :
Application No.: 10/516,165 : ON PETITION
Filed: November 30, 2004 :
Attorney Docket No.: 06275-424US1 :

This is a decision on the petition, filed April 27, 2010, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on March 11, 2010, cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

The application is being referred to Technology Center AU 1626 for further processing of the request for continued examination under 37 CFR 1.114.

/SDB/

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

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**BAKER & DANIELS LLP**
**300 NORTH MERIDIAN STREET**
**SUITE 2700**
**INDIANAPOLIS IN 46204**

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In re Application of :
Monica De La Cruz et al :
Application No. 10/516,169 : DECISION ON PETITION
Filed: November 29, 2004 :
Attorney Docket No. GRLK-P110-US :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 19, 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/RCE.; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final rejection mailed February 2, 2009, is accepted as having been unintentionally delayed.

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

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted. While a courtesy copy of this decision is being mailed to the person signing the

petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

Further, petitioner is encouraged to note 37 CFR 1.4(c) which reads:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

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

This application is being referred to Technology Center AU 1796 for appropriate action by the Examiner in the normal course of business on the reply received November 19, 2009.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

cc:

**JEFFREY T. GENDZWILL**
**2900 K STREET, NW, SUITE 200**
**WASHINGTON, DC 20007-5118**

30 SEP 2005

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Justin D G Brennan
Morgan Lewis & Bockius
1701 Market Street
Philadelphia PA 19103-2921

| | |
|---|---|
| In re Application of | |
| THUROT | |
| Application No.: 10/516,189 | DECISION ON |
| PCT No.: PCT/FR03/01382 | |
| Int. Filing Date: 02 May 2003 | PETITION UNDER |
| Priority Date: 03 May 2002 | |
| Attorney Docket No.: 027367-5016 | 37 CFR 1.137(b) |
| For: MODULAR INSTALLATION FOR COMPOSTING ORGANIC MATERIAL | |

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

## BACKGROUND

On 02 May 2003, applicants filed international application PCT/FR03/01382 which designated the U.S. and claimed a priority date of 03 May 2002. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 13 November 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 03 November 2004.

On 29 November 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, the surcharge under 37 CFR 1.492(e), an assertion of small entity status, and a petition under 37 CFR 1.137(b) to revive the application.

## DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), applicant submitted the basic national fee on 29 November 2004.

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

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

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

**CONCLUSION**

The petition under 37 CFR 1.137(b) is **GRANTED** for the reasons set forth above.

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

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including preparing and mailing a NOTIFICATION OF MISSING REQUIREMENTS (Form PCT/DO/EO/905) requiring an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b).

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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COLUMBIA MD 21044

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JUN 17 2010

OFFICE OF PETITIONS

In re Application of
Tim Fletcher
Application No. 10/516,196
Filed: August 18, 2005
Attorney Docket No. **W9552-01**

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed April 21, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to file a proper reply to the final Office action mailed August 14, 2009, which set a three (3) month shortened statutory period for reply. The application became abandoned on February 15, 2010. A Notice of Abandonment was mailed on March 25, 2010.

**The Notice of Appeal, filed April 21, 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 application file is being forwarded to Technology Center 1700, GAU 1796 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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Alexandria, VA 22313-1450
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**Vinson & Elkins, L.L.P.**
**1001 Fannin Street**
**2300 First City Tower**
**Houston, TX 77002-6760**

COPY MAILED

APR 09 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Garry R. Harper et al. | : | |
| Application No. 10/516,203 | : | DECISION ON PETITION |
| Filed: January 9, 2006 | : | TO WITHDRAW |
| Attorney Docket No. IVGN 461 | : | 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 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 Tracey B. Davies on behalf of all attorneys of record. All attorneys/agents have been withdrawn.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

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

T. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Invitrogen Corporation**
**c/o Intellevate**
**P.O. Box 52050**
**Minneapolis, MN 55402**

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/516,203 | 01/09/2006 | Garry R. Harper | IVGN 461 |

**CONFIRMATION NO. 9847**

Vinson & Elkins, L.L.P.
1001 Fannin Street
2300 First City Tower
Houston, TX 77002-6760

**POWER OF ATTORNEY NOTICE**

*OC000000029300032*

Date Mailed: 04/08/2008

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/15/2007.

- 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.

/tswilliams/

Office of Initial Patent Examination (571) 272-4000 or 1-800-PTO-9199.

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**VINSON & ELKINS, LLP**
**1001 FANNIN STREET/2300 FIRST CITY TOWER**
**HOUSTON, TX 77002-6760**

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FEB 26 2008

In re Application of :
**BAKER**, et al. :
Application No. 10/516,204 : DECISION ON PETITION
Filed: November 23, 2005 : TO WITHDRAW
Attorney Docket No. **IVGN 462** : 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 15, 2007.

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

A review of the file record indicates that the power of attorney to **VINSON & ELKINS, LLP** has been revoked by the assignee of the patent application on November 8, 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: **INVITROGEN CORPORATION**
**C/O INTELLEVATE**
**P.O. BOX 52050**
**MINNEAPOLIS, MN 55402**

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CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON DC 20044-4300

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JAN 31 2008

**OFFICE OF PETITIONS**

In re Application of :
Jianqi Li et al. :
Application No. 10/516,205 : ON PETITION
Filed: December 1, 2004 :
Attorney Docket No.: **101402.55477US** :

This is a decision on the petition filed January 7, 2008 under 37 CFR 1.181 to withdraw the holding of abandonment for the above-identified application.

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

The application was held abandoned on August 2, 2007, for failure to submit a timely response to the non-Final Office Action mailed May 1, 2007, which set a three month period for reply. Accordingly, a Notice of Abandonment was mailed December 11, 2007.

Petitioner asserts that a response was filed and, in support, petitioner has submitted, *inter alia*, a copy of the response in the form of an amendment with a certificate of mail date of August 1, 2007 and a post card receipt date stamped August 3, 2007 by the USPTO.

The evidence submitted corroborates a timely response to the non-Final Office Action. Accordingly, the holding of abandonment is withdrawn and the Notice of Abandonment is vacated. No petition fee Is due and none has been charged.

This matter will be referred to Technology Center 1624 for appropriate action on the amendment filed August 3, 2007 (certificate of mail date August 1, 2007), a copy of which was submitted upon petition.

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Jianqi Li | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7576086 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/18/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/516,205 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/01/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1021** 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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13 NOV 2006

GlaxoSmithKline
Corporate Intellectual Property
Five Moore Drive, PO Box 13398
Research Triangle Park, NC 27709-3398

| | |
|---|---|
| In re Application of | |
| GIBLIN, Gerard Martin Paul, et al. | |
| Application No. 10/516,230 | DECISION |
| PCT No.: PCT/EP03/05790 | |
| Int. Filing Date: 30 May 2003 | ON PETITION UNDER |
| Priority Date: 31 May 2002 | |
| Attorney Docket No.: P33063 | 37 CFR 1.8 |
| For: PYRROLE COMPOUNDS FOR THE TREATMENT OF PROSTAGLANDIN MEDIATED DISEASES | |

This is a decision on applicant's "Petition For Withdrawal of Holding of Abandonment 37 CFR 1.181," filed on 22 August 2006.

## BACKGROUND

On 30 May 2003, applicants filed international application no. PCT/EP03/05790, claiming a priority date of 31 May 2002. A copy of the international application was transmitted to the Office by the International Bureau on 11 December 2003. The deadline for payment of the basic national fee in the United States was 30 November 2004.

On 29 November 2004, applicants submitted a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, the basic national fee.

On 31 May 2005, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that oath or declaration and the surcharge for late filing of the oath or declaration were required.

On 12 July 2006, the Office mailed a Notification of Abandonment (Form PCT/DO/EO/909), indicating that the application went abandoned for failure to timely reply to the Notification of Missing Requirements.

On 22 August 2006, applicants filed the instant petition indicating that applicants had timely responded to the Notification of Missing Requirements via facsimile on 08 June 2005, enclosing a copy of the 08 June 2005 response.

## DISCUSSION

Applicants claim to have responded to the Notification of Missing Requirements on 08 June 2005, but the facsimile transmission is not present in the file. However, 37 CFR 1.8(b) states, in part:

> In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in

> the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of correspondence, or after 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.

Items (1) and (2) have been satisfied. Applicants filed the petition promptly after the mailing of the Notification of Abandonment. Applicants supplied a copy of the declaration and the cover letter with the certificate of facsimile transmission.

Item (3) has not been satisfied. Applicant has not provided a statement based on personal knowledge. Applicant has not provided a facsimile transmission record and the docket records indicate that the "Notice of Missing Parts," rather than a Notification of Missing Requirements, was completed 14 June 2005, not 08 June 2005 as applicants have indicated.

## CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.8 to withdraw the holding of abandonment is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.8."

The application remains **ABANDONED**.

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

27 DEC 2006

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| | |
|---|---|
| In re Application of | |
| GIBLIN, Gerard Martin Paul, et al. | |
| Application No. 10/516,230 | DECISION |
| PCT No.: PCT/EP03/05790 | |
| Int. Filing Date: 30 May 2003 | ON PETITION UNDER |
| Priority Date: 31 May 2002 | |
| Attorney Docket No.: P33063 | 37 CFR 1.137(b) |
| For: PYRROLE COMPOUNDS FOR THE TREATMENT OF PROSTAGLANDIN MEDIATED DISEASES | |

Applicants' Petition Under 37 CFR 1.137(b), filed in the above-captioned application on 20 December 2006 is **GRANTED**.

Applicants indicate that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, as required by 37 CFR 1.137(b)(3). The appropriate reply and petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

Applicants have supplied a declaration of inventorship in compliance with 37 CFR 1.497(a)-(b). The fee for late filing of the search fee, examination fee or oath or declaration has been paid.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision. The application has a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 22 August 2006.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

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28 JUL 2008

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Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

In re Application of :
SCHOENDORFER,Don :
U.S. Application No. 10/516,232 :
PCT No.: PCT/US03/16894 :
PCT Filing Date: May 30, 2003
Attorney Docket No. KKJINC.004NP :
For: VORTEX-ENHANCED REVERSE OSMOSIS FILTRATION DEVICE AND METHODS

DECISION ON PETITION
UNDER 37 CFR 1.78(a)

This decision is in response to "Petition to Accept Unintentionally Delayed Priority Claim under 37 CFR 1.78(a)(6)" filed June 27, 2008, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED AS MOOT**.

This nonprovisional application was filed on May 30, 2003, and was pending at the time of filing of this petition. While a reference to the prior-filed provisional application was not included in an Application Data Sheet (ADS) or in the first sentence of the specification following the title, reference nevertheless was made in the National Stage papers (see WIPO publication) of the above-identified PCT application.

The current procedure where a claim for priority under 37 CFR §1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear in the national stage application papers within the time period under 37 CFR 1.78(a)(5)(ii) and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR §1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s), a petition will be required to

accept a late claim for priority under 37 CFR § 1.78(a)(6).[1] In the instant case, the Office noted the claim for priority of the prior-filed application as shown by its inclusion on the filing receipt.

In view of the above, the petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

Any questions concerning this decision on petition may be directed to Anthony Smith at (571) 272-3298. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to the Examiner of Technology Center AU 1723 for appropriate action on the amendment under 37 CFR 1.312 filed 27 June 2008.

Boris Milef
Legal Examiner
Office of Petitions and PCT Legal Administration

[1] *Note* MPEP 201.11 (III)(D).

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 04/28/09

TO SPE OF : ART UNIT 1797

SUBJECT : Request for Certificate of Correction for Appl. No.: 10516232 Patent No.: 7425265 B2

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

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

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

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

**Thank You For Your Assistance**

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

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

**Comments:** _____

_____

_____

_____ 1797
**SPE** **Art Unit**



PAGE 1/1 * RCVD AT 5/4/2009 10:04:50 AM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/4 * DNIS:2709990 * CSID:7033055408 * DURATION (mm-ss):00-52

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IPLM GROUP, P.A.
POST OFFICE BOX 18455
MINNEAPOLIS, MN 55418

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Brian A. Robertson | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7655724 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/516,238 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/29/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **94** 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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**KLARQUIST SPARKMAN, LLP**
**121 SW SALMON STREET**
**SUITE 1600**
**PORTLAND OR 97204**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Stofko, John I. | : | |
| Application No. 10/516,239 | : | ON PETITION |
| Filed: January 29, 2004 | : | |
| Attorney Docket No. 6865-654777-02 | : | |

This is a decision on the petition under 37 CFR 1.102(c)(1), filed August 2, 2006, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section IV: Applicant's Age must be accompanied by evidence showing that at least one of the applicants is 65 years of age, or more, such as a birth certificate or a statement by applicant. No fee is required.

The instant petition includes a Statement from the applicant, John I. Stofko. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-3206. All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

This matter is being referred to the Technology Center Art Unit 1714 for action on the merits commensurate with this decision.

Liana Chase
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA VA 22313-1404

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OFFICE OF PETITIONS

Applicant: Arakawa et al.
Appl. No.: 10/516,264
International Filing Date: May 29, 2003
Title: PROTEIN INDUCING CELL DEATH OF HELICOBACTER PYLORI
Attorney Docket No.: 033723-008
Pub. No.: US 2006/0051363 A1
Pub. Date: March 9, 2006

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on May 1, 2006, for the above-identified application.

The request under 37 CFR 1.221(b) is Dismissed.

Applicant requests that the application be republished because the patent application publication contains material errors in claim 4, line 19, wherein "SEQ ID NO: 2, and having" is misprinted as "SEQ ID NO: 2, and having", claim 8, lines 5 and 6, wherein "a protein comprising either of the following proteins:" is misprinted as "a Protein comprising either of the following Proteins:", lines 16 and 17, wherein "a protein comprising either of the following proteins:" is misprinted as "a Protein comprising either of the following Proteins:" and claim 14, line 11, wherein "adenocarcinoma" is misprinted as "adencarcinoma".

37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. [1]

The error in claim 4, line 19, wherein "SEQ ID NO: 2, and having" is misprinted as "SEQ ID NO: 2. and having", and claim 8, lines 5 and 6, wherein "a protein comprising either of the following proteins:" is misprinted as "a Protein comprising either of the following Proteins:", lines 16 and 17, wherein "a protein comprising either of the following proteins:" is misprinted as

[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).

"a Protein comprising either of the following Proteins:" are Office errors, but they are not material Office errors under 37 CFR 1.221. The errors are not material Office errors because errors are minor typographical errors and the errors do not affect the understanding of the publication. The application is clearly understandable to one of ordinary skill in the art reading the application and claims. 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.

The Office did not make a material mistake in claim 14, as the text is correctly printed as "adencarcinoma", as presented in the amendment filed November 30, 2004.

Applicant is reminded of his duty to conduct a reasonable inquiry before filing a paper before the Office. See MPEP 410.

Applicants' request for a corrected patent application publication on May 1, 2006, may constitute a "failure to engage in reasonable efforts to conclude processing or examination of the application." See 1.704(c). This determination will be made on or after a mailing of a Notice of Allowance.

The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application 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

By facsimile: 571-273-8300

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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OFFICE OF PETITIONS

In re Application of

Arakawa, et al.

Application No. 10/516,264

Filed: November 30, 2004

Attorney Docket No. 1680/6

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181(a) to withdraw the holding of abandonment, filed April 21, 2008.

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

This application was held abandoned on October 19, 2007, after it was believed that no response was received to the non-final Office action mailed July 18, 2007. The notice allowed a period for reply of three (3) months from its mailing date. Extensions of the time set for reply were available pursuant to 37 CFR 1.136(a). A Notice of Abandonment was mailed on March 19, 2008, indicating that a reply to the non-final Office action was not received.

Petitioner states that an amendment responsive to the non-final Office action was filed on October 18, 2007. An Office date-stamped postcard whereby the USPTO acknowledged receiving the response on October 18, 2007, accompanied the petition. Based on the aforementioned, it appears that the application was improperly held abandoned as a response was received prior to expiration of the period for reply. The holding of abandonment is withdrawn, accordingly.

Further inquires regarding this decision may be directed to the undersigned at (571) 272-3222.

The application file is being forwarded Technology Center 1600, GAU 1645, for further processing including review of the amendment filed October 18, 2007, a copy of which was filed with the petition on April 21, 2008.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

In re Application of :
Christopher John Nicholls :
Application No. 10/516,269 : ON PETITION
Filed: November 29, 2004 :
Attorney Docket No. FTIP-37200

This is a decision on the petition under 37 CFR 1.137(a), filed January 15, 2009, to revive the above-identified application.

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

The above-identified application became abandoned for failure to reply to the final Office action mailed July 9, 2008, which set a shortened statutory period for reply of three (3) months from its mailing date. No response was received within the allowable period, and the application became abandoned on October 10, 2008.

A grantable petition under 37 CFR 1.137(a)[1] must be accompanied by: (1) the required reply,[2] unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks item (3).

**The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.**

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is

[1] As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

[2] In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."[3]

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."[4]

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"[5]

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."[6]

**The standard**

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."[7]

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"[8] Nonawarness of a PTO rule will not constitute unavoidable delay.[9]

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[3]Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

[4]Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

[5]Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

[6]Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

[7]Id.

[8]See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

[9]See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a

**Application of the standard to the current facts and circumstances**

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner asserts that by inadvertent error a timely response to the final Office action was not filed.

With regard to item (3), the unavoidable standard requires that petitioner establish, by evidentiary showing, that petitioner acting reasonably and prudently relative to the prosecution of the application and despite petitioner's action the application was unavoidably abandoned. An "inadvertent error", as asserted by petitioner, is more akin to unintentional delay as set forth in 37 CFR 1.137(b), but does not satisfy the unavoidable standard as intended by 37 CFR 1.137(a). The petition is dismissed accordingly.

Alternatively, petitioner may revive the application based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply, the required petition fee ($1,620.00 for a large entity and $810.00 for a verified small entity), and a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

It is noted that fee for the instant petition is $270.00, not $810.00 as was remitted with the petition. The amount of $540.00 will be refunded in due course.

The request for an extension of time within the third month made January 15, 2009, is noted, but cannot be granted because the request was made after the expiration of the maximum statutory period for reply to the final Office action. The amount of $555.00 will be refunded, in due course.

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

By mail: Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

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

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specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

Telephone inquiries regarding this decision should be directed to the undersigned (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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United States Patent and Trademark Office
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CLEVELAND OH 44114-3108

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MAR 16 2009

**OFFICE OF PETITIONS**

In re Application of :
Christopher John Nicholls :
Application No. 10/516,269 : ON PETITION
Filed: November 29, 2004 :
Attorney Docket No. FTIP-37200

This is a decision on the petition under 37 CFR 1.137(b), filed February 20, 2009, to revive the above-identified application.

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

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition" under 37 CFR 1.137(b)."

The above-identified application became abandoned for failure to reply to the final Office action mailed July 9, 2008, which set a shortened statutory period for reply of three (3) months from its mailing date. No response was received within the allowable period, and the application became abandoned on October 10, 2008.

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

(1) the required reply, unless previously filed. In a non-provisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee, or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

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

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

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

The instant petition does not satisfy the requirements of item (1) above.

A proper response to the final Office action did not accompany the petition. A proper response would include either an amendment that places the application in condition for allowance, a Request for Continued Examination, or a Notice of Appeal. A Request for Continued Examination is not a proper response to a non-final Office action. To be considered grantable, the renewed petition must be accompanied by a proper response to the final Office action.

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

By mail:

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Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

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

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

In re Application of :
Christopher John Nicholls :
Application No. 10/516,269 : ON PETITION
Filed: November 29, 2004 :
Attorney Docket No. FTIP-37200

This is a decision on the renewed petition under 37 CFR 1.137(b), filed May 12, 2009, to revive the above-identified application.

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

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition" under 37 CFR 1.137(b)."

The above-identified application became abandoned for failure to reply to the final Office action mailed July 9, 2008, which set a shortened statutory period for reply of three (3) months from its mailing date. No response was received within the allowable period, and the application became abandoned on October 10, 2008.

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

(1) the required reply, unless previously filed. In a non-provisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee, or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

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

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

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

The instant petition does not satisfy the requirements of item (1) above.

Examiner Hashem has determined that the amendment filed May 12, 2009, does not place the application in condition for allowance. Accordingly, a proper response to the final Office action did not accompany the petition. The renewed petition must be accompanied by a proper response to the final Office action which would include either an amendment that places the application in condition for allowance, a Request for Continued Examination, or a Notice of Appeal. No petition fee is due with the renewed petition. Questions regarding the insufficiency of the amendment filed May 12, 2009, should be directed to Examiner Hashem.

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

By mail:

Mail Stop Petitions
Commissioner for Patents
United States Patent and Trademark Office
Box 1450
Alexandria, VA 22313-1450

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

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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SUITE 1200
CLEVELAND OH 44114-3108

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SEP 30 2009

**OFFICE OF PETITIONS**

In re Application of :
Christopher John Nicholls :
Application No. 10/516,269 : ON PETITION
Filed: November 29, 2004 :
Attorney Docket No. FTIP-37200

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply to the final Office action mailed July 9, 2008, which set a shortened statutory period for reply of three (3) months from its mailing date. No response was received within the allowable period, and the application became abandoned on October 10, 2008.

The continuing application accorded application serial number 12/354,795 filed January 16, 2009, is noted. With continuity having been established, the subject application is again abandoned in favor of the continuing application.

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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Frommer Lawrence & Haug
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New York, NY 10151

Mail Date: 05/13/2010

| | | |
|---|---|---|
| **Applicant** | : Jinyo Kumaki | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7636107 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/516,270 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/29/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1207** 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.

#6

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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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26 JAN 2006

Gregory J. Maier
Oblon, Spivak, McClleand, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

In re Application of :
SCHMIDT, et al. :
U.S. Application No.: 10/516,297 : DECISION ON PETITION
PCT No.: PCT/EP03/06130 :
Int. Filing Date: 11 June 2003 : UNDER 37 CFR 1.47(a)
Priority Date: 13 June 2002 :
Attorney Docket No.: 262434US2PCT :
For: METHOD AND INSTRUMENT FOR SURGICAL: NAVIGATION :

This decision is in response to applicant's "Petition Under 37 C.F.R. § 1.47(a)" filed 19 December 2005 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 11 June 2003, applicant filed international application PCT/EP03/06130, which claimed a priority date of 13 June 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, 13 December 2004.

On 09 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by the requisite basic national fee, an English translation of the international application, a First Preliminary Amendment and an Information Disclosure Statement.

On 18 May 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicants of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 19 December 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 five-month extension fee. With the filing of the extension of time petition and payment of the extension fee, 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 all four items.

Regarding item (1), applicant has provided payment of $130.00. Applicant is advised that the petition fee for a petition under 37 CFR 1.47 is $200.00 pursuant to 37 CFR 1.17(g). As authorized, $70.00 will be charged to deposit account number 15-0030.

As to item (2), applicant has provided sufficient evidence to show that Mr. Eckert refuses or because of his duties at the European Patent Office is unable to execute the declaration thus satisfying this item.

Regarding item (3), applicant has provided the last known address of the non-signing inventor.

As to item (4), applicant has filed a compliant declaration of the inventors executed by the remaining inventors on their own behalf and on behalf of the non-signing inventor.

Accordingly, it is proper to grant applicant's petition at this time.

## CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.47(a) is **GRANTED**.

The application has an international filing date of 11 June 2003 under 35 U.S.C. 363, and will be given a date of **19 December 2005** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

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

This application is being returned to the DO/EO/US for processing in accordance with this decision. 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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26 JAN 2006

Mr. Lars Eckert
Schildensteinstrasse 8
Munich 81673
GERMANY

In re Application of
SCHMIDT, et al.
U.S. Application No.: 10/516,297
PCT No.: PCT/EP03/06130
Int. Filing Date: 11 June 2003
Priority Date: 13 June 2002
Attorney Docket No.: 262434US2PCT
For: METHOD AND INSTRUMENT FOR SURGICAL NAVIGATION

Dear Mr. Eckert:

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

Gregory J. Maier
Oblon, Spivak, McClleand, Maier & Neustadt, P.C.
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NIXON & VANDERHYE PC
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ARLINGTON VA 22203

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OFFICE OF PETITIONS

In re Application of :
Akiyama, et al. :
Application No. 10/516,333 : DECISION ON PETITION
Filed: April 18, 2005 :
Attorney Docket No. 1035-548

This is a decision on the "REQUEST FOR CORRECTION OF FILING DATE OF APPLICATION", filed January 16, 2007.

The petition is **DISMISSED**.

The application was deposited under 35 U.S.C. 371 on November 14, 2004. The requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) were received on April 18, 2005. A "NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495" was mailed on July 8, 2005. The Notice informed applicants that "the date appearing on the filing receipt as the "filing date" is the date on which the last of the 35 U.S.C. (c)(1), (c)(2) and (c)(4) requirements has been received in the office."

The matter is being forwarded to the Office of Patent Publication for processing into a patent.

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

Cliff Congo
Petitions Attorney
Office of Petitions

03 MAR 2006

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#6

Richard S. Bullitt
BAYER HEALTHCARE
36 Columbia Road
Morristown, NJ 07962

| | |
|---|---|
| In re Application of: | |
| MERTIN, Dirk, et al. | DECISION ON PETITION FOR REVIVAL OF ABANDONED APPLICATION UNDER 37 CFR 1.137(b) |
| U.S. Application No.: 10/516,344 | |
| PCT No.: PCT/EP03/05228 | |
| International Filing Date: 19 May 2003 | |
| Priority Date: 31 May 2002 | |
| Attorney's Docket No.: LeA 36165 | |
| For: PHARMACEUTICAL PREPARATIONS FOR ORAL ADMINISTRATION CONTAINING ION-EXCHANGE RESINS ... THICKENING AGENTS | |

This decision is issued in response to the "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 21 November 2005.

## BACKGROUND

On 30 November 2004, applicants filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. The Transmittal Letter was accompanied by, among other materials, payment of the basic national fee and an English translation of the international application.

On 31 May 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497.

On 21 November 2005, applicants filed a response to the Notification Of Missing Requirements that included payment for the required four-month extension of time to respond, an executed declaration, and the Petition For Revival considered herein.

## DISCUSSION

Based on the four-month extension of time, applicants' 21 November 2005 submission is considered a timely response to the Notification Of Missing Requirements mailed 31 May 2005. The submission included the executed declaration required by the Notification Of Missing Requirements. Accordingly, the present application did not become abandoned for failure to respond to the Notification Of Missing Requirements. The "Petition For Revival" that accompanied the response to the Notification Of Missing Requirements is therefore moot.

## CONCLUSION

The Petition For Revival filed 21 November 2005 is **DISMISSED AS MOOT**.

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 21 November 2005.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
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**ROBERT M BAUER, ESQ.**
**MACDONALD ILLIG JONES & BRITTON LLP**
**SUITE 700**
**100 STATE STREET**
**ERIE PA 16507-1459**

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OFFICE OF PETITIONS

In re Application of :
**SERNA,** Pedro et al. :
Application No. 10/516,354 : DECISION ON PETITION
Filed: July 28, 2005 : TO WITHDRAW
Attorney Docket No. **NSN.1022US** : 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 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 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, [consent of client], does not meet any of the conditions set forth in 37 CFR 10.40.

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

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

cc: **HARRINGTON & SMITH LLP**
**ATTN. HARRY SMITH**
**4 RESEARCH DRIVE**
**SHELTON CT 06484-6212**

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SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO IL 60606-1080

In re Application of :
:
KAHN, et al. :
Application No. 10/516,374 : DECISION ON PETITION
Filed: November 30, 2004 : TO WITHDRAW
Attorney Docket No. 9761730-0027 : 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 21, 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 David Metzger on behalf of all attorneys of record. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

The application became abandoned for failure to timely respond to the office action mailed January 18, 2007.

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: JONATHAN KAHN
1108 CHEYENNE DRIVE
CROWN POINT, IN 46307

cc: JORDAN A. SIGALE
LOEB & LOEB LLP
321 NORTH CLARK, SUITE 2300
CHICAGO, IL 60610

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**JORDAN A. SIGALE**
**LOEB & LOEB LLP**
**321 N. CLARK, SUITE 2300**
**CHICAGO, IL 60610**

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**OFFICE OF PETITIONS**

In re Application of :
Johnathan Kahn et al. :
Application No. 10/516,374 : ON PETITION
Filed: November 30, 2004 :
Attorney Docket No. KAHN 0034 :

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

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the final Office action mailed, January 18, 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 April 19, 2007. A Notice of Abandonment was mailed on April 19, 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 continuing application under 37 CFR 1.53(b), (2) the petition fee of $750.00, and (3) a proper statement of unintentional delay. Accordingly, the failure to timely reply to the Office action of January 18, 2007 is accepted as being unintentionally delayed.

The petition is not accompanied by a statement of express abandonment in favor of the filing of a continuing application. In order to facilitate action, the petition to revive should include reference to the filing of a continuing application and a letter of express abandonment conditional upon the granting of the petition and of a filing date to the continuing application. Nevertheless, in view of the statement that the reply is the filing of a continuing application, this will be construed as a request to expressly abandon this application in favor of the granting of a filing date to the continuing application. Accordingly, this application is revived solely for the purpose of continuity with continuing Application No. 11/977,384, filed September 12, 2007. As continuity has been established by the revival of this application, this application is again abandoned in favor of the continuing application. If this was not the intent of applicant, the Office should be promptly notified.

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

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

Frances Hicks
Petitions Examiner
Office of Petitions

16 MAY 2005



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Amy E. Rinaldo
Kohn & Associates, PLLC
30500 Northwestern Highway, Suite 410
Farmington Hills, Michigan 48334

In re Application of :
FRANAK et al. :
Application No.: 10/516,389 : DECISION ON PETITION
PCT No.: PCT/US02/23958 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 29 July 2002 :
Priority Date: 30 July 2001 :
Attorney Docket No.: 0256.00004 :
For: ACCESS PRESSURE RATIO AND TESTING METHOD :

The petition to revive under 37 CFR 1.137(b) filed 30 November 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
Tel: (571) 272-3298
Fax: (571) 273-0459

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Amy E. Rinaldo
Kohn & Associates, PLLC
30500 Northwestern Highway, Suite 410
Farmington Hills, Michigan 48334

In re Application of :
FRINAK et al. :
Application No.: 10/516,389 : DECISION ON PETITION
PCT No.: PCT/US02/23958 :
Int. Filing Date: 29 July 2002 :
Priority Date: 30 July 2001 :
Attorney Docket No.: 0256.00004 :
For: ACCESS PRESSURE RATIO AND :
TESTING METHOD

This decision is in response to applicants' "Petition under 37 CFR 1.181" filed 03 July 2006. No petition fee is required.

## BACKGROUND

On 29 July 2002, applicants filed international application PCT/US02/23958 which claimed a priority date of 30 July 2001. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the priority date, 30 January 2004.

On 30 November 2004, applicants 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; a preliminary amendment; and a petition to revive under 37 CFR 1.137(b). In a decision dated 16 May 2005, applicants' petition was granted.

On 25 May 2005, the United States Designated Office (DO/EO/US) mailed a Notification Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a signed oath/declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) together with a surcharge payment were required. The notification set a two-month time limit in which to respond.

On 19 June 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 25 May 2005 within the time period set therein.

On 03 July 2006, applicants filed the present petition which was accompanied, among other things: a copy of the declaration(s) and power of attorney(s) filed 09 June 2005; an Express Mail Customer Receipt dated 09 June 2005; and an Express Mail Track & Confirm Statement.

## DISCUSSION

The above-identified application was abandoned on 25 July 2005 for failure to respond to the Notification of Missing Requirements mailed 25 May 2005. Applicants state in the present petition that an oath/declaration was mailed to the United States Patent and Trademark Office on 09 June 2005 pursuant to 37 CFR 1.10. A review of the application file reveals that the oath/declaration allegedly filed 09 June 2005 is not located therein.

37 CFR 1.10 (e) states:

> Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS, but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;
>
> (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;"
>
> (3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and
>
> (4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence, and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence and original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

Applicants have satisfied Items (1) through (4). The evidence of record is sufficient to establish with reasonable certainty that the oath/declaration was deposited with the United States Postal Service as an "Express Mail" Mailing on 09 June 2005. Applicants' petition to withdraw the holding of abandonment is granted.

## CONCLUSION

As construed above, applicants' petition to withdraw the holding of abandonment is **GRANTED**.

The application has an international filing date of 29 July 2002 under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of **09 June 2005**.

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

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

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Amy E Rinaldo
Kohn & Associates
Suite 410
30500 Northwestern Highway
Farmington Hills, MI 48334

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Stanley Frinak | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7597666 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/06/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/516,389 | : OF WYETH |
| **Filed** | : 06/09/2005 | : |
| | | : |

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.

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MINNEAPOLIS MN 55458-1339

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|---|---|---|
| In re Application of | : | |
| SMITH, Norman R. et al. | : | |
| Application No.: 10/516,400 | : | DECISION |
| PCT No.: PCT/GB03/02955 | : | |
| Int. Filing Date: 08 July 2003 | : | ON REQUEST UNDER |
| Priority Date: 08 July 2002 | : | |
| Attorney's Docket No.: 142.016US01 | : | 37 CFR 1.497(d) |
| For: IMAGE PROCESSING SYSTEM FOR USE WITH A PATIENT POSITIONING DEVICE | : | |

This decision is in response to "Request to Correct Inventorship Under 37 C.F.R. §1.48(a)," filed on 04 November 2005. It has been treated as a request under 37 CFR 1.497(d).

## BACKGROUND

On 08 July 2003, applicant filed international application PCT/GB03/02955, which claimed a priority date of 08 July 2002. A copy of the international application was transmitted to the Office on 15 January 2004 by the International Bureau. The deadline for entry into the national stage in the United States was midnight on 08 January 2005.

On 01 December 2004, applicant filed a submission for entry into the national stage in the United States, accompanied by, *inter alia*, the U.S. Basic National Fee and the surcharge for late filing of the oath or declaration.

On 04 May 2005, the Office mailed Notification of Missing Requirements, indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required.

On 04 November 2005, applicant filed a declaration of the inventors, the instant request and the fee for a four month extension of time.

## DISCUSSION

Applicants file this request to add Robert Edward Howe 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 satisfied. Applicants provided as statement by the inventor that applicants are attempting to add and the processing fee.

Item (3) has not been satisfied. Applicants must provide consent of the assignee. Applicant has not established under 37 CFR 3.73 that Vision RT Limited is the assignee. Specifically, applicant did not provide a copy of the recorded assignment or state the location of the assignment, *e.g.* reel and frame number. Though applicants indicate that the assignments accompanied this submission, they are not located in the file.

## CONCLUSION

For the above reasons, applicants' request under 37 CFR 1.497(d) is **REFUSED**.

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 P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

17 APR 2007

FOGG AND ASSOCIATES, LLC
P.O. BOX 581339
MINNEAPOLIS, MN 554458-1339

| | | |
|---|---|---|
| In re Application of | : | |
| SMITH et al. | : | DECISION ON |
| Application No.: 10/516,400 | : | |
| PCT No.: PCT/GB03/02955 | : | RENEWED REQUEST |
| Int. Filing Date: 08 July 2003 | : | |
| Priority Date: 08 July 2002 | : | UNDER 37 CFR 1.497(d) |
| Attorney's Docket No.: 142.016US01 | | |
| For: Image Processing System For Use With a Patient Positioning Device | : | |

This decision is in response to applicants' renewed request under 37 CFR 1.497(d), filed 07 June 2006, to add Mr. Robert Edward Howe as an inventor. The request under 37 CFR 1.497(d) is GRANTED.

## BACKGROUND

On 08 July 2003, applicants filed international application PCT/GB03/02955, claiming a priority date of 08 July 2002. The deadline for entry into the national stage in the United States was midnight on 08 January 2005.

On 01 December 2004, applicants filed a submission for entry into the national stage in the United States, accompanied by, *inter alia*, the US basic national fee, the surcharge for late filing of an oath or declaration and an Application Data Sheet that did not include Mr. Robert Edward Howe as an inventor.

On 04 May 2005, the Office mailed a Notice of Missing Requirements, indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required.

On 04 November 2005, applicants filed a declaration of the inventors, a request under 37 CFR 1.497(d) to add Mr. Robert Edward Howe as an inventor and a four-month extension fee.

On 07 April 2006, the Office refused applicants' request because the written consent of the assignee to allow the addition of Mr. Robert Edward Howe as an inventor had not been provided.

On 07 June 2006, applicants filed the instant renewed request under 37 CFR 1.497(d) to add Mr. Robert Edward Howe as an inventor, a signed statement from Mr. Robert Edward Howe stating that the error in inventorship occurred without deceptive intention on his part, the consent of the assignee, a declaration signed by all inventors and a copy of the Notice of Recordation of Assignment.

## DISCUSSION

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 intent on his or her part; (2) the processing fee set forth in 37 CFR 1.17(i); and (3) if an assignment has been executed by any of the original inventors, the written consent of the assignee. With the filing of applicants' renewed request, applicants have satisfied items (1) through (3) above.

## CONCLUSION

Applicants' renewed request under 37 CFR 1.497(d) is GRANTED.

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

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

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-3297
Facsimile: (571) 273-0459

Stefan Staicovici
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-1208

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P.O. Box 1450
Alexandria, VA 22313-1450
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Patent No. : 7,304,313 B2
Ser. No. : 10/516,407
Inventor(s) : Moses
Issued : Dec. 4, 2007
Title : LOW- PRESSURE CHAMBER FOR SCANNING ELECTRON MICROSCOPY IN A WET ENVIRONMENT POLISHING
Docket No. : P-7448-US

Re: Request for Certificate of Correction

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

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

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

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

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

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

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

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

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

By fax: (571) 273-0025
ATTN: Office of Petitions

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

**Ennis Young**
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) **756-1542** or (703) 756-1814

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

Pearl Cohen Zedek Latzer, LLP
1500 Broadway
12th Floor
New York NY 10036

MAILED

JUL 13 2010

OFFICE OF PETITIONS

In re Patent No. 7,304,313 :
Issue Date: December 4, 2007 :
Application No. 10/516,407 : DECISION ON PETITION
Filed: December 2, 2004 :
Attorney Docket No. P-7448-US :

This is a decision on the Request To Issue Patent In Name Of Assignee Under 37 CFR 3.81(b); Request For Certificate Of Correction; Response To Denial Of Request For Certificate Of Correction, filed on May 26, 2010, requesting correction on the Title Page of the subject patent to identify the correct assignee's name. The Requests are being treated as a Petition Under 37 CFR 3.81(b). A completed Certificate of Correction Form PTO/SB/44 was submitted with the petition.

The petition under 37 CFR 3.81(b) is **GRANTED**.

Petitioner urges that the present Petition was submitted to correct the assignee's name on the previously submitted PTOL-85B and such error was inadvertent. Accordingly, petitioner requests, in effect, that a Certificate of Correction (PTO/SB/44) be issued the correct name of the assignee to the Title Page of the Letters Patent.

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

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

The requisite $100.00 fee (Fee Code 1811) as set forth under 37 CFR 1.20(a), and the requisite $130.00 processing fee (Fee Code 1464) as set forth under 37 CFR 1.17(i) have been submitted. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR 3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the form (PTO/SB/44) that was submitted with petition.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

Any questions concerning the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,304,313.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

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

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| | | |
|---|---|---|
| In re Application of | : | |
| Tobias Linke, et al. | : | |
| Application No. 10/516,410 | : | DECISION GRANTING PETITION |
| Filed: December 2, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 2001P23305WOUS | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed December 23, 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 November 28, 2008 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642.

This application is being referred to Technology Center AU 3682 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

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

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

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JUL 30 2007

**OFFICE OF PETITIONS**

In re Application of
Johann Reitter, et al.
Application No. 10/516,451
Filed: December 2, 2004
Attorney Docket No. 449122074800

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 25, 2007.

The request is **APPROVED**.

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

The request was signed by Deborah Gladstein on behalf of all attorneys of record who are associated with customer No. 25227.

All attorneys/agents associated with the Customer Number 25227 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must

have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

There are no pending Office actions at the present time.

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: JOHANN REITTER
WOTZING 16
4880 BERG IM ATTERGAU
AUSTRIA

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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 |
|---|---|---|---|
| 10/516,451 | 12/02/2004 | Johann Reitter | 449122074800 |

**CONFIRMATION NO. 3006**

*OC000000025049031*

25227
MORRISON & FOERSTER LLP
1650 TYSONS BOULEVARD
SUITE 400
MCLEAN, VA 22102

Date Mailed: 07/27/2007

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 05/25/2007.

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

---

Office of Initial Patent Examination (571) 272-4000, or 1-800-PTO-9199
FORMER ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/516,457 | 12/03/2004 | Michel Puech | Q84448 | 2874 |

23373 7590 07/25/2008

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

| EXAMINER | |
|---|---|
| LUND, JEFFRIE ROBERT | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1792 | |

| 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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United States Patent and Trademark Office
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mbc

7-25-08

| | | |
|---|---|---|
| In re application of: | Puech | :DECISION ON |
| Serial no.: | 10/516,457 | :PETITION |
| Filed: | December 3, 2004 | : |
| For: | HEATER LINER FOR A PLASMA ETCHING REACTOR, AND AN ETCHING METHOD USING THE LINER | : |

This is a decision on the PETITION FILED UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed December 20, 2007.

On April 5, 2007, a first non-final office action was mailed. Claims 9-11 were rejected under 35 USC 112, 2nd paragraph. (Claim 10 was not listed in the head of paragraph 7 of the Office Action, but is separately discussed near the bottom of p. 4.) On December 20, 2007, a final office action was mailed.

On May 20, 2008, applicant filed the instant petition under 37 CFR 1.181 to formally request the withdrawal of finality of the Office Action of December 20, 2007.
Applicant's position for the withdrawal of the finality is that the grounds of rejection under 35 USC 112, 2nd for indefiniteness of the word "suitable" in claim 9, "thermocoaxial type" in claim 10 and "such as" in claim 11 were new grounds of rejection.

DECISION
The Office Action mailed April 5, 2007 rejected claim 9 for the phrase "such as", claim 10 for the phrase "thermocoaxial type", and claim 11 for the phrase "such as".

As stated in MPEP 706.07(a),
*"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."*

The rejections of claims 10 and 11 under 35 USC 112, 2nd paragraph are not new grounds of rejection because they were presented in the Office Action mailed April 5, 2007. The rejection

of claim 9 under 35 USC 112, 2nd paragraph is a new grounds of rejection because it was not present in the Office Action mailed April 5, 2007. The new grounds of rejection was not necessitated by applicant's amendment nor based on information submitted in any information disclosure statement.

The petition is **GRANTED**. The proposed after final amendment filed on March 20, 2008 will be entered, and the examiner will issue a new office action.

Applicant further requests a refund for the extension fees paid in connection with filing a Notice of Appeal on May 20, 2008.

A refund may be given for any fee paid by mistake or in excess of that required. There was no mistake for the fees paid by the applicant. The fees were paid to keep the application active and to avoid abandonment.

The request for refund is **DISMISSED.**

/JACQUELINE STONE/

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

David J. Cushing
SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, NW
Suite 800
Washington, DC 20037

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**STITES & HARBISON PLLC**
**1199 NORTH FAIRFAX STREET**
**SUITE 900**
**ALEXANDRIA VA 22314**

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MAY 22 2008

In re Application of :
Heinz SCHNEIDER :
Application No. 10/516,458 : DECISION ON PETITION
Filed: December 17, 2004 :
Attorney Docket No. **P08486US00/DEJ** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 14, 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, June 06, 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 September 07, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $770, and (3) a proper statement of unintentional delay. Accordingly, the reply to the non final Office Action of June 06, 2007 is 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 Technology Center AU 3752 for appropriate action on the concurrently filed amendment.

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

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LOWE HAUPTMAN & BERNER, LLP
1700 DIAGONAL ROAD, SUITE 300
ALEXANDRIA VA 22314

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NOV 23 2007

OFFICE OF PETITIONS

In re Application of :
Xavier Hugon et al :
Application No. 10/516,461 : DECISION ON PETITION
Filed: December 3, 2004 :
Attorney Docket No. :
62819(4590-353)

This is a decision on the petition under 37 CFR 1.137(b), filed May 14, 2007, to revive the above-identified application.

The petition is **GRANTED.**

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed July 26, 2006, which set a shortened statutory period for reply of three (3) months. A three (3) month extension of time was obtained under the provisions of 37 CFR 1.136(a). Accordingly, the application became abandoned on January 27, 2007. A Notice of Abandonment was mailed on March 30, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the required reply in the form of a request for continued examination, $790 filing fee, and submission as required by 37 CFR 1.114, (2) the petition fee of $1,500, and (3) a proper statement of unintentional delay. Accordingly, the failure to timely reply to the final Office action of July 26, 2006 is accepted as being unintentionally delayed.

This application is being referred to Technology Center AU 2874 for processing the request for continued examination and for appropriate action in the normal course of business on the submission under 37 CFR 1.114 received May 14, 2007.

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

Frances Hicks
Petitions Examiner
Office of Petitions

28 JUL 2005

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COMMISSIONER FOR PATENTS
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P.O. BOX 1450
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John F. Colligan
Whirlpool Patents Company - MD 0750
500 Renaissance Drive, Suite 102
St. Joseph, MI 49085

| | | |
|---|---|---|
| In re Application of | : | |
| MARITAN, et al. | : | |
| U.S. Application No.: 10/516,467 | : | DECISION ON PETITION |
| PCT No.: PCT/EP03/03723 | : | |
| Int. Filing Date: 10 April 2003 | : | UNDER 37 CFR 1.137(b) |
| Priority Date: 16 May 2002 | : | |
| Attorney Docket No.: IT20020014 | : | |
| For: REFRIGERATOR WITH CARBONATED WATER DISTRIBUTOR | : | |

The petition to revive under 37 CFR 1.137(b) filed 02 December 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors is required.

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

30 AUG 2006

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Philips Electronics North America Corporation
Intellectual Property & Standards
1109 McKay Drive, M/S41-SJ
San Jose, CA 95131

| | | |
|---|---|---|
| In re Application of ARNOLD et al | : | |
| U.S. Application No.: 10/516,468 | : | |
| PCT Application No.: PCT/IB03/01962 | : | |
| Int. Filing Date: 16 May 2003 | : | DECISION |
| Priority Date Claimed: 04 June 2002 | : | |
| Attorney Docket No.: AT02 0029 US | : | |
| For: ROLL BACK METHOD FOR A SMART CARD | : | |

This is in response to applicant's "Petition to Withdraw Abandonment Under 37 C.F.R. §1.181(a)" filed 21 July 2006.

## BACKGROUND

On 16 May 2003, applicant filed international application papers with the United States Receiving Office (RO/US). The submission was assigned the above-identified International Application Number and International Filing Date.

On 16 May 2003, applicant filed international application PCT/IB03/01962, which claimed priority of an earlier European Patent Office application filed 04 June 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 11 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 04 December 2004.

On 02 December 2004, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 17 June 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 04 August 2005, applicant purportedly filed an executed declaration via facsimile.

On 13 July 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909), which indicated that the application is abandoned for failure to timely respond to the Notification of Missing Requirements.

On 21 July 2006, applicant filed the present petition under 37 CFR 1.181.

## DISCUSSION

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.

With regard to item (1) above, the present petition was promptly filed.

With regard to item (2) above, the present petition includes a copy of the previously transmitted correspondence and certificate.

With regard to item (3) above, the statement contained in the petition is not from the person whose name appears on the certificate of transmission.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 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 1.181".

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

COMMISSIONER FOR PATENTS
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08 NOV 2006

Philips Electronics North America Corporation
Intellectual Property & Standards
1109 McKay Drive, M/S41-SJ
San Jose, CA 95131

| | | |
|---|---|---|
| In re Application of ARNOLD et al | : | |
| U.S. Application No.: 10/516,468 | : | |
| PCT Application No.: PCT/IB03/01962 | : | |
| Int. Filing Date: 16 May 2003 | : | DECISION |
| Priority Date Claimed: 04 June 2002 | : | |
| Attorney Docket No.: AT02 0029 US | : | |
| For: ROLL BACK METHOD FOR A SMART CARD | : | |

This is in response to applicant's "Renewed Petition to Withdraw Abandonment Under 37 C.F.R. §1.181(a)" filed 04 October 2006.

## BACKGROUND

On 16 May 2003, applicant filed international application papers with the United States Receiving Office (RO/US). The submission was assigned the above-identified International Application Number and International Filing Date.

On 16 May 2003, applicant filed international application PCT/IB03/01962, which claimed priority of an earlier European Patent Office application filed 04 June 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 11 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 04 December 2004.

On 02 December 2004, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 17 June 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 04 August 2005, applicant purportedly filed an executed declaration via facsimile.

On 13 July 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909), which indicated that the application is abandoned for failure to timely respond to the Notification of Missing Requirements.

On 21 July 2006, applicant filed a petition under 37 CFR 1.181.

On 30 August 2006, this Office mailed a decision dismissing the 21 July 2006 petition.

On 04 October 2006, applicant filed the present renewed petition under 37 CFR 1.181.

## DISCUSSION

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.

Applicant has previously satisfied items (1) and (2) above.

With regard to item (3) above, requisite statement has been provided.

## CONCLUSION

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

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 13 July 2006 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 16 May 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 21 July 2006.

The application is being forwarded to the DO/EO/US for further processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

Mail Date: 05/28/2010

| | | |
|---|---|---|
| **Applicant** | : Chris McEvilly | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7624412 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/24/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/516,470 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/28/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1279** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. None

LADAS & PARRY LLP
224 SOUTH MICHIGAN AVENUE
SUITE 1600
CHICAGO IL 60604

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SEP 28 2007
OFFICE OF PETITIONS

In re Application of :
Rabih Moughelbay et al. :
Application No. 10/516,471 : DECISION ON PETITION
Filed: November 29, 2004 : UNDER 37 C.F.R. § 1.137(A)
Attorney Docket No. 37388-404200 :
Title: TYING DEVICE :

This is a decision on the petition filed September 17, 2007, pursuant to 37 C.F.R. § 1.137(a)[1], to revive the above-identified application.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed February 15, 2006, which set a shortened statutory period for reply of three months. A response was received on August 15, 2006 (along with a "preliminary amendment") however it does not

1 A grantable petition pursuant to 37 C.F.R. §1.137(a) must be accompanied by:

(1) the required reply (in a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof);
(2) the petition fee;
(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and;
(4) a terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

appear that an extension of time under the provisions of 37 C.F.R. § 1.136(a) was requested. Accordingly, the above-identified application became abandoned on May 16, 2006. A notice of abandonment was mailed on September 18, 2006.

**The present petition has not been executed.**

37 C.F.R. § 10.18(a) sets forth:

> For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature, personally signed by such practitioner, in compliance with § 1.4(d)(1) of this chapter.

Since the present petition has been submitted without a signature, the petition cannot be processed. For this reason, the petition under 37 C.F.R. § 1.137(a) must be **DISMISSED.**

**It is noted that a review of the electronic file indicates that the present petition was submitted via facsimile transmission, and it appears that only the first page of form PTO/SB/61 (a form that consists of three pages plus a one-page privacy statement) was received.**

Receipt of the associated petition fee, and a five-page response including amendments to the claims and remarks is acknowledged.

The concurrently filed Power of Attorney and Change of Correspondence Address has been entered and made of record.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.137(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].

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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

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

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

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

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 further action(s) of Petitioner.

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Paper No. None

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CHICAGO IL 60604

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NOV 05 2007
OFFICE OF PETITIONS

In re Application of :
Rabih Moughelbay et al. :
Application No. 10/516,471 : DECISION ON RENEWED PETITION
Filed: November 29, 2004 : UNDER 37 C.F.R. § 1.137(A)
Attorney Docket No. 37388-404200 :
Title: TYING DEVICE :

This is a decision on the renewed petition filed October 2, 2007, pursuant to 37 C.F.R. § 1.137(a)[1], to revive the above-identified application.

## BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed February 15, 2006, which set a shortened statutory period for

1 A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

(1) the required reply (in a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof);
(2) the petition fee;
(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and;
(4) a terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

reply of three months. A response was received on August 15, 2006 (along with a "preliminary amendment") however it does not appear that an extension of time under the provisions of 37 C.F.R. § 1.136(a) was requested. Accordingly, the above-identified application became abandoned on May 16, 2006. A notice of abandonment was mailed on September 18, 2006.

## PROCEDURAL HISTORY

An original petition pursuant to 37 C.F.R. § 1.137(a) was filed on September 17, 2007, and was dismissed via the mailing of a decision on September 28, 2007, for failure to execute the petition.

## THE APPLICABLE STANDARD

Nonawareness of a PTO rule will not constitute unavoidable delay[2]

The burden of showing the cause of the delay is on the person seeking to revive the application[3].

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."[4]

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"[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 either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action[6].

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2 See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel. See also Donnelley v. Dickinson, 123 Fsupp2d 456, 459.

3 Id.

4 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

5 See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

6 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

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[7].

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable[8]."

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account[9]."

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable[10]."

## ANALYSIS

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

> It is noted that a review of the electronic file indicates that the present petition was submitted via facsimile transmission, and it appears that only the first page of form PTO/SB/61 (a form that consists of three pages plus a one-page privacy statement) was received.

With this renewed petition, Petitioner has asserted that the previous submission consisted of the entire petition, and has provided a copy of the same. It is noted that the petition contains a certificate of facsimile transmission dated September 17, 2007. It is further noted that $1540 was charged to

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7 In re Mattullath, 38 App. D.C. at (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).
8 Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.
9 Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.
10 Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

Petitioner's Deposit Account, when only $500[11] was due. The difference has been refunded to Petitioner's Deposit Account.

With this renewed petition, Petitioner has met requirements (1)[12] and (2) of 37 C.F.R. § 1.137(a). The fourth requirement is not applicable.

Petitioner has asserted that the entire period of delay was unavoidable, and that an "adequate showing of the cause of the delay" was enclosed with this renewed petition. However, **the electronic file has been reviewed, and a statement of facts explaining the cause of the delay has not been located.** As such, Petitioner has failed to establish that the entire period of delay was unavoidable.

It follows that the present petition must be **DISMISSED**.

## 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 Under 37 C.F.R. § 1.137(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[13], hand-delivery[14], or facsimile[15]. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web[16].

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.

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11 Although the fee that is associated with the filing of a petition to revive under the unavoidable standard is presently $510, the fee that was in effect on September 17, 2007 was $500.
12 A copy of the amendment that was submitted with the original petition was included with this renewed petition.
13 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
14 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
15 (571) 273-8300- please note this is a central facsimile number.
16 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[17]. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

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

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

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CHICAGO IL 60604

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DEC 10 2007

**OFFICE OF PETITIONS**

In re Application of :
Rabih Moughelbay et al. :
Application No. 10/516,471 : DECISION ON PETITION
Filed: November 29, 2004 : PURSUANT TO
Attorney Docket No. 37388-404200 : 37 C.F.R. § 1.137(B)
Title: TYING DEVICE :

This is a decision on the petition filed November 21, 2007, pursuant to 37 C.F.R. § 1.137(b)[1], to revive the above-identified application.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed February 15, 2006, which set a shortened statutory period for reply of three months. A response was received on August 15, 2006 (along with a "preliminary amendment") however it does not appear that an extension of time under the provisions of 37 C.F.R. § 1.136(a) was requested. Accordingly, the above-

1 A grantable petition pursuant to 37 C.F.R § 1.137(b) must be accompanied by:

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

identified application became abandoned on May 16, 2006. A notice of abandonment was mailed on September 18, 2006.

An original petition pursuant to 37 C.F.R. § 1.137(a) was filed on September 17, 2007, and was dismissed via the mailing of a decision on September 28, 2007, for failure to execute the petition. A renewed petition was filed on October 2, 2007, which was dismissed via the mailing of a decision on November 5, 2007, for failure to include a showing that the entire period of delay was unavoidable.

With this latest submission, Petitioner has set forth that the prior two filings were erroneously submitted under Rule § 1.137(a). Petitioner has included the petition fee, and the proper statement of unintentional delay. The amendment that was filed on October 2, 2007 shall serve as the proper reply. The fee that is associated with the filing of this petition will be charged to Petitioner's Deposit Account in due course, and it is noted that a terminal disclaimer is not required.

Having met each of the requirements of Rule § 1.137(b), the present petition is **GRANTED**.

Petitioner's request for a refund of the fee that was submitted with the petition that was filed pursuant to Rule § 1.137(a) cannot be granted however, as the petition was not necessitated by any error on the part of the Office. Moreover, petition fees are jurisdictional. See 37 C.F.R. § 1.137(a)(2).

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the amendment that was received on October 2, 2007 can be processed.

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

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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 further action(s) of Petitioner.

concerning examination procedures or status of the application should be directed to the Technology Center.

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

29 JUN 2006

#6

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

Dykas, Shaver, & Nipper, LLP
P.O. Box 877
Boise, Idaho 83701-0877

In re Application of :
McGUIRE, John :
Application No.: 10/516,486 : DECISION ON PETITION
PCT No.: PCT/GB03/01923 :
Int. Filing Date: 02 May 2003 :
Priority Date: 31 May 2002 :
Attorney Docket No.: MCGJ101NUS :
For: APPARATUS FOR HOLDING A CATHETER BAG

This decision is issued in response to applicant's "Petition under 37 CFR 1.181 and Statement in Support Thereof" filed 04 May 2006. No petition fee is required.

## BACKGROUND

On 02 May 2003, applicants filed international application 02 May 2003 which claimed a priority date of 31May 2002. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire on 01 December 2004.

On 30 November 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; and a preliminary amendment.

On 09 May 2005, the United States Designated Office (DO/EO/US) mailed a Notification Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a signed oath/declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) together with a surcharge payment were required. The notification set a two-month time limit in which to respond.

On 04 May 2006, applicant filed the present petition which was accompanied, among other things: a copy of the declaration(s) and power of attorney(s) and a post card receipt dated 18 May 2005.

## DISCUSSION

Applicant states that a declaration/power of attorney was received at the United States Patent and Trademark Office on 18 May 2005. A review of the present application reveals that the declaration is not located therein. Section 503 of the Manual of Patent

Examining Procedure under the heading "RETURN POSTCARD" states, in part:

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

Here, applicant has provided a copy of their date-stamped filing receipt. The receipt identifies the application by applicant, title of invention, serial number, and attorney docket number. The receipt itemizes a declaration of the inventor. The receipt is stamped "Rec'd PCT/PTO 18 May 2005" across its face is sufficient to indicate that the above items were in fact received in the Office on 18 May 2005.

## CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

This application will be given an international filing date of 02 May 2003 and a date of **18 May 2005** under 35 U.S.C. 371.

The application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
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UNITED STATES PATENT AND TRADEMARK OFFICE

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PHARMACEUTICAL PATENT ATTORNEYS, LLC
55 MADISON AVENUE
4TH FLOOR
MORRISTOWN NJ 07960-7397

| | |
|---|---|
| In re Application of | : |
| Juan Luis Hancke-Orozco et al | : PETITION TO MAKE SPECIAL |
| Serial No.: 10/516,500 | : |
| Filed: December 2, 2004 | : |
| Attorney Docket No.: | |

This is in response to the petition filed July 22, 2005, to make the above-identified application special under the provisions of 37 CFR 1.102(d).

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/516,500 | 12/02/2004 | Juan Luis Hancke Orozco | Herbal Powers | 4925 |

22925 7590 11/18/2009

PHARMACEUTICAL PATENT ATTORNEYS, LLC
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MORRISTOWN, NJ 07960-7397

| EXAMINER | |
|---|---|
| RAHMANI, NILOOFAR | |
| ART UNIT | PAPER NUMBER |
| 1625 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 11/18/2009 | 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):

docket@LicensingLaw.net
administration@LicensingLaw.net

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

---

*Ex parte* Juan Luis Hancke Orozco, and Rafael Augustin Burgos Aguilera

---

Appeal 2009-015020
Application 10/516,500
Technology Center 1600

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Decided: November 16, 2009

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DECISION ON PETITIONS

This is a decision on two petitions filed on October 8, 2009, both entitled "Rule 41.3 Petition for Supervisory Intervention." One petition ("First Petition") requests that "the Board of [Patent] Appeals [and Interferences] strike the Examiner's August 21, 2009 *Revised Second Supplemental Examiner's Answer*." First Petition, p. 1. (emphasis in original). The other petition ("Second Petition") requests that "the Board of [Patent] Appeals [and Interferences] issue a corrected *Docketing Notice* because it will avoid confusion regarding what arguments are, and are not, before the Board." Second Petition, p. 1. (emphasis in original).

FINDINGS

1. In this application, a Final Rejection was entered on January 19, 2007.

2. A Corrected Appeal Brief was filed on June 13, 2007, an Examiner's Answer was entered on August 29, 2007, and a Reply Brief was filed on September 4, 2007.

3. A Supplemental Examiner's Answer was entered on October 24, 2007, and a Supplemental Reply Brief was filed on November 8, 2007.

4. Another Supplemental Examiner's Answer was entered on December 3, 2007, and an Order Returning Undocketed Appeal to Examiner was entered on March 31, 2009 returning the application to the Examiner for correction of formal defects in the preceding Supplemental Examiner's Answer.

5. A still further Supplemental Examiner's Answer was entered on August 21, 2009, and an Appeal Docketing Notice was mailed on September 21, 2009. The First and Second Petitions followed on October 8, 2009.

6 In respect to appellant responses to supplemental examiner's answers, 37 C.F.R. § 41.43(b) provides that:

> If a supplemental examiner's answer is furnished by the examiner, appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer.

## DISCUSSION

As indicated by the chronology of papers filed by Appellants and papers entered by the Office outlined above, it is clear that the Docketing Notice of September 21, 2009 was entered one month after entry of the last-entered Supplemental Examiner's Answer of August 21, 2009. Thus, the Docketing Notice was entered before the two-month period for response to

the Supplemental Examiner's Answer of August 21, 2009 had expired. The Docketing Notice, therefore, was entered prematurely. The Board should not have entered the Docketing Notice and taken jurisdiction of the Appeal until after the period for response to the Supplemental Examiner's Answer of August 21, 2009 had expired.

## DECISION

Accordingly, the Docketing Notice of September 21, 2009 is rescinded and the Appeal is remanded to Technology Center 1600 for completion of the briefing or expiration of the period for completion of such briefing.

In view of the remand to the Technology Center, the First and Second Petitions addressed to the Board are dismissed as moot. Any objections or disagreements that Appellants may have with the Supplemental Examiner's Answer of August 21, 2009, should be addressed in a Supplemental Reply Brief and/or Petition to the Technology Center.

Appellants are given a period of two months from the mailing date of this Decision to respond to the Supplemental Examiner's Answer of August 21, 2009.

Michael R. Fleming
Chief Administrative Patent Judge

Mark Pohl
Pharmaceutical Patent Attorneys LLC
55 Madison Avenue, 4th Floor
Morristown, NJ 07960-6397

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**ISIS PHARMACEUTICALS, INC**
**1896 RUTHERFORD ROAD**
**CARLBAD, CA 92008**

**COPY MAILED**

NOV 17 2006

**OFFICE OF PETITIONS**

In re Application of :
**BENNETT**, et al. :
Application No. 10/516,505 : DECISION ON PETITION
Filed: December 1, 2004 : TO WITHDRAW
Attorney Docket No. PTS-0055USA : 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 5, 2006.

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

A review of the file record indicates that the power of attorney to Paul K. Legaard and the attorneys of ISIS PHARMACEUTICALS, INC has been revoked by the assignee of the patent application on June 29, 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: **KNOBBE, MARTENS, OLSON & BEAR, LLP**
**2040 MAIN STREET, 14th FLOOR**
**IRVINE CA 92614**

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NEEDLE & ROSENBERG, P.C.
SUITE 1000
999 PEACHTREE STREET
ATLANTA, GA 30309-3915

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FEB 0 8 2008

**OFFICE OF PETITIONS**

In re Application of :
Martin Loessner et al. :
Application No. 10/516,507 : DECISION ON PETITION
Filed: December 1, 2004 : TO WITHDRAW
Attorney Docket No. 05146.0003U2 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 28, 2007.

The request is **NOT APPROVED**.

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

The request cannot be approved because no reasons for withdrawal have been provided. The Office cannot, at this time, determine whether practitioner's request is one of the mandatory or permissive reasons enumerated in 37 CFR 10.40. Any subsequent requests must include reasons for withdrawal. Please note that there is a space provided for on PTO/SB/83 (Request to Withdraw as Attorney or Agent) to supply practitioner's reasons.

A courtesy copy of this decision is being mailed to the first named inventor at the address noted in the Declaration for Patent Application, as well as to the address noted in the request. If the attorneys with this firm desires to receive future communication concerning this application, proper power of attorney documents should be submitted.

A non-final rejection was mailed on October 12, 2007. Failure to timely respond will result in the abandonment of the application.

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

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

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Dirk de Meester
Chief Operating Officer
EBI Food Safety B.V.
Johan van Oldenbarneveltlaan 9
2582 NE Den, Haag
The Netherlands

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**NEEDLE & ROSENBERG, P.C.**
**SUITE 1000**
**999 PEACHTREE STREET**
**ATLANTA, GA 30909-3915**

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OFFICE OF PETITIONS

In re Application of

Martin Loessner et al.
Application No. 10/516,507
Filed: December 1, 2004
Attorney Docket No. 05146.0003U2

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 18, 2008.

The request is **moot** because a revocation of power of attorney has been filed.

A review of the file record indicates that the power of attorney to David E. Huizenga and all attorneys/agents of record has been revoked by the assignee of the patent application on March 14, 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.

There are no outstanding Office actions at this time.

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

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Browdy and Newark, PLLC
624 Ninth Street, NW
Suite 300
Washington, DC 20001-5303

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/516,507 | 12/01/2004 | Martin Loessner | 05146.0003U2 |

**CONFIRMATION NO. 5123**

**POWER OF ATTORNEY NOTICE**

23859
NEEDLE & ROSENBERG, P.C.
SUITE 1000
999 PEACHTREE STREET
ATLANTA, GA 30309-3915

Date Mailed: 03/18/2008

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/14/2008.

- 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).

/kainabinet/

---

Office of Initial Patent Examination (571) 272-4000 or 1-800-PTO-9199

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MINNEAPOLIS, MN 55440-1022

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Josef Beden | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7648627 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/19/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/516,528 | : 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 **726** 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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**MORRISON & FOERSTER LLP**
**1650 TYSONS BOULEVARD, SUITE 400**
**MCLEAN, VA 22102**

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MAR 17 2008

OFFICE OF PETITIONS

In re Application of :
**HAHN**, et al. :
Application No. 10/516,534 : DECISION ON PETITION
Filed: December 2, 2004 : TO WITHDRAW
Attorney Docket No. **449122078200** : 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 October 29, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **BELL, BOYD & LLOYD, LLP**
**P.O. BOX 1135**
**CHICAGO IL 60690**

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M/S41-SJ
1109 MCKAY DRIVE
SAN JOSE, CA 95131

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OCT 2 8 2008

**OFFICE OF PETITIONS**

In re Application of :
Leonardus Joseph Michael Ruitenburg et al :
Application No. 10/516,548 : ON PETITION
Filed: December 2, 2004 :
Attorney Docket No. NL 020540 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 8, 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 September 21, 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 December 22, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810 and the submission required by 37 CFR 1.114; (2) the petition fee of $1540; and (3) a proper statement of unintentional delay.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

This application is being referred to Technology Center AU 2618 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Irvin Dingle
Petition Examiner
Office of Petitions

cc: Mark A. Wilson
PMB: 348
2530 Berryessa Road
San Jose, CA 95132

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FOLEY & LARDNER LLP
150 EAST GILMAN STREET
P.O. BOX 1497
MADISON WI 53701-1497

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OFFICE OF PETITIONS

In re Patent No. 7,453,472
Issued: November 18, 2008
Application No. 10/516,554
Filed: November 30, 2004
Dkt. No.: 083404-0145

: PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R §1.705", filed January 14, 2009. This matter is being properly treated as an application for patent term adjustment pursuant to 37 CFR 1.705(d).

The request for reconsideration of patent term adjustment (PTA) is **DISMISSED**.

The above-identified application matured into U.S. Pat. No. 7,453,472 on November 18, 2008. The patent issued with a PTA 460 days. The request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See, 37 CFR 1.705(d). Patentees request that the patent term adjustment be increased from 460 days to 814 days.

Patentees request reconsideration 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). Patentee asserts that the correct number of days of Patent Term Adjustment is 814 days under the courts interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentee asserts that pursuant to Wyeth, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." Patentee maintains that the total non-overlapping PTO delay under §154(b)(1)(A) & (B) is 872 days (354 days + 518 days) as these periods do not occur on the same day. Further, patentee acknowledges a delay of 58 days pursuant to 37 CFR 1.704(b). Thus, patentee asserts entitlement to an overall patent term adjustment of 814 days (872 days *less* 58 days).

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, patentees are entitled to the period of Office delay reduced by the period of applicant delay.

The Office agrees that as of the issuance of the patent on November 18, 2008, the application was pending three years and 354 days after the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application. The Office agrees that certain action was not taken within a specified time frame, and, thus, the entry of a period of adjustment of 518 days is correct. At issue is whether patentees should accrue an additional 354 days of patent term adjustment for the Office taking in excess of three years to issue the patent as well as 518 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that the period of 354 days delay in issuance of the patent overlaps with the period of examination delay of 518 days. Patentees' calculation of the period of overlap is inconsistent with the Office's interpretation of this provision. 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

> To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

Likewise, 35 CFR 1.703(f) provides that:

> To the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004), the Office interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

> If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule, 65 Fed. Reg. 56366 (Sept. 18, 2000). See, also, Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See, also, Explanation of 37 CFR 1.703(f) and of the

> United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A), 69 Fed. Reg. 34283 (June 21, 2004).

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 three-year pendency does not overlap only to the extent that the actual dates in the period beginning three years after the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application 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

---

[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).

the overlap does not begin three years after the national stage commenced under 35 U.S.C. 371(b) or (f) in an international 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)(1)(A) is the entire period during which the application was pending before the Office, November 30, 2004, to the date the patent issued on November 18, 2008. Prior to the issuance of the patent, 518 days of patent term adjustment were accorded for the Office failing to respond within a specified time frame during the pendency of the application.

The application actually issued three years and 354 days after the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application. However, the Office did not delay 354 days and then delay an additional 518 days. Accordingly, 518 days of patent term adjustment (not 518 days and 354 days) was properly entered because the period of delay of 354 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 518 days attributable to grounds specified in § 1.702(a)(1). Entry of both periods is not warranted.

In view thereof, no adjustment to the patent term will be made.

The Office acknowledges submission of the required application fee of $200.00. See, 37 CFR 1.18(e). The request for refund of the required application fee is hereby DISMISSED. Submission of the application fee is a prerequisite prior to treatment on the merits of any application for patent term adjustment.

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

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INDIANAPOLIS IN 46206-6288

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NOV 0 4 2008

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,371,872 | : | |
| MOHER et al. | : | DECISION ON REQUEST FOR |
| Issue Date: May 13, 2008 | : | RECONSIDERATION OF PATENT |
| Application No. 10/516,559 | : | TERM ADJUSTMENT and |
| Filed: November 30, 2004 | : | NOTICE OF INTENT TO ISSUE |
| Attorney Docket No. X-14978M | : | CERTIFICATE OF CORRECTION |

This is a decision on the "PETITION TO THE DIRECTOR UNDER 37 C.F.R. §1.181 TO REVIEW THE DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION" filed October 10, 2008. Patentees request that the Patent Term Adjustment for the above-identified patent be set at three hundred eight-one (381) days.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **three hundred eighty-one (381) days**.

On May 13, 2008, the above-identified application matured into U.S. Patent No. 7,371,872. The patent issued with a revised Patent Term Adjustment of three hundred thirty-one (331) days. On July 14, 2008, patentees filed a timely request for reconsideration within two (2) months of the date the patent issued. See 37 CFR 1.705(d). On September 19, 2008, the Office granted the request to the extent that the patent term

adjustment indicated in the patent was to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of three hundred seventy (370) days.

On October 10, 2008, patentees filed the present request for reconsideration, in which they assert that there were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the above-identified application as set forth in 37 CFR 1.704. Specifically, patentees dispute the reduction of eleven (11) days based on the filing of the Certified Copy of the Foreign Priority Application on March 25, 2008. Patentees state that they originally submitted the Certified Copy of the Foreign Priority Application on June 6, 2003, the receipt of which was acknowledged by the USPTO. Patentees further state that they resubmitted a copy of the previously filed Certified Copy of the Foreign Priority Application on March 25, 2008, pursuant to Box 3(c)(1) checked in the Notice of Allowability. Patentees assert that the resubmission of the Certified Copy of the Foreign Priority Application, for which receipt was acknowledged by the Office, does not warrant a reduction of the patent term adjustment pursuant to 37 CFR 1.704(c)(10).

The record has been carefully reviewed, and based on the facts specific to this application, it is determined that the resubmission of the Certified Copy of the Foreign Priority Application on March 25, 2008, does not constitute a failure to engage in reasonable efforts to conclude processing or examination of the above-identified application pursuant to 37 CFR 1.704(c)(10). The reduction of 11 days is not warranted and will be removed.

In view thereof, the patent term adjustment indicated on the patent should be three hundred eighty-one (381) days.

This matter is being referred 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 **three hundred eighty-one (381) days.**

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.

Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,371,872 B2

DATED : May 13, 2008

INVENTOR(S) : Moher 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~~ 370) days

Delete the phrase "by ~~391~~ 370 days" and insert – by 381 days--

Day : Friday
Date: 10/31/2008

PALM INTRANET

Time: 13:57:45

| PTA Calculations for Application: 10/516559 | | | |
|---|---|---|---|
| Application Filing Date: | 11/30/2004 | PTO Delay (PTO): | 381 |
| Issue Date of Patent: | 05/13/2008 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 50 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 381 |
| PTO Delay Adjustment: | 50 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 109 | 10/31/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | 1 | | |
| 108 | 10/31/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | 10 | | |
| 107 | 10/31/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 50 | |
| 106 | 10/31/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | 50 | | |
| 103 | 09/18/2008 | RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ISSUE | | | |
| 102 | 09/18/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | 39 | | |
| 97.5 | 04/23/2008 | PTA 36 MONTHS | | | |
| 97 | 05/13/2008 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 96 | 04/14/2008 | EXPORT TO FINAL DATA CAPTURE | | | |
| 95 | 04/10/2008 | FINISHED INITIAL DATA CAPTURE | | | |
| 94 | 04/10/2008 | DISPATCH TO FDC | | | |
| 93 | 04/04/2008 | EMAIL NOTIFICATION | | | |
| 90 | 04/04/2008 | MAIL ACKNOWLEDGEMENT OF PRIORITY PAPERS-PUB | | | |
| 89 | 03/25/2008 | ACKNOWLEDGEMENT OF PRIORITY PAPERS-PUB | | | |
| 88 | 03/25/2008 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | 6 | |
| 87 | 03/31/2008 | MISCELLANEOUS INCOMING LETTER | | 44 | |
| 86 | 03/31/2008 | RESPONSE TO REASONS FOR ALLOWANCE | | | |
| 85 | 04/01/2008 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 84 | 03/31/2008 | ISSUE FEE PAYMENT VERIFIED | | | |
| 83 | 03/31/2008 | ISSUE FEE PAYMENT RECEIVED | | | |
| 81 | 01/03/2008 | ELECTRONIC REVIEW | | | |
| 79 | 12/31/2007 | MAIL NOTICE OF ALLOWANCE | | | |

| | | | | | |
|---|---|---|---|---|---|
| 78 | 12/27/2007 | ISSUE REVISION COMPLETED | | | |
| 77 | 12/27/2007 | DOCUMENT VERIFICATION | | | |
| 76 | 12/26/2007 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 75 | 12/26/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 74 | 12/26/2007 | NOTICE OF ALLOWABILITY | | | |
| 73 | 12/05/2007 | DATE FORWARDED TO EXAMINER | | | |
| 72 | 11/27/2007 | AMENDMENT AFTER FINAL REJECTION | | | |
| 71 | 08/27/2007 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 70 | 08/20/2007 | FINAL REJECTION | | | |
| 69 | 07/02/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 68 | 07/02/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 0 | 65 |
| 67 | 07/02/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 66 | 07/11/2007 | DATE FORWARDED TO EXAMINER | | | |
| 65 | 07/02/2007 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 64 | 05/17/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 63 | 05/17/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 58 | 08/20/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 35 | 05/17/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 34 | 04/05/2007 | ELECTRONIC REVIEW | | | |
| 33 | 04/04/2007 | EMAIL NOTIFICATION | | | |
| 32 | 04/02/2007 | MAIL NON-FINAL REJECTION | | | |
| 31 | 03/27/2007 | NON-FINAL REJECTION | | | |
| 30 | 03/20/2007 | DATE FORWARDED TO EXAMINER | | | |
| 29 | 03/15/2007 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 28 | 02/17/2007 | ELECTRONIC REVIEW | | | |
| 27 | 02/16/2007 | EMAIL NOTIFICATION | | | |
| 26 | 02/15/2007 | MAIL RESTRICTION REQUIREMENT | 381 | | -1 |
| 25 | 02/12/2007 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 24 | 11/30/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 23 | 02/01/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 22 | 11/17/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
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|---|---|---|---|---|---|
| 21 | 07/20/2005 | MAIL OF WITHDRAW OF INFORMAL AMENDMENT NOTICE | | | |
| 19 | 07/20/2005 | WITHDRAW OF INFORMAL AMENDMENT NOTICE | | | |
| 18 | 07/07/2005 | MISCELLANEOUS INCOMING LETTER | | | |
| 15 | 03/04/2005 | PRELIMINARY AMENDMENT | | | |
| 14 | 06/28/2005 | CLEARED BY OIPE CSR | | | |
| 13 | 06/08/2005 | MAIL NON-COMPLIANT PRELIMINARY AMENDMENT | | | |
| 12 | 06/07/2005 | NON-COMPLIANT PRELIMINARY AMENDMENT | | | |
| 11 | 06/01/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 10 | 06/01/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 8 | 05/23/2005 | OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL) | | | |
| 7 | 11/30/2004 | REFERENCE CAPTURE ON IDS | | | |
| 6.7 | 11/30/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 6 | 11/30/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 5 | 11/30/2004 | PRELIMINARY AMENDMENT | | | |
| 4 | 12/11/2004 | 371 COMPLETION DATE | | | |
| 3 | 05/16/2005 | APPLICATION DISPATCHED FROM OIPE | | | |
| 2 | 05/16/2005 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 1 | 11/30/2004 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** [ ] Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

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14 JUL 2005

#3

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John D. Lanza
Lahive & Cockfield, LLP
28 State Street
Boston, MA 02109

In re Application of :
UNSWORTH, et al. :
U.S. Application No.: 10/516,567 : DECISION ON PETITION
PCT No.: PCT/GB03/02376 :
Int. Filing Date: 30 May 2003 : UNDER 37 CFR 1.137(b)
Priority Date: 31 May 2002 :
Attorney Docket No.: BKT-004US :
For: IMPROVEMENTS IN OR RELATING TO THE :
MONITORING OF TWO-PHASED FLUID FLOW :

The petition to revive under 37 CFR 1.137(b) filed 01 December 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors is required.

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

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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 5400
SEATTLE WA 98104

MAILED

MAR 12 2010

OFFICE OF PETITIONS

In re Application of :
Wobben :
Application No. 10/516,570 : ON PETITION
Filed: September 14, 2005 :
Attorney Docket No. 970054.480USPC :

This is in response to petition to revive an unintentionally abandoned application under 37 CFR 1.137(b), filed January 4, 2010.

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

The above-identified application became abandoned for failure to timely file a proper response to the final Office action, mailed May 12, 2009, which set a shortened statutory period for reply of three months. No reply having been received, the application became abandoned on August 13, 2009. The Office mailed a Notice of Abandonment on December 23, 2009.

With the instant petition, petitioner paid the petition fee, made the proper statement of unintentional delay, and submitted the required reply in the form of an RCE.

The application is being forwarded to Group Art Unit 3745 for consideration of the RCE, filed January 4, 2010.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT and TRADEMARK OFFICE

13 MAR 2009

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OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA VA 22320-4850

| | | |
|---|---|---|
| In re Application of | : | |
| Fumio SAKITANI | : | |
| Application No.: 10/516,591 | : | DECISION ON |
| PCT No.: PCT/JP03/07075 | : | |
| Int. Filing Date: 04 June 2003 | : | PETITION |
| Priority Date: 04 June 2002 | : | |
| Attorney's Docket No.: 121965 | : | UNDER 37 CFR 1.181 |
| For: SHEET-LIKE ELECTRONIC... | : | |
| COMPONENT MANUFACTURING SYSTEM | : | |

This decision is in response to the "REQUEST FOR CORRECTION OF PALM RECORDS," filed on 30 March 2005, 26 May 2006, 21 December 2006, 12 June 2008, and 10 November 2008 which is being treated as a petition under 37 CFR 1.181 requesting that the 371(c)(1), (c)(2), and (c)(4) date of the above application be corrected to 04 March 2005.

## BACKGROUND

On 03 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1), and a copy of the international application, and a translation into English of the international application were provided with the transmittal letter. However, no executed Declaration was filed at such time.

On 04 March 2005, applicant filed a second transmittal letter, which was accompanied with a submission of an executed declaration.

On 05 March 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495" which informed applicant that the 371(c)(1), (c)(2) and (c)(4) date is 03/05/2005 and that the date of completion of all 35 U.S.C. 371 is 04 December 2005.

On 30 March 2005, 26 May 2006, 21 December 2006, 12 June 2008, and 10 November 2008 applicant submitted the present petition requesting a corrected filing receipt, stating that the date of receipt under 35 USC 371(c)(1), (c)(2), and (c)(4) requirements is 04 March 2005.

## DISCUSSION

A review of the file indicates that the executed declaration was received on **04 March 2005**, which is the also the date that applicants satisfied the requirement under 35 U.S.C. 371(c)(4). Accordingly, this is the date that 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements were satisfied. In addition, the date of completion of all 35 USC 371 is 04 March 2005 because it is the date that the applicable sections of 35 USC 371 were met.

Consequently, the Notification of Acceptance (Form PCT/DO/EO/903) mailed on 05 March 2005 was erroneous because it indicated the Date of Completion of all 35 USC 371 Requirements is 03/05/2005 and the Date of Receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements is 12/04/2005.

## DECISION

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

The Notification of Acceptance (Form PCT/DO/EO/903) mailed on 11 March 2005 is **VACATED** with the mailing of this decision.

A new Notification of Acceptance (Form PCT/DO/EO/903) will be mailed in accordance with 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. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **04 March 2005** and the Date of Completion of all 35 USC 371 Requirements **04 March 2005**.

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

17 MAR 2006

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#7

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

| | | |
|---|---|---|
| In re Application of | : | |
| Agnew et al. | : | |
| Application No. 10/516,606 | : | |
| PCT No.: PCT/GB03/02576 | : | |
| Int. Filing Date: 16 June 2003 | : | DECISION |
| Priority Date: 14 June 2002 | : | |
| Atty. Docket No.: 08364.0079 | : | |
| For: Mobile Navigation | : | |
| | : | |

This is in response to the "Petition To Withdraw Holding Of Abandonment..." filed on 15 February 2006.

## BACKGROUND

This international application was filed on 16 June 2003, claimed an earliest priority date of 14 June 2002, and designated the U.S. The International Bureau communicated a copy of the published international application to the USPTO on 24 December 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 14 December 2004. Applicants filed, *inter alia*, the basic national fee on 03 December 2004.

On 27 June 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the filing of an oath or declaration compliant with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(e).

On 18 January 2006, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicants, indicating that this international application had become abandoned with respect to the national stage in the United States for failure to timely reply to the Form PCT/DO/EO/905 mailed on 27 June 2005.

## DISCUSSION

Applicants request withdrawal of the holding of abandonment on the basis that a response was allegedly filed on 27 January 2006, within the period for response to the Form PCT/DO/EO /905 as extended under 37 CFR 1.136(a). Inspection of the application file reveals that the 27 January 2006 response is present, and that said response included a petition and fee for a five-month extension of time under 37 CFR 1.136(a) as well as the required reply in the form of the $130.00 surcharge and a declaration of the inventors in compliance with 37 CFR 1.497(a) and (b). As such, the Notification of Abandonment mailed on 18 January 2006 was premature, and it is hereby **VACATED**.

## CONCLUSION

The petition is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for continued processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **27 January 2006**.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/516,621 | 12/03/2004 | Tatsuo Tsuneka | SAE-036 | 5295 |

20374 7590 04/01/2008

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ARLINGTON, VA 22202

| EXAMINER | |
|---|---|
| CHEUNG, WILLIAM K | |
| **ART UNIT** | **PAPER NUMBER** |
| 1796 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 04/01/2008 | PAPER |

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

The time period for reply, if any, is set in the attached communication.

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4-1-08

chk

| | | |
|---|---|---|
| In re application of | TSUNEKA et al. | |
| Serial no. | 10/516, 621 | : DECISION |
| Filed: | December 3, 2004 | :ON |
| For: | AQUEOUS RESIN DISPERSION COMPOSITION AND METHOD FOR PRODUCING THE SAME | : PETITION |

This is a decision on the PETITION FILED UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION of November 16, 2007.

On May 22, 2006, applicant filed an RCE and included a declaration under 1.132 containing comparative examples. The examiner issued a final rejection on July 25, 2006. An after final amendment was filed by applicant on . In response, the examiner issued another final rejection on November 8, 2006. Applicant submitted an after final amendment requesting reconsideration. The examiner noted in an advisory action mailed February 22, 2007 that the final rejection was maintained. Applicant filed a pre-appeal request. As a result of the pre-appeal conference, the prosecution was re-opened. On May 30, 2007, the examiner rejected claims 6-11 over new prior art in a non-final rejection. On August 30, 2007, in response to the non-final office action, applicant amended claim 6. The examiner then finally rejected claims 6-11 with the same rejection on November 16, 2007.

MPEP 7.06.07 states:

*In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.*
*However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should*

*include a rebuttal of any arguments raised in the applicant's reply.*

CONCLUSION

Petitioner urges that the examiner did not respond to the comparative example in the 1.132 declaration submitted on May 22, 2006. In the final office action of July 25, 2006, the examiner at page 4 fully responded to the comparative examples submitted in the declaration. Applicant had requested that the examiner revisit the comparative example in light of the new art presented by the examiner in the office action of May 30, 2007. The examiner did not respond to this request in the final office action of November 16, 2007.

The petition is therefore **GRANTED**.

Jacqueline M. Stone/lk

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

KUBOVCHIK & KUBOVCHIK
The Farragut Building
900 17th St NW, Suite 710
Washington, D.C. 20006

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MINNEAPOLIS, MN 55402-0902

| | | |
|---|---|---|
| In re Application of ITO et al | : | |
| U.S. Application No.: 10/516,638 | : | |
| PCT Application No.: PCT/JP02/11785 | : | |
| Int. Filing Date: 12 November 2002 | : | DECISION |
| Priority Date Claimed: 06 June 2002 | : | |
| Attorney Docket No.: 14633.5USWO | : | |
| For: PROCESS FOR DEUTERATION OF INERT METHYLENE | : | |

This is in response to applicant's "Request for Corrected Filing Receipt" filed 30 September 2005, which is being treated as a petition under 37 CFR 1.10(c). No petition fee is due.

## BACKGROUND

On 12 November 2002, applicant filed international application PCT/JP02/11785, which claimed priority of an earlier Japan application filed 06 June 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 18 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 06 December 2004.

On 15 November 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, which was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1), was accorded a receipt date of 02 December 2004.

On 29 April 2005, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903), which indicated 02 December 2004 as the date of receipt of the 35 U.S.C. 371 requirements.

On 30 September 2005, applicant filed the present petition under 37 CFR 1.10(c).

## DISCUSSION

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 promptly filed after applicant became aware of the accorded receipt date of the national stage papers.

With regard to item (2) above, a review of the certificate of mailing and the Express Mail mailing label indicates that the Express Mail mailing label number was placed on the correspondence in question prior to the original mailing by Express Mail.

With regard to item (3) above, the copy of the Express Mail mailing label filed with the petition fails to show a "date-in" of 15 November 2004.

## 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 Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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11 APR 2008

HAMRE, SCHUMANN, MUELLER & LARSON, P.C.
P.O. BOX 2902
MINNEAPOLIS, MN 55402-0902

| | | |
|---|---|---|
| In re Application of HIROTA et al | : | |
| U.S. Application No.: 10/516,638 | : | |
| PCT Application No.: PCT/JP02/11785 | : | |
| Int. Filing Date: 12 November 2002 | : | DECISION |
| Priority Date Claimed: 06 June 2002 | : | |
| Attorney Docket No.: 14633.5USWO | : | |
| For: PROCESS FOR DEUTERATION OF INERT METHYLENE | : | |

This is in response to applicant's "Request for Reconsideration" filed 01 October 2007, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

## BACKGROUND

On 12 November 2002, applicant filed international application PCT/JP02/11785, which claimed priority of an earlier Japan application filed 06 June 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 18 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 06 December 2004.

On 15 November 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, which was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1), was accorded a receipt date of 02 December 2004.

On 29 April 2005, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903), which indicated 02 December 2004 as the date of receipt of the 35 U.S.C. 371 requirements.

On 30 September 2005, applicant filed a petition under 37 CFR 1.10(c).

On 30 July 2007, this Office mailed a decision dismissing the 30 September 2005 petition.

On 01 October 2007, applicant filed the present petition under 37 CFR 1.181.

## DISCUSSION

The evidence of record is sufficient to establish that the national stage papers were originally filed on 17 November 2004. Specifically, the copy of the return postcard, which includes the national stage papers in its itemized contents and which bears a USPTO date stamp of 17 November 2004, serves as prima facie evidence that the national stage papers were received by the USPTO on 17 November 2004.

## CONCLUSION

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

The Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 29 April 2005 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 12 November 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 17 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, including preparation and mailing of a corrected Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903), which should indicate 17 November 2004 as the date of receipt of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) requirements and the date of completion of all 35 U.S.C. 371 requirements.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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**FOLEY & LARDNER LLP**
**150 EAST GILMAN STREET**
**P.O. BOX 1497**
**MADISON WI 53701-1497**

**MAILED**

MAY 12 2009

**OFFICE OF PETITIONS**

In re Application of :
**CLICK,** Robert E. :
Application No. 10/516,640 : DECISION ON PETITION
Filed: December 01, 2004 : TO WITHDRAW
Attorney Docket No. **082734-0113** : 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 04, 2007.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to Foley & Lardner has been revoked by the assignee of the patent application on September 11, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **ANTHONY J. BOURGET**
**P.O. BOX 81**
**EAU CLAIRE, WI 54702-0081**

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ANTHONY J. BOURGET
P.O. BOX 81
EAU CLAIRE WI 54702-0081

**MAILED**

MAY 15 2009

**OFFICE OF PETITIONS**

In re Application of :
Robert E. Click :
Application No. 10/516,640 : DECISION ON PETITION
Filed: 12/01/2004 :
Title: NOVEL BACTERIUM FOR :
TREATMENT OF DISEASE :

This is decision on the petition under 37 CFR 1.181, filed January 21, 2009, to withdraw the holding of abandonment.

On June 18, 2008, the Office mailed a Restriction Requirement, which set a period of one month or thirty days, whichever was longer, to reply. Extensions of time for response were available. In the absence of a timely filed response, the application became abandoned on July 19, 2008. On January 6, 2009, the Office mailed a Notice of Abandonment.

Petitioners request that the Office withdraw the holding of abandonment due to non-receipt of the Restriction Requirement. Specifically, petitioners assert that the Office did not timely enter the appointment of power of attorney and change of correspondence address associated with Customer No. 26365. Petitioners argue that the Office mailed correspondence, including the Restriction Requirement, to the previous address of record rather than that associated with Customer No. 26365.

A review of the record reveals that the USPTO received a Power of Attorney and Correspondence Address Indication Form and a Statement Under 37 CFR 3.73(b) on September 11, 2007. The Correspondence Address Indication Form and the Change of Correspondence Address requested that the Office change the correspondence address for the above-identified application to the address associated with Customer No. 26365. Unfortunately, the Office did not associate the application with Customer No. 26365. Therefore, the Office mailed the Restriction Requirement to an incorrect correspondence address. The address has been corrected.

In view of the above, the petition under 37 CFR 1.181 is **GRANTED**. The holding of abandonment is hereby withdrawn and the application is restored to pending status. No petition fee is necessary.

The application is being referred to Technology Center AU 1651.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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United States Patent and Trademark Office
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BACHMAN & LAPOINTE, P.C.
900 CHAPEL STREET
SUITE 1201
NEW HAVEN, CT 06510

Mail Date: 06/28/2010

| | | |
|---|---|---|
| **Applicant** | : Olaf Schafer | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7632264 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/516,656 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/30/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **572** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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OFFICE OF PETITIONS

Morrison & Foerster LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

| | | |
|---|---|---|
| In re Application of | : | |
| Martinus Johannes Maria Warmerdam et al. | : | |
| Application No. 10/516,663 | : | DECISION ON PETITION |
| Filed: November 30, 2004 | : | TO WITHDRAW |
| Attorney Docket No. 4662-371 | : | 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 30, 2006.

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

A review of the file record indicates that the power of attorney to the attorneys and/or 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

09 AUG 2005



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BURTON A. AMERNICK
CONNOLLY BOVE LODGE & HUTZ LLP
1990 M STREET, N.W.
SUITE 800
WASHINGTON, DC 20036-3425

| | |
|---|---|
| In re Application of SUGIOKA et al | : |
| Application No.: 10/516,695 | : |
| PCT Application No.: PCT/JP03/06176 | : |
| Int. Filing Date: 19 May 2003 | : DECISION ON PETITION |
| Priority Date Claimed: 24 May 2002 | : UNDER 37 CFR 1.137(b) |
| Attorney Docket No.: 21581-00334-US1 | : |
| For: FIRE RETARDANT RESIN COMPOSITION, METHOD OF ITS PRODUCTION, SHAPED ARTICLES COMPRISING THE SAME, AND SILICA | : |

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 19 May 2003, applicants filed international application PCT/JP03/06176. The international application claims a priority date of 24 May 2002 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 04 December 2003. The deadline for paying the basic national fee in the United States was thirty months from the priority date, that is 24 November 2004. Applicants missed this deadline.

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), a copy of the international application as required by 35 U.S.C. 371(c)(2), and the petition fee of $1370.

On 06 January 2005, applicants submitted an executed declaration as required by 35 U.S.C. 371(c)(4).

## 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.

## CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is GRANTED as to the National Stage in the United States of America.

Applicant has satisfied the requirements under 35 U.S.C. 371.

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

Amy Vanatta
PCT Legal Administration Detailee
Telephone: 571-272-6094
Facsimile: 571-273-0419

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 05/11/10

TO SPE OF : ART UNIT 1796

SUBJECT : Request for Certificate of Correction for Appl. No.: 10516695 Patent No.: 7601775

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (C of C)**
**Randolph Square 9D40-D**
**Palm Location 7580**

[redacted]

Lamonte Newsome
**Certificates of Correction Branch**
**703-756-1574**

**Thank You For Your Assistance**

---

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

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

**Comments:** _____

_____

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_____ 1796
**SPE** **Art Unit**



PAGE 2/2 * RCVD AT 7/13/2010 2:30:25 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-5/3 * DNIS:2709990 * CSID:703 306 3186 * DURATION (mm-ss):01-04

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William S Frommer
Frommer Lawrence & Haug
745 Fifth Avenue
New York, NY 10151

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Mitsutoshi Shinkai | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7606466 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/20/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/516,706 | : 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 **1309** 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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SHELDON MAK ROSE & ANDERSON PC
100 East Corson Street, Third Floor
Pasadena, CA 91103-3842

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OFFICE OF PETITIONS

In re Application of :
John Chung Lee :
Application No. 10/516,722 : DECISION ON PETITION
Filed: December 02, 2004 :
Attorney Docket No. 17127 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed 04 January 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 28 June 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 29 September 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $770.00, and (3) a proper statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $525.00 extension of time fee submitted with the petition on 04 January 2008 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Telephone inquiries concerning this decision should be directed to Allen C. Ho at (571) 272-6052.

This application is being referred to Technology Center AU 2168 for appropriate action by the Examiner in the normal course of business on the reply received on 04 January 2008.

David Bucci
Petitions Examiner
Office of Petitions

#4

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20 DEC 2005

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Raymond M. Galasso
SIMON, GALASSO & FRANTZ PLC
P.O. Box 26503
Austin, Texas 78755-0503

| | | |
|---|---|---|
| In re Application of: | : | |
| HUDGEONS, Brandon, et al. | : | |
| U.S. Application No.: 10/516,724 | : | DECISION ON PETITION |
| PCT No.: PCT/US03/13745 | : | FOR REVIVAL UNDER |
| International Filing Date: 01 May 2003 | : | 37 CFR 1.137(b) |
| Priority Date: 01 May 2002 | : | |
| Attorney's Docket No.: 1590.00002 | : | |
| For: INTERACTIVE MULTI-MEDIA SYSTEM | : | |

This decision is issued in response to applicant's Petition for Revival under 37 CFR 1.137(b), filed 02 December 2004.

## BACKGROUND

On 01 May 2003, applicants filed international application PCT/US03/13745 which claimed a priority date of 01 May 2002 and designated the United States. The deadline for filing the basic national fee was thirty months from the priority date, that is, 01 November 2004.

On 02 December 2004, applicant filed the present petition for revival under 37 CFR 1.137(b), accompanied by, among other materials, a transmittal letter requesting entry into the national phase for international application PCT/US03/13745.

## 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). Applicant here has failed to satisfy items (1) and (2).

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, the "required reply" was payment of the basic national fee for entry into the national stage. The present petition included the authorization to charge Deposit Account No. 50-1259 the required fees, including the small entity basic national fee. However, when the USPTO attempted to charge the Deposit Account for the required fees, the Deposit Account had insufficient funds. Accordingly, the Deposit Account authorization cannot be treated as a payment for the required fees. Because the "required reply" has not been submitted, item (1) is not satisfied.

Similarly, with respect to item (2), the authorization to charge Deposit Account No. 50-1259 for the petition fee was insufficient in that the Deposit Account did not contain sufficient funds.

## CONCLUSION

Applicants' petition or revival under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should be entitled "Renewed Petition Under 37 CFR 1.137(b)" and include the materials required to satisfy items (1) and (2) above, that is, payment of the applicable basic national fee and petition fee.

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

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

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Raymond M. Galasso
SIMON, GALASSO & FRANTZ PLC
P.O. Box 26503
Austin, Texas 78755-0503

| | | |
|---|---|---|
| In re Application of: | : | |
| HUDGEONS, Brandon, et al. | : | |
| U.S. Application No.: 10/516,724 | : | DECISION ON RENEWED |
| PCT No.: PCT/US03/13745 | : | PETITION FOR REVIVAL |
| International Filing Date: 01 May 2003 | : | UNDER 37 CFR 1.137(b) |
| Priority Date: 01 May 2002 | : | |
| Attorney's Docket No.: 1590.00002 | : | |
| For: INTERACTIVE MULTI-MEDIA SYSTEM | : | |

In a decision mailed on 20 December 2005, applicant's petition under 37 CFR 1.137(b) was dismissed without prejudice for failure to submit all the requirements of a grantable petition. Specifically, applicant had not submitted the required basic national fee or the petition fee.

On 14 February 2006, applicants filed the renewed petition considered herein. The renewed petition was accompanied by a payment of the required basic national fee and petition fee. Applicant has therefore satisfied all the requirements for a grantable petition under 37 CFR 1.137(b).

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

It is noted that the declaration filed by applicants on 02 December 2004 is not acceptable under 37 CFR 1.497 in that it is not directed to the present application. Rather, the declaration specifically executes the U.S. provisional application to which priority was claimed in the international application.

The application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an oath or declaration acceptable under 37 CFR 1.497.

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

2 2 MAY 2008

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Raymond M Galasso
Simon Galasso & Frantz
P O Box 26503
Austin TX 78755-0503

| | | |
|---|---|---|
| In re Application of: | : | |
| HUDGEONS, Brandon, et al. | : | DECISION ON PETITION |
| U.S. Application No.: 10/516,724 | : | (37 CFR 1.137(b)) |
| Int'l Application No: PCT/US03/13745 | : | |
| Int'l Filing Date: 01 May 2003 | : | |
| Priority Date: 01 May 2002 | : | |
| Atty Docket No.: 1590.00002 | : | |
| For: INTERACTIVE MULTI-MEDIA SYSTEM | : | |

This decision is issued in response to applicants' petition for revival under 37 CFR 1.137(b), filed 27 March 2008. Applicants have paid the required petition fee.

## BACKGROUND

On 08 March 2006, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required. The Notification set forth an extendable two-month response period, and indicated that the failure to file a timely response would result in abandonment.

Applicants did not file a response to the Notification Of Missing Requirements during the extendable response period. Accordingly, the present application became abandoned at midnight on 08 May 2006.

On 14 November 2007, the DO/EO/US mailed a "Notification Of Abandonment" (Form DO/EO/909) confirming the abandonment of the present application.

On 27 March 2008, applicants filed 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). The present petition fails to satisfy item (1).

With respect to item (1), the "required reply" here is a proper response to the Notification Of Missing Requirements mailed 08 March 2006, that is, an oath or declaration acceptable under 37 CFR 1.497. Applicants' present petition includes an executed declaration document. However, the declaration is not acceptable in that it appears to be a compilation of multiple documents. See MPEP section 201.03(II)(B): "Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration." The compilation is evident from the fact that the six-page declaration includes one copy each of page 1, 2, and 4, but three different copies of page 3 (each of these copies has been executed by a different inventor, and the copy of page executed by inventor Marcus SHAFTEL lists different inventors than the other two copies of page 3). Applicants must provide complete copies of acceptable declarations executed by each of the inventors. Until such materials are provided, the "required reply" has not been submitted.

## CONCLUSION

Applicants' petition for revival under 37 CFR 1.137(b) is **DISMISSED** without prejudice for failure to satisfy all the requirements of a grantable petition.

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 request for reconsideration should be entitled "Renewed Petition Under 37 CFR 1.137(b)" and it must include the materials required to complete the "required reply," that is, complete declarations executed by each of the inventors of record, in compliance with 37 CFR 1.497.

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, P.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 AUG 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Raymond M Galasso
Simon Galasso & Frantz
P O Box 26503
Austin TX 78755-0503

| | | |
|---|---|---|
| In re Application of: | : | |
| HUDGEONS, Brandon, et al. | : | DECISION ON RENEWED |
| U.S. Application No.: 10/516,724 | : | PETITION |
| Int'l Application No: PCT/US03/13745 | : | (37 CFR 1.137(b)) |
| Int'l Filing Date: 01 May 2003 | : | |
| Priority Date: 01 May 2002 | : | |
| Atty Docket No.: 1590.00002 | : | |
| For: INTERACTIVE MULTI-MEDIA SYSTEM | : | |

This decision is issued in response to applicants' renewed petition for revival under 37 CFR 1.137(b), filed 22 July 2008. Applicants have paid the required petition fee.

## BACKGROUND

In a decision mailed on 22 May 2008, applicants' petition for revival under 37 CFR 1.137(b) was dismissed for failure to satisfy all the requirements of a grantable petition. Specifically, applicants had not submitted the "required reply" in the form of an executed declaration acceptable under 37 CFR 1.497. The decision indicated that the declaration materials filed by applicants on 22 May 2008 were an unacceptable compilation of multiple documents.

On 22 July 2008, applicants filed the renewed petition considered herein, accompanied by a revised declaration.

## DISCUSSION

The four-page declaration document filed with the renewed petition is a complete document which resolves the compilation defect identified in the previous decision. However, the revised declaration is not acceptable with respect to inventors Julia HEARD and Christopher CAVELLO because the addresses for these inventors contains handwritten alterations that were not dated and initialed (see 37 CFR 1.52(c)). Any changes made in ink in the application or declaration prior to signing should be initialed and dated by the applicants prior to execution of the declaration. The Office will not consider whether non-initialed and/or non-dated alterations were made before or after signing of the oath or declaration but will require a new oath or

declaration (see MPEP 605.04(a)).[1] Therefore, a newly executed declaration is required here from Ms. HEARD and from Mr. CAVELLO.

Based on the above, the revised declaration filed 22 July 2008 is not acceptable as filed. Applicants have therefore not provided the "required reply," and the final element for a grantable petition for revival remains unsatisfied.

## CONCLUSION

Applicants' renewed petition for revival under 37 CFR 1.137(b) is **DISMISSED** without prejudice for failure to satisfy all the requirements of a grantable petition.

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 request for reconsideration should be entitled "Second Renewed Petition Under 37 CFR 1.137(b)" and it must include the materials required to complete the "required reply," that is, acceptable declarations executed by inventors Christopher CAVELLO and Julia HEARD.

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

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[1] It is noted inventor Julia HEARD initialed the altered address; however, the alteration was not dated, as also required.

07 NOV 2008

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GALASSO & ASSOCIATES
P O Box 26503
Austin TX 78755-0503

| | | |
|---|---|---|
| In re Application of: | : | |
| HUDGEONS, Brandon, et al. | : | DECISION ON SECOND |
| U.S. Application No.: 10/516,724 | : | RENEWED PETITION |
| Int'l Application No: PCT/US03/13745 | : | (37 CFR 1.137(b)) |
| Int'l Filing Date: 01 May 2003 | : | |
| Priority Date: 01 May 2002 | : | |
| Atty Docket No.: 1590.00002 | : | |
| For: INTERACTIVE MULTI-MEDIA SYSTEM | : | |

In a decision mailed by this Office on 27 August 2008, applicants' first renewed petition for revival under 37 CFR 1.137(b) was dismissed without prejudice for failure to satisfy all the requirements of a grantable petition. Specifically, the decision indicated that the declaration filed by applicants on 22 July 2008 was not in acceptable form.

On 27 October 2008, applicants filed the "Second Renewed Petition Under 37 CFR 1.137(b)" considered herein, accompanied by a revised declaration. The revised declaration is acceptable under 37 CFR 1.497 and therefore satisfies the "required reply" element of a grantable petition for revival. Based on this submission, applicants have now satisfied the final requirement of a grantable petition for revival under 37 CFR 1.137(b).

The second renewed petition for revival under 37 CFR 1.137(b) is **GRANTED**.

This application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 27 October 2008

neen

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Attorney Advisor
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**COOLEY GODWARD KRONISH LLP**
**ATTN: PATENT GROUP**
**SUITE 1100**
**777 - 6TH STREET, NW**
**WASHINGTON, DC 20001**

MAILED

APR 27 2009

OFFICE OF PETITIONS

In re Application of :
**VIGH,** Gyula :
Application No. 10/516,734 : DECISION ON PETITION
Filed: February 06, 2006 : TO WITHDRAW
Attorney Docket No. **057734-01-5005** : 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 30, 2009.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Thomas Blinka on behalf of all attorneys of record who are associated with customer No. 58249. All attorneys/agents associated with the Customer Number 58249 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: **GYULA VIGH**
**14410 DECKER DRIVE**
**MAGNOLIA TX 77355**

cc: **WAYNE BELLMAN**
**LIFE THERAPEUTICS LTD.**
**COMPANY MATTERS PTY LTD.**
**LEVEL 12, 680 GEORGE STREET**
**SYDNEY NSW 2000**

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FALLS CHURCH, VA 22040-0747

Mail Date: 07/20/2010

| | | |
|---|---|---|
| **Applicant** | : Rolf Kalland | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7649840 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/19/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/516,740 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/12/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1072** 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 MAY 2005



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Lawrence Perry
Fitzpatrick, Cella, Harper & Scinto
30 Rockefeller Plaza
New York, New York 10112

| | | |
|---|---|---|
| In re Application of | : | |
| SHIMIZU et al. | : | |
| U.S. Application No.: 10/516,749 | : | |
| PCT No.: PCT/JP03/08479 | : | DECISION ON PETITION |
| Int. Filing Date: 03 July 2003 | : | UNDER 37 CFR 1.47(a) |
| Priority Date: 04 July 2002 | : | |
| Attorney Docket No.: 00005.001249 | : | |
| For: FILTERS OF ELECTRONIC DISPLAY DEVICE | : | |

This decision is in response to applicants' "Petition under 37 CFR 1.47(a)" filed 06 December 2004 to accept the application without the signature of joint-inventor, Kyoko Katagi. The $200 petition fee has been submitted.

## BACKGROUND

On 03 July 2003, applicants filed international application PCT/JP03/08479 which claimed a priority date of 04 July 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 15 January 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 January 2005.

On 06 December 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); declaration and power of attorney executed by four of the five joint-inventors; and a Petition under 37 CFR 1.47(a)

## DISCUSSION

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

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

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

A review of the present petition reveals that petitioner has not shown that a bona fide attempt was made to present the application papers (specification, claims, and drawings) to Kyoko Katagi. Petitioner states Kyowa Hakko Chemical sent the application papers to Mrs. Katagi's house on 25 August 2004. However, no documentary evidence to support the refusal or the attempt was provided with the declaration. Furthermore, it does not appear that petitioner has first hand knowledge of all the facts.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, and drawings) were sent to Kyoko Katagi, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Kyoko Katagi under 37 CFR 1.47(a) at this time.

## CONCLUSION

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

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

Any further correspondence with respect to this matter 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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In re Application of :
SHIMIZU et al. :
U.S. Application No.: 10/516,749 :
PCT No.: PCT/JP03/08479 : DECISION ON PETITION
Int. Filing Date: 03 July 2003 : UNDER 37 CFR 1.47(a)
Priority Date: 04 July 2002 :
Attorney Docket No.: 00005.001249 :
For: FILTERS OF ELECTRONIC DISPLAY DEVICE :

This decision is in response to applicants' "Renewed Petition under 37 CFR 1.47(a)" filed 26 July 2005 to accept the application without the signature of joint-inventor, Kyoko Katagi. No petition fee is required.

## BACKGROUND

On 03 July 2003, applicants filed international application PCT/JP03/08479 which claimed a priority date of 04 July 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 15 January 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 January 2005.

On 06 December 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); declaration and power of attorney executed by four of the five joint-inventors; and a Petition under 37 CFR 1.47(a). In a "Decision on Petition under 37 CFR 1.47(a) dated 26 May 2005, applicants petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 26 July 2005, applicants filed the present petition under 37 CFR 1.47(a).

## DISCUSSION

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

A review of the present petition reveals that applicants have satisfied item (2), in that the applicants have shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Kyoko Katagi. The steps taken by Ikuo Shimuzu are sufficient to show that Kyoko Katagi has refused to execute the application.

Accordingly, it is appropriate to accord the national stage application status under 37 CFR 1.47(a).

## CONCLUSION

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

The application has an international filing date of 03 July 2003 under 35 U.S.C. 363 and a date of **06 December 2004** 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.

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Fax: (571) 273-0459

08 AUG 2005

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Kyoko Katagi
1363-9-D-202
Oaza-wakaguri, Ami-machi, Inashiki-gun
Ibaraki Japan 300-0333

In re Application of
SHIMIZU et al.
U.S. Application No.: 10/516,749
PCT No.: PCT/JP03/08479
Int. Filing Date: 03 July 2003
Priority Date: 04 July 2002
Attorney Docket No.: 00005.001249
For: FILTERS OF ELECTRONIC DISPLAY DEVICE

Dear Ms. Katagi:

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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Counsel of Record:
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26 AUG 2

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| | |
|---|---|
| In re Application of<br>RUBASSAY<br>Application No.: 10/516,757<br>PCT No.: PCT/US03/09031<br>Int. Filing Date: 25 March 2003<br>Priority Date: 25 March 2002<br>Attorney Docket No.: GTI-1490-USN<br>For: MINIMIZING METAL TOXICITY DURING ELECTROPORATION ENHANCED DELIVERY OF POLYNUCLEOTIDES | DECISION ON<br><br>PETITION UNDER<br><br>37 CFR 1.137(b) |

The petition to revive under 37 CFR 1.137(b) filed 04 December 2004 in the above-captioned application is hereby **GRANTED** as follows:

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

A review of the application file reveals that the required petition fee of $1370 was paid. Thus, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America. The declaration in compliance with 37 CFR 1.497(a) and (b) has been provided and is acceptable.

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 December 2004.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

27 SEP 2005

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In re Application of
RUBASSAY
Application No.: 10/516,757
PCT No.: PCT/US03/09031
Int. Filing Date: 25 March 2003
Priority Date: 25 March 2002
Attorney Docket No.: GTI-1490-USN
For: MINIMIZING METAL TOXICITY DURING ELECTROPORATION ENHANCED DELIVERY OF POLYNUCLEOTIDES

DECISION

ON PETITION UNDER

37 CFR 1.137(b)

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

On 26 August 2005, a decision was mailed to applicant granting his petition to revive under 37 CFR 1.137(b) filed 04 December 2004 in the above-captioned application. For the reasons set forth below, the decision mailed on 26 August 2005 is hereby **VACATED**. The petition to revive under 27 CFR 1.137(b) filed on 04 December 2004 is **DISMISSED WITHOUT PREJUDICE**. The application remains **ABANDONED**.

Upon closer review of the application file and USPTO finance records, it noted that applicant did not pay the full basic national fee due upon the filing of a petition to revive. Applicant paid $100, the basic national fee for an application where the international preliminary examination revealed that all claims satisfied provisions of PCT Article 33(1)-(4). However, in the instant case, there was no international preliminary examination report, satisfying the provisions of the Article. For the instant application, the application fee required upon entering the national stage was $790, the basic national fee required where the U.S. acted in its capacity as International Searching Authority. Applicant did not provide a deposit account number or authorization to charge any additional fees to the deposit account.

Since applicant failed to pay the full basic national fee required with the petition to revive, the proper reply was not submitted. Thus, the petition to revive must be dismissed without prejudice and the application remains abandoned.

Applicant is advised to file a renewed petition to revive along with the appropriate basic national fee. Applicant is reminded that on 08 December 2004, the basic national fee under 37 CFR 1.492(a) was changed to $300.

The application remains **abandoned**. The application will be held in the PCT Legal Office to await applicant's further reply.

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07 DEC 2007

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In re Application of :
RUBASSAY :
Application No.: 10/516,757 :
PCT No.: PCT/US03/09031 : **DECISION**
Int. Filing Date: 25 March 2003 :
Priority Date: 25 March 2002 :
Attorney Docket No.: GTI-1490-USN :
For: MINIMIZING METAL TOXICITY :
DURING ELECTROPORATION ENHANCED :
DELIVERY OF POLYNUCLEOTIDES :

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

A review of the above referenced application shows that on 26 August 2005, a decision was mailed to applicant granting his petition to revive under 37 CFR 1.137(b) filed 04 December 2004 in the above-captioned application.

However, on 27 September 2005, a decision vacating the decision mailed on 26 August 2005 was mailed indicating that applicant had failed to pay the appropriate basic national fee.

On 20 August 2007, a Notification of Abandonment was mailed to applicant.

On 05 October 2007, a petition to revive under 27 CFR 1.137(b) was filed.

A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper response unless it has been previously submitted, (2) the fee required by law for revival of an unintentionally abandoned application (1.17(m)), and (3) a statement that the "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".

A review of the application file reveals that the basic national fee of $310 was paid. However, applicant only paid a petition fee of $1500. The correct fee for a petition to revive an unintentionally abandoned application on 05 October 2007 was

$1540. Applicant did not provide a deposit account authorization for the shortfall. Thus, the requirements of 37 CFR 1.137(b) have not been satisfied. The request to revive the application abandoned under 35 U.S.C. 371(d) is dismissed as to the National stage in the United States of America.

Applicant's petition to revive international application no. PCT/US03/09031 under 37 CFR 1.137(b) is **DISMISSED WITHOUT PREJUDICE**.

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

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

03 APR 2008

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

Daniel M Chambers
Biotechnology Law Group
527 N. Highway 101, Suite E
Solana Beach CA 92075-1173

In re Application of
RUBASSAY
Application No.: 10/516,757
PCT No.: PCT/US03/09031
Int. Filing Date: 25 March 2003
Priority Date: 25 March 2002
Attorney Docket No.: GTI-1490-USN
For: MINIMIZING METAL TOXICITY DURING ELECTROPORATION ENHANCED DELIVERY OF POLYNUCLEOTIDES

DECISION

ON PETITION UNDER

37 CFR 1.137(b)

This is a decision on applicant's Petition under 37 CFR 1.137(b) filed in the United States Patent and Trademark Office on 23 January 2008. The petition to revive under 27 CFR 1.137(b) is hereby **GRANTED** as follows:

A review of the application file reveals that the required petition fee of $1540 is now paid. The basic national fee of $310 was previously paid. Thus, the requirements of 37 CFR 1.137(b) have been now satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America. The declaration, in compliance with 37 CFR 1.497(a) and (b), has also been provided and is acceptable.

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 23 January 2008.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

30 SEP 05

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MORRISON & FOERSTER LLP
3811 VALLEY CENTRE DRIVE
SUITE 500
SAN DIEGO CA 92130-2332

| | | |
|---|---|---|
| In re Application of | : | |
| ZHOU | : | |
| Application No.: 10/516,759 | : | DECISION ON |
| PCT No.: PCT/CN03/00217 | : | |
| Int. Filing Date: 26 March 2003 | : | PETITION UNDER |
| Priority Date: 26 March 2002 | : | |
| Attorney Docket No.: 524012000300 | : | 37 CFR 1.137(b) |
| For: ERBB3 BASED METHODS AND | : | |
| COMPOSITIONS FOR TREATING NEOPLASMS | : | |

This decision is in response to applicants' submission filed 02 December 2004.

## BACKGROUND

On 26 March 2003, applicants filed international application PCT/CN03/00217 which designated the U.S. and claimed a priority date of 26 March 2002. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 02 October 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 27 September 2004 (26 September 2004 being a Sunday).

On 02 December 2004, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the basic national fee, an assertion of small entity status, and a petition under 37 CFR 1.137(b) to revive the application.

## DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), applicant submitted the basic national fee on 02 December 2004.

As to item (2), applicant submitted the petition fee on 02 December 2004.

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

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

**CONCLUSION**

The petition under 37 CFR 1.137(b) is **GRANTED** for the reasons set forth above.

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

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including preparing and mailing a NOTIFICATION OF MISSING REQUIREMENTS (Form PCT/DO/EO/905) requiring 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.

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

27 FEB 2006

#6

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Susan M. Pellegrino
Bayer Pharmaceuticals Corporation
400 Morgan Lane
West Haven, CT 06516-4175

In re Application of :
LUITHLE, et al. :
U.S. Application No.: 10/516,777 : DECISION ON PETITION
PCT No.: PCT/EP03/05735 :
Int. Filing Date: 02 June 2003 : UNDER 37 CFR 1.137(b)
Priority Date: 10 June 2002 :
Attorney Docket No.: Le A 36 131 :
For: 2-HETEROARYL CARBOXAMIDES :

This decision is in response to applicant's "Petition For Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 13 January 2006.

## BACKGROUND

On 02 June 2003, applicant filed international application PCT/EP03/05735, which claimed priority of an earlier application filed 10 June 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 10 December 2004.

On 02 December 2004, applicant filed a transmittal letter for entering the U.S. national stage under 35 U.S.C. 371 accompanied by payment of the U.S. basic national fee; an English translation of the international application; an Information Disclosure Statement; a preliminary amendment and an Application Data Sheet.

On 18 May 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. Applicant was also instructed to provide payment of the $130.00 surcharge for providing an executed oath or declaration of the inventors later than thirty months from the priority date and $1260 in additional claim fees or cancel the additional claims for which fees are due. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 13 January 2006, applicant filed the present petition to revive pursuant to 37 CFR 1.137(b) accompanied by an executed combined declaration and power of attorney.

## DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required). Applicant has satisfied items (2) and (3), item (4) does not apply.

As to item (1), applicant has currently provided an executed declaration of the inventors and paid the appropriate surcharge. Regarding the additional claim fees of $1260 identified on the Form PCT/DO/EO/905, applicant claims that no additional claim fees are due based on the preliminary amendment filed 02 December 2004. Applicant is advised that the $1260 in claim fees was calculated after consideration of the preliminary amendment filed 02 December 2004. Specifically, claims 2-11 are dependent to claim 1; claim 15 is dependent to claims 1-11; claim 16 is dependent to claim 1 and/or claim 15; claim 17 is dependent to claim 1 and claim 18 is dependent to claim 15. This results in a total number of claims of 38. Therefore, as authorized, and to complete the proper reply to the Form PCT/DO/EO/905, the $1260 is claims fees will be charged to deposit account number 13-3372.

Applicant has satisfied all four items and it is therefore proper to grant applicant's petition at this time.

## CONCLUSION

Applicant's petition under 37 CFR 1.137(b) is **GRANTED**.

The application has an international filing date of 02 June 2003 under 35 U.S.C. 363 and will be given a date of **13 January 2006** 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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Barbara A. Shimei
Director, Patents & Licensing
Bayer HealthCare LLC - Pharmaceuticals
555 White Plains Road, Third Floor
Tarrytown NY 10591

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JAN 04 2010

In re Application of :
Joachim Luithle et al. :
Application No. 10/516,777 : DECISION ON PETITION
Filed: January 13, 2006 :
Attorney Docket No. Le A 36 131 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 10, 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 December 23, 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 January 24, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Election, (2) the petition fee of $810, and (3) a proper statement of unintentional delay.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

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

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

This application is being referred to Technology Center AU 1625 for appropriate action by the Examiner in the normal course of business on the reply received.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Nicholas J. DiCeglie, Jr.
Edwards Angell Palmer & Dodge LLP
P.O. Box 55874
Boston, Massachussets 02205

#6

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19 JAN 2006

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

In re Application of HANING et al
U.S. Application No.: 10/516,778
PCT Application No.: PCT/EP03/05695
Int. Filing Date: 30 May 2003
Priority Date Claimed: 03 June 2002
Attorney Docket No.: Le A 36 111
For: USE OF COMPOUNDS THAT STIMULATE CGMP

DECISION

This is in response to the correspondence filed 08 September 2005, which is being treated as a request for status under 37 CFR 1.42.

## BACKGROUND

On 30 May 2003, applicant filed international application PCT/EP03/05695, which claimed priority of an earlier Germany application filed 03 June 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 11 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 03 December 2004.

On 03 December 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 07 July 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 08 September 2005, applicant filed the present request for status under 37 CFR 1.42, including 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."

The declaration filed 08 September 2005 is in compliance with 37 CFR 1.42 and 1.497.

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

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 30 May 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 08 September 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

05 JUL 2005

#4

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Tim Tingkang Xia
Morris, Manning & Martin, LLP
1600 Atlanta Financial Center
3343 Peachtree Street, N.E.
Atlanta, Georgia 30326-1044

| | | |
|---|---|---|
| In re Application of | : | |
| LEI | : | |
| Application No.: 10/516,787 | : | |
| PCT No.: PCT/CN02/00384 | : | DECISION ON PETITION |
| Int. Filing Date: 03 June 2002 | : | |
| Priority Date: 03 June 2002 | : | UNDER 37 CFR 1.137(b) |
| Atty. Docket No.: 14982-47684 | : | |
| For: APPLICATION OF AN ALLOY IN KITCHEN UTENSILS MANUFACTURE | : | |

The petition to revive under 37 CFR 1.137(b) filed 24 June 2005 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National Fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

The application has an international filing date of 03 June 2002 under 35 U.S.C. 363 and will be given a date of **24 June 2005** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

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

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

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

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Ulf Petersson | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7574282 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/11/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/516,793 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/11/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1065** 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.

18 MAR 2005

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Porter Wright Morris & Arthur LLP
41 South High Street
Columbus, OH 43215-6195

| | | |
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| In re Application of | : | |
| McMorrow | : | |
| Application No.: 10/516,806 | : | |
| PCT No.: PCT/EP02/12619 | : | |
| Int. Filing Date: 12 November 2002 | : | DECISION |
| Priority Date: 13 November 2001 | : | |
| Attorney Docket No.: 3998264-151581 | : | |
| For: A Laryngoscope | : | |

This is in response to the documents filed on 03 December 2004 and on 07 February 2005, which are being treated as a petition under 37 CFR 1.181.

## BACKGROUND

This international application was filed on 12 November 2002 and claimed a priority date of 13 November 2001. The International Bureau transmitted a copy of the published international application to the USPTO on 22 May 2003. Consequently, the thirty month period for payment of the basic national fee in the United States expired as of midnight on 13 May 2004.

## DISCUSSION

Referring to papers filed on 03 December 2004, applicant "requests that the USPTO accord these papers the original filing date of May 13, 2004 on the basis of the stamped postcard receipt." Said papers filed on 03 December 2004 include a preliminary amendment, an "Authorization re Deposit Account," a "Certificate Of Filing By Express Mail," an Information Disclosure Statement, a copy of the published international application, and a copy of the International Search Report, along with a copy of a return postcard receipt itemizing the papers enumerated above and stamped as "Rec'd PCT/PTO 13 MAY 2004." MPEP 503 states in part that "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Pursuant to that practice, the copies of the preliminary amendment, the "Authorization re Deposit Account," the "Certificate Of Filing By Express Mail," the Information Disclosure Statement, the copy of the published international application, and the copy of the International Search Report filed on 03 December 2004 are being accepted as copies of the corresponding documents originally filed on 13 May 2004.

## DECISION

The petition is **GRANTED**.

The $920.00 basic national fee (applicable as of 13 May 2004) is being charged to counsel's Deposit Account No. 16-2326, as authorized by the "Authorization re Deposit Account" filed on 13 May 2004.

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an executed oath or declaration and a surcharge under 37 CFR 1.492(e).

Richard Cole
PCT Legal Examiner
PCT Legal Office

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

27 JAN 2005

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Richard M. Mescher
Porter Wright Morris & Arthur, LLP
41 South High Street
Columbus, OH 43215-6194

In re Application of
THOMPSON
Application No.: 10/516,807
Filing Date: 16 June 2004
For: SEATING FOR A VEHICLE

DECISION ON PETITION
UNDER 37 CFR 1.181

This decision is in response to applicant's correspondence filed 03 December 2004, and supplemented on 13 December 2004, in the United States Patent and Trademark Office (USPTO). The submission is being treated as a petition under 37 CFR 1.181. No petition fee is required

## BACKGROUND

On 12 December 2002, applicant filed the international application, which claimed a priority date of 20 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, 20 June 2004.

On 03 December 2004, applicant filed the present petition, including, a copy of a transmittal letter, a copy of a deposit account authorization, a copy of a preliminary amendment, a copy of an international search report and a copy of a stamped postcard receipt.

## DISCUSSION

Applicant has provided a legible copy of the receipt postcard which shows a USPTO date stamp, "DT07 Rec'd PCT/PTO 16 JUN 2004" and clearly identifies the documents detailed above, as well as listing the inventor, international application number and title. The filed transmittal letter and certificate of mailing identify the application as a PCT National stage application pursuant to 35 U.S.C. 371 and claim small entity status. The evidence is sufficient to establish that the national stage filing was received in the USPTO on 16 June 2004. Applicant's statement that, "We are requesting that this application be treated as an original filing" is being interpreted to mean that applicant certifies that the present filing is a true and complete copy of the papers originally filed 16 June 2004. If this is an incorrect interpretation applicant should contact the office of PCT Legal Administration immediately.

As authorized, all appropriate fees will be charged to Deposit Account No.: 16-2326.

## CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

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 Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventor is required.

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

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TUCKER ELLIS & WEST LLP
1150 HUNTINGTON BUILDING
925 EUCLID AVENUE
CLEVELAND, OH 44115-1414

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MAR 2 8 2008

**OFFICE OF PETITIONS**

In re Application of :
Grigory Valentinovich Gelikonov et al :
Application No. 10/516,810 : ON PETITION
Filed: June 20, 2005 :
Attorney Docket No. 76700/00009

This is a decision on the petition, filed March 27, 2008 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on February 12, 2008 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

This matter is being referred to Technology Center AU 2886 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Renner, Otto Boisselle & Sklar, LLP
1621 Euclid Ave. – 19th Floor
Cleveland, OH 44116

---

[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).

26 APR 2005

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Arlir M. Amado
KRAMER & AMADO
2001 Jefferson Davis Highway, Suite 1101
Arlington, VA 22202

In re Application of :
ALMAGRO, Eliseo Quintanilla :
U.S. Application No.: 10/516,825 :
PCT No.: PCT/ES03/00272 :
Int. Filing Date: 05 June 2003 :
Priority Date: 06 June 2002 :
Attorney Docket No.: PRT 3011 :
For: NOVEL THERAPEUTIC USE OF :
POLYPODIUM EXTRACTS :

**DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)**

Applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed with the national stage papers on 07 December 2004 is hereby **GRANTED** as follows:

The basic national fee and petition fee have been paid. Applicant states that "[t]he entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration was not included with any of the papers submitted.

This application is being forwarded to the United States Designated/Elected Office for further processing including mailing a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b), a surcharge fee and a processing fee are required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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**CLARK & ELBING LLP**
**101 FEDERAL STREET**
**BOSTON MA 02110**

**COPY MAILED**

SEP 3 0 2005

**OFFICE OF PETITIONS**

In re Application of :
Becq et al. :
Application No. 10/516,839 : ON PETITION
Filed: March 4, 2005 :
Attorney Docket No. 50376/003001 :

This is a decision on the petition filed May 24, 2005, which is being treated as a petition under 37 CFR 1.181 to correct the spelling of an inventor's name.

The petition is **GRANTED.**

The name was changed from Yvette METLEY to Yvette METTEY.

A Corrected Filing Receipt was previously mailed on May 25, 2005.

This matter is being referred to Technology Center AU 1625 for examination in due course.

Telephone inquiries regarding this decision should be directed to Paralegal Liana Chase at (571) 272-3282.

Frances Hicks
Petitions Examiner
Office of Petitions

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

**COPY MAILED**

NOV 25 2008

**OFFICE OF PETITIONS**

In re Application of :
Hoogerbrugge et al. :
Application No. 10/516,843 : ON PETITION
Filed: December 3, 2004 :
Attorney Docket No. ML02 0480 US :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 24, 2008, to revive the above-identified application.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Mr. Mark A. Wilson 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. Wilson 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. Wilson, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, September 21, 2007, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on December 22, 2007. A Notice of Abandonment was mailed May 16, 2008.

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.

Application No. 10/516,843

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) an adequate statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Alicia Kelley at (571) 272-6059.

This application is being referred to Technology Center 2185 for further examination on the merits.

/SDB/

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

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UNITED STATES DEPARTMENT OF COMMERCE
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SNELL & WILMER LLP (OC)
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA, CA 92626

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Alistair Zorica | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7665148 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/23/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/516,850 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/23/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **901** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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Paper No.

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

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AUG 31 2007

**OFFICE OF PETITIONS**

In re Application of :
Farm et al. : DECISION ON PETITION
Application No. 10/516,857 :
Filed: December 3, 2004 :
Atty Docket No. P/1228-189 :

This is a decision on the PETITION TO WITHDRAW NOTICE OF ABANDONMENT filed April 9, 2007.

The above-identified application became abandoned for failure to file a timely and proper reply to the non-final Office action mailed June 27, 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 September 28, 2006. A courtesy Notice of Abandonment was mailed on March 27, 2007.

Petitioner states that in response to the Office action (specifically, an Amendment/Submission and attached Replacement Sheet) was timely filed electronically on September 25, 2006. In support thereof, petitioner submits a copy of the amendment.

Petitioner's evidence has been reviewed, and is persuasive. However, consideration of their evidence is unnecessary. Their response, as noted by petitioner, is present in the application with a date of receipt of September 25, 2006.

Accordingly, the Notice of Abandonment mailed March 27, 2007 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 3748 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 of record as filed on September 25, 2006 (and resubmitted on petition filed April 9, 2007).

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

11 JUL 2005

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#3

Michael P. Girard
Klarquist Sparkman, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204

In re Application of :
BATT, Michael :
Application No.: 10/516,862 : DECISION ON PETITION
PCT No.: PCT/AU03/00517 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 02 May 2003 :
Priority Date: 07 May 2002 :
Attorney Docket No.: 7214-69896-01 :
For: AN ADJUSTABLE FIN SYSTEM

The petition to revive under 37 CFR 1.137(b) filed 02 December 2004 in the above-captioned application is hereby **GRANTED** as follows:

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

A review of the application file reveals that applicant has submitted the basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

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

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21 DEC 2006

BAKER & MCKENZIE LLP
Pennzoil Place, South Tower
711 Louisiana, Suite 3400
Houston, Texas 77002-2746

In re Application of:
HSIAO, Wen-Laun Wendy, et al.
U.S. Application No.: 10/516,864
PCT No.: PCT/US03/20587
Int'l Filing Date: 27 June 2003
Priority Date: 28 June 2002
Attorney's Docket No.: 32144183.4
For: PLASMA OR SERUM MARKER AND PROCESS FOR DETECTION OF CANCER

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

In a decision mailed by this Office on 17 February 2006, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice for failing to satisfy all the requirements of a grantable petition. Specifically, petitioner had not submitted an acceptable declaration executed by the cooperating inventor on behalf of the non-signing inventor, and applicants had not provided an express statement of the last known address of the non-signing inventor.

On 30 March 2006, petitioners filed the renewed petition considered herein. The renewed petition includes the required statement of the last known address of non-signing inventor Sze-Chuen Cesar WONG. The renewed petition also includes a declaration executed by co-inventor Wen-Luan Wendy HSIAO and containing an unsigned signature block for the non-signing inventor.

Applicants' 30 March 2006 submission satisfies the remaining requirements for a grantable petition under 37 CFR 1.47(a). Accordingly, the renewed petition under 37 CFR 1.47(a) is **GRANTED**.

The application is accepted without the signature of non-signing inventor Sze-Chuen Cesar WONG.

As provided in 37 CFR 1.47(a), a notice of the acceptance of the application will be published in the Official Gazette, and a letter informing the non-signing inventor of the application will be forwarded to the inventor's last-known address, as set forth in the renewed 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 30 March 2006.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
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#7

UNITED STATES PATENT AND TRADEMARK OFFICE

17 FEB 2006

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BAKER & MCKENZIE LLP
Pennzoil Place, South Tower
711 Louisiana, Suite 3400
Houston, Texas 77002-2746

In re Application of:
HSIAO, Wen-Laun Wendy, et al.
U.S. Application No.: 10/516,864
PCT No.: PCT/US03/20587
International Filing Date: 27 June 2003
Priority Date: 28 June 2002
Attorney's Docket No.: 32144183.4
For: PLASMA OR SERUM MARKER AND PROCESS FOR DETECTION OF CANCER

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This decision is issued in response to applicants' "Response To Notice To File Missing Parts Of Application" filed 06 October 2005, treated in part herein as a petition under 37 CFR 1.47(a). Deposit Account No. 50-3420 will be charged the $200 petition fee.

## BACKGROUND

On 27 June 2003, applicants filed international application PCT/US03/20587 which claimed a priority date of 28 June 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., 28 December 2004.

On 03 December 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 06 July 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497, the surcharge for filing the declaration later than thirty months after the priority date, and sequence listing materials were required.

On 06 October 2005, applicants filed a response to the Notification Of Missing Requirements (with required extension fee) which included the required sequence listing materials and the additional materials considered herein as a petition under 37 CFR 1.47(a). The petition seeks acceptance of the application without the signature of co-inventor Sze-Chuen Cesar WONG, whom applicants argue 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 nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Here, applicants have authorized a charge to Deposit Account No. 50-3420 for required fees. Based on this authorization, the Deposit Account will be charged the required $200 petition fee. Item (1) is therefore satisfied.

The petition does not expressly state the last known address of the nonsigning inventor. Item (2) is therefore not satisfied.

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

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

Applicants here have not filed an acceptable declaration executed by inventor Wen-Luan Wendy HSAIO and containing an unsigned signature block for the nonsigning inventor Sze-Chuen Cesar WONG. Neither of the two inventorship declarations included in the international application are in acceptable form. The first such declaration (Sheet 7 of the Request) is executed by Wen-Luan Wendy HSAIO, but the declaration does not identify the second inventor. The second such declaration (Sheet 8 of the Request) includes an unsigned signature box identifying the nonsigning inventor; however, this declaration does not identify, and is not signed by, inventor HSAIO. On both of these declarations, the space in which the name of the second inventor should have been entered was left blank.[1] Based on the above, applicants have failed to submit an acceptable declaration executed by the cooperating inventor and containing an unsigned signature block for the nonsigning inventor. Accordingly, item (3) is not satisfied.

Regarding item (4), MPEP section 409.03(d) sates that, before it can be concluded that an inventor has refused to join in the application, "[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney." The MPEP also states the following:

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application

[1] The present petition also includes a copy of a separate, unsigned declaration that was apparently forwarded to the nonsigning inventor for signature. It is noted that, even if executed, this declaration would not be acceptable in that it fails to identify both of the inventors herein.

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

Here, applicant has provided a statement of facts, with supporting evidence, confirming that a copy of the complete application papers and declaration were forwarded to the nonsigning inventor by email and by hand delivery to his last known address. The statement also provides evidence that, upon learning that the last known address of the inventor was no longer current, the application materials were delivered to the inventor at his place of employment. Based on this submission, item (4) is satisfied.

## CONCLUSION

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

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy items (2) and (3) of a grantable petition, as discussed above, that is, an express statement of the last known address of the nonsigning inventor and a declaration executed by the cooperating inventor that includes an unsigned signature block for the nonsigning inventor and all other information required under 37 CFR 1.497. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, 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
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

#8

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21 DEC 2006

BAKER & MCKENZIE LLP
Pennzoil Place, South Tower
711 Louisiana, Suite 3400
Houston, Texas 77002-2746

In re Application of:
HSIAO, Wen-Laun Wendy, et al.
U.S. Application No.: 10/516,864
PCT No.: PCT/US03/20587
Int'l Filing Date: 27 June 2003
Priority Date: 28 June 2002
Attorney's Docket No.: 32144183.4
For: PLASMA OR SERUM MARKER AND PROCESS FOR DETECTION OF CANCER

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

In a decision mailed by this Office on 17 February 2006, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice for failing to satisfy all the requirements of a grantable petition. Specifically, petitioner had not submitted an acceptable declaration executed by the cooperating inventor on behalf of the non-signing inventor, and applicants had not provided an express statement of the last known address of the non-signing inventor.

On 30 March 2006, petitioners filed the renewed petition considered herein. The renewed petition includes the required statement of the last known address of non-signing inventor Sze-Chuen Cesar WONG. The renewed petition also includes a declaration executed by co-inventor Wen-Luan Wendy HSIAO and containing an unsigned signature block for the non-signing inventor.

Applicants' 30 March 2006 submission satisfies the remaining requirements for a grantable petition under 37 CFR 1.47(a). Accordingly, the renewed petition under 37 CFR 1.47(a) is **GRANTED**.

The application is accepted without the signature of non-signing inventor Sze-Chuen Cesar WONG.

As provided in 37 CFR 1.47(a), a notice of the acceptance of the application will be published in the Official Gazette, and a letter informing the non-signing inventor of the application will be forwarded to the inventor's last-known address, as set forth in the renewed 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 30 March 2006.

Richard M. Ross
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Office of PCT Legal Administration
Telephone: (571) 272-3296
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21 DEC 2006

Sze-Chuen Cesar WONG
Flat c, Floor 9, King's Court
14-16 Village Road, Happy Valley
HONG KONG SAR

In re Application of: HSIAO, Wen-Laun Wendy, et al.
U.S. Application No.: 10/516,864
PCT No.: PCT/US03/20587
Int'l Filing Date: 27 June 2003
Priority Date: 28 June 2002
Attorney's Docket No.: 32144183.4
For: PLASMA OR SERUM MARKER AND PROCESS FOR DETECTION OF CANCER

Dear Sze-Chuen Cesar WONG:

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

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

Richard M. Ross
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Counsel of Record:
BAKER & MCKENZIE LLP
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711 Louisiana, Suite 3400
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16 MAR 2006

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22897
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100 Commons Way
Holmdel, NJ 07733

In re Application of :
HOUSTON *et al* :
Application No.: 10/516,875 :
PCT No.: PCT/GB02/05646 :
Int. Filing Date: 13 December 2002 : **DECISION**
Priority Date: 05 June 2002 :
Attorney Docket No.: 9931-006US :
For: A METHOD FOR DETERMINING THE :
HELIX ANGLE OF A HELICAL :
FORMATION FOR A CONDUIT :

This decision is in response to applicants' "Request for Correction of Filing Receipt and Notice of Acceptance of Application in Accordance with 37 CFR 1.181" filed on 10 March 2006 which is hereby **GRANTED** as follows:

A review of the subject application shows that the declaration was stamped as received by the USPTO on 09 August 2005. Thus, the Notification of Acceptance of Application Under 35 U.S.C. 371 and 1.495 (Form PCT/DO/EO/903) and filing receipt indicate that the 371 date was 09 August 2005.

In the petition, applicants claim that the declaration was filed on 04 August 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* § 503 MPEP.

Applicants have provided a copy of the date-stamped postcard receipt for documents submitted 04 August 2005. The application number, title and docket number are listed on the postcard receipt. The postcard receipt indicates that among the documents received in the USPTO included an "Executed Declaration and Power of Attorney." The postcard receipt is stamped as received by the USPTO on 04 August 2005.

In addition, the transmittal letter accompanying the declaration is located in the file. The transmittal letter is stamped as received on 04 August 2005. Moreover, the $65.00 surcharge fee was also charged on 04 August 2005.

Accordingly, applicants have provided *prima facie* evidence that the declaration was received by the USPTO on 04 August 2005, not 09 August 2005.

For the reasons discussed above, the Form PCT/DO/EO/903 mailed 27 October 2005 and Filing Receipt mailed 13 December 2005 are both **VACATED**.

This application is being forwarded to the DO/EO/US to mail a corrected Form PCT/DO/EO/903 indicating a date of receipt of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) and date of receipt of all 35 U.S.C. 371 requirements of **04 August 2005**, then mailing a corrected filing receipt indicating the same.

The application will then be forwarded to Technology Center 3700 for further processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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Burns Doane Swecker & Mathis
P O Box 1404
Alexandria VA 22313-1404

| | | |
|---|---|---|
| In re Application of | : | |
| BUSCEMA | : | |
| Application No.: 10/516,879 | : | DECISION ON |
| PCT No.: PCT/EP03/02400 | : | |
| Int. Filing Date: 10 March 2003 | : | PETITION UNDER |
| Priority Date: 11 March 2002 | : | |
| Attorney Docket No.: 008788-085 | : | 37 CFR 1.137(b) |
| For: METHOD FOR ENCODING IMAGE PIXELS A | : | |
| METHOD FOR PROCESSING IMAGES AND A | : | |
| METHOD FOR POCESSING IMAGES AIMED AT | : | |
| QUALITATIVE RECOGNITION OF THE OBJECT | : | |
| REPRODUCED BY ONE OR MORE IMAGE PIXELS | : | |

This decision is in response to applicants' submission filed 03 December 2004.

## BACKGROUND

On 10 March 2003, applicants filed international application PCT/EP03/02400 which designated the U.S. and claimed a priority date of 11 March 2002. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 18 September 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 13 September 2004 (11 September 2004 being a Saturday).

On 03 December 2004, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the basic national fee and a "PETITION TO REVIVE UNDER 37 CFR 1.137(b)".

## DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), applicant submitted the basic national fee on 03 December 2004.

As to item (2), applicant submitted the petition fee on 03 December 2004.

Item (3) has not been satisfied. Petitioner states that "Applicant's attorney *has been advised* that the entire delay in filing the required reply, i.e., the national stage filing, 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" (emphasis added). However, petitioner fails to actually make the required statement. Nor is the required statement made by someone having more knowledge of the circumstances of the abandonment than petitioner. Thus, it is not clear whether the delay was unintentional or not.

**CONCLUSION**

The petition under 37 CFR 1.137(b) is **DISMISSED**, without prejudice, for the reasons set forth above.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)". 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

13 SEP 2005

#5

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Burns Doane Swecker & Mathis
P O Box 1404
Alexandria VA 22313-1404

| | | |
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| In re Application of | : | |
| BUSCEMA, Paolo Massimo | : | |
| Application No.: 10/516,879 | : | DECISION |
| PCT No.: PCT/EP03/02400 | : | |
| Int. Filing Date: 10 March 2003 | : | ON PETITION UNDER |
| Priority Date: 11 March 2002 | : | |
| Docket No.: 008788-085 | : | 37 CFR 1.137(b) |
| For: METHOD FOR ENCODING ... MORE IMAGE PIXELS | : | |

Applicants' "Renewed Petition Under 37 C.F.R. 1.137(b)," filed in the above-captioned application on 21 June 2005 is **GRANTED**.

Previously, applicants paid the national fee and petition fee. A terminal disclaimer was not required. However, applicants statement of unintentional delay was found deficient. Applicant's present statement that the delay in filing the petition 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. 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 P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

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UNITED STATES DEPARTMENT OF COMMERCE
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Sunstein Kann Murphy & Timbers LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

Mail Date: 04/21/2010

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|---|---|---|
| **Applicant** | : Ian Carr | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7600182 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/06/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/516,898 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 08/15/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **951** 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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**DLA Piper US, LLP**
**153 Townsend Street**
**Suite 800**
**San Francisco, CA 94107-1957**

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OFFICE OF PETITIONS

In re Application of :
Thomas Paddock et al. :
Application No. 10/516,907 : DECISION ON PETITION
Filed: August 9, 2005 : TO WITHDRAW
Attorney Docket No. 355325-995112 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 16, 2008.

The request is **NOT APPROVED**.

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

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

It should be noted that the reason can not be accepted because there is no record of an assignee intervening in this application. If an assignee has intervened in this application, then compliance with 37 CFR 3.73(b) should be met. A proper statement under 37 CFR 3.73(b) must submitted in order to grant this request.

A courtesy copy of this decision is being mailed to applicant.

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

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

Kimberly Inabinet

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Edward Kelly
Ropes & Gray, LLP
One International Place
Boston, MA 02109

05 MAY 2005

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William H. Dippert, Esq.
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599 Lexington Avenue, 29th Floor
New York, NY 10022-7650

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| In re Application of | : | |
| Baussi et al. | : | |
| Application No.: 10/516,926 | : | |
| PCT No.: PCT/IL03/00438 | : | |
| Int. Filing Date: 26 May 2003 | : | DECISION |
| Priority Date: 29 May 2002 | : | |
| Attorney Docket No.: 340/04299 | : | |
| For: Direction Finding Cell Phones | : | |

This is in response to the petition under 37 CFR 1.137(b) filed on 01 December 2004.

## BACKGROUND

This international application was filed on 26 May 2003, claimed an earlier priority date of 29 May 2002, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 04 December 2003. The 30 month time period for paying the basic national fee in the United States expired at midnight on 29 November 2004. This international application had become abandoned with respect to the national stage in the U.S. for failure to timely file the full required basic national fee.

## DISCUSSION

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

Regarding requirement (1), the required reply in the form of the basic national fee accompanied the petition.

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

Regarding requirement (3), the petition includes a statement that "The entire delay in filing the application from the due date until the filing of a grantable petition pursuant to 37

C.F.R. §1.137(b) was unintentional." This statement is being construed as a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

## DECISION

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

This application is being forwarded to the National Stage Processing Branch for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an executed oath or declaration of the inventors.

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PCT Legal Office

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OFFICE OF PETITIONS

MARTIN D. MOYNIHAN d/b/a PRTSI, INC.
P.O. BOX 16446
ARLINGTON VA 22215

In re Application of
Baussi, et al.
Application No. 10/516,926
Filed: July 14, 2005
Docket No.: 37160

: DECISION ON PETITION

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed April 7, 2009.

The Notice of Abandonment mailed April 1, 2009 indicates that the application is abandoned for failure to timely submit a proper reply to the non-final Office action mailed April 8, 2008.

Petitioner asserts that a Notice of Appeal and extension of time were timely filed October 7, 2008.

The Notice of Appeal and extension of time, filed October 7, 2008, have been located in the official application file.

In view of the evidence presented, the petition to withdraw the holding of abandonment is hereby GRANTED.

The Notice of Abandonment is hereby VACATED and the holding of abandonment is WITHDRAWN.

The appeal brief is due two month from the mail date of the instant decision on petition.

The application file is being forwarded to Technology Center 2617 for further processing.

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

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#6

13 JAN 2006

ARENT FOX PLLC
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SUITE 400
WASHINGTON, DC 20036

| | | |
|---|---|---|
| In re Application of DEL SOLDATO et al | : | |
| U.S. Application No.: 10/516,938 | : | |
| PCT Application No.: PCT/EP03/06502 | : | |
| Int. Filing Date: 20 June 2003 | : | DECISION |
| Priority Date Claimed: 25 June 2002 | : | |
| Attorney Docket No.: 026220-00058 | : | |
| For: NITROOXYDERIVATIVES OF CYCLOOXYGENASE-2 INHIBITORS | : | |

This is in response to applicant's "Petition Under 37 C.F.R. §1.47(a)" filed 13 September 2005.

## BACKGROUND

On 20 June 2003, applicant filed international application PCT/EP03/06502, which claimed priority of an earlier Italy application filed 25 June 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 31 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 25 December 2004.

On 14 December 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 May 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 13 September 2005, applicant filed the present petition under 37 CFR 1.47(a).

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventor on his own behalf and on behalf of the nonsigning inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Piero Del Soldato refuses to sign the application papers. The petition adequately demonstrates that a bona fide attempt was made to present a copy of the application to Del Soldato for signature. Specifically, letters were sent to Del Soldato via registered mail on two separate occasions (see affidavit of Marie Teresa Noro). Furthermore, the petition sufficiently establishes that Del Soldato refuses to sign. In particular, the petition specifically states that Del Soldato's attorney, Fabrizio Conte, signed a copy of each letter that was sent to both Del Soldato and Conte. Given that Del Soldato's attorney received both letters and Del Soldato's continued failure to respond, it is reasonable to conclude that Del Soldato refuses to join in the application.

With regard to item (3) above, applicant is advised that effective 22 November 2004, the fee for a petition under 37 CFR 1.47 increased to $200.00. Any fee deficiency will be charged to Deposit Account No. 01-2300 as authorized by applicant.

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 20 June 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 13 September 2005.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning 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

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13 JAN 2006

Piero Del Soldato
Via Enrico Toti 22
Monza, MI 20052
ITALY

In re Application of DEL SOLDATO et al
U.S. Application No.: 10/516,938
PCT Application No.: PCT/EP03/06502
Int. Filing Date: 20 June 2003
Priority Date Claimed: 25 June 2002
For: NITROOXYDERIVATIVES OF CYCLOOXYGENASE-2 INHIBITORS

Dear Piero Del Soldato:

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

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

Bryan Tung
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Attorney Docket No.: 026220-00058

24 FEB 2006

#9

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Macclesfield Cheshire UK SK11 -6LP
GB UNITED KINGDOM

| | |
|---|---|
| In re Application of WOOLFE et al. | |
| Application No.: 10/516,943 | DECISION ON PETITION |
| PCT No.: PCT/GB03/02669 | |
| Int. Filing: 20 June 2003 | UNDER 37 CFR 1.47(a) |
| Priority Date: 22 June 2002 | |
| Attorney Docket No.: 00303/US | |
| For: PHARMACEUTICAL COMPOSITION | |

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 17 November 2005, to accept the application without the signatures of joint inventors, Jacqueline Yvonne Allen and Mark Clifford Elliot.

## BACKGROUND

On 16 December 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 17 May 2005, 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 17 November 2005, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventors. 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 signatures of inventors Jacqueline Yvonne Allen and Mark Clifford Elliot, alleging that Ms. Allen refuses to sign the application and Mr. Elliot is unavailable.

## 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 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 addresses of non-signing inventors were provided. With regard to item

(4), the declarations executed by the available joint inventors on their behalf and on behalf of the non-signing inventors were submitted and satisfies this requirement of 37 CFR 1.47(a).

Inventor Allen's Refusal to Sign

With respect to Item (2) above, Petitioner indicated that a declaration by a member of the patent department of Norton Healthcare Ltd. was attached, detailing the efforts made to obtain the nonsigning inventor's signatures. However, the only declaration submitted was that of counsel Michael Steinberg, which was not a statement of first hand knowledge and did not provide details of the attempts made or diligent efforts to contact the nonsigning inventors.

Mr. Steinberg states that a copy of the patent application along with declaration was sent to Ms. Allen by Simone Frankel. However, a statement from Ms. Frankel detailing her efforts to contact Ms. Allen was not provided. Nor was a copy of the letter to Ms. Allen requesting her signature on the application provided. Moreover, Mr. Steinberg states that Ms. Allen acknowledged by phone that she received these documents but that she refused to sign the declaration. Mr. Steinberg does not state that he spoke to Ms. Allen. If he did, the date and time of her refusal and reason for her refusal, if she so stated, should be provided.

Petitioner has not provided evidence that a complete copy of the application papers, including specification, claims and drawings and declaration, were provided to Ms. Allen. What is required is that Ms. Allen be presented with a copy of all of the national stage application papers (specification, including claims and drawings, oath or declaration) for this application. 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. See Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal. [1]

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[1] 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.

Unavailability of Inventor Elliot

With respect to counsel's inability to find or reach Mr. Elliot, Petitioner states that "diligent efforts have been made by members of the Patent Department of Norton Healthcare Ltd. to locate Ms. Allen and Mr. Elliot and obtain their signatures on the declaration, but these efforts have been unsuccessful." Mr. Steinberg further states that the copy of the application and declaration were sent to Mr. Elliot by Ms. Frankel and were returned by the postal service as undeliverable. However, a statement by Ms. Frankel, the person with first hand knowledge, which fully describes the exact facts relied on to establish that a diligent effort was made, was not submitted.

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. Elliot 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) does not indicate that any search for Mr. Elliot's new address was made. Since no attempts to locate inventor Elliot were 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. Elliot is unavailable to sign the application.

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 10/516,943 (specification, including claims, drawings, and declaration) to the nonsigning inventors for their signature and Ms. Allen's refusal to sign, either in writing or by telephone, these documents and (2) that "a diligent effort" was made to contact the nonsigning inventor Mark Clifford Elliot. 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
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#11

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02 OCT 2006

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| In re Application of WOOLFE et al. | : |
| Application No.: 10/516,943 | : DECISION ON |
| PCT No.: PCT/GB03/02669 | : |
| Int. Filing: 20 June 2003 | : RENEWED PETITION |
| Priority Date: 22 June 2002 | : |
| Attorney Docket No.: 00303/US | :UNDER 37 CFR 1.47(a) |
| For: PHARMACEUTICAL COMPOSITION | : |

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 26 June 2006, to accept the application without the signatures of joint inventors, Jacqueline Yvonne Allen and Mark Clifford Elliot. Applicant's request for a two month extension of time is granted.

## BACKGROUND

On 16 December 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 17 May 2005, 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 17 November 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 inventors. 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 signatures of inventors Jacqueline Yvonne Allen and Mark Clifford Elliot, alleging that Ms. Allen refuses to sign the application and Mr. Elliot is unavailable.

On 24 February 2006, a decision dismissing the petition under 37 CFR 1.47(a) was mailed to applicant indicating that Petitioner had not provided evidence that a complete copy of the application papers, including specification, claims and drawings and declaration, were provided to Ms. Allen and that diligent efforts to locate Mr. Elliot were not pursued and documented.

On 26 June 2006, applicant filed a renewed petition under 37 CFR 1.47(a) with a request for a two month extension of time.

## DISCUSSION

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

Item (1), (3) and (4) were previously satisfied.

### Inventor Allen's Refusal to Sign

With respect to Item (2)[1] above, a copy of Simone Frankel's 7 December 2004 letters to Ms. Allen and Mr. Elliot requesting their respective signatures on the application were produced, along with Ms. Frankel's first hand statement detailing her efforts to contact the inventors. Ms. Frankel is the Personal Assistant to the European Director-Intellectual Property for Norton Healthcare Limited. It is clear from Ms. Frankel's letters that *only* a declaration, assignment and power of attorney were presented to the inventors.[2] The inventors must be presented with a copy of all of the national stage application papers (specification, including claims and drawings, oath or declaration) for this application. 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.

Petitioner also provided the affidavit of David William Cottam, Intellectual Property Counsel for Norton Healthcare Limited detailing his efforts to contact the nonsigning inventors. Mr. Cottam states that on 22 June, 24 June and 27 June 2005, he attempted to contact Jacqueline Allen on her cell phone, leaving messages with each call. Finally, on 08 August 2005, Ms. Allen answered her cell phone. After Mr. Cottam explained the need for her to sign documents sent in December 2004, Ms. Allen indicated that "she wanted independent legal advice about her rights". On 9 August 2005, Mr. Cottam sent a copy of the patent application, declaration and power of

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[1] A declaration of counsel Michael Steinberg, which was not a statement of first hand knowledge and did not provide details of the attempts made or diligent efforts to contact the nonsigning inventors, was provided with the 17 November 2005 petition. Mr. Steinberg stated that a copy of the patent application along with declaration was sent to Ms. Allen by Simone Frankel. However, Ms. Frankel's letters and her first hand statement of facts were not provided with the petition and are now appended to the renewed petition.

[2] 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).....

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.

attorney via Royal Mail including a listing of patent attorneys in the London area. A copy of this letter was attached to Mr. Cottam's statement. The correspondence was returned to Mr. Cottam on 3 September 2005 marked "refused". This is sufficient evidence to conclude that Ms. Allen refuses to sign the application papers.

Unavailability of Inventor Elliot

With respect to counsel's inability to find or reach Mr. Elliot, Ms. Frankel's affidavit states that on 7 December 2004, she sent a letter by registered post to Mark Clifford Elliot at his last known address of 40 Farleigh Road, Stoke Newington, London N16 7 TH. She further indicates that the letter to Mark Elliot was returned as undeliverable at the aforementioned address.

In his affidavit, Mr. Cottam relates that "he asked Mr. Elliot's former colleagues regarding Mr. Elliot's whereabouts and learned that "Mark Elliot was living in a tent somewhere on the South coast of England and was moving around the countryside as he wished." This is hearsay evidence regarding the whereabouts of Mr. Elliot.

Sufficient diligent efforts made to locate Mr. Elliot were not pursued and documented, such as Internet searches, E-mail contact to obtain a current address, contact with his former employer(s) or joint inventor(s)s 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"[3] 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) does not indicate that a further search for Mr. Elliot's new address was made. Since attempts to locate inventor Elliot were insufficient, 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. Elliot is unavailable to sign the application.

In sum, Petitioner has satisfied Items (1), (3) and (4) above. With regard to Item (2), Petitioner has demonstrated that Ms. Allen refuses to sign the application. However, Petitioner has not satisfied Item (2) with respect to Mr. Elliot, that is, that "diligent efforts" were made to contact the nonsigning inventor Mark Clifford Elliot. Petitioner should pursue further efforts in a diligent attempt to locate Mr. Elliot before it can be concluded that Mr. Elliot is unavailable. 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**.

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[3] 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.

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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05 MAR 2007

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| Attorney Docket No.: 00303/US | :UNDER 37 CFR 1.47(a) |
| For: PHARMACEUTICAL COMPOSITION | : |

This is a decision on applicant's second renewed petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 04 December 2006, to accept the application without the signatures of joint inventors, Jacqueline Yvonne Allen and Mark Clifford Elliott.

## BACKGROUND

On 16 December 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 17 May 2005, 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 17 November 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 inventors. 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 signatures of inventors Jacqueline Yvonne Allen and Mark Clifford Elliott, alleging that Ms. Allen refuses to sign the application and Mr. Elliott is unavailable.

On 24 February 2006, a decision dismissing the petition under 37 CFR 1.47(a) was mailed to applicant indicating that Petitioner had not provided evidence that a complete copy of the application papers, including specification, claims and drawings and declaration, were provided to Ms. Allen and that diligent efforts to locate Mr. Elliott were not pursued and documented.

On 26 June 2006, applicant filed a renewed petition under 37 CFR 1.47(a) with a request for a two month extension of time. On 02 October 2006, a decision dismissing the petition was mailed indicating that Petitioner had provided sufficient evidence of Ms. Allen's refusal to sign

but had not furnished sufficient evidence to conclude that Mr. Elliott refused to sign the application papers or was unavailable.

On 4 December 2006, Petitioner filed a second renewed petition under 37 CFR 1.47(a).

## DISCUSSION

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

Item (1), (3) and (4) were previously satisfied.

Unavailability of Inventor Elliott[1]

With respect to counsel's inability to find or reach Mr. Elliott, Petitioner now presents the affidavit of Samantha Claire Radley. Ms. Radley's affidavit states that she conducted an Internet search for "Mr. Elliot" without success. However, it is noted that the nonsigning inventor's name is identified as Mark Clifford *Elliott*, on the published international application for PCT/GB03/02669, with Mr. Elliott's last name containing two *t*s. Since Mr. Elliott's name was misspelled for the Internet search, a new Internet search must be conducted for Mark Clifford Elliott, as the inventor's name is correctly spelled.

Sufficient diligent efforts made to locate Mr. *Elliott* must be pursued and documented, such as Internet searches, E-mail contact to obtain a current address, contact with his former employer(s) or joint inventor(s)s to obtain a forwarding address or a request from the Postal Service for his forwarding address. As stated previously, where inability to find or reach a nonsigning inventor "after diligent effort"[2] 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) should indicate that a further search for Mr. *Elliott*'s new address was made. Since attempts to locate inventor *Elliott* were insufficient, it can not be concluded at this time that "a diligent

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[1] 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.

effort" was made to locate the non-signing inventor and that Mr. Elliott is unavailable to sign the application.

In sum, Petitioner has satisfied Items (1), (3) and (4) above. With regard to Item (2), Petitioner has not satisfied Item (2) with respect to Mr. Elliott, that is, that "diligent efforts" were made to contact the nonsigning inventor Mark Clifford *Elliott* using Internet searches and the correct spelling of his name.

Petitioner should pursue further efforts in a diligent attempt to locate Mr. Elliott before it can be concluded that Mr. Elliott is unavailable. 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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Enclosure: First page of WO/2004/000290 (the publication of PCT/GB03/02669)

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Search result: 1 of 1

# (WO/2004/000290) PHARMACEUTICAL COMPOSITION

Biblio. Data | Description | Claims | National Phase | Notices | Documents

**Latest bibliographic data on file with the International Bureau**

**Publication Number:** WO/2004/000290
**Publication Date:** 31.12.2003
**Chapter 2 Demand Filed:** 12.12.2003
**International Application No.:** PCT/GB2003/002669
**International Filing Date:** 20.06.2003

**Int. Class.:** ***A61K 31/135*** (2006.01), ***A61K 31/215*** (2006.01)

**Applicants:** **NORTON HEALTHCARE LIMITED** [GB/GB]; Ivax Quays, Albert Basin, Royal Docks, London E16 2QT (GB) *(All Except US)*.
**WOOLFE, Austen, John** [GB/GB]; 31 Emberson Way, North Weald, Essex CM16 6DL (GB) *(US Only)*.
**LANGFORD, Alan** [NZ/GB]; 33a Briscoe Road, Hoddesdon, Hertfordshire EN11 9DG (GB) *(US Only)*.
**ALLEN, Jacqueline, Yvonne** [GB/GB]; 13 Peartree Avenue, Earlsfield, London SW17 0JG (GB) *(US Only)*.
**ELLIOTT, Mark, Clifford** [GB/GB]; 40 Farleigh Road, Stoke Newington N16 7TH (GB) *(US Only)*.

**Inventors:** **WOOLFE, Austen, John** [GB/GB]; 31 Emberson Way, North Weald, Essex CM16 6DL (GB).
**LANGFORD, Alan** [NZ/GB]; 33a Briscoe Road, Hoddesdon, Hertfordshire EN11 9DG (GB).
**ALLEN, Jacqueline, Yvonne** [GB/GB]; 13 Peartree Avenue, Earlsfield, London SW17 0JG (GB).
**ELLIOTT, Mark, Clifford** [GB/GB]; 40 Farleigh Road, Stoke Newington N16 7TH (GB).

**Agent:** **HAY, Martin, Alexander**; Martin A. Hay & Co., 13 Queen Victoria Street, Macclesfield, Cheshire SK11 6LP (GB).

**Priority Data:** 0214491.3 22.06.2002 GB
0228111.1 03.12.2002 GB

**Title:** PHARMACEUTICAL COMPOSITION

**Abstract:** A pharmaceutical composition for administration as an aerosol, which comprises a cannabinoid, a propellant and an effective amount of a cough suppressant.

**Designated States:** AE, AG, AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EC, EE, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NO, NZ, OM, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW.
African Regional Intellectual Property Org. (ARIPO) (GH, GM, KE, LS, MW, MZ, SD, SL, SZ, TZ, UG, ZM, ZW)
Eurasian Patent Organization (EAPO) (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM)
European Patent Office (EPO) (AT, BE, BG, CH, CY, CZ, DE, DK, EE, ES, FI, FR, GB, GR, HU, IE, IT, LU, MC, NL, PT, RO, SE, SI, SK, TR)
African Intellectual Property Organization (OAPI) (BF, BJ, CF, CG, CI, CM, GA, GN, GQ, GW, ML, MR, NE, SN, TD, TG).

**Publication Language:** English (EN)

**Filing Language:** English (EN)

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| Priority Date: 22 June 2002 | : |
| Attorney Docket No.: 00303/US | :UNDER 37 CFR 1.47(a) |
| For: PHARMACEUTICAL COMPOSITION | : |

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 06 August 2007, to accept the application without the signatures of joint inventors, Jacqueline Yvonne Allen and Mark Clifford Elliott. Applicant's request for a three month extension of time is granted.

## BACKGROUND

On 17 November 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 inventors. 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 signatures of inventors Jacqueline Yvonne Allen and Mark Clifford Elliott, alleging that Ms. Allen refuses to sign the application and Mr. Elliott is unavailable.

On 24 February 2006, a decision dismissing the petition under 37 CFR 1.47(a) was mailed to applicant indicating that Petitioner had not provided evidence that a complete copy of the application papers, including specification, claims and drawings and declaration, were provided to Ms. Allen and that diligent efforts to locate Mr. Elliott were not pursued and documented.

On 26 June 2006, applicant filed a renewed petition under 37 CFR 1.47(a) with a request for a two month extension of time. On 2 October 2006, a decision dismissing the petition was mailed indicating that Petitioner had provided sufficient evidence of Ms. Allen's refusal to sign but had not furnished sufficient evidence to conclude that Mr. Elliott refused to sign the

application papers or was unavailable.

On 4 December 2006, applicant filed a renewed petition under 37 CFR 1.47(a). On 05 March 2007, a decision dismissing the petition indicating that "diligent efforts" were not made to contact the nonsigning inventor Mark Clifford Elliott using Internet searches and the correct spelling of his name.

On 06 August 2007, applicant filed a renewed petition under 37 CFR 1.47(a).

## DISCUSSION

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

Item (1), (3) and (4) were previously satisfied. Item (2) above was previously satisfied with respect to nonsigning inventor, Jacqueline Yvonne Allen.

### Unavailability of Inventor Elliott

With respect to counsel's inability to find or reach Mr. Elliott, Petitioner now present the affidavit of Samantha Claire Radley. Ms. Radley's affidavit states that she conducted a Internet search for Mr. Elliott without success. She also contacted his former employer to obtain an updated address and was advised that the last known address for Mr. Elliott had not changed. Ms. Radley was apprised that an employment reference had been made on behalf of Mr. Elliott by SRG Limited. Ms. Radley contacted Glen Harris of SRG Limited. According to Ms. Radley, Mr Harris attempted to contact Mr. Elliott by telephone and email without success. Ms. Radley also contacted the United Kingdom Post Office customer services department, which confirmed Mr. Elliott's last known address. The United Kingdom Post Office did not have any redirection advice for Mr. Elliott.

Sufficient diligent efforts to locate Mr. Elliott were pursued and documented, such as Internet searches, E-mail contact to obtain a current address, contact with his former employer and a former colleague in search of a forwarding address and 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 had submitted a statement of facts under 37 CFR 1.47(a) indicating that a further search for Mr. Elliott's new address was made. The attempts to locate inventor Elliott were sufficient to conclude that "a diligent effort" was made to locate the non-signing inventor. The action taken by petitioner is sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. Under these circumstances, it can now be concluded that Mr. Elliott is unavailable to sign the application.

In sum, Petitioner has now satisfied Items (1) - (4) above. Petitioner has submitted sufficient evidence with respect to Mr. Elliott, that is, that "diligent efforts" were made to contact the nonsigning inventor Mark Clifford Elliott and that Jacqueline Yvonne Allen refuses to sign the application papers. 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 November 2005. The application has an international filing date of 20 June 2003 under 35 U.S.C. 363, and a date of 17 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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JAN 18 2007

**OFFICE OF PETITIONS**

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| In re Application of | : | |
| Jose Wirtz | : | |
| Application No. 10/516,957 | : | DECISION ON PETITION |
| Filed: December 3, 2004 | : | |
| Attorney Docket No. 206,738 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 30, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees and submit corrected drawings on or before June 27, 2006, as required by the Notice of Allowance and Fee(s) Due and Notice of Allowability, mailed March 27, 2006. Accordingly, the date of abandonment of this application is June 28, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $700, the publication fee of $300, and drawings, (2) the petition fee of $750; and (3) a proper statement of unintentional delay.

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

This application is being referred to Publishing Division for appropriate processing in accordance with this decision on petition.

Frances Hicks
Petitions Examiner
Office of Petitions

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Mail Date: 04/26/2010

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|---|---|---|
| **Applicant** | : Andreas Martin | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7576233 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/18/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/516,958 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/11/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1199** 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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Alexandria, VA 22313-1450
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PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND OH 44114-3108

2/12/09

In re Application of:
OBERLI, STEPHANE et al
Serial No. 10/516,972
Filed: Jul. 14, 2005
Docket: BLAN-37253
Title: PIG FOR INSTALLING A CABLE IN A CONDUIT

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition filed January 30, 2009 under 37 CFR 1.181 requesting withdrawal of the communication regarding non-compliant appeal brief issued on December 31, 2008.

The petition is **granted.**

In the petition, petitioner argues that the examiner's communication mailed on December 31, 2008 requiring the applicant to file a corrected appeal brief in compliance with 37 C.F.R. 41.37(c)(1)(v) is in error. In particular, the examiner found the brief filed on November 26, 2008 does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number, and to the drawing, if any, by reference characters; and/or does not identify the structure, material, or acts described in the specification as corresponding to each claimed function for every means plus function and step plus function for each independent claim involved in the appeal and for each dependent claim argued separately by reference to the specification by page and line number, and to the drawing, if any, by reference characters, as required by 37 CFR 41.37(c)(1)(v). In particular, the examiner in essence stated that "a radially resilient support part" is not supported by the description on page 8, line 30 thru page 9, line 5 as indicated by the appellant. Therefore, this appeal cannot go forward due to this fatal defect.

In the petition, petitioner is of the opinion that the brief in its present form should have been admitted. In particular, petitioner argues that the examiner's objection to the brief is essentially the same issue as the 35 USC 112, first paragraph issue on appeal. The issue of new matter under appeal should be fairly decided by the Board of Appeals.

In finding petitioner's points of argument persuasive and after consultation with an administrator at the Board of Appeals, (Ms. Krista Zele), the requested relief is granted. The issue of new

matter under appeal is the same issue as the formality objection raised by the examiner in the Notification of Non-compliant Appeal Brief of December 31, 2008 and therefore must be decided by the Board of Appeals.

The examiner's communication mailed on December 31, 2008 requiring the applicant to file a corrected appeal brief in compliance with 37 C.F.R. 41.37(c)(1)(v) is hereby withdrawn. The examiner is directed to enter the Appeal Brief filed on Jan. 30, 2009 and proceed with appeal conference and an examiner's answer as soon as possible.

The application is being forwarded to Supervisory Patent Examiner of Art Unit 3723 for further processing. Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner at (571) 272-4856.

PETITION GRANTED.

Donald T. Hajec, Director
Technology Center 3700

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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31 JAN 2006

Huntsman LLC
Legal Department
10003 Woodloch Forest Drive
The Woodlands, TX 77380

In re Application of MESSE et al :
U.S. Application No.: 10/516,978 :
PCT Application No.: PCT/GB03/02410 :
Int. Filing Date: 04 June 2003 : DECISION
Priority Date Claimed: 06 June 2002 :
Attorney Docket No.: 128905-1004 (HAM 830006) :
For: ACTINIC RADIATION CURABLE :
COMPOSITIONS AND THEIR USE :

This is in response to the "Satisfaction of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" filed 22 August 2005, which is being treated as a petition under 37 CFR 1.47(a).

## BACKGROUND

On 04 June 2003, applicant filed international application PCT/GB03/02410, which claimed priority of an earlier United Kingdom application filed 06 June 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 18 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 06 December 2004.

On 03 December 2004, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 17 June 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 22 August 2005, applicant filed the present petition under 37 CFR 1.47(a).

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventor on his own behalf and on behalf of the nonsigning inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Barrie Hayes refuses to sign the application papers. However, petitioner has not adequately shown that a bona fide attempt was made to present a copy of the application papers to Hayes for signature. In particular, the letter dated 09 February 2003 did not include a copy of the application papers. The hypertext link in the body of the letter is not equivalent to providing an actual copy of the application papers. Furthermore, the link is not operational. Moreover, the petition does not include documentary evidence (i.e. a copy of the DHL confirmation) which illustrates that the correspondence was received by Hayes. In addition, the petition does not sufficiently demonstrate that Hayes refuses to sign. Specifically, the affidavit of Britt Van Essche fails to provide details of applicant's response to Hayes' letter dated 20 February 2005. It is noted that Hayes' letter does not state that he refuses to sign. Thus, it would not be reasonable to conclude at the present time that Hayes refuses to join in the application.

With regard to item (3) above, applicant is advised that effective 22 November 2004, the fee for a petition under 37 CFR 1.47 increased to $200.00. Any fee deficiency will be charged to Deposit Account No. 08-3442 as authorized by applicant.

With regard to item (4) above, the petition does not state the last known address of the nonsigning inventor.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)".

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

01 MAY 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

Huntsman LLC
Legal Department
10003 Woodloch Forest Drive
The Woodlands, TX 77380

| | | |
|---|---|---|
| In re Application of MESSE et al | : | |
| U.S. Application No.: 10/516,978 | : | |
| PCT Application No.: PCT/GB03/02410 | : | |
| Int. Filing Date: 04 June 2003 | : | DECISION |
| Priority Date Claimed: 06 June 2002 | : | |
| Attorney Docket No.: 128905-1004 (HAM 830006) | : | |
| For: ACTINIC RADIATION CURABLE COMPOSITIONS AND THEIR USE | : | |

This is in response to applicant's "Renewed Petition Under 37 C.F.R 1.47(a)" filed 04 April 2006.

## BACKGROUND

On 04 June 2003, applicant filed international application PCT/GB03/02410, which claimed priority of an earlier United Kingdom application filed 06 June 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 18 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 06 December 2004.

On 03 December 2004, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 17 June 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 22 August 2005, applicant filed a petition under 37 CFR 1.47(a).

On 31 January 2006, this Office mailed a decision dismissing the 22 August 2005 petition.

On 04 April 2006, applicant filed the present renewed petition under 37 CFR 1.47(a).

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicant has previously satisfied items (1) and (3) 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 joint inventor Barrie Hayes refuses to sign the application papers. Petitioner has adequately demonstrated that a bona fide attempt was made to present a copy of the application papers to Hayes for signature. In particular, the application papers were delivered to Hayes 16 February 2006 (see affidavit of Sandra Bauwens, ¶7). Furthermore, the petition sufficiently illustrates that Hayes refuses to sign. Specifically, the Bauwens' affidavit states that Hayes made a constructive refusal to sign during a telephone conversation on 21 March 2006 (see Bauwens' affidavit, ¶9). Thus, it can be concluded with reasonable certainty that Hayes refuses to join in the application.

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 04 June 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 22 August 2005.

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

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

Bryan Tung
PCT Legal Examiner
PCT Legal Office

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

01 MAY 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Barrie Hayes
Westlands
33 High Street, eversdan
Cambridgeshire CB3 7HE
Great Britain

In re Application of MESSE et al
U.S. Application No.: 10/516,978
PCT Application No.: PCT/GB03/02410
Int. Filing Date: 04 June 2003
Priority Date Claimed: 06 June 2002
For: ACTINIC RADIATION CURABLE
COMPOSITIONS AND THEIR USE

Dear Barrie Hayes:

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

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

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

Huntsman LLC
Legal Department
10003 Woodloch Forest Drive
The Woodlands, TX 77380

Attorney Docket No.: 128905-1004 (HAM 830006)

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Alexandria, Virginia 22313-1450
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HUNTSMAN ADVANCED MATERIALS AMERICAS LLC
10003 WOODLOCH FOREST DRIVE
THE WOODLANDS, TX 77380

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Laurence Josette Messe | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7595351 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/29/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/516,978 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 08/22/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **774** 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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Morrison & Foerster LLP
12531 High Bluff Drive
Suite 100
San Diego, CA 92130-2040

COPY MAILED
NOV 15 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Luppo Edens et al. | : | |
| Application No. 10/516,983 | : | DECISION ON PETITION |
| Filed: December 3, 2004 | : | TO WITHDRAW |
| Attorney Docket No. 246152024500 | : | 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 30, 2006.

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

A review of the file record indicates that the power of attorney to the attorneys and/or agents associated with the firm Morrison & Foerster LLP has been revoked by the assignee of the patent application on September 22, 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 |
|---|---|---|---|
| 10/516,983 | 12/03/2004 | Luppo Edens | 246152024500 |

**CONFIRMATION NO. 1387**

*OC000000021224688*

*OC000000021224688*

25225
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date Mailed: 11/14/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/19/2006.

- 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 Williams

TERRI S WILLIAMS
OP (571) 272-2991

FORMER ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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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 |
|---|---|---|---|
| 10/516,983 | 12/03/2004 | Luppo Edens | 246152024500 |

**CONFIRMATION NO. 1387**

*OC000000021224691*

*OC000000021224691*

23117
NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

Date Mailed: 11/14/2006

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/19/2006.

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.

Terri S. Williams

TERRI S WILLIAMS
OP (571) 272-2991

ATTORNEY/APPLICANT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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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 |
|---|---|---|---|
| 10/516,983 | 12/03/2004 | Luppo Edens | 246152024500 |

**CONFIRMATION NO. 1387**

*OC000000021224688*

*OC000000021224688*

25225
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date Mailed: 11/14/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/19/2006.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

Terri S. Williams

TERRI S WILLIAMS
OP (571) 272-2991

NEW ATTORNEY/AGENT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

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

1/11/08

Patent No. :7137802
Ser. No. : 10517014
Inventor(s) :Bacher, Helmut et al.
Issued : 11/21/06
Title : DEVICE FOR PROCESSING THERMOPLASTIC MATERIAL
Docket No. :

Re: Request for Certificate of Correction

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

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

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

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

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

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

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

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

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

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

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

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

**Henry Randall**
For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 Ext. 108

TOWNSEND AND TOWN AND CREW LLP
TWO EMBARCADERO CENTER, EIGHTH FLOOR
SANFRANCISCO, CA 94111-3834

HR

05 JUN 2006

#6

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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David N. Fronek
Dorsey & Whitney LLP
Intellectual Property Department
Suite 1500
50 South Sixth Street
Minneapolis, MN 55402-1498

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Alan K. DOERER | : | |
| Application No.: 10/517,031 | : | |
| PCT No.: PCT/US03/17782 | : | |
| Int. Filing Date: 05 June 2003 | : | PETITION UNDER |
| Priority Date: 06 June 2002 | : | |
| Attorney's Docket No.: 14372.03 | : | |
| For: AIRCRAFT DOOR SYSTEM AND METHOD | : | |
| ... THE SAME | : | 37 CFR 1.137(b) |

This decision is in response to applicant's "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," filed on 21 November 2005. The petition fee of $1,500.00 has been paid by check

## BACKGROUND

On 05 June 2003, this international application was filed, which claimed an earliest priority date of 06 June 2002. The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 06 December 2004.

On 06 December 2004, applicant filed in the United States Patent and Trademark Office (PTO) a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, *inter alia*, the copy of the international application, but national basic fee was not submitted at that time. This international application became abandoned with respect to the United States at midnight on 06 December 2004 for failure to pay the required basic national fee.

On 21 October 2005, the United States Patent and Trademark Office mailed the Notification of Abandonment (PCT/DO/EO/909) because applicant failed to provide the full U.S. Basic National Fee by 30 months (37 CFR 1.495(b)(2)).

On 21 November 2005, applicants filed the instant petition under 37 CFR 1.137(b), which was accompanied by the petition fee and the basic national fee.

## DISCUSSION

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

Petitioner has provided: (1) the proper reply by having submitted the basic national filing fee, (2) the petition fee set forth in §1.17(m), and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Accordingly, the petition is deemed to satisfy requirements (1), (2), (3), and (4) under 37 CFR 1.137(b).

## DECISION

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

**COPY MAILED**

JUN 30 2009

**OFFICE OF PETITIONS**

In re Application of :
Damijan Miklavcic et al. :
Application No. 10/517,038 : ON PETITION
Filed: August 25, 2005 :
Attorney Docket No. P/2528-21 :

This is a decision on the petition filed June 10, 2009 under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

In response to a non-Final Office Action mailed August 20, 2008 an amendment was filed on November 20, 2008. However, in response thereof, a Notice of Non-Compliant Amendment (37 CFR 1.121) was mailed December 1, 2008 which set a one month period for reply. No reply or extensions of time having been requested, this application became abandoned January 2, 2009. Accordingly, a Notice of Abandonment was mailed June 8, 2009.

All other requirements having been met , this matter is being referred to Technology Center 1797 for appropriate action on the amendment filed June 10, 2009.

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

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

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

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

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

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

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

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Ulf Petersson | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7613543 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/03/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/517,043 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/15/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1086** 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.

13 MAY 2005

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NOVARTIS
Corporate Intellectual Property
One Health Plaza, Building 104
East Hanover, NJ 07936-1080

| | | |
|---|---|---|
| In re Application of: | : | |
| HOHNEKER, John, Arthur, et al. | : | |
| PCT No.: PCT/EP03/05988 | : | DECISION ON PETITION |
| U.S. Application No: 10/517,074 | : | UNDER 37 CFR 1.47(A) |
| International Filing Date: 06 June 2003 | : | |
| Priority Date: 10 June 2002 | : | |
| Attorney's Docket No.: ON/4-32515A | : | |
| For: COMBINATIONS COMPRISING EPOTHILONES AND PHARMACEUTICAL USES THEREOF | : | |

This decision is issued in response to the 19 April 2005 submission by applicants of a declaration executed by three of the four inventors, treated herein as a petition under 37 CFR 1.47(a) for acceptance of the application without the signature of the remaining inventor. Deposit Account No. 19-0134 will be charged the required petition fee.

## BACKGROUND

On 06 April 2003, applicants filed international application PCT/EP03/05988 which claimed a priority date of 10 June 2002 and which designated the United States. On 18 December 2003, a copy of the international application was communicated to the United States Patent Office ("USPTO") by the International Bureau ("IB"). The deadline for filing the basic national fee was thirty months from the priority date, i.e., 10 December 2004.

On 06 December 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 12 April 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 19 April 2005, applicants the materials considered herein. The submission included payment of the required surcharge, a declaration executed by three of the four inventors, and a statement regarding the purported refusal of the remaining inventor, John David ROTHERMEL, to execute the declaration.

## 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.

Pursuant to the previously filed authorization, Deposit Account No. 19-0134 will be charged the required petition fee. Item (1) is satisfied.

The 19 April 2005 submission does not included an express statement of the nonsigning inventor's last known address. Item (2) is therefore not satisfied.

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

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

Here, applicants have filed a declaration executed by three of the four inventors and including an unsigned signature box identifying the nonsigning inventor. This declaration is treated as having been executed by the available inventors on their own behalf and on behalf of the nonsigning inventor. Item (3) is therefore satisfied.

Regarding item (4), applicants assert that the nonsigning inventor has refused to execute the application. However, before a refusal to execute the application can be claimed, MPEP § 409.03(d) requires that the nonsigning inventor be provided with a copy of the complete application, including specification, drawings, and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made." Applicants here have supplied a statement from Oona A. Jackson with respect to the inventor's purported refusal to sign the application. However, this statement does not provide specific details regarding the attempts to obtain the inventor's signature and his purported refusal. In addition, it is not clear whether Oona A. Jackson is the proper person to provide this statement in that the statement does not assert that Ms. Jackson is the person who made the attempts to obtain the inventor's signature and to whom the inventor made his statement of refusal. Finally, applicants have not provided the required firsthand evidence confirming that the inventor has been provided with a copy of the complete application papers. Item (4) is not satisfied on the present record.

## CONCLUSION

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

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must be accompanied by the materials needed to satisfy the outstanding requirements for a grantable petition, as discussed above and in the section 409.03 of the MPEP.

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.

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

JC10 Rec'd PCT/PTO 11 JUL 2005

4-5

CASE ON/4-32515A

| FILING BY "EXPRESS MAIL" UNDER 37 CFR 1.10 | |
|---|---|
| EV724616241US<br>Express Mail Label Number | July 11, 2005<br>Date of Deposit |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PCT NATIONAL STAGE APPLICATION OF

HOHNEKER ET AL.

INTERNATIONAL APPLICATION NO: PCT/EPO3/05988

FILED: 6 JUNE 2003

U.S. APPLICATION NO: 10/517,074

35 USC §371 DATE:

FOR: COMBINATIONS COMPRISING EPOTHILONES AND PHARMACEUTICAL USES THEREOF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**DECISION ON PETITION UNDER 37 CFR 1.47(b) IS MOOT**

Sir:

The Decision is rendered moot by the submission of the fully executed Declaration and Power of Attorney for the above identified U.S. Patent Application.

If there are any fees due in connection with this communication, including any fees required for an extension of time, such an extension is requested and the Commissioner is authorized to charge the fees to Deposit Account No. 19-0134 to Novartis Corporation.

Respectfully submitted,

Novartis
Corporate Intellectual Property
One Health Plaza, Building 104
East Hanover, NJ 07936-1080
(862) 778-7852

Oona A. Jackson
Attorney for Applicants
Reg. No. 48,152

Date: July 11, 2005

RECEIVED
15 JUL 2005
Legal Staff
International Division

19 JUL 2005

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NOVARTIS
Corporate Intellectual Property
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East Hanover, NJ 07936-1080

| | | |
|---|---|---|
| In re Application of: | : | |
| HOHNEKER, John, Arthur, et al. | : | |
| PCT No.: PCT/EP03/05988 | : | DECISION ON RENEWED |
| U.S. Application No: 10/517,074 | : | PETITION UNDER |
| International Filing Date: 06 June 2003 | : | 37 CFR 1.47(a) |
| Priority Date: 10 June 2002 | : | |
| Attorney's Docket No.: ON/4-32515A | : | |
| For: COMBINATIONS COMPRISING EPOTHILONES AND PHARMACEUTICAL USES THEREOF | : | |

This decision is issued in response to the submission entitled "Decision On Petition Under 37 CFR 1.47(b) Is Moot" filed 11 July 2005, treated herein as a renewed petition under 37 CFR 1.47(a). No additional petition fee is required.

## BACKGROUND

The procedural background for this petition is set forth in detail in the decision mailed by this Office on 13 May 2005. That decision dismissed without prejudice the petition under 37 CFR 1.47(a) filed herein; such petition had sought acceptance of this application without the signature of inventor John David ROTHERMEL.

On 11 July 2005, applicant filed a submission entitled "Decision On Petition Under 37 CFR 1.47(b) Is Moot," treated herein as a renewed petition under 37 CFR 1.47(a). This submission included a declaration executed by the previously non-signing inventor.

## DISCUSSION

As noted above, the renewed petition was accompanied by a copy of the declaration executed by previously nonsigning inventor John David ROTHERMEL, the subject of the earlier petition under 37 CFR 1.47(a). Accordingly, applicant's petition under 37 CFR 1.47(a) is now moot. Applicant has now submitted a fully executed declaration in compliance with 37 CFR 1.497.

## CONCLUSION

Applicant's petition under 37 CFR 1.47(a) is **MOOT.**

The executed declaration filed 11 July 2005, in combination with the declarations filed 19 April 2005 (executed by the other inventors herein), satisfies the requirements of 37 CFR 1.497.

This application is being forwarded to the National Stage Processing Branch of the International Division for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date is 11 July 2005.

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

19 DEC 2007

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Andrew K Gonsalves
Nixon Peabody
Clinton Square
PO Box 31051
Rochester NY 14603-1051

| | | |
|---|---|---|
| In re Application of | : | |
| HALLBRINK et al. | : | |
| Application No.: 10/517,079 | : | DECISION |
| PCT No.: PCT/IB03/03163 | : | |
| Int. Filing Date: 18 June 2003 | : | |
| Priority Date: 18 June 2002 | : | |
| Attorney's Docket No.: 20747/230 | : | |
| For: CELL PENETRATING PEPTIDES | : | |

This decision is in response to applicants' submission filed in the United States Patent and Trademark Office (USPTO) on 07 September 2007, which has properly been treated as a petition under 37 CFR 1.181. No petition fee is required.

## BACKGROUND

On 18 June 2003, applicants filed international application PCT/IB03/03163, which designated the United States and claimed a priority date of 18 June 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 24 December 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 20 December 2004 (18 December 2004 being a Saturday).

On 06 December 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 17 May 2005, the DO/EO/US mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required as were certain "Sequence Listing" requirements.

On 11 August 2005, applicants submitted a response to the NOTIFICATION OF MISSING REQUIREMENTS mailed 17 May 2005.

On 30 June 2006, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (From PCT/DO/EO/916) indicating, *inter alia*, that certain "Sequence Listing"

requirements still had not been met.

On 24 July 2006, applicants submitted a response to the NOTIFICATION OF DEFECTIVE RESPONSE mailed 30 June 2006.

On 01 September 2006, the DO/EO/US mailed a second NOTIFICATION OF DEFECTIVE RESPONSE indicating that certain "Sequence Listing" requirements still had not been met.

On 19 September 2006, the DO/EO/US mailed a third NOTIFICATION OF DEFECTIVE RESPONSE indicating that certain "Sequence Listing" requirements still had not been met.

On 03 October 2006, applicants submitted a response to the NOTIFICATION OF DEFECTIVE RESPONSE mailed 01 September 2006.

On 24 October 2006, the DO/EO/US mailed a fourth NOTIFICATION OF DEFECTIVE RESPONSE indicating that certain "Sequence Listing" requirements still had not been met.

On 22 November 2006, applicants submitted a response to the NOTIFICATION OF DEFECTIVE RESPONSE mailed 24 October 2006.

On 14 February 2007, the DO/EO/US mailed a fifth NOTIFICATION OF DEFECTIVE RESPONSE indicating that certain "Sequence Listing" requirements still had not been met.

On 14 March 2007, applicants submitted a response to the NOTIFICATION OF DEFECTIVE RESPONSE mailed 14 February 2007.

On 23 April 2007, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to respond the NOTIFICATION OF MISSING REQUIREMENTS mailed 19 September 2006.

On 07 September 2007, applicants filed the instant petition.

## DISCUSSION

The third NOTIFICATION OF DEFECTIVE RESPONSE mailed 19 September 2006 was mailed in error. It was simply a duplicate of the third NOTIFICATION OF DEFECTIVE RESPONSE mailed 01 September 2006. The IFW file contains a notation to this effect. Thus, the third NOTIFICATION OF DEFECTIVE RESPONSE mailed 19 September 2006 is hereby VACATED. Accordingly, the NOTIFICATION OF ABANDONMENT mailed 23 April 2007 is also hereby VACATED.

## CONCLUSION

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

For the reasons set forth above, the NOTIFICATION OF DEFECTIVE RESPONSE mailed 19 September 2006 is VACATED.

For the reasons set forth above, the NOTIFICATION OF ABANDONMENT mailed 23 April 2007 is VACATED.

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

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application in accordance with this decision.

/Daniel Stemmer/

Daniel Stemmer
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
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UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/517,080 | 12/06/2004 | Manish Chawla | RLL-265US | 8568 |

7590 02/13/2008

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PRINCETON, NJ 08540

| EXAMINER |
|---|
| HAGOPIAN, CASEY SHEA |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1615 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 02/13/2008 | PAPER |

## DECISION DISMISSING PETITION UNDER 37 CFR 1.138(d)

*The declaration of express abandonment will not be recognized*

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

The petition is dismissed.

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

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

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

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

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

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

Patent Publication Branch
Office of Data Management

29 SEP 2005



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Wood Herron & Evans
2700 Carew Tower
Cincinnati OH 45202

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|---|---|---|
| In re Application of | : | |
| TSATSANIS, Michail et al. | : | |
| Application No.: 10/517,090 | : | |
| PCT No.: PCT/US03/18004 | : | DECISION ON |
| Int. Filing Date: 06 June 2003 | : | |
| Priority Date: 07 June 2002 | : | PETITION UNDER |
| Attorney Docket No.: VOY-023US | : | |
| For: MULTILINE TRANSMISSION IN COMMUNICATION SYSTEMS | : | 37 CFR 1.47(a) |

This is in response to applicants' "Petition to Accept Declaration of Non-Signing Inventor 37 CFR §1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 30 August 2005.

## BACKGROUND

On 06 June 2003, applicants filed international application PCT/US03/18004, claiming a priority date of 07 June 2002. The deadline for paying the basic national fee in the United States expired at midnight on 07 December 2004.

On 06 December 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 01 April 2005, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration of the inventors and the surcharge for late filing of the oath or declaration were required.

On 30 August 2005, applicants submitted the instant petition accompanied by the fee for a three month extension of time.

## DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the non-signing applicant.

Items (1), (2), (3) and (4) have been satisfied. The fee under 37 CFR 1.17(h) has been paid. Applicants have supplied evidence that the non-signing inventor was presented with a complete copy of the application papers and has not returned a signed declaration. Applicants state that the last known address of inventor Michail Tsatsanis is 217 Baltimore Avenue, Huntington Beach, CA 92648. The declaration submitted 30 August 2005 complies with 37 CFR 1.47(a) and 37 CFR 1.497(a)-(b).

## CONCLUSION

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

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record.

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

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including accordation of a 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) date of **30 August 2005**.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

29 SEP 2005

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Michail Tsatsanis
217 Baltimore Avenue
Huntington Beach, CA 92648

In re Application of
TSATSANIS, Michail et al.
Application No.: 10/517,090
PCT No.: PCT/US03/18004
Int. Filing Date: 06 June 2003
Priority Date: 07 June 2002
Attorney Docket No.: VOY-023US
For: MULTILINE TRANSMISSION IN COMMUNICATION SYSTEMS

Dear Mr. Tsatsanis:

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

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

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

Wood Herron & Evans
2700 Carew Tower
Cincinnati OH 45202

#9

UNITED STATES PATENT AND TRADEMARK OFFICE

28 DEC 2005

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WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI OH 45202

In re Application of TSATSANIS et al.
Application No.: 10/517,095
PCT No.: PCT/US03/17989
Int. Filing: 06 June 2003
Priority Date: 07 June 2002
Attorney Docket No.: VOY-025US
For: A METHOD AND SYSTEM FOR PROVIDING WINDOW SHAPING FOR MULTILINE TRANSMISSION IN A COMMUNICATIONS SYSTEM

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicant's petition under 37 CFR 1.47(a) and request for three month extension of time, filed in the United States Patent and Trademark Office (USPTO) on 26 August 2005. The request for a three month extension of time is granted.

## BACKGROUND

On 28 March 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 26 August 2005, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) along with a request for a three month extension of time. The petition requested the acceptance of the application without the signature of inventor Michail Tsatsanis. Applicant alleges that the inventor refuses to sign the application. The petition included the requisite petition fee, a declaration signed by the joint inventors on behalf of the nonsiging inventor and a statement of facts 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).

Items (1), (3) and (4) are satisfied. The petition fee has been paid, the last known address of the non-signing inventor was provided and the declaration was submitted by the joint inventors on behalf of the non-signing inventor.

Item (2) is satisfied. Petitioner states that on 11 August 2005, he sent a complete copy of the application via certified mail, return receipt requested, to Mr. Tsatsanis. A copy of the certified mail receipt signed by Mr. Tsatsansi on 17 August 2005 was attached to the petition. Petitioner further states that "Inventor Michail Tsatsanis has failed to return an executed declaration...and thus refuses to join in the application."

The action taken by petitioner is now sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. Applicant has made diligent efforts to contact Mr. Tsatsanis to obtain his signature and by his conduct, it can be concluded that Mr. Tsatsanis refuses to sign the application papers. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

Applicant has provided sufficient evidence that Michail Tsatsanis's conduct constitutes a refusal to sign the application. Petitioner has satisfied the requirements of 37 CFR 1.47(a). Accordingly, it is appropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

## CONCLUSION

The petition under 37 CFR §1.47(a) is **GRANTED**.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 26 August 2005. The application has an international filing date of 06 June 2003 under 35 U.S.C. 363, and a date of 26 August 2005 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

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

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

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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28 DEC 2005

MICHAIL TSATSANIS
217 BALTIMORE AVENUE
HUNTINGTON BEACH, CA 92648

In re Application of TSATSANIS et al.
Application No.: 10/517,095
PCT No.: PCT/US03/17989
Int. Filing: 06 June 2003
Priority Date: 07 June 2002
Attorney Docket No.:VOY-025US
For: A METHOD AND SYSTEM FOR PROVIDING WINDOW SHAPING FOR MULTILINE TRANSMISSION IN A COMMUNICATIONS SYSTEM

DECISION ON PETITION UNDER 37 CFR 1.47(a)

Dear Mr. Tsatsanis:

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

WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI OH 45202

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10 FEB 2006

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SUITE 2100
PRINCETON NJ 08540

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| In re Application of | : | DECISION ON |
| KUMAR et al | : | |
| PCT No.: PCT/IB03/02186 | : | |
| Application No.: 10/517,101 | : | |
| Int. Filing Date: 09 June 2003 | : | PETITION UNDER |
| Priority Date: 07 June 2002 | : | |
| Attorney's Docket No.: RLL-266US | : | |
| For: MODIFIED RELEASE, MULTIPLE | : | |
| UNIT DRUG DELIVERY SYSTEMS | : | 37 CFR 1.47(a) |

This is in response to the "PETITION TO FILE WHEN AN INVENTOR CANNOT BE REACHED UNDER 37 C.R.F. § 1.47(a)" filed on 08 December 2005. The $200.00 petition fee has been charged to petitioner Deposit Account No.: 50-0912 as stipulated in the petition.

## BACKGROUND

On 09 June 2003, applicants filed international application PCT/IB03/02186, which claimed priority to an earlier application filed 07 June 2002. The thirty (30) month time period for paying the basic national fee in the United States of America expired at midnight on 07 December 2004.

On 07 December 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. A copy of the intentional application was transmitted on 18 December 2003 to the USPTO from the International Bureau.

On 09 May 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 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. The notice also indicated that the items must be submitted within two months from the mailing 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 2005, petitioner filed the present petition accompanied, inter alia, an executed Declaration without the signature of one of the five inventors, i.e., without the signature of Ravikumar NITHIYANANDAM.

## DISCUSSION

Petitioner's petition under 37 CFR 1.47(b) is improper because this petition is for the circumstance when all of the inventors refuse to execute an application for patent, or cannot be found or reached after diligent effort. In this situation two of the four inventors signed the declaration. Accordingly, the petition has been treated under 37 CFR 1.47(a).

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

> (a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in § **1.17(h)**, and the last known address of the nonsigning inventor. The nonsigning inventor may subsequently join in the application by filing an oath or declaration complying with § **1.63**.

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

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

> **REFUSAL TO JOIN:**
>
> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the **37 CFR 1.47** applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the

application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See **MPEP § 106**. It is reasonable to require that the inventor be presented with the application papers before a petition under **37 CFR 1.47** is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

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

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

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

Petitioner has satisfied items (1), (3) and (4) of 37 CFR 1.47(a). However, item (2) has not been satisfied.

Regarding item 2, Mr. Hare states that Nithiyanandam has been presented with a copy of the application papers and has failed to respond to the request to sign the declaration. To date we have made numerous attempts to contact Mr. Nithiyanandam but have not received a response. However, it is unclear if the documents were actually mailed to him and received by the non-signing inventor or how the application papers were presented to Mr. Nithiyanandam because no documentary evidence to support this assertion has been provided such as a signed postal receipt and the cover letter addressed to Mr. NIthiyanandum instructing him what to do, or other evidentiary proof.

Moreover, the averments of Mr. Hare are insufficient to support a finding that the nonsigning inventor, Mr. Nithiyanandam, could not be reached after diligent effort because the petition fails to show diligent effort to locate him. The petition does indicated if Mr. Hare has 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 Mr. Nithiyanandam.

In addition, it is unclear if Mr. Hare has first hand knowledge of the above facts with regard to the nonsigning inventor, if he doesn't then petitioner needs to submit statements, with specific facts on the actions referred above to the presentation of the application papers and the numerous attempts to contact the nonsigning inventor by persons who have first-hand knowledge of such facts.

The current record does not sufficiently establish Mr. NITHYANANDAM's refusal to join in the patent application because no evidentiary documents have been submitted to show that a *bona fide* attempt was made to deliver the complete application to him and that he refused to sign the required papers.

Consequently, the petition has not met the requirements under 37 CFR 1.47(a).

## CONCLUSION

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

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." 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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24 APR 2006

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| In re Application of | : | DECISION ON |
| KUMAR et al | : | |
| PCT No.: PCT/IB03/02186 | : | |
| Application No.: 10/517,101 | : | |
| Int. Filing Date: 09 June 2003 | : | PETITION UNDER |
| Priority Date: 07 June 2002 | : | |
| Attorney's Docket No.: RLL-266US | : | |
| For: MODIFIED RELEASE, MULTIPLE | : | |
| UNIT DRUG DELIVERY SYSTEMS | : | 37 CFR 1.47(a) |

This decision is in response to applicants' " RENEWED PETITION UNDER 37 CFR 1.47(b)" which is being treated as a renewed petition under 37 CFR 1.47(a) filed on 05 April 2006 in response to a decision by this Office dated 10 February 2006.

## BACKGROUND

The decision by this Office dated 10 February 2006 indicated that requirement (2) had not been satisfied.

On 05 April 2006, petitioner filed this renewed petition accompanied, inter alia, an executed composite declaration that includes the signature of the non-signing inventor Ravikumar NITHIYANANDAM.

## DISCUSSION

The second renewed petition states that the declaration is now signed by all the inventors.

Accordingly, the declaration submitted on 05 April 2006 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 **05 April 2006.**

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OFFICE OF PETITIONS

In re Application of

Wagner, et al.

Application No. 10/517,109

Filed: December 7, 2004

Attorney Docket No. DE 020140

: DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed April 8, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to file a proper and timely response to the final Office action mailed June 1, 2007, which set a shortened statutory period for reply of three-months from its mailing date. A response was not received within the allowable period and the application became abandoned on September 2, 2007. A Notice of Abandonment was mailed on January 9, 2008.

The Request for Continued Examination filed April 8, 2008, is noted.

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

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. 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.

The application file is being forwarded to Technology Center 2100, GAU 2114 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

cc:
Kenneth D. Springer
Volentine & Whitt, PLLC
11951 Freedom Drive
Suite 1260
Reston, VA 20190

26 APR 2006

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P.O. BOX 484
Princeton, New Jersey 08542-0484

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| In re Application of | : | DECISION ON |
| Balyberdin et al | : | |
| PCT No.: PCT/EP03/05202 | : | |
| Application No.: 10/517,121 | : | |
| Int. Filing Date: 17 May 2003 | : | PETITION UNDER |
| Priority Date: 4 June 2002 | : | |
| Attorney's Docket No.: RF-33 | : | |
| For: METHOD AND DEVICE FOR | : | |
| PRODUCING ... RUBBER WASTES | : | 37 CFR 1.47(b) |

This decision is in response to applicants' "PETITION UNDER 37 C.F.R. 1.47 AND REQUEST FOR ONE MONTH EXTENSION OF TIME" submitted on 17 October 2005 that seeks the acceptance of the application without the signature of the inventors Vladimir Balyberdin and Roudolf Gorelik. Petitioner has paid the requisite $200 petition fee.

## BACKGROUND

On 17 May 2003, applicant filed international application PCT/EP03/05202, which claimed priority of an earlier application filed 04 June 2002.

On 02 December 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). However, no executed declaration or oath was submitted at such time.

On 13 July 2005, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating, *inter alia*, that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. It indicated that the current oath or declaration does is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68. The notification set two months from the date of this notice or 32 months from the priority date for the application, whichever is later to respond. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) and to respond to the Notice, petitioner filed on 17 October 2005, the following:

1) a petition under 37 CFR 1.47(b);

2) a Declaration for U.S. Patent Application executed by Mr. Siegfried Kohli;

3) the required petition fee.

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner has satisfied items (1), (3), and (6) but not items (2), (4) and (5); thus not completing the requirements under 37 CFR 1.47(b).

Petitioner has satisfied item (1) because the petition fee has been provided.

Regarding requirement (2), although petitioner has concluded that the inventors refuse to sign the declaration, the petition does not include sufficient proof to establish this conclusion. The standards for proof are set forth in MPEP § 409.03(d), which provides:

> 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....
>
> Where a refusal of the inventor 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 non - signing inventor, or, if the non - signing inventor is represented by counsel, to the address of the non - signing 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.

Mr. Roberts argues that Vladimir Balyberdin and Roudolf Gorelik either refused to join in the application for patent, or cannot be found or reached after diligent effort, and they have not signed the required Declaration for the patent application. Although, Mr. Roberts states that Dr. Siegfried transmitted to them the application papers, they have not responded back to him.

However, Mr. Roberts is not the person who performed the actions listed in the petition and does not have first hand knowledge of those facts as required by MPEP Section 409.03(d). He will need to submit statements, with specific facts on the actions referred to in the petition by the person, Dr. Siegfried Kohli, who has first-hand knowledge of such facts.

Furthermore, although documentary evidence to support this assertion has been provided such as the letter, the letter is in a foreign language and no English translation has been provided. Therefore, it is unclear what is said in these documents and translations of the document will need to be provided.

Also, no English translated copy of the registered returned envelope, a certified mail return receipt, and etc., as required by MPEP Section 409.03 to support his allegation about the correspondence being sent to the non-signing inventors have been provided. Therefore, it is unclear if they actually received the documents. Moreover, because Mr. Roberts alleges that they cannot be found after diligent effort, then appears that they may not be living in their last known residence. If they don't, then petitioner is under an obligation to try to find or reach them by searching them in the internet and phone-directory. Where there is an inability to find or reach a joint inventor "after diligent effort, " petitioner may file a statement of facts that fully describes the exact facts which are relied on to establish that a diligent effort was made under 37 CFR 1.47.

Consequently, the petition does not include sufficient factual proof that Messrs. Balyberdin and Gorelik refuse to sign the required papers or cannot be reached or found after diligent effort.

Regarding item (3), petitioner has stated the last known addresses of the inventors

Regarding item (4) a declaration has been provided which is executed by Siegfried Kohli, Managing Director of the inventor's contractual assignee, for signing on behalf of the corporation for the non-signing co-inventors, Messrs. Balyberdin and Gorelik. However, it is unclear if Mr. Kohli has authority to sign on behalf of the corporation.

In general, a person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the organization is not presumed to be an officer or to have the authority to sign on behalf of the organization. However, an exception is made with respect to foreign juristic applicants. This is because in foreign countries, a person who holds the title "Manager" or "Director" is normally an officer or the equivalent thereof; therefore, those terms are generally acceptable as indicating proper persons to sign applications for foreign applicants. However, titles such as "Manager of Patents," suggesting narrowly limited duties, are not acceptable. In this instance, Mr. Kohli has the title Managing Director, which indicates that his title is limited.

Regarding item (5) petitioner has not submitted sufficient proof that applicant has sufficient proprietary interest in the application. The documents submitted are in a foreign language so it is unclear what is stated in them.

Regarding item (6) applicant has presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage if the response to the missing parts of the application is not timely.

Accordingly, because items (2), (4) and (5) under 37 CFR 1.47(b) have 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(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

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

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#7

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19 JUL 2006

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Princeton, New Jersey 08542-0484

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| In re Application of | : | DECISION ON |
| Balyberdin et al | : | |
| PCT No.: PCT/EP03/05202 | : | |
| Application No.: 10/517,121 | : | |
| Int. Filing Date: 17 May 2003 | : | PETITION UNDER |
| Priority Date: 4 June 2002 | : | |
| Attorney's Docket No.: RF-33 | : | |
| For: METHOD AND DEVICE FOR | : | |
| PRODUCING ... RUBBER WASTES | : | 37 CFR 1.47(b) |

This decision is in response to applicants' "Renewed Petition Under 37 C.F.R.1.47(b)" submitted on 14 June 2006 that indicates that Vladimir Balyberdin and Roudolf Gorelik has now executed the declaration.

## BACKGROUND

In a decision by this Office dated 02 February 2006, the decision stated that applicants had not satisfied requirements (2) and (4) and (5) under 37 CFR 1.47(b). The decision concluded that it was not appropriate to accord national stage application status under 37 CFR 1.47(b) at that time.

On 14 June 2006, petitioner filed this instant renewed petition accompanied, inter alia, by an executed declaration by Vladimir Balyberdin and Roudolf Gorelik.

## DISCUSSION

The petition states that the applicant finally succeeded in obtaining Vladimir Balyberdin and Roudolf Gorelik's signatures on a declaration. Thus, the declaration is now executed by the non-signing inventors.

Accordingly, the declaration submitted on 14 June 2006 complies with 37 CFR 1.497(a) and (b).

## CONCLUSION

The petition under 37 CFR 1.47(b) 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 date of this application is **14 June 2006**.

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OCT 12 2007

**OFFICE OF PETITIONS**

Applicant: Bevec
Appl. No.: 10/517,125
International Filing Date: June 5, 2003
Title: USE OF COMPOUNDS HAVING THE BIOLOGICAL ACTIVITY OF VASOACTIVE INTESTINAL PEPTIDE FOR THE TREATMENT OF SARCOIDOSIS
Attorney Docket No.: 69137-00003USPX
Pub. No.: 2006/0241028 A1
Pub. Date: October 26, 2006

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on December 26, 2006, 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 wherein the foreign priority data for EP document "02012767.6" is misprinted as "02017767.6".

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 failure to include the proper foreign priority claim to application EP 02012767.6 on the front page of the published patent application is an Office error but it is not a material error, as required by 37 CFR 1.221(b). The error in the foreign priority claim is not a material mistake because it does not affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance

[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).

of a patent. The specification and claims were accurately published, thus one can read and understand the content of the application. The error also does not affect the use of the patent application publication as a prior art reference, because the foreign priority date is not useable as a reference date.

On July 12, 2006, a Filing Receipt was mailed by the Office.

On July 31, 2006, Applicant's representative made a request for a corrected filing receipt. The correction in the Office electronic records was made too late in the publication process to be entered into the publication.

It would greatly benefit the Office if **applicant did not provide copies of papers**, which were previously submitted or **a complete copy of the pre-grant publication**, as it unnecessarily increases the cost to the Office. See 37 CFR 1.4(b). A request for corrected publication need only point out what was printed incorrectly in the application, where the error occurs in the publication and where the correct text or drawing is found in the application papers. Marked up relevant copies of the applications papers and the pre-grant publication may facilitate processing of the request, where it is not readily apparent where the error occurs. If it is not clear why the error is a material error, further explanation may be warranted.

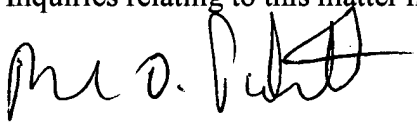
The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application compliance with the Office's electronic filing system requirements and be accompanied by the 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

By facsimile: 571-273-8300

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



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

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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 5400
SEATTLE WA 98104

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MAR 22 2010

OFFICE OF PETITIONS

In re Patent No. 7,589,641 :
Wobben : DECISION ON REQUEST FOR
Issue Date: September 15, 2009 : RECONSIDERATION OF
Application No. 10/517,130 : PATENT TERM ADJUSTMENT
Filed: June 29, 2005 : AND NOTICE OF INTENT
Attorney Docket No. : TO ISSUE CERTIFICATE OF
970054.482USPC : CORRECTION
Title: Hazard Navigation Light :
For Wind Turbines :

This is a decision on the petition filed on November 5, 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 two hundred eighty-nine (289) days.

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

The period of adjustment to which the patent is entitled under 37 CFR 1.702(a) is 274.

The period of adjustment to which the patent is entitled under 37 CFR 1.702(b) is 439, not 441 days. In an international application, this period is based on the failure of the Office to issue a patent within three years after the national stage commenced under 35 U.S.C. 371(b) or (f). See 37 CFR 1.702(b). The priority date of this application is June 7, 2002. As early commencement was not requested, national stage commenced in this application on December 7, 2004. Thus, "B" delay is 439 days, counting the number of days beginning on December 8, 2007 and ending on February 18, 2009, the day before the filing of the

Request for Continued Examination (RCE). See 1.703(b) and 35 U.S.C. 154(b)(1)(B)(i).

However, a review of the record shows that a 12-day reduction was warranted pursuant to 37 CFR 1.704 (c)(10) which provides:

> (10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:
>
> i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
>
> (ii) Four months;

The Notice of Allowance was mailed on May 6, 2009. On July 27, 2009, patentees filed a "Request for Consideration of a Previously Submitted Information Disclosure Statement (IDS)". The submission of the request after the mailing of the Notice of Allowance on May 6, 2009 constituted a failure to engage pursuant to 37 CFR 1.704 (c)(10). This period is 12 days, counting the number of days in the period beginning on July 27, 2009 and ending on August 7, 2009, the date of the mailing of the response to the request.

As such, patentees' delay totals 164 days (61 + 61 + 30 + 12).

The period of adjustment under 37 CFR 1.702(a) and (b) must be reduced due to applicant delay of 164 days.

In view thereof, the patent is entitled to an overall adjustment of 549 days (274 days under 37 CFR 1.702(a) + 439 days under 37 CFR 1.702(b) - 164 days of applicant delay).

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

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

The application is being forwarded to the Certificate of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by five hundred forty-nine **(549)** days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney, Charlema Grant at (571) 272-3215.

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,589,641 B2

DATED : **September 15, 2009** **DRAFT**

INVENTOR(S) : Wobben

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 122 days

Delete the phrase "by 122 days" and insert – by 549 days--

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701 FIFTH AVE
SUITE 5400
SEATTLE, WA 98104

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Aloys Wobben | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7589641 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/517,130 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/29/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **561** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

#6

09 AUG 2005

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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY and POPEO, P.C.
One Financial Center
Boston, MA 02111

In re Application of :
BRAND, Stephen *et al* :
U.S. Application No.: 10/517,135 :
PCT No.: PCT/US03/18377 :
Int. Filing Date: 09 June 2003 :
Priority Date: 07 June 2002 :
Attorney Docket No.: 24492-010 NATL :
For: COMPOSITIONS AND METHODS FOR TREATING DIABETES :

**DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)**

Applicants' petition for revival under 37 CFR 1.137(b) filed on 05 July 2005 is hereby **GRANTED** as follows:

Applicants submitted $300.00 for payment of the Basic National Stage fee and $1,500.00 for the petition fee. Applicants state that "[t]he entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration has not been provided.

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 declaration in compliance with 37 CFR 1.497(a) and (b), a surcharge fee and payment of the search fee and examination fee are required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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**OFFICE OF PETITIONS**

MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON MA 02111

In re Application :
Brand, et al. :
Application No. 10/517,135 : PATENT TERM ADJUSTMENT
Filed: February 17, 2006 :
Dkt. No.: 24492-510NATL :

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)." 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 March 9, 2009, at the time of issue fee payment.

The Determination of Patent Term Adjustment under 35 USC 154(b) was mailed December 8, 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.

Alesia M. Brown
Petitions Attorney
Office of Petitions

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ONE FINANCIAL CENTER
BOSTON MA 02111

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APR 12 2010

OFFICE OF PETITIONS

In re Patent No. 7,560,425 : DECISION ON APPLICATION FOR
Issued: July 14, 2009 : PATENT TERM ADJUSTMENT
Application No. 10/517,135 :
Filed: February 17, 2006 :
Dkt. No.: 24492-510NATL :

This is a decision on the petition filed on September 10, 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 597 days.

The instant petition bears a illegible handwritten signature and registration number, but does not provide the name of the individual making the signature. Accordingly, the petition under 37 CFR 1.705(d) is not properly signed within the meaning of 37 CFR 1.34. See, also, 1283 OG 148 (June 22, 2004).

Accordingly, the petition is **DISMISSED**.

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON MA 02111

In re Patent No. 7,560,425
Issued: July 14, 2009
Application No. 10/517,135
Filed: February 17, 2006
Atty. Dkt. No.: 24492-510N01US

: DECISION ON APPLICATION FOR
: PATENT TERM ADJUSTMENT UNDER
: 37 CFR 1.705(d)

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d)," filed April 22, 2010.

The above-identified application matured into U.S. Patent No. 7,560,425 on July 14, 2009. An improper request for patent term adjustment was filed September 10, 2009. The request was improper because it was not properly signed in accordance with 37 CFR 1.33(b), as indicated in the decision mailed April 12, 2010.

The instant request for reconsideration of patent term adjustment under 37 CFR 1.705(d) was filed April 22, 2010. However, in accordance with 37 CFR 1.705(d), a proper request for reconsideration of patent term adjustment must be timely submitted within two months of the date of issuance of the patent. As the instant request for reconsideration of patent term adjustment was submitted more than two months after the date of issuance of the patent, the request is deemed untimely submitted within the meaning of 37 CFR 1.705(d).

Accordingly, the application for patent term adjustment ("PTA") under 37 CFR 1.705(d) is DISMISSED AS UNTIMELY.

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

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VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Henrik Ryegard | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7630775 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/517,145 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/07/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **645** 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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09 JUL 2009

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Kevin Bastian
TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834

| | | |
|---|---|---|
| In re Application of: | : | |
| NAKAMURA et al. | : | |
| US Application No.: 10/517,151 | : | |
| PCT Application No.: PCT/JP2003/007070 | : | |
| Int. Filing Date: 04 June 2003 | : | DECISION |
| Atty Docket No.: 082379-000400US | : | |
| For: GENES AND POLYPEPTIDES RELATING TO HEPATOCELLULAR OR COLORECTAL CARCINOMA | : | |

This is in response to applicants' "REQUEST FOR CORRECTED FILING RECEIPT" filed on 22 May 2008, which is being treated as a petition under 37 CFR 1.181. No petition fee is required.

## BACKGROUND

On 04 June 2003, applicants filed international application PCT/JP2003/007070. On 06 December 2004, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, inter alia, the basic national fee required by 35 U.S.C. 371 (C)(1).

On 21 June 2005, the DO/EO/US mailed a Notification of Missing Requirement Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US), which required an executed declaration.

On 18 August 2005, applicant submitted an executed oath and the surcharge fee of $130.

On 03 October 2005, the DO/EO/US mailed a Notice of Acceptance of Application under 35 USC 371 and 37 CFR 1.495 (PCT/DO/EO/903). The Date of Receipt of 371(c)(1),(c)(2) and (c)(4) requirement is listed as 18 July 2005.

On 22 May 2008, applicant filed the present request to correct the 371(c) date.

## DISCUSSION

A review of the application file reveals that the applicant submitted the declaration on 18 August 2005. As such, the Notice of Acceptance mailed on 03 October 2005 was defective, and it is hereby VACATED.

## CONCLUSION

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

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including a corrected Notice of Acceptance and a corrected filing receipt. The correct 35 U.S.C. 371 (c)(1),(c)(2) and (c)(4) date is 18 August 2005.

Shian Luong
PCT Special Programs Examiner
Office of PCT Legal Administration
Telephone: (571) 272-4557
Fax: (571) 273-0459

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

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**Ericsson, Inc.**
**6300 Legacy Drive**
**M/S EVR 1-C-11**
**Plano, TX 75024**

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OFFICE OF PETITIONS

In re Application of :
Johannes Wilhelmus Theodorus Eikenbroek :
Application No. 10/517,181 : DECISION ON PETITION
Filed: December 7, 2004 :
Attorney Docket No. P15069-US1 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 28, 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 February 13, 2008, as required by the Notice of Allowance and Fee(s) Due, mailed November 13, 2007. Accordingly, the date of abandonment of this application is February 14, 2008. A Notice of Abandonment was mailed on March 12, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $1440 and the publication fee of $300, (2) the petition fee of $1540, and (3) a proper statement of unintentional delay. Accordingly, the issue and publication fees are accepted as being unintentionally delayed.

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

This application is being referred to the Office of Data Management for further processing into a patent.

Andrea Smith
Petitions Examiner
Office of Petitions

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United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/517,183 | 07/25/2005 | Tateo Uegaki | 045616/285784 | 4362 |

7590 03/16/2009

ALSTON & BIRD LLP
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101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

| EXAMINER | |
|---|---|
| ABDELSALAM, FATHI K | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3689 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/16/2009 | PAPER |

## DECISION DISMISSING PETITION UNDER 37 CFR 1.138(d)

*The declaration of express abandonment will not be recognized*

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

The petition is dismissed.

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

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

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

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

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

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

Betty Powell

Patent Publication Branch
Office of Data Management

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

MAILED

AUG 3 1 2009

OFFICE OF PETITIONS

In re Application of :
Mogensen et al. :
Application No. 10/517,194 : LETTER REGARDING
Filed: December 6, 2004 : PATENT TERM ADJUSTMENT
Attorney Docket No. 12706-7 :

This letter is in response to the "Request for Review of Patent Term Adjustment" filed April 24, 2009. Pursuant to applicants' duty of good faith and candor to the Office, applicants request the determination of patent term adjustment under 35 U.S.C. 154(b) be reviewed for accuracy.

The request for review of the 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 800 days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On February 6, 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 the patent term adjustment to date is 828 days.

Applicants do not state a basis for their disclosure that the Patent Term Adjustment on the Notice of Allowance may be incorrect. However, a review of the record indicates the Office erroneously calculated the patent term adjustment.

The Office mailed a non-final Office action on May 16, 2008. Applicants filed an "Amendment" on August 18, 2008. Applicants filed a "Supplemental Amendment" on September 15, 2008. The Office did not enter a reduction of patent term adjustment for the September 15, 2008 Supplemental Amendment when calculating the patent term adjustment that appeared on the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) mailed with the Notice of Allowance.

Per 37 CFR 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

> Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which

case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

Pursuant to 37 CFR 1.704(c)(8), the Office should have entered a reduction of 28 days for the September 15, 2008 Supplemental Amendment when calculating the patent term adjustment mailed with the Notice of Allowance.

In view of the previous discussion, the Office has entered a reduction of 28 days in patent term adjustment for applicant delay due to the filing of the September 15, 2008 Supplemental Amendment.

As a result or the 28-day reduction, the patent term adjustment at the time of mailing of the notice of allowance is 800 days which is 830 days of Office delay reduced by 30 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).

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM screen

Day : Friday
Date: 8/28/2009

# PALM INTRANET

Time: 11:29:17

| PTA Calculations for Application: 10/517194 | | | |
|---|---|---|---|
| Application Filing Date: | 12/06/2004 | PTO Delay (PTO): | 830 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 2 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 800 |
| PTO Delay Adjustment: | -28 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 40 | 08/28/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 28 | |
| 32 | 02/06/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 31 | 02/03/2009 | ISSUE REVISION COMPLETED | | | |
| 30 | 02/03/2009 | DOCUMENT VERIFICATION | | | |
| 29 | 02/03/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 28 | 02/02/2009 | NOTICE OF ALLOWABILITY | | | |
| 25 | 01/23/2009 | DATE FORWARDED TO EXAMINER | | | |
| 24 | 01/09/2009 | AMENDMENT AFTER FINAL REJECTION | | | |
| 23 | 11/13/2008 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 22 | 11/10/2008 | FINAL REJECTION | | | |
| 21 | 09/08/2008 | DATE FORWARDED TO EXAMINER | | | |
| 20 | 08/18/2008 | RESPONSE AFTER NON-FINAL ACTION | | 2 | 19 |
| 19 | 05/16/2008 | MAIL NON-FINAL REJECTION | 830 | | -1 |
| 18 | 05/12/2008 | NON-FINAL REJECTION | | | |
| 17 | 03/24/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 16 | 07/13/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 15 | 04/17/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 14 | 04/17/2006 | REFERENCE CAPTURE ON IDS | | | |
| 13.7 | 04/17/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 13 | 04/17/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 12 | 03/24/2006 | REFERENCE CAPTURE ON IDS | | | |
| | | INFORMATION DISCLOSURE STATEMENT (IDS) | | | |

| | | | | | |
|---|---|---|---|---|---|
| 11.7 | 03/24/2006 | FILED | | | |
| 11 | 03/24/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 10 | 08/11/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 9 | 08/11/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 8 | 12/06/2004 | PRELIMINARY AMENDMENT | | | |
| 7 | 07/13/2005 | REFERENCE CAPTURE ON IDS | | | |
| 6.7 | 07/13/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 6 | 07/13/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 5 | 07/12/2005 | CLEARED BY OIPE CSR | | | |
| 4 | 12/06/2004 | 371 COMPLETION DATE | | | |
| 3 | 07/06/2005 | APPLICATION DISPATCHED FROM OIPE | | | |
| 2 | 07/06/2005 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 1 | 12/06/2004 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to OASIS | Home page

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MAY 24 2007

MODIANO & ASSOCIATI
VIA MERAVIGLI 16
MILANO 20123 IT
ITALY

| | |
|---|---|
| In re Application of | : |
| Michele Muccini et al | : |
| Serial No.: 10/517,203 | : PETITION DECISION |
| Filed: December 8, 2004 | : |
| Attorney Docket No.: 39714/GM/1P | : |

This is a decision on the PETITION FOR ACCEPTANCE OF COLOR DRAWINGS UNDER 37 CFR 1.84(a)(2). The petition was filed April 13, 2007. Entry of color drawings requires: 1) three sets of the color drawings, 2) a proper amendment to the specification indicating color photographs or drawings are present in the file, and 3) the required fee under 37 CFR 1.17(h).

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

The petition is **GRANTED**.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile transmission at 571-273-8300.

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

Back To Home Page

PATENT APPLICATION

10517203

PATENT APPLICATION

United States Patent and Trademark Office

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#6

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

| | | |
|---|---|---|
| In re Application of | : | |
| Fisher | : | |
| Application No.: 10/517,216 | : | DECISION |
| PCT No.: PCT/GB03/02266 | : | |
| Int. Filing Date: 23 May 2003 | : | ON |
| Priority Date: 23 May 2002 | : | |
| Attorney Docket No.: 02292/0202193-US0 | : | PETITION |
| For: Nuclear Transfer | : | |

The petition to revive under 37 CFR 1.137(b) filed 03 December 2004 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 required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." This statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that the basic national fee of $950.00 was provided. The required petition fee of $1370.00 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. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **22 March 2005**.

Boris Milef
PCT Legal Examiner
PCT Legal Office

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

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MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

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NOV 29 2006
OFFICE OF PETITIONS

In re Application of
Luppo Edens, et al.
Application No. 10/517,220
Filed: May 14, 2003
Attorney Docket No. 246152024400

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 30, 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).

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

April M. Wise
Petitions Examiner
Office of Petitions

cc: Luppo Edens
Hoflaan 118
3062 JL Rotterdam
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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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/517,220 | 12/07/2004 | Luppo Edens | 246152024400 |

**CONFIRMATION NO. 2616**

*OC000000021322701*

*OC000000021322701*

25225
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date Mailed: 11/22/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/30/2006.

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

---

April M Wise

APRIL M WISE
OP (571) 272-1642

FORMER ATTORNEY/AGENT COPY

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7 FEB 2006

35876
ROGALSKYJ & WEYLAND, LLP
P.O. Box 44
Livonia, NY 14487-0044

| | | |
|---|---|---|
| In re Application of | : | |
| ALESSI, Dario *et al* | : | |
| U.S. Application No.: 10/517,225 | : | **DECISION ON** |
| PCT No.: PCT/GB03/02509 | : | **PETITION** |
| Int. Filing Date: 09 June 2003 | : | **UNDER 37 CFR 1.182** |
| Priority Date: 08 June 2002 | : | |
| Attorney's Docket No.: 002.00250 | : | |
| For: METHODS | : | |

This decision is in response to applicants' "Petition Under 37 CFR 1.182" ("Pet.") filed via facsimile on 29 December 2005.

## BACKGROUND

On 08 December 2004, applicants filed for entry into the national stage in the United States under 35 U.S.C. 371. Applicants listed the international application number as PCT/US03/02509 on the transmittal letter (Form PTO-1390). The customer number was recorded as 35876.

On 04 April 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 must be provided.

On 09 June 2005, applicants filed a "Response to Notification of Missing Requirements" which was accompanied by, *inter alia*, a declaration executed by four joint inventors. The declaration listed the international application as PCT/GB03/02509. The customer number was recorded on the declaration as 35878.

On 29 June 2005, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) to customer number 35878. The Form PCT/DO/EO/903 indicated that the 35 U.S.C. 371 requirements were satisfied for the national stage of PCT/US03/02509 on 09 June 2005.

On 29 December 2005, applicants filed the subject petition to correct the international application number along with a change of correspondence address listing the customer number as 35876.

## DISCUSSION

The declaration submitted on 09 June 2005 was not a declaration for PCT/US03/02509. Accordingly, the Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) and filing receipt mailed 29 June 2005 are **VACATED**.

Petitioners claim that on the transmittal letter filed upon entry of the national stage the international application number was "incorrectly identified." The transmittal letter (Form PTO-1390) filed 08 December 2004 indicated that the papers were for the national stage of PCT/US03/02509. Petitioners request that the above-captioned application be identified as the national stage of PCT/GB03/02509. The $400.00 petition fee has been charged to Deposit Account No. 50-0772 as authorized.

A review of the national stage papers reveals that the inventor names and priority date claimed on the Form PTO-1390 filed 08 December 2004 correspond to PCT/GB03/02509, not PCT/US03/02509. Moreover, the Preliminary Amendment filed 08 December 2004 notes that the application is a national stage of PCT/GB03/02509. The International Search Report submitted also refers to PCT/GB03/02509.

Thus, it is clear that a typographical error was made on the transmittal letter. The correct international application number is PCT/GB03/02509.

## CONCLUSION

For the reasons listed above, applicants' petition under 37 CFR 1.182 is **GRANTED**.

The customer number is changed back to 35876.

This application is being forwarded to the DO/EO/US to process the above-captioned application as the national stage of PCTGB03/02509.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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**OFFICE OF PETITIONS**

CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
540 WHITE PLAINS RD
P O BOX 2005
TARRYTOWN NY 10591-9005

In re Application of :
Gruner, et al. :
Application No. 10/517,234 : ON PETITION
Filed: March 20, 2007 :
Attorney Docket No. 4-22696/A/PCT :

This is a decision on the petition to revive under 37 CFR 1.137(b), filed March 20, 2007.

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

The above-identified application became abandoned for failure to timely file a response to the non-final Office action mailed September 19, 2006, which set a period for reply of three (3) months. No extensions of time under 37 CFR 1.136(a) were purchased. Accordingly, no reply having received, the application became abandoned on December 20, 2006. The mailing of this decision precedes the mailing of a Notice of Abandonment.

With the instant petition, petitioner paid the required petition fee, made the proper statement of unintentional delay, and submitted the required reply in the form of an Amendment.

Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the $1020 extension of time fee submitted with the petition on March 20, 2007 was subsequent to the maximum period obtainable for reply (March 19, 2007), this fee will be refunded to petitioner under separate cover.

The matter is being forwarded to Group Art Unit 1751 for consideration of the Amendment filed March 20, 2007.

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

Cliff Congo
Petitions Attorney
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 07/10/08

**TO SPE OF** : ART UNIT 1633

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/517,251 Patent No.: 7,351,875

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

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

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

Please review COCIN dated 05/15/08 Spec and claims

**Delora Dillard**
**Certificates of Correction Branch**
**703-308-9250 ext. 172**

**Thank You For Your Assistance**

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

Note your decision on the appropriate box.

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

**Comments:** Requested changes consistent with Allowance.

Joe Woitach — SPE

1633 — Art Unit

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 07/10/08

**TO SPE OF** : ART UNIT 1633

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/517,251 Patent No.: 7,351,875

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

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

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

Please review COCIN dated 05/15/08 Spec and claims

**Delora Dillard**
**Certificates of Correction Branch**
**703-308-9250 ext. 172**

**Thank You For Your Assistance**

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

Note your decision on the appropriate box.

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

**Comments:** Requested changes consistent with Allowance.

/Joe Woitach/ — **SPE**

1633 — **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Dr. Paul J. Vincent
DREISS, FUHLENDORF, STEIMLE & BECKER
Postfach 10 37 62
D-70032 Stuttgart
GERMANY

| | | |
|---|---|---|
| In re Application of: | : | |
| KLEIN, Gerhard | : | DECISION |
| U.S. Application No.: 10/517,276 | : | |
| PCT No.: PCT/EP03/00379 | : | |
| International Filing Date: 16 January 2003 | : | |
| Priority Date: 10 June 2002 | : | |
| Attorney's Docket No.: 2213 0084US | : | |
| For: MACHINE FOR SUPERFINISHING BY HONING | : | |

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

## BACKGROUND

On 16 January 2003, applicant filed international application PCT/EP03/00379, which claimed a priority date of 10 June 2002 and which designated the United States. On 18 December 2003, a copy of the international application was communicated to the USPTO by the International Bureau (IB). Payment of the basic national fee in the United States was due within thirty months of the priority date, i.e. 10 December 2004.

On 09 December 2004, applicant filed a "Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371" (Form PTO-1390) with respect to international application PCT/EP03/00379. This submission included, among other materials, the authorization to charge Deposit Account No. 50-1030 for required fees, including the basic national fee. The submission was assigned application number 10/517,276, and Deposit Account No. 50-1030 was charged $1,000 in fees.

On 10 December 2004, applicant filed a second "Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371" (Form PTO-1390) with respect to the same international application, PCT/EP03/00379. This submission was assigned application number 10/517,379, and Deposit Account No 50-1030 was again charged $1,000 in fees.

On 31 January 2005, applicant filed a "Request For Withdrawal Of Application And Refund Of Fees." This request seeks withdrawal of the duplicate national stage application filed 10 December 2004 (10/517,379) and the refund of fees charged therein.

## DISCUSSION

As is evident from the above recited facts, two sets of papers to enter the national stage under 35 U.S.C. 371 have been submitted for international application number PCT/EP03/00379 (U.S. application numbers 10/517,276 and 10/517,379). The end result for an international application designating the United States of America is a single U.S. national stage application. Therefore, the submission of two sets of national stage papers to enter the United States was improper. The documents filed on 09 December 2004 in application number 10/517,276, the first papers submitted by counsel as the national stage of PCT/EP03/00379, will continue to be processed. The second set of materials, filed on 10 December 2004 and assigned application number 10/517,379, which represent an improper duplicate national stage application, have been placed in application file 10/517,276. The duplicate fees charged in application number 10/517,379 have been refunded to Deposit Account 50-1030, and application number 10/517,379 has been discontinued.

Based on the above, the "Request For Withdrawal Of Application And Refund Of Fees" filed 31 January 2005 is moot.

## CONCLUSION

The papers filed on 10 December 2004 and assigned application number 10/517,379 have been placed in the file of application number 10/517,276. Application 10/517,379 will be discontinued.

Application 10/517,276 will continue to be processed as the national stage of PCT/EP03/00379.

Deposit Account No. 50-1030 has been refunded the duplicative $1000 in fees charged under application number 10/517,379.

The present application (10/517,276) is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accord with this decision, including the mailing of a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) requiring submission of an executed declaration in compliance with 37 CFR 1.497 and the surcharge for filing this declaration later than thiry months after the priority date.

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

28 OCT 2005
UNITED STATES PATENT AND TRADEMARK OFFICE

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625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA, VA 22314

In re Application of DE SMET et al :
U.S. Application No.: 10/517,308 :
PCT Application No.: PCT/BE03/00108 :
Int. Filing Date: 24 June 2003 : DECISION
Priority Date Claimed: 24 June 2002 :
Attorney Docket No.: DESM3003/JEK :
For: REFRESH PIXEL CIRCUIT FOR ACTIVE MATRIX :

This is in response to applicant's "Non-Fee Petition Under 37 C.F.R. 1.181" filed 21 October 2005.

## BACKGROUND

On 24 June 2003, applicant filed international application PCT/BE03/00108, which claimed priority of an earlier United Kingdom application filed 24 June 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 31 December 2003. The thirty-month period for paying the basic national fee in the United States expired on 24 December 2004.

On 17 December 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 14 September 2005, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

On 21 October 2005, applicant filed the present petition under 37 CFR 1.181.

## DISCUSSION

The petition states that the Notification of Acceptance of Application was prematurely mailed since applicant had not yet filed a declaration. A review of the application file reveals that a declaration under PCT Rule 4.17(iv) is present. Therefore, the requirements under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) were met on 17 December 2004. Therefore, correction of the Notification of Acceptance is not indicated at the present time.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 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 1.181".

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

Bryan Tung
PCT Legal Examiner
Office of PCT Legal Administration

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

23 MAY 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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James E. Armstrong, IV
ARMSTRONG, KRATZ, QUINTOS,
HANSON & BROOKS, LLP
Suite 1000
1725 K Street, N.W.
Washington, D.C. 20006

| | | |
|---|---|---|
| In re Application of | : | |
| LIANG, ZICAI | : | |
| Application No.: 10/517,324 | : | DECISION ON PETITION |
| PCT No.: PCT/SE03/01077 | : | |
| Int. Filing Date: 23 June 2003 | : | UNDER 37 CFR 1.181 |
| Priority Date: 21 June 2002 | : | |
| Attorney Docket No.: 040679 | : | |
| For: OCULAR GENE THERAPY | : | |

This decision is in response to applicant's "SECOND REQUEST FOR STATUS" filed 22 March 2007, which has been treated as a petition under 37 CFR 1.181. No petition fee is required.

## BACKGROUND

On 23 June 2003, applicant filed international application PCT/SE03/01077, which claimed priority of an earlier application filed 21 June 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 31 December 2003. Pursuant to 37 CFR 1.485, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 21 December 2004.

On 20 December 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), a copy of the international application as required by 35 U.S.C. 371(c)(2), and an oath or declaration as required by 35 U.S.C. 371(c)(4).

On 26 July 2005, applicant was mailed a NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE AND/OR AMINO ACID SEQUENCE DISCLOSURE UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant that the paper or compact disc copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).

listing", as well as an amendment specifically directing its entry into the application or a substitute computer readable form copy of the sequence listing. Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 26 September 2005, applicant submitted a sequence listing for the application in paper copy form and in a computer readable form. A statement was also made indicating that the content of the sequence listing information recorded in computer readable form is identical to the written sequence listing.

On 12 April 2006, applicant was mailed a NOTIFICATION OF DEFECTIVE RESPONSE UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) again informing applicant of the need to provide a substitute paper or compact disc copy of the "sequence listing", as well as an amendment specifically directing its entry into the application or a substitute computer readable form copy of the sequence listing. In addition, applicant was advised of the need to furnish a statement that the content of the sequence listing information recorded in computer readable form is identical to the written sequence listing. Applicant was given one month to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 12 May 2006, applicant submitted a purported corrected sequence listing in paper and in CRF. A statement was made indicating that the paper copy and the computer readable form sequence listing are the same.

On 30 June 2006, applicant submitted a supplemental sequence listing to replace the sequence listing submitted on 12 May 2006.

On 06 July 2006, the Scientific and Technical Information Center (STIC) Biotechnology Branch issued an error report indicating that the sequence listing does not conform to the requirement.

On 04 April 2007, applicant submitted a request for status. Applicant indicated that the transaction history page in the PAIR system erroneously indicates the abandonment of the subject application and requested the file be reviewed and the status of the application be corrected.

## DISCUSSION

37 CFR 1.821(g) refers to nucleotide and/or amino acid sequence disclosures in patent applications. It requires compliance with the requirements of 37 CFR 1.821(b) through (f). If they are not satisfied at the time of filing under 35 U.S.C. 111(a) or at the time of entering the national stage of an international application under 35 U.S.C. 371, applicant will be notified and given a period of time to comply with such requirements in order to prevent abandonment of the application. When an action by the applicant is a *bona fide* attempt to comply with these rules and it is apparent that compliance with some requirement has inadvertently been omitted, the applicant may be given a new time period to correct the omission.

Application No.: 10/517,324

Applicant was given a NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE AND/OR AMINO ACID SEQUENCE DISCLOSURE UNDER 35 U.S.C. 371 on 26 July 2005. The response submitted on 26 September 2005 was defective. The Office proceeded to send out a NOTIFICATION OF DEFECTIVE RESPONSE on 12 April 2006. Applicant's responses to the notification were once again defective as set out in the sequence listing error report. Since the sequence listing did not comply with 37 CFR 1.821(b)-(f) after the notifications, the failure to comply resulted in the abandonment of the application.

## CONCLUSION

For the reasons detailed above, applicant's petition under 37 CFR 1.181 is **DISMISSED**.

This application remains **ABANDONED**.

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 1.181." 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.

Leonard Smith
Supervisory Legal Examiner
Office of PCT Legal Administration

Shian Luong
Special Programs Examiner
Office of PCT Legal Administration
Tel: (571) 272-4557
Fax: (571) 273-0459

DATE 28 SEP 2007 APPLICATION NUMBER 10/517,324

DOC CODE AETOEC.OSV DOC DATE 28 SEP 2007

# DELIVER THE ATTACHED FIFLE/DOCUMENT TO THE TC SCANNING CENTER

CONTRACTOR: THE ATTACHED FILE/DOCUMENT MUST BE INDEXED AND SCANNED INTO IFW WITHIN **8** WORK HOURS; UPLOADING OF THE SCANNED IMAGES SHOULD OCCUR NO LATER THAN **16** WORK HOURS FOLLOWING RECEIPT OF THIS REQUEST

AFTER SCANNING, ORIGINAL DOCUMENTS SHOULD BE BOXED IN ACCORDANCE WITH INSTRUCTIONS

2 8 SEP 2007

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Donald W. Hanson
KRATZ, QUINTOS &
HANSON, LLP
Suite 400
1420 K Street, N.W.
Washington, D.C. 20005

| | | |
|---|---|---|
| In re Application of | : | |
| LIANG, ZICAI, et al | : | |
| Application No.: 10/517,324 | : | DECISION ON RENEWED |
| PCT No.: PCT/SE03/01077 | : | |
| Int. Filing Date: 23 June 2003 | : | PETITION |
| Priority Date: 21 June 2002 | : | |
| Attorney Docket No.: 040679 | : | UNDER 37 CFR 1.181 |
| For: RANDOMISED DNA LIBRARIES AND | : | |
| DOUBLE SIDED-STRANDED RNA LIBRARIES, | : | |
| USE AND METHOD OF PRODUCTION | : | |
| THEREOF | : | |

This decision is in response to applicant's "RENEWED PETITION UNDER 37 C.F.R. 1.181" filed 23 July 2007 to withdraw the holding of the abandonment of the application.

## BACKGROUND

On 23 May 2007, applicants were mailed a decision dismissing applicants' petition under 37 CFR 1.181. Applicants were afforded two months to file any request for reconsideration and advised that this time period could be extended pursuant to 37 CFR 1.136(a).

On 23 July 2007, applicants filed the present renewed petition for reconsideration of the dismissal of applicants' petition.

## DISCUSSION

As detailed in the decision mailed on 23 May 2007, 37 CFR 1.821(g) refers to nucleotide and/or amino acid sequence disclosures in patent applications. It requires compliance with the requirements of 37 CFR 1.821(b) through (f). If they are not satisfied at the time of filing under 35 U.S.C. 111(a) or at the time of entering the national

stage of an international application under 35 U.S.C. 371, applicant will be notified and given a period of time to comply with such requirements in order to prevent abandonment of the application. When an action by the applicant is a *bona fide* attempt to comply with these rules and it is apparent that compliance with some requirement has inadvertently been omitted, the applicant may be given a new time period to correct the omission.

Applicants argue that they were never advised whether the sequence listings filed on 12 May 2006 and 30 June 2006 failed to conform to regulations prior to abandonment.

Applicants submitted four sequence listings throughout the history of this application. A third sequence listing was filed on 12 May 2006 and then a supplemental sequence listing on 30 June 2007 replacing the previous filed sequence listing. On 06 July 2006, the Scientific and Technical Information Center (STIC) Biotechnology Branch issued an error report indicating that the sequence listing did not conform to the requirement. The error report was based on the 30 June 2007 filing. However, the 30 June 2007 sequence listing was not an effective response since it was filed beyond the one-month reply period as set forth in the NOTIFICATION OF DEFECTIVE RESPONSE (PCT/DO/EO/916) mailed 12 April 2006 in response to the second submission of sequence listing. No extension of time remained from the NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE AND/OR AMINO ACID SEQUENCE DISCLOSURES (PCT/DO/EO/922) mailed 26 July 2005 with regard to the first filed sequence listing. The sequence listing filed on 12 May 2006 was also processed, but did not fulfill the requirement as set forth in 37 CFR 1.821(g). Courtesy copies of the error reports are hereby attached.

With regard to non-receipt of the error report, once a PCT/DO/EO/916 is mailed and applicants failed to meet the requirement with the filing of the new sequence listing, applicants are not afforded another opportunity to correct any defects remaining on the sequence listing due to the fact that the period for response to the 916 is non-extendable. A notice of abandonment was properly mailed on 24 May 2007 as a result of applicants' failure to comply with the requirements of the application.

In summary, applicants failed to initially file an acceptable sequence listing, the time period set in the original request for an acceptable sequence listing has expired as also has the additional one month grace period set in the PCT/DO/EO/916, and to date applicants still have not submitted an acceptable sequence listing. In view of the fact that all time periods have expired, the case is properly held to be abandoned.

## CONCLUSION

For the reasons detailed above, applicants' petition under 37 CFR 1.181 is **DISMISSED**.

This application remains **ABANDONED**.

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 1.181." Any further extensions of time available may be obtained under 37 CFR 1.136(a).

In the alternative, applicants are strongly urged to consider filing a petition to revive the application under 37 CFR 1.137.

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.

Richared Cole
Legal Examiner
Office of PCT Legal Administration

Shian Luong
Special Programs Examiner
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UNITED STATES PATENT AND TRADEMARK OFFICE

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19 MAR 2008

Donald W. Hanson
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HANSON, LLP
Suite 400
1420 K Street, N.W.
Washington, D.C. 20006

In re Application of :
LIANG, ZICAI, et al :
Application No.: 10/517,324 :
PCT No.: PCT/SE03/01077 :
Int. Filing Date: 23 June 2003 : PETITION
Priority Date: 21 June 2002 :
Attorney Docket No.: 040679 : UNDER 37 CFR 1.137(b)
For: RANDOMISED DNA LIBRARIES AND :
DOUBLE SIDED-STRANDED RNA LIBRARIES, :
USE AND METHOD OF PRODUCTION :
THEREOF :

This decision is in response to applicant's "PETITION TO REVIVE UNDER 37 C.F.R. 137(b)" filed in the United States Patent and Trademark Office (USPTO) on 08 January 2008.

## BACKGROUND

On 23 May 2007, applicants were mailed a decision dismissing applicants' petition under 37 CFR 1.181. Applicants were afforded two months to file any request for reconsideration and advised that this time period could be extended pursuant to 37 CFR 1.136(a).

On 23 July 2007, applicants filed the renewed petition for reconsideration of the dismissal of applicants' petition. The petition was again dismissed.

On 28 December 2007, applicants filed the present petition under 37 CFR 137(b) to revive the application.

## DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required).

Regarding item (1), applicant has provided the required reply. The CRF of the sequence listing filed with the petition complied with the statutory requirement.

Regarding item (2), the $1540 petition fee has been charged to Deposit Account No. 01-2340 as authorized by applicant.

Regarding item (3), applicant's statement that "The delay from the deadline for entry into the U.S. national stage to the date of the present petition was unintentional" and the prompt filing of the petition satisfies the requirement.

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

## CONCLUSION

For the reasons detailed above, applicants' petition under 37 CFR 1.137(b) is **GRANTED**.

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision. The application has a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 20 December 2004.

Richared Cole
Legal Examiner
Office of PCT Legal Administration

Shian Luong
Special Programs Examiner
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JUN 06 2007

OFFICE OF PETITIONS

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

In re Application of :
Roland Brandl :
Application No. 10/517,327 : ON PETITION
Filed: December 9, 2004 :
Attorney Docket No. AT02 0034 US :

This is a decision on the petition, filed February 13, 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 April 5, 2006. A Notice of Abandonment was mailed on November 3, 2006. In response, on February 13, 2007, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Mr. Kevin Fortin appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts.

The application is being referred to Technology Center AU 2836 for consideration of the amendment filed February 13, 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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SEP 18 2007

OFFICE OF PETITIONS

Patterson, Thuente, Skaar & Christensen, P.A.
4800 IDS Center
80 South 8th Street
Minneapolis, Minnesota 55402-2100

In re Application of :
Darke :
Application No. 10/517,329 : Letter Regarding PTA
Filed: December 9, 2004 :
Attorney Docket No. 2733.18US01 :

This is in response to the "PATENT TERM ADJUSTMENT LETTER OF CANDOR AND GOOD FAITH," filed June 11,2007. Applicants disclose that the correct date of entry into the national stage was December 11, 2004 not December 9, 2004. Accordingly, applicants assert that the correct PTA must be two less days.

The request for correction of the patent term adjustment (PTA) is **GRANTED.** The Office will *sua sponte* adjust the PTA determination at the time of the notice of allowance to reflect an actual determination of one hundred days not 102 days.

Patentees are given **thirty (30) days** from the mail date of this decision to respond if they disagree with the decision. No extensions of time will be granted under § 1.136.

Applicants assert that the Office may have erred in granting too much because the applicant entered the national stage on the 30 months from the earliest claim priority. Applicants believe that the amount of PTA awarded under 37 CFR 1.702(a)(1) is not accurate.

Applicants arguments are persuasive. A review of the file reflects that the national stage requirements were fulfilled on December 11, 2004. See Notice of Acceptance of Application under 37 CFR 371 and 37 CFR 1.495. Accordingly, the Office should have granted 131 days for the failure to meet the requirements of 37 CFR 1.702(a)(1).[1] It is further noted that applicants delayed under 37 CFR 1.704(b) by a period of 31 days for the submission of the response to non-final action received by the Office on October 23, 2006.[2] Accordingly, the correct amount of PTA at the time of the mailing of the notice of allowance is **100** (131-31=100) days.

As this letter was submitted as an advisement to the Office of an error in Applicants' favor, the Office will not assess the $200.00 application fee under 37 CFR 1.705(b). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

---

[1]The delay began on February 12, 2006 and ended on June 22, 2006.

[2]The delay began on September 22, 2006 and ended on October 23, 2006, a 31 day delay.

After mailing of this letter, the Office will forward this application to the Office of Patent publication for a prompt issuance of the patent.

Telephone inquiries specific to this matter should be directed to Kery A. Fries, Senior Legal Advisor, at (571) 272-7757

Kery Fries

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

cc: Exhibit A-Notice of Acceptance of Application under 37 CFR 371 and 37 CFR 1.495
Adjusted Pair Calculation

Exh. b. + A

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| U.S. APPLICATION NUMBER NO. | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
|---|---|---|
| 10/517,329 | Jason William Darke | 2733.18US01 |

| INTERNATIONAL APPLICATION NO. | |
|---|---|
| PCT/GB03/02506 | |
| I.A. FILING DATE | PRIORITY DATE |
| 06/10/2003 | 06/11/2002 |

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

**CONFIRMATION NO. 2913**

**371 ACCEPTANCE LETTER**

*OC000000016547119*

Date Mailed: 07/19/2005

## 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:

| 12/09/2004 | 12/11/2004 |
|---|---|
| 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 12/09/2004
- Copy of the International Search Report filed on 12/09/2004
- Copy of IPE Report filed on 12/09/2004
- Preliminary Amendments filed on 12/09/2004
- Information Disclosure Statements filed on 12/09/2004
- Oath or Declaration filed on 12/09/2004
- U.S. Basic National Fees filed on 12/09/2004
- Priority Documents filed on 12/09/2004
- Specification filed on 12/09/2004
- Claims filed on 12/09/2004
- Drawings filed on 12/09/2004

Day : Saturday
Date: 9/15/2007

PALM INTRANET

Time: 09:38:27

| PTA Calculations for Application: 10/517329 | | | |
|---|---|---|---|
| Application Filing Date: | 12/09/2004 | PTO Delay (PTO): | 133 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 31 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 100 |
| PTO Delay Adjustment: | -2 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 46 | 09/15/2007 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 2 | |
| 33 | 03/15/2007 | MAIL NOTICE OF ALLOWANCE | | | |
| 32 | 03/13/2007 | ISSUE REVISION COMPLETED | | | |
| 31 | 03/13/2007 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 30 | 03/13/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 29 | 03/06/2007 | NOTICE OF ALLOWABILITY | | | |
| 28 | 02/28/2007 | DATE FORWARDED TO EXAMINER | | | |
| 27 | 02/21/2007 | AMENDMENT AFTER FINAL REJECTION | | | |
| 26 | 02/28/2007 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |
| 25 | 02/20/2007 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 24 | 12/21/2006 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 23 | 12/19/2006 | FINAL REJECTION | | | |
| 22 | 10/23/2006 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 21 | 11/13/2006 | DATE FORWARDED TO EXAMINER | | | |
| 20 | 10/23/2006 | RESPONSE AFTER NON-FINAL ACTION | | 31 | 16 |
| 19 | 10/23/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 18 | 10/27/2006 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |
| 17 | 10/18/2006 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 16 | 06/22/2006 | MAIL NON-FINAL REJECTION | 133 | | -1 |
| 15 | 06/21/2006 | NON-FINAL REJECTION | | | |
| 14 | 12/09/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 13 | 11/04/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 12 | 12/09/2004 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | | |
| 11 | 12/09/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 10 | 12/09/2004 | REFERENCE CAPTURE ON IDS | | | |
| 9 | 12/09/2004 | PRELIMINARY AMENDMENT | | | |
| 8 | 11/04/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 7 | 07/29/2005 | TRANSFER INQUIRY TO GAU | | | |
| 6 | 07/26/2005 | CLEARED BY OIPE CSR | | | |
| 5 | 12/11/2004 | 371 COMPLETION DATE | | | |
| 4 | 07/19/2005 | APPLICATION DISPATCHED FROM OIPE | | | |
| 3 | 07/19/2005 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 2 | 07/18/2005 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 1 | 12/09/2004 | INITIAL EXAM TEAM NN | | | |

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**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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28 JUN 2006

#5

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Carter J. White
Legal Department
5950 North Course Drive
Houston, Texas 77072

In re Application of
CARRIER, et al.
Serial No.: 10/517,332
PCT No.: PCT/GB04/02863
Int. Filing Date: 22 July 2004
Priority Date: 12 August 2003
Atty Docket No.: PA-00422US1
For: ELECTRICAL TREATMENT FOR OIL BASED DRILLING OR COMPLETION FLUIDS

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This decision is issued in response to applicant's "Petition under Rule 37 CFR 1.47(a) for Acceptance of Application Where Joint Inventor Cannot Be Located to Join in Application for Patent" filed 12 April 2006 to accept the application without the signature of joint inventor, Michelle Bridget Carrier.

## BACKGROUND

On 22 July 2004, applicant filed international application PCT/GB04/02863 which claimed priority to a previous application filed 12 August 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, 12 February 2006.

On 09 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; a preliminary amendment; and an Information Disclosure Statement.

On 07 June 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.

On 12 April 2006, applicant filed the present petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor Michelle Bridget Carrier.

## 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), (3) and (4).

Applicant states in the present petition that Michelle Bridget Carrier is unavailable to execute the application, however, it appears by the evidence presented that Michelle Bridget Carrier has refused to execute 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.

Petitioner provided sufficient information that a bona fide attempt was made to present a copy of the application papers to the nonsigning inventor, however, the petition and accompanying papers does not provide first hand knowledge that the nonsigning inventor has refused to execute the declaration and application. The statements made with regards to the efforts to reach Michelle Bridget Carrier constitutes secondhand knowledge,

in that the actions to which petitioner is averring to were conducted by Leah S. Bardin. Lastly, did petitioner or Ms. Bardin receive confirmation via DHL delivery certificate that Michelle Bridget Carrier received the application papers?

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, and drawings) were sent to Michelle Bridget Carrier, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

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). 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.

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

25 MAY 2007

Carter J. White
Legal Department
5950 North Course Drive
Houston, Texas 77072

In re Application of :
CARRIER, et al. :
Serial No.: 10/517,332 : DECISION ON PETITION
PCT No.: PCT/GB04/02863 : UNDER 37 CFR 1.47(a)
Int. Filing Date: 02 July 2004 :
Priority Date: 12 August 2003 :
Atty Docket No.: PA-00422US1 :
For: ELECTRICAL TREATMENT FOR OIL BASED DRILLING OR COMPLETION FLUIDS :

This decision is in response to applicants' "Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)" and "Petition under Rule 37 CFR 1.47(a) for Acceptance of Application Where Joint Inventor Cannot Be Located to Join in Application for Patent" filed 15 May 2007.

## BACKGROUND

On 02 July 2004, applicant filed international application PCT/GB04/02863 which claimed priority to a previous application filed 12 August 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, 12 February 2006.

On 09 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; a preliminary amendment; and an Information Disclosure Statement.

On 07 June 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.

On 12 April 2006, applicant filed a petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor Michelle Bridget Carrier. In a decision dated 28 June 2006, applicant's petition under 1.47(a) was dismissed without prejudice.

On 10 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment indicating that the application was abandoned for failure to file a complete response to the Decision on Petition under 37 CFR 1.47(a) mailed 28 June 2006 within the time period set therein.

On 15 May 2007, applicant filed the present petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a).

## DISCUSSION

The above-identified application was abandoned for failure to respond to the Decision on Petition under 37 CFR 1.47(a) mailed 28 June 2006.

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional delay must be accompanied by: (1) the required reply, (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) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

In order to comply with the proper response requirement of item (1) above for revival under 37 CFR 1.137(b), applicants submitted the present Petition Under 37 CFR 1.47(a). Under the present circumstances, in order for the response requirement, item (1) above, to be satisfied, the petition to accept the application without the signature of joint-inventor Michelle Bridget Carrier must be grantable.

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.

A review of the papers filed 15 May 2007 reveals that petitioner has paid the requisite petition fee, provided sufficient proof that the non-signing inventor (Michelle Bridget Carrier) refused to sign, stated the last known address of the non-signing inventor (Michelle Bridget Carrier), and provided an acceptable declaration. Accordingly, all of the requirements of items (1), (2), (3), and (4) above have been satisfied..

Accordingly, it is appropriate to accord the national stage application status under 37 CFR 1.47(a).

As for the remaining elements of a grantable petition under 37 CFR 1.137(b), applicant has submitted the required petition fee, satisfying item (2), and the petition includes a statement that the "entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," satisfying item (3); item (4) does not apply to the present application.

Thus, applicant has satisfied all the requirements for a grantable petition for revival under 37 CFR 1.137(b).

## CONCLUSION

The renewed petition under 37 CFR 1.47(a) is **GRANTED**.

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

The application will be given an international filing date of 22 July 2004 under 35 U.S.C. 363, and a date of **12 April 2006** 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 nonsigning inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(c) 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
Tel: (571) 272-3298
Fax: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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**OLIFF & BERRIDGE, PLC**
**P.O. BOX 320850**
**ALEXANDRIA VA 22320-4850**

MAILED

JUL 29 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hitoshi Kobayashi | : | |
| Application No. 10/517,337 | : | DECISION GRANTING PETITION |
| Filed: January 25, 2005 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 12176 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed July 29, 2009, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on July 7, 2009 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries should be directed to Terri Williams at (571) 272-2991.

This application is being referred to Technology Center AU 2612 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

Terri Williams
Petitions Examiner
Office of Petitions

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

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Sven Ole Warnaar | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7632496 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/517,338 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/09/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **94** 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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**Townsend and Townsend and Crew, LLP**
**Two Embarcadero Center**
**Eighth Floor**
**San Francisco, CA 94111-3834**

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MAY 18 2007

OFFICE OF PETITIONS

In re Application of :
Paolo Botti et al. :
Application No. 10/517,392 : DECISION ON PETITION
Filed: November 24, 2004 : TO WITHDRAW
Attorney Docket No. 021724-000400US : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 15, 2006.

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

A review of the file record indicates that the power of attorney to Townsend and Townsend and Crew, LLP has been revoked by the assignee of the patent application on March 12, 2007. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Intellectual Property Department**
**Amylin Pharmaceuticals, Inc.**
**9360 Towne Centre Drive**
**San Diego CA 92121**

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Paper No.

Intellectual Property
Department
Amylin Pharmaceuticals, Inc.
9360 Towne Centre Drive
San Diego CA 92121

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APR 07 2009

OFFICE OF PETITIONS

In re Application of :
Botti et al. :
Application No. 10/517,392 : ON APPLICATION FOR
Filed: June 17, 2005 : PATENT TERM ADJUSTMENT
Atty Docket No. 0949US-UTL :

This is in response to the Application for Patent Term Adjustment filed December 19, 2008. Applicant requests that the patent term adjustment be increased from five hundred twenty-one (521) days to one thousand ninety-three (1093) days. Referring to Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008), applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent[1].

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

[1] This request is based on a date of commencement under 371 of December 10, 2004, and an assumed issue date of June 16, 2009.

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

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

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

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

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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**OFFICE OF PETITIONS**

In re Application of
Theodore F. Dimitroff
Application No. 10/517,396
Filed: November 28, 2004
Attorney Docket Number: HAMPAUS-0001

ON PETITION

This is a decision on the petition filed June 15, 2007, to withdraw the holding of abandonment, which is treated under 37 CFR 1.181, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181," or, as explained in more detail below, "...under 37 CFR 1.137(a)" or (b). This is not a final agency decision.

This application became abandoned on January 13, 2007 after the applicant failed to file a timely response to the non-Final Office Action mailed October 12, 2006. Accordingly, the Notice of Abandonment was mailed May 29, 2007.

Petitioner argues that the non-Final Office Action was not received as it was returned to the USPTO by the United States Postal Service.

A review of the file reveals that the non-Final Office Action was mailed to the address of record on October 12, 2006, but was returned by the US Postal Service on October 23, 2006 as undeliverable. The review further reveals that there does not appear to have been a change of address filed prior to the mailing of the non-Final Office Action and the forwarding order filed with the USPS expired. See MPEP sections 601.03 and 711.02(c).

As petitioner has not presented any evidence that the address of record had been changed with the USPTO at the time the non-Final Office Action was mailed, and in the absence of petitioner showing that they acted responsibly with respect to providing the USPTO with an up to date address, the showing of record is therefore insufficient to warrant withdrawal of the holding of abandonment.

**ALTERNATIVE VENUES**

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(a)[1] or 37 CFR 1.137(b),[2] which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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

By mail: Mail Stop Petition

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[1]A grantable petition under 37 CFR 1.137(a) must be accompanied by:

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

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

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and

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

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

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

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

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

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

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

By FAX: (571) 273-8300

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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**OFFICE OF PETITIONS**
ON PETITION

In re Application of
Theodore F. Dimitroff
Application No. 10/517,396
Filed: November 28, 2004
Attorney Docket Number: HAMPAUS-0001

This is a decision on the renewed petition filed October 11, 2007 (October 8, 2007 certificate of mail date) under 37 CFR 1.181, to withdraw the holding of abandonment, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513 or in the alternative, under 37 CFR 1.137(b) to revive the application .

The petition under 37 CFR 1.181 is **DISMISSED**.
The petition under 37 CFR 1.137(b) is **GRANTED**.

This application became abandoned on January 13, 2007 after the applicant failed to file a timely response to the non-Final Office Action mailed October 12, 2006. Accordingly, the Notice of Abandonment was mailed May 29, 2007.

In a petition filed June 15, 2007, petitioner argued that the non-Final Office Action was not received as it was returned to the USPTO by the United States Postal Service but did not present any evidence that the address of record had been changed with the USPTO at the time the non-Final Office Action was mailed. Thus the holding of abandonment was not withdrawn and the petition was dismissed in a decision mailed August 6, 2007.

Comes now petitioner with the instant renewed petition under 37 CFR 1.181 renewing the argument that the abandonment should be withdrawn and that the holding in Delgar does not afford blame for non-receipt.

To the contrary, petitions under 37 CFR 1.181 to withdraw the holding of abandonment are granted when evidence is presented to show that the petitioner acted responsibly with respect to providing the USPTO with an up to date address. Without such evidence, as is the instant case where there does not appear to have been a change of address filed prior to the mailing of the non-Final Office Action and the forwarding order filed with the USPS expired, the showing of record is insufficient to warrant withdrawal of the holding of abandonment.

With respect to the petition to revive, the petition fee in the amount of $1540.00 has been applied and all other requirements under 37 CFR 1.137(b) having been met, this matter is being referred to Technology Center 3672 for appropriate action on the amendment filed October 7, 2007 with the instant petition.

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

23 MAY 2005

#3

UNITED STATES PATENT AND TRADEMARK OFFICE

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

David Klein
DEKEL PATENT LTD.
Beit HaRof'im
18 Menuha VeNahala Street, Room 27
Rehovot, Israel

In re Application of :
ARTSIELY, Eyal :
Application No.: 10/517,405 :
PCT No.: PCT/IL03/00027 :
Int. Filing Date: 09 January 2003 : **DECISION**
Priority Date: 17 January 2002 :
Attorney Docket No.: 1147RAV-US :
For: ROTARY MOTION MECHANISM :

Applicant's petition to revive under 37 CFR 1.137(b) filed with the national stage papers on 08 December 2004 is hereby **GRANTED** as follows:

Applicant submitted fees in the amount of $1,200.00 with the subject petition. The USPTO fee schedule changed on 08 December 2004. Hence, the following fees have been paid: (1) petition to revive fee of $750.00; (2) basic national fee of $150.00; (3) assignment fee of $40.00 and (4) national stage search fee of $250.00. The additional $10.00 will be placed in a holding code. These payments constitute an appropriate reply. 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 declaration in compliance with 37 CFR 1.497(a) and (b) has been provided.

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 and a national stage examination fee are required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

10/517412

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : March 1, 2007

**TO SPE OF** : ART UNIT 1626

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7161007 B2

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

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

Elisha Evans
**Certificates of Correction Branch**
***Tel. No. 703-308-9390 EXT 110***

**Thank You For Your Assistance**

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

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

**Comments:**

Joseph K. McKane
JOSEPH K. McKANE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

**SPE** 1626 **Art Unit**

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

**DATE** : March 1, 2007

**TO SPE OF** : ART UNIT 1626

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7161007 B2

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

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

Elisha Evans
**Certificates of Correction Branch**
***Tel. No. 703-308-9390 EXT 110***

**Thank You For Your Assistance**

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

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

**Comments:**

Joseph K McKane
JOSEPH K. McKANE
~~SUPERVISORY PATENT EXAMINER~~
TECHNOLOGY CENTER 1600

**SPE**

1626
**Art Unit**

# UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT NO. : 7,161,007

DATED: : JANUARY 9, 2007

INVENTOR(S) : FRIDOLIN BÄBLER ET AL

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

The title page

Item (60) should read:

-- (60) Provisional application No. 60/396,377, filed on July 17, 2002 --.

Column 1

The first paragraph after the title should read:

-- The application is a 371 of PCT/EP03/07337, filed on July 8, 2003 which claims benefit under 35 U.S.C. 119(c) of U.S. Provisional application No. 60/396,377, filed on July 17, 2002. --.

MAILING ADDRESS OF SENDER:

Shiela A. Loggins
Ciba Specialty Chemicals Corporation
Patent Department
540 White Plains Road
P.O. Box 2005
Tarrytown, NY 10591

PATENT NO.7,161,007
(No. of add'l. Copies (3))

FEB - 6 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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P.O. Box 1450
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www.uspto.gov

BASF Performance Products LLC
Patent Department
540 White Plains Road
P.O. Box 2005
Tarrytown, NY 10591

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Kenneth Sundberg | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7585391 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/517,413 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/16/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **0** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Klaus Ingemann Pedersen | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7650154 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/19/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/517,448 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/09/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1299** 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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ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Mail Date: 05/18/2010

**Applicant** : Klaus Ingemann Pedersen
**Patent Number** : 7650154
**Issue Date** : 01/19/2010
**Application No**: 10/517,448
**Filed** : 12/09/2004

: 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 **1355** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of patent term adjustment (PTA) days determined by the recalculation.

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

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

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

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MAR 04 2010

OFFICE OF PETITIONS

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

| | | |
|---|---|---|
| In re Patent No. 7,572,770 | : | DECISION ON REQUEST |
| Marc Donath | : | FOR |
| Issue Date: August 11, 2009 | : | RECONSIDERATION OF |
| Application No. 10/517,450 | : | PATENT TERM ADJUSTMENT |
| Filed: September 1, 2005 | : | and |
| Atty Docket No.4614-0160PUS1 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on October 13, 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 three hundred seventeen (317) 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 five hundred seventy-three (573) days[1] is **GRANTED to the extent indicated herein.**

---

[1] The "B" delay period is 600 days, not 344 days. Patentee calculated this period based on the date this application fulfilled the requirements of 35 U.S.C. 371. However, in an international application, this period is based on the failure of the Office to issue a patent within three years after the national stage commenced under 35 U.S.C. 371(b) or (f). See 1.702(b). The priority date of this application is June 20, 2002. As the requirements for early commencement were not met, the national stage commenced in this application on December 20, 2004. Thus, "B" delay is 600 days, counting the number of days beginning on December 21, 2007 and ending on August 11, 2009, the date of issuance. See 1.703(b).

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

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

The application is being forwarded to the Certificates of 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 five hundred seventy-three **(573)** days.

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney at (571) 272-3222.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**DRAFT COPY**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,572,770 B2

DATED : Aug. 11, 2009

INVENTOR(S) : Donath

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 (219) days

Delete the phrase "by 219 days" and insert – by 573 days--

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Commissioner for Patents
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Thomas W. Cole
Roberts Mlotkowski & Hobbes, P.C.
P.O. Box 10064
McLean, VA 22102

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APR 26 2007

OFFICE OF PETITIONS

In re Application of:
Shiro Saka
Application No.: 10/517,485
Filed: July 06, 2005
Atty's Docket No.: 039371-13

DECISION ON PETITION UNDER
37 CFR 1.137(b)

This is a decision on the petition for revival of the above-entitled application under 37 CFR 1.137(b), filed October 10, 2006.

The petition is **GRANTED**.

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 mailed July 06, 2006, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned at midnight on October 06, 2006.

On October 10, 2006, applicant filed the petition for revival under 37 CFR 1.137(b) considered herein. The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that it includes: (1) the petition fee; (2) the required statement of unintentional delay; and (3) the required reply in the form of payment of the issue and publication fees. Accordingly, the issue and publication fee payments are accepted as having been unintentionally delayed.

The application is being referred to the Office Of Publications.

Telephone inquiries concerning this decision should be directed to the undersigned.

Derek A. Putonen
Attorney Advisor
(571) 272-3294

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

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FEB 26 2010

In re Application of :
Theo Burchard :
Application No. 10/517,492 : ON PETITION
Filed: January 9, 2006 :
Attorney Docket No. 2732-152

This is a decision on the petition, filed February 25, 2010 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 1, 2010 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 1794 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/
Irvin Dingle
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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JUN 11 2008

In re Application of :
**ORAM**, Guy R J. :
Application No. 10/517,496 : DECISION ON PETITION
Filed: June 24, 2005 : TO WITHDRAW
Attorney Docket No. **U 015530-0** : 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 17, 2007 and resubmitted April 23, 2008 and May 09, 2008.

The request is **APPROVED**.

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

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

The request to change the correspondence address of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor.

There is an outstanding Office action mailed January 24, 2008 that requires a reply from the applicant.

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

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **GUY ORAM**
**C/O MILLENIUM BIOLOGIX**
**785 MIDPARK DRIVE**
**KINGSTON, ONTARIO K7M 7G3**

cc: **MILLENIUM BIOLOGIX AG**
**WAGISTRASSE 23, CH-8952**
**SCHILEREN CH SWITZERLAND**

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FEB 07 2008

**OFFICE OF PETITIONS**

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

In re Application of :

**FULDE,** Fabienne A. et al. :
Application No. 10/517,497 : DECISION ON PETITION
Filed: May 26, 2005 : TO WITHDRAW
Attorney Docket No. **U 015529-5** : 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 17, 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 Tredelle Jackson at 571-272- 2783.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **MILLENIUM BIOLOGIX AG**
**WAGISTRASSE 23**
**CH-8952 SCHILEREN**
**SWITZERLAND**

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JUL 26 2006

OFFICE OF PETITIONS

WINSTEAD SECHREST AND MINICK PC
100 Congress Avenue, Suite 800
Austin, TX 78701

In re Application of :
Homer L. WEBB :
Application No. 10/517,503 : DECISION ON PETITION
Filed: December 10, 2004 : TO WITHDRAW
Attorney Docket No. 39888-P001 WOUS : 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 8, 2005.

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 Ross S. Garsson on behalf of all attorneys of record.

Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the first named inventor Homer L. Webb at the address indicated below.

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

David Bucci
Petitions Examiner
Office of Petitions

cc: Homer L. Webb
25 Dawson Road
Round Rock, TX 78664

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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 |
|---|---|---|---|
| 10/517,503 | 12/10/2004 | Homer L Webb | 39888-P001WOUS |

**CONFIRMATION NO. 1250**

*OC000000019734311*

Ross Spencer Garsson
WINSTEAD SECHREST AND MINICK PC
100 Congress Avenue
Suite 800
Austin, TX 78701

Date Mailed: 07/24/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 07/08/2005.

- 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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KENYON & KENYON LLP
ONE BROADWAY
NEW YORK NY 10004

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DEC 29 2006
OFFICE OF PETITIONS

In re Application of :
Kynast, et al. :
Application No. 10/517,514 : ON PETITION
Filed: June 21, 2005 :
Attorney Docket No. 10191/3619 :

This is a decision on the petition under 37 CFR 1.181, filed December 8, 2006, 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 May 15, 2006, which set forth an extendable three (3) month period for reply. The Office contended that this application became abandoned on August 16, 2006 for failure to reply to the May 15, 2006 non-final Office action. A Notice of Abandonment was mailed on November 27, 2006.

Petitioners request withdrawal of the holding of abandonment based on the assertion that a request for a three month extension of time and an amendment were timely mailed on certificate of mailing date November 13, 2006 and received in the Office on November 17, 2006. The undersigned finds this argument completely convincing, as these documents are present in the application file and Office financial records shows that the required three month extension of time fee was charged on November 20, 2006. The mailroom date for the payment was erroneously listed as November 17, 2006. The extension of time and the amendment both contain proper certificate of mailings listing November 13, 2006 as the date of deposit. Therefore, the three month extension of time and amendment were timely filed.

Office financial records will be changed to show that the three month extension of time has a mailroom date of November 13, 2006.

The petition under 37 CFR 1.181 is **granted**, the holding of abandonment is withdrawn, and the November 27, 2006 Notice of Abandonment is **vacated**. No petition fee has been or will be charged in connection with this matter.

Accordingly, the application file will be forwarded to Technology Center A.U. 3661 for consideration of the amendment filed on November 17, 2006 (certificate of mailing date November 13, 2006).

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

Shirene Willis Brantley

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

30 SEP 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

#3

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IPSOLON LLP
805 SW BROADWAY, #2740
PORTLAND OR 97205

| | | |
|---|---|---|
| In re Application of | : | |
| BECK, Clifford et al. | : | |
| Application No.: 10/517,516 | : | DECISION |
| PCT No.: PCT/GB03/01743 | : | |
| Int. Filing Date: 24 April 2003 | : | ON PETITION UNDER |
| Priority Date: 08 May 2002 | : | |
| Docket No.: 1085-064-PWH | : | 37 CFR 1.137(b) |
| For: METHOD AND APPARATUS FOR DE-WATERING ARTICLES | : | |

Applicants' "Petition For Revival of an International Application For Patent Designating the United States Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the above-captioned application on 08 December 2004 is **GRANTED**.

Applicants state that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," as required by 37 CFR 1.137(b)(3). The appropriate national fee and petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration has not yet been submitted.

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

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/517,558 | 07/13/2005 | Richard Frank Tester | 08830-0307US1 | 2680 |

23973 7590 02/20/2009

DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA, PA 19103-6996

| EXAMINER | |
|---|---|
| PALENIK, JEFFREY T | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1615 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 02/20/2009 | PAPER |

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

The time period for reply, if any, is set in the attached communication.

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FEB 2 0 2009

DANIEL A. MONACO
DRINKER BIDDLE & REATH
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ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA PA 19103-6996

| | |
|---|---|
| In re Application of | : |
| Tester et al | :Decision on Petition |
| Serial No.: 10/517,558 | : |
| Filed : 13 July 2005 | : |
| Attorney Docket No.: 08830-0307US1 | : |

This letter is in response to the Petition under 37 C.F.R. 1.144 and 1.181 filed on 23 January 2009 requesting reconsideration of the lack of unity requirement mailed 27 October 2007.

## BACKGROUND

This application was filed as a national stage of a PCT application and as such is entitled to PCT unity of invention rules.

On 27 October 2007, the examiner set forth a lack of unity requirement which divided the claims 1-12, 16-19, 23 and 25-35 into 4 groups as follows:

> Group I, 1-12, 16, 23 and 25 drawn to a bioadhesive pharmaceutical formulation comprising beta-limit dextrin
> Group II, Claims 17-19 drawn to nutritional product comprising beta-limit dextrin
> Group III, claims 26-29 drawn to a method of delivering an active agent formulation comprising beta-limit dextrin
> Group IV, claims 30-35 drawn to a method of providing nutrition containing beta-limit dextrin

The examiner also required an election of species between buccal-melt, aerosol powder or thin film.

On 28 February 2008, applicants elected Group I, claims 1-12, 16, 23 and 25 and species (i) buccal-melt product with traverse. Applicants added new claims 36 and 37.

On 19 August 2008, the examiner considered the traversal and made the lack of unity determination FINAL. On the form PTOL-326, the examiner accounted for the claims as follows:

> Claims 1-12, 16, 23 and 25 are pending.
> Claim 6 is withdrawn from consideration.
> Claims 1-5, 7-12, 16, 23 and 25 are rejected.

In the body of the Office action, the examiner accounted for the claims as follows:

> Claims 6, 36 and 37 are withdrawn from consideration.
> Claims 4 and 5 were rejected under 35 U.S.C. 112, 2nd paragraph.
> Claims 1-5, 7-12, 16, 23 and 25 were rejected under 35 U.S.C. 103(a).

On 23 January 2009, applicants filed a response to the Office action and this petition.

**DISCUSSION**

The file history and petition have been considered carefully.

Before turning to the merits of the petition, it is noted that the status of the claims in Office action mailed 19 August 2008 is inconsistent and incomplete in the PTOL 326 form and in the body of the Office action. Claims 17-19 and 26-37 are also pending and have been presumably withdrawn from consideration as being directed to non-elected inventions.

Turning now to the merits of the petition, PCT Rules 13.2 states that:

> **Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.**

**A. Concerning the Lack of Unity Requirement Made between Group I (product) and Group III (process of using the product):**

To show unity of invention lacking amongst the first product and the method of using the first product, applicants are correct that the examiner would need to address the technical feature shared by the product of Group I and the process of Group III. In this instance, the shared technical feature is the product of claim 1.

Chapter 10 of the ISPE Guidelines makes it clear that the contribution must be both in terms of novelty, which corresponds to anticipation under US practice, and inventive step, which corresponds to unobviousness under US practice. The criteria for determining the concept of "contribution over the prior art" is further discussed in Chapter 10 of the International Search and Preliminary Examination Guidelines:

*Rule 13.2; AI Annex B, Part 1(b)*

> 10.02 Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," is considered with respect to novelty and inventive step. For example, a document discovered in the international search shows that there is a presumption of lack of novelty or inventive step in a main claim, so that there may be no technical relationship left over the prior art among the claimed inventions involving one or more of the same or corresponding special technical features, leaving two or more dependent claims without a single general inventive concept.

The examiner originally supported the lack of unity of invention determination with respect both to the Groupings with the following reasons:

> **The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: there is no special technical feature since U.S. Patent 4,780,149, teaches the application of β-limit dextrin containing starch hydrosylates via food and pharmaceutical products (column 1, lines 6-9).**

While the original reference used by the examiner to demonstrate that unity was lacking did not address all the limitations of claim 1, the rejection of the product claims of elected Group I under 35 USC 103 is now provided as evidence that the invention as claimed does not make a contribution over the prior art. Because the product of Group I does not make a contribution over the prior art, unity of invention is lacking between Group I and Group III.

Should all claims to the elected product of Group I become in condition for allowance, MPEP 1893.05(d) provides the following guidance on rejoinder practice for applicants filed in compliance with 35 U.S.C 371.

> If an examiner (1) determines that the claims lack unity of invention and (2) requires election of a single invention, when all of the claims drawn to the elected invention are allowable (i.e., meet the requirements of 35 U.S.C. 101, 102, 103 and 112), the nonelected invention(s) should be considered for rejoinder. Any nonelected product claim that requires all the limitations of an allowable product claim, and any nonelected process claim that requires all the limitations of an allowable process claim, should be rejoined. See MPEP § 821.04. Any nonelected processes of making and/or using an allowable product should be considered for rejoinder. The examiner should notify applicants of potential rejoinder of non-elected process claims by placing form paragraph 8.21.04 at the end of any lack of unity determination made between a product and a process of making the product or between a product and a process of using the product.

**Concerning the Election of Species Requirement Between buccal-melt and thin film.**

The election of species requirement supported using the same rationale set forth the following species: (i) buccal-melt, (ii) aerosol powder and (iii) thin film. The relevant claims are set forth below:

4. (Currently amended) A bioadhesive pharmaceutical formulation as claimed in Claim 1 which is a buccal-melt ~~type~~ product.

5. (Original) A bioadhesive pharmaceutical formulation as claimed in Claim 4 which is a wafer.

6. (Previously presented) A bioadhesive pharmaceutical formulation as claimed in Claim 1 which is a powder for use in aerosol delivery formulations.

7. (Previously presented) A bioadhesive pharmaceutical formulation as claimed in Claim 1 which is a thin film.

Applicants elected buccal-melt. The examiner made the lack of unity determination FINAL in the Office action mailed 19 August 2008.

However, in that same Office action on the merits, the examiner examined claim 7 directed to the non-elected species of thin film along with claims to the elected species of buccal-melt. The examiner rejected all of claims 1-5, 7-12, 16, 23 and 25 under 35 U.S.C. 103(a) as being unpatentable over Kaper et al and Burgoyne et al. In the body of the obviousness rejection, the examiner has considered the merits of withdrawn species of thin film (claim 7) by stating that, "the Examiner broadly and reasonably interprets a wafer as being a form of or species of thin film." The examiner went on to state that "bucally (e.g., orally) administered compositions which are very well known in the art as having many different form, particularly a wafer or a ribbon form, as evidence by Garbutt..."

Because the term "wafer" (claim 5) encompasses or is encompassed by "thin film" (claim 7), because both wafers and thin films may be administered to melt in the mouth (buccal-melt type product of claim 4), and because the Office action addressed claims 4, 5 and 7 (directed to buccal-melt-type product, wafer and thin film, respectively) on the merits, the election of species requirement amongst the "species" of buccal-melt and thin film cannot be maintained.

**Concerning the Withdrawal of newly added Claim 36, directed to lyophilized products:**

On 28 February 2008, applicants added new product claim 36 shown below:

36. (Previously presented) A bioadhesive pharmaceutical formulation according to claim 1, wherein said formulation is a lyophilized formulation.

In the Office action mailed 19 August 2008, Claim 36 was withdrawn from consideration. The examiner accounted for withdrawing claim 36 from consideration by stating that had the claim been submitted with the previous revision of the claims, the freeze-dried formulation of claim 36 would also have been subjected to the same election of species requirement as the buccal-melt product and aerosol powder formulations. Then the examiner pointed to page 14, lines 21-27 of the specification stating that freeze-dried matrix formulations are independent from both wafer and powder forms.

It is noted that "independence" is not a criteria for finding unity of invention lacking under PCT Guidelines. Unity of invention is lacking between elected species and the withdrawn species of claim 36 for the reasons set forth below:

> Newly submitted claim 36 is directed to an invention that lacks unity with the invention originally claimed for the following reasons: Claim 36 is directed to the non-elected species of lyophilized formulation. This species lacks unity of invention with the elected species because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.
>
> The invention of Group I does not make a contribution over the prior art, as evidenced by the prior art rejection set forth in the Office action of 189 August 2008.
>
> Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise require all the limitations of an allowed generic claim. Currently, the following claim(s) of Group I are generic: 1, 3, 8-12 and 16.
>
> Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim [ 3 ] withdrawn from consideration as being directed to a nonelected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

**DECISION**

The petition filed under 37 CFR 1.144 on 23 January 2009 is **GRANTED-IN-PART**.

Claims 1, 3-12, 16-19, 25-37 are currently pending.

The lack of unity determination set forth on 28 June 2005 among the Groups I-IV has been maintained with the following modification that newly added claim 36 and 37 are placed in Groups I and III, respectively:

Group I, claims 1, 3-12, 16, 25 and 36 drawn to a bioadhesive pharmaceutical formulation comprising beta-limit dextrin
Group II, Claims 17-19 drawn to nutritional product comprising beta-limit dextrin
Group III, claims 26-29 and 37 drawn to a method of delivering an active agent formulation comprising beta-limit dextrin
Group IV, claims 30-35 drawn to a method of providing nutrition containing beta-limit dextrin

The request for rejoinder between the product (Group I) and process of using (Group III) is denied as premature, given that the product does not make a contribution over the prior art, as evidenced by the rejection under 35 U.S.C. 103(a). Should all claims to the elected invention become free of the prior art and should all claims to the process invention require all the limitations of the allowable product, the examiner should then consider rejoinder of Group III with Group I, per MPEP 821.04.

The election of species requirement made FINAL on 19 August 2008 amongst the species of buccal-melt and thin film is withdrawn.

With regard to Group I, the election of species requirement is set forth with the following modification:

Species (i) buccal melt, wafer, thin film, waxy starch, tablet formulations (because claims 4, 5, 7, 16 and 25 were already examined together on the merits and these limitations were specifically addressed in the prior art rejections)
Species (ii) aerosol powder of claim 6
Species (iii) lyophilized formulation of claim 36

Claims 1, 3, 8-12 and 16 of Group I are generic.

Because Claims 1, 3-5, 7-12, 16 and 25 read upon the elected/examined species of buccal melt, wafer, thin film, waxy starch tablets and deep freeze formulations of a bioadhesive pharmaceutical formulation comprising beta-limit dextrin, they will be examined together.

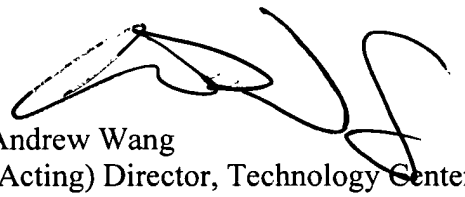
Claims 6 is withdrawn from consideration as being directed to non-elected species of aerosol powder, there being no allowable generic claim.

Claim 36 is withdrawn from consideration as being directed to non-elected species of lyophilized formulation, there being no allowable generic claim.

The application will be forwarded to the examiner to consider the papers filed 23 January 2009 and to prepare an Office action on claims 1, 3-5, 7-12, 16 and 25 and the elected/examined species of buccal melt, wafer, thin film, waxy starch and tablets formulations of a bioadhesive pharmaceutical formulation comprising beta-limit dextrin, consistent with this petition decision.

Any request for reconsideration of this decision should be filed within TWO (2) months of the mail date of this decision.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-272-8300.



Andrew Wang
(Acting) Director, Technology Center 1600

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

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MAY 26 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Eva Steiness | : | DECISION ON PETITION |
| Application No. 10/517,563 | : | TO WITHDRAW |
| Filed: July 8, 2005 | : | FROM RECORD |
| Attorney Docket No. 50412/020003 | : | |

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 21, 2005.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to practitioners associated with Edwards Angell Palmer & Dodge LLP, has been revoked by the assignee of the patent application on March 13, 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 571-272-6059.

Alicia Kelley
Petitions Examiner
Office of Petitions

cc: CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

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Paper No.

SMITH MOORE LLP
P.O. BOX 21927
GREENSBORO NC 27420

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JAN 23 2008

**OFFICE OF PETITIONS**

In re Application of :
Josef H. Burgert :
Application No. 10/517,572 : DECISION ON PETITION
Filed: December 9, 2004 : UNDER 37 C.F.R. § 1.137(b)
Attorney Docket Number: :
5003073.091.US2 :
Title: PROCESS FOR THE :
PREPARATION OF IRON ION :
CONTAINING WATER-ABSORBENT :
POLYMERS WITH LOW RESIDUAL :
MONOMER CONTENT :

This is a decision on the petition, pursuant to 37 C.F.R. § 1.137(b)[1], to revive the above-identified application, filed on October 12, 2007.

Petitioner has entitled this petition "petition to withdraw notice of abandonment..." however it is clear that he has intended to file under Rule § 1.137(b).

This petition is **DISMISSED**.

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1 A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

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

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R § 1.113 in a timely manner to the final Office action mailed February 5, 2007, which set a shortened statutory period for reply of three months. An after-final amendment was received on April 3, 2007, and an advisory action was mailed on April 9, 2007. No extensions of time under the provisions of 37 C.F.R §1.136(a) were obtained, and no further responses were received. Accordingly, the above-identified application became abandoned on May 6, 2007. A notice of abandonment was mailed on August 14, 2007.

With the present petition, Petitioner has submitted the petition fee and has submitted a Request for Continued Examination along with the associated fee. A terminal disclaimer is not required.

As such, Petitioner has met requirements (1) and (2) of 37 C.F.R. § 1.137(b). The fourth requirement is not applicable.

Regarding the third requirement, 37 C.F.R. § 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 C.F.R. § 1.137(b) was unintentional. With the present petition, Petitioner has not submitted this statement.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.137(b)." 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].

On renewed petition, Petitioner should include the required statement of unintentional delay.

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

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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

else to the address will delay the delivery of the response to the undersigned.

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

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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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 further action(s) of Petitioner.

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ROBERT D. SHEDD, PATENT OPERATIONS
THOMPSON LICENSING, LLC
PO BOX 5312
PRINCETON, NJ 08543-5312

MAILED

JUN 17 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Brian Albert Wittman | : | |
| Application No. 10/517,574 | : | DECISION GRANTING PETITION |
| Filed: December 9, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. PU020277 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed June 16, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on May 12, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

The petition is not signed by an attorney of record. Nevertheless, in accordance with 37 CFR 1.34, the signature of Mr. Brian J. Dorini 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. Dorini desires to receive future correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

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

This application is being referred to Technology Center AU 2431 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Wolfgang Fuellhaas | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7665273 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/23/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/517,585 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/30/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1172** 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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BACON & THOMAS, PLLC
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA, VA 22314-1176

Mail Date: 04/28/2010

| | | |
|---|---|---|
| **Applicant** | : Wouter Van Praag | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7607899 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/27/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/517,602 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/08/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **658** 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. |
|---|---|---|---|---|
| 10/517,604 | 12/21/2004 | Goro Fujita | 263495US6PCT | 8524 |

22850 7590 01/28/2008

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

| EXAMINER | |
|---|---|
| GOMA, TAWFIK A | |
| **ART UNIT** | **PAPER NUMBER** |
| 2627 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 01/28/2008 | ELECTRONIC |

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

The time period for reply, if any, is set in the attached communication.

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

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/517,604 | 12/21/2004 | Goro Fujita | 263495US6PCT | 8524 |

7590 01/28/2008

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

| EXAMINER | |
|---|---|
| GOMA, TAWFIK A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2627 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 01/28/2008 | ELECTRONIC |

## DECISION GRANTING PETITION UNDER 37 CFR 1.138(d)

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Patent Publication Branch
Office of Data Management

Refund Ref: 0030049642
01/24/2008

Credit Card Refund Total: $500.00

Am Exp..: XXXXXXXXXXX1001

| Notice of Abandonment | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/517,604 | FUJITA ET AL. | |
| | Examiner | Art Unit | |
| | Goma, Tawfik | 2627 | |

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

This application is abandoned in view of:

1. ☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.
   (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____ ), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
   (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
   (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
   (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
   (d) ☐ No reply has been received.

2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
   (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
   (b) ☐ The submitted fee of $_____ is insufficient. A balance of $_____ is due.
   The issue fee required by 37 CFR 1.18 is $_____. The publication fee, if required by 37 CFR 1.18(d), is $_____.
   (c) ☐ The issue fee and publication fee, if applicable, has not been received.

3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
   (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
   (b) ☐ No corrected drawings have been received.

4. ☑ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. ☐ The reason(s) below:

/Rick Clemons/ □□Administrative Assistant□□Art Unit: 3900

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**FOLEY AND LARDNER LLP**
**SUITE 500**
**3000 K STREET NW**
**WASHINGTON DC 20007**

MAILED

JAN 19 2010

OFFICE OF PETITIONS

In re Application of :
Jorg Peter :
Application No. 10/517,637 : DECISION ON PETITION
Filed: April 11, 2005 : TO WITHDRAW
Attorney Docket No. 085449-0157 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 24, 2009.

The request is **NOT APPROVED.**

The Office will no longer accept address changes to a new practitioner or law firm filed with a Request, absent the filing of a power of attorney to the new representative. The Office will either change the correspondence address of record 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 under 37 CFR 3.71, the most current address information provided for the first named inventor.

Accordingly, the request to withdraw from record cannot be approved because no forwarding address was provided. The new correspondence address should be that of the first signing inventor or and assignee who has properly intervened in this application. If applicable, **see** 37 CFR 3.73(b).

All future communications from the Office will continue to be directed to the above-identified address until otherwise properly notified.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

30 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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LEVINE & MANDELBAUM
444 MADISON AVENUE
35TH FLOOR
NEW YORK, NY 10022

In Re Application of :
DALLE et al. :
Application No.: 10/517,643 : DECISION
PCT No.: PCT/FR03/02979 :
Int. Filing Date: 09 October 2003 :
Priority Date: 10 October 2002 :
Attorney Docket No.: MART0840US :
For: FLUID CONNECTOR FOR MEDICAL USES :
AND USES THEREOF :

This is a decision on applicant's "COMMUNICATION" filed in the United States Patent and Trademark Office (USPTO) on 27 May 2005.

On 09 October 2003, applicant filed international application No. PCT/FR03/02979 which claimed a priority date of 10 October 2002 and which designated the United States. Thereafter, on 09 December 2004, before the expiration of the thirty month period, applicant filed, *inter alia*, a transmittal letter for entry into the national stage and the basic national stage filing fee. Applicant also filed an executed French language declaration under PCT Rule 4.17.

On 18 May 2005, a Notification of Acceptance Under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) incorrectly indicating a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 09 December 2004. No Notification of Missing Requirements (Form PCT/DO/EO/905) was issued.

Applicant urges that the Form PCT/DO/EO/903 be vacated and that a Notification of Missing Requirements be issued indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) is required.

A review of the application in the USPTO's Image File Wrapper (IFW) file confirms that the executed French language declaration was submitted on 09 December 2004, which does not comply with 37 CFR 1.497(a) & (b) and 1.52(b)(1)(ii).

37 CFR 1.52(b)(1)(ii) states, in pertinent part, that the application (specification, including the claims, drawings, and oath or declaration) must be in the English language or be accompanied by a translation.

The Notification of Acceptance mailed on 18 May 2005 was erroneously issued.

## CONCLUSION

For the reasons set forth above, applicant's request to vacate the Notification of Acceptance is **GRANTED**.

The Notification of Acceptance (Form PCT/DO/EO/903) mailed on 18 May 2005 is hereby **VACATED**, because it incorrectly indicates a 35 U.S.C. 371(c) (1), (c)(2) and (c)(4) date of 09 December 2004.

The application will be forwarded to the United States Designated/Elected Office for further processing including issuance 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) and (b) is required.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571)272-3286

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED
DEC 09 2008

In re Application of :
NEKOVEE et al. :
Application No. 10/517,652 : DECISION ON PETITION
Filed: December 13, 2004 :
Attorney Docket No. 36-1875 :

This is a decision on the petition, filed November 6, 2008, which is being treated as a petition under 37 CFR 1.181 (no fee), requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to timely respond to the Office communication of September 16, 2008, which set a one (1) month shortened statutory period for reply. A reply was due on or before October 16, 2008.

Petitioner states that a reply was in fact timely filed. To support this assertion, petitioner has submitted a copy of a return postcard which acknowledges receipt by the U.S. Patent and Trademark Office (USPTO) on October 16, 2008 of, an amendment. The amendment acknowledged as having been received in the USPTO on October 16, 2008 is of record in the application file. Additionally, MPEP 503 states that "[a] post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO." Accordingly, it is concluded that the amendment was timely received in the USPTO.

It should be noted that it has been USPTO policy to wait one (1) month after the period for response has expired before pulling files for abandonment. See MPEP 711.04(a). In view of the above, the holding of abandonment is hereby withdrawn and the application restored to pending status.

This application is being referred to Technology Center AU 2445 for appropriate action in the normal course of business on the reply received with petition.

Anthony Knight
Supervisor
Office of Petitions

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

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MAR 1 4 2006

OFFICE OF PETITIONS

In re Application of
Kim et al.
Application No. 10/517,679
International Filing Date: April 14, 2004
For: CATALYTIC FILTER FOR REMOVING SOOT PARTICULATES FROM DIESEL ENGINE EXHAUST AND METHOD OF PREPARING THE SAME
Attorney Docket No: 047559/286038
Pub. No.: US 2005/0239642 A1
Pub. Date: October 27, 2005

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221 (b), received on December 21, 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 mistake, as coinventors Sung-Hyoan Kim, Chang-Q Lee and Wha-Sik Min are omitted from the list of the inventors on the front page of the publication.

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 Sung-Hyoan Kim, Chang-Q Lee and Wha-Sik Min from the list of the inventors 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 July 7, 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), 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 (571) 272-7709 (voice).

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

Enclosure: Corrected Filing Receipt

27 JUN 2005

#3

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Jeffrey M. Kaden
Gottlieb, Rackman & Reisman, P.C.
270 Madison Avenue
New York, NY 10016-0601

| | | |
|---|---|---|
| In re Application of | : | |
| PERI | : | |
| U.S. Application No.: 10/517,687 | : | DECISION ON PETITION |
| PCT No.: PCT/CA03/00903 | : | |
| Int. Filing Date: 11 June 2003 | : | UNDER 37 CFR 1.137(b) |
| Priority Date: 11 June 2002 | : | |
| Attorney Docket No.: 4328-005 | : | |
| For: PEPTIDES AND PEPTIDOMIMETICS USEFUL FOR INHIBITING THE ACTIVITY OF PROSTAGLANDIN F2A RECEPTOR | : | |

The petition to revive under 37 CFR 1.137(b) filed 01 April 2005 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" 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 inventor is required.

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

Request for Legal Staff Consideration

Serial No. 10/517687 Date 20 June 2005

Request: Petition for Revival

Requestor Christine Washington Supervisor Cathy Short

Response:

Petition Granted. Please Prepare & Mail 905 Regarding Lack of Declaration

By: D. Puteren Date 6/27/05

RECEIVED
24 JUN 2005
Legal Staff
International Division

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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DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE
18TH AND CHERRY STREETS
PHILADELPHIA PA 19103-6996

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SEP 2 8 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kamel Khalili | : | |
| Application No. 10/517710 | : | ON REQUEST FOR |
| Filing or 371(c) Date: 07/27/2005 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. | : | |
| 06056-0309US1 | : | |

This is in response to the REQUEST FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b), filed May 27, 2009. Applicant submits that the correct patent term adjustment to be indicated on the patent is 429 days, not 191 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. The request is properly treated under 37 CFR 1.705(b).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is

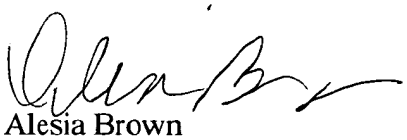
advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

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



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

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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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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DRINKER BIDDLE & REATH
ATTN: INTELLECTUAL PROPERTY GROUP
ONE LOGAN SQUARE, SUITE 2000
PHILADELPHIA PA 19103-6996

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APR 22 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Kamel Khalili | : | DECISION ON REQUEST |
| Patent Number: 7,612,039 | : | FOR RECONSIDERATION OF |
| Issue Date: 11/03/2009 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/517710 | : | and |
| Filing or 371(c) Date: 07/27/2005 | : | NOTICE OF INTENT TO ISSUE |
| Attorney Docket Number: 06056-0309US1 | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on December 30, 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 four hundred fifty-nine (459) 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 four hundred fifty-nine (459) days is **GRANTED to the extent indicated herein**.

The calculation of delay pursuant to 37 CFR 1.702(b) is based on a national stage commencement date of December 13, 2004, not December 10, 2004. As the expiration of the 30-month period pursuant to 35 U.S.C. 371(b) fell on a Sunday, the period expired on the subsequent business day[1]. See PCT Rule 80.5. Accordingly, the commencement date is Monday, December 13, 2004, and the "B" delay ends on August 4, 2008, the day before the RCE was filed. See, 35 U.S.C. 154(b)(1)(B)(i).

Further as to the "B" delay, the period of adjustment of 235 days is reduced to the extent that periods of delay attributable to the grounds specified in § 1.702 overlap, and the period of adjustment granted under this section shall not exceed the actual number of days the issuance of the patent was delayed. 35 U.S.C. 154(b)(2)(A), 37 CFR 1.702(f). In this instance, the period of

[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). It is noted that applicant requested, but did not perfect early commencement.

adjustment of 30 days pursuant to 37 CFR 1.702(a)(4) overlaps with the period of adjustment pursuant to 37 CFR 1.702(b). As such, the patent term adjustment is 205, not 235 days.

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

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

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by four hundred twenty-six (**426**) days.

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

/Derek L. Woods/

Derek L. Woods
Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,612,039 B2

DATED : November 3, 2009

INVENTOR(S) : Khalili 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 426 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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DORITY & MANNING, P.A.
POST OFFICE BOX 1449
GREENVILLE SC 29602-1449

12/4/07

In re Application of:
Bogl, Stefan
Serial No. 10/517,711
Filed: Dec. 10, 2004
Docket: CBZ-1266
Title: METHOD AND DEVICE FOR THE PRODUCTION OF A PRECISE CONCRETE PREFABRICATED PART

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition filed Sep. 4, 2007 under 37 CFR 1.181 requesting entry of the Reply Brief field on Mar. 15, 2007. The petition is being considered pursuant to 37 CFR § 1.181, and no fee is required.

The petition is granted.

The record shows on Mar. 15, 2007, the appellant filed a reply brief to the examiner's answer of Jan. 16, 2007. In the reply brief, the appellant made further arguments regarding the examiner's improper interpretation of "add on elements" in the German patent, DE 19753705. The appellant also argues that it is not permissible to interpret a Section 102 reference outside of its express or inherent disclosure. It is not permissible to interpret a Section 102 reference so as to contradict its express disclosure, as the present Final Action has done. The appellant also presents further arguments regarding claims 21, 22, 24, 28 and 30.

On Jul. 2, 2007, the examiner issued an Office action to notify the appellant refusal to enter the reply brief of Mar. 15, 2007 because the reply brief is not in compliance with 37 CFR 41.41(a)[1]. In particular, the examiner asserts the reply brief is not limited to new points of argument or to new grounds of rejection raised in the examiner's answer.

[1] 37 CFR §41.41 Reply brief. (a) (1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer. (2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal. (b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section. (c) Extensions of time under § 1.136 (a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136 (b) of this title for extensions of time to reply for patent applications and § 1.550 (c) of this title for extensions of time to reply for ex parte reexamination proceedings.

In particular, the examiner asserts the reply brief is not limited to new points of argument or to new grounds of rejection raised in the examiner's answer.

According to 37 CFR §41.41, there is no prohibition against the appellant's additional arguments relating to the interpretation of a prior art reference against the claims under appeal such as in the reply brief of Mar. 15, 2007. In finding petitioner's points of argument persuasive, the requested relief is granted. The Office action mailed on Jul. 2, 2007 is hereby withdrawn. The examiner has been directed to enter and consider the reply brief of Mar. 15, 2007 in accordance with 37 CFR § 41.43.

The application is being forwarded to Examiner McDonald of Art Unit 3723 for entry and consideration of reply brief filed on Mar. 15, 2007. Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner at (571) 272-4856.

PETITION GRANTED.

for Karen M. Young

Frederick R. Schmidt, Director
Technology Center 3700

17 FEB 2005
UNITED STATES PATENT AND TRADEMARK OFFICE

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

Xavier Pillai
Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780

In re Application of :
BURKE, et al. : DECISION ON REQUEST
Application No.: 10/517,717 :
Filing Date: 10 December 2004 : UNDER 37 CFR 1.497(d)
Attorney Docket No.: 231461 :
For: SH2 DOMAIN BINDING INHIBITORS :

This decision is in response to applicant's "Request to Correct Inventorship Under 37 C.F.R. § 1.48" filed 10 December 2004 in the United States Patent and Trademark Office (USPTO). The petition is being treated as a request under 37 CFR 1.497(d).

## BACKGROUND

On 26 June 2003, applicant filed international application PCT/US03/19987, which claimed priority of an earlier application filed 28 June 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 28 December 2004.

On 10 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); the present petition which is being treated as a request under 37 CFR 1.497(d); an application data sheet and a First Preliminary Amendment.

On 26 January 2005, applicant filed a combined declaration and power of attorney and supplemental application data sheet. In addition, applicant provided payment of the appropriate surcharge for filing an executed oath or declaration later than thirty months from the priority date.

## 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:

(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).

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

Regarding Item (1), applicant has not submitted a statement from inventor Voigt avowing that the error in inventorship occurred without any deceptive intention on the inventor's part.

As to Item (4), applicant has not provided a statement granting the consent of the assignee. Assignee is required to establish its ownership in accordance with 37 CFR 3.73 (See MPEP 201.03 and 324).

In light of the above, it is not possible to grant applicant's petition at this time.

## CONCLUSION

For the reasons above, applicant's request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

Applicant is hereby afforded **TWO (2) MONTHS** from the mail date of this decision to file any request for reconsideration. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.497(d)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be 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

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Xavier Pillai
Leydig, Voit & Mayer, Ltd.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780

| | | |
|---|---|---|
| In re Application of | : | |
| BURKE, et al. | : | DECISION ON RENEWED |
| Application No.: 10/517,717 | : | |
| Filing Date: 10 December 2004 | : | PETITION UNDER |
| Attorney Docket No.: 231461 | : | |
| For: SH2 DOMAIN BINDING INHIBITORS | : | 37 CFR 1.497(d) |

This decision is in response to applicant's "Renewed Petition Under 37 C.F.R. § 1.497(d)" filed 17 March 2005 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 17 February 2005, applicant was mailed a decision in the present application regarding the attempted deletion of inventor Johannes H. Voigt. Applicant was afforded two months to file any request for reconsideration.

On 17 March 2005, applicant filed the renewed petition considered herein.

## DISCUSSION

Before an applicant can proceed under 37 CFR 1.48(b), the 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. Applicant's current submission of the combined declaration and power of attorney executed by all five 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 **17 March 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 **17 March 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 Johannes H. Voight pursuant to 37 CFR 1.48(b).

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
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P.O. BOX 2207
WILMINGTON, DE 19899

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JUL 2 5 2008

OFFICE OF PETITIONS

In re Application of :
Neu et al. :
Application No. 10/517,722 : ON PETITION
Filed: December 10, 2004 :
Attorney Docket No. 00143-00244-US :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 25, 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 13, 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). A three month extension of time pursuant to the provisions of 37 CFR 1.136(a) was not timely filed. 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 a Request for Continued Examination (RCE) and fee of $810.00, and the submission required by 37 CFR 1.114; (2) the petition fee of $1,540.00; and (3) a proper statement of unintentional delay.

Further, an extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. *See* In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $1050.00, three month extension of time fee submitted with the petition on June 25, 2008 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be refunded to petitioner's credit card.

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

This application is being referred to Technology Center AU 1616 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Liana Walsh
Petitions Examiner
Office of Petitions

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**SANDRA POTEAT THOMPSON**
**BUCHALTER NEMER**
**A PROFESSIONAL CORPORATION**
**18400 VON KARMAN, SUITE 800**
**IRVINE CA 92612**

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MAY 0 6 2009

**OFFICE OF PETITIONS**

In re Application of
**THOMPSON, George**
Application No. 10/517,727
Filed: December 10, 2004
Attorney Docket No. **P9450-0305**

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 December 16, 2008.

The request is **NOT APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request cannot be approved because there is no indication that act two (2) noted in the above-identified certifications has been performed.

A review of the file record indicates that Customer No. 62993 does not have power of attorney in this patent application nor is there any statement or evidence of record of employment in or otherwise being engaged in the proceedings in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

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

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

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **PURCELL SYSTEMS, INC.**
**22924 EAST APPLEWAY AVENUE**
**LIBERTY LAKE, WA 99019**

31 MAR 2005

#3

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ALAN S. HODES
BEYER WEAVER & THOMAS, LLP
P.O. BOX 778
BERKELEY, CA 94704-0778

| | |
|---|---|
| In re Application of NANDHRA | |
| Application No.: 10/517,738 | |
| PCT Application No.: PCT/US01/05895 | |
| Int. Filing Date: 23 February 2001 | |
| Priority Date Claimed: 24 February 2000 | |
| Attorney Docket No.: FINDP001 | DECISION ON PETITION |
| For: METHOD AND SYSTEM FOR EXTRACTING, ANALYZING, STORING, COMPARING, AND REPORTING ON DATA STORED IN WEB AND/OR OTHER NETWORK REPOSITORIES AND APPARATUS TO DETECT, PREVENT AND OBFUSCATE INFORMATION REMOVAL FROM INFORMATION SERVERS | UNDER 37 CFR 1.137(b) |

Applicant's "Petition to Revive Unintentionally Abandoned International Application," filed in the United States Patent and Trademark Office on 09 December 2004, which is being treated as a Petition for Revival under 37 CFR 1.137(b), is GRANTED.

## BACKGROUND

On 23 February 2001, applicant filed international application PCT/US01/05895. The international application claims a priority date of 24 February 2000 and designates the United States. The deadline for paying the basic national fee in the United States was thirty months from the priority date, that is 24 August 2004. Applicant missed this deadline.

On 09 December 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), an executed declaration as required by 35 U.S.C. 371(c)(4), and the petition fee of $750.

## 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 U.S. National Phase application, from the due date for filing it as set forth in 37 CFR 1.495 until the filing of this petition was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3). The submission of the national fee and the copy of the international application satisfies 37 CFR 1.137(b)(1). The payment of the petition fee satisfies the requirement under 37 CFR 1.137(b)(2). A terminal disclaimer is not required because the application was filed on or after 08 June 1995. Therefore, the requirements for a grantable petition under 37 CFR 1.137(b) have been satisfied.

## CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is GRANTED as to the National Stage in the United States of America.

Applicant has satisfied the filing requirements under 35 U.S.C. 371.

The application has an international filing date of 23 February 2001 under 35 U.S.C. 363 and a date of 09 December 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.

Amy Vanatta
PCT Legal Administration Detailee
Telephone: 571-272-6095
Facsimile: 571-273-0459

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

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EGBERT LAW OFFICES
412 MAIN STREET, 7TH FLOOR
HOUSTON, TX 77002

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MAY 29 2007

OFFICE OF PETITIONS

In re Patent No. 7,159,709 :
Issue Date: January 9, 2007 :
Application No. 10/517,752 : NOTICE
Filed: December 13, 2004 :
Attorney Docket No. 1429-150

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

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

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

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

Irvin Dingle
Petitions Examiner
Office of Petitions

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HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS TX 75202-3789

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AUG 15 2007

OFFICE OF PETITIONS

In re Application of :

**WATSON**, et al. :
Application No. 10/517,755 : DECISION ON PETITION
Filed: October 12, 2005 : TO WITHDRAW
Attorney Docket No. **25791.108.05** : 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 18, 2007.

The request is **NOT APPROVED.**

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

The request cannot be approved because no reasons for withdrawal have been provided. The Office cannot, at this time, determine whether practitioner's request is one of the mandatory or permissive reasons enumerated in 37 CFR 10.40. Any subsequent requests must include reasons for withdrawal. Please note that there is a space provided for on PTO/SB/83 (Request to Withdraw as Attorney or Agent) to supply practitioner's reasons.

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

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **TODD MATTINGLY**
**KING & SPALDING LLP**
**1100 LOUISIANA STREET, SUITE 400**
**HOUSTON, TX 77002**

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OFFICE OF PETITIONS

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

In re Application of :
**BRUNNER,** Andreas et al. :
Application No. 10/517,756 : DECISION ON PETITION
Filed: August 02, 2005 : TO WITHDRAW
Attorney Docket No. **U 015531-8** : 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 17, 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 Tredelle Jackson at 571-272- 2783.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **ANDREAS BRUNNER**
**NEUGUTSTRASSE 5**
**CH-8425 OBEREMBRACH, SWITERLAND**

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

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APR 15 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,662,047 | : | |
| Issue Date: February 16, 2010 | : | |
| Application No. 10/517,767 | : | ON PETITION |
| Filed: December 23, 2004 | : | |
| Attorney Docket No. 100341-00057 | : | |

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

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

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

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

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

Joan Olszewski
Petitions Examiner
Office of Petitions

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

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JAN 23 2009

OFFICE OF PETITIONS

In re Application of :
Saeed R. Khan :
Application No. 10/517,781 : DECISION ON PETITION
Filed: April 20, 2005 : TO WITHDRAW
Attorney Docket No. 018890-000810US : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 3, 2008.

The request is **moot because a revocation of power of attorney has been filed**.

A review of the file record indicates that the power of attorney to Kenneth E. Jenkins and all attorneys/agents of record have been revoked by the assignee of the patent application on January 6, 2009, 2008. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: DLA Piper LLP (US)
4365 Executive Drive
Suite 1100
San Diego, CA 92121-2133

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103 East Neck Road
Huntington NY 11743

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MAR 31 2008

OFFICE OF PETITIONS

In re Application of :
Stroebel, et al. :
Application No. 10/517,789 : DECISION ON PETITION
Filed: December 13, 2004 :
Attorney Docket No. 3085 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 18, 2007, to revive the above-identified application.

The petition is 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.

In accordance with 37 CFR 1.33(b), "[a]mendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by: (1) A patent practitioner of record appointed in compliance with § 1.32(b); (2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34; (3) An assignee as provided for under § 3.71(b) of this chapter; or (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter."

The instant petition bears an illegible signature and does not set forth the name of the person executing the petition. Accordingly, it cannot be determined that the petition has been properly executed in accordance with 37 CFR 1.33(b).

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

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

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

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Striker Striker & Stenby
103 East Neck Road
Huntington NY 11743

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JUN 20 2008

In re Application of :
Stroebel, et al. :
Application No. 10/517,789 : DECISION ON PETITION
Filed: December 13, 2004 :
Attorney Docket No. 3085 :

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed April 21, 2008 to revive the above-identified application.

This application became abandoned April 20, 2007 for failure to timely submit a proper reply to the non-final Office action mailed January 19, 2007. The non-final Office action set a three month shortened statutory period of time for reply. Notice of Abandonment was mailed September 18, 2007.

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

The instant petition has been carefully reviewed and found in compliance with the above set forth requirements.

In view thereof, the petition is hereby **GRANTED**.

This application is being forwarded to Technology Center 3600 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

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SUITE 1800
SALT LAKE CITY UT 84111

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OFFICE OF PETITIONS

In re Application of :
Martin Vido :
Application No. 10/517,795 :
Filed: December 13, 2004 :
Attorney Docket No. 14223.10 :

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 4, 2008, to revive the above-identified application.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. In accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts. However, if petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. A courtesy copy of this decision is being mailed to petitioner. Nevertheless, all future correspondence regarding this application file will be directed solely to the address of record until otherwise instructed.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must so notify the Office.

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed February 14, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 15, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application under 37 CFR 1.53(b); (2) the petition fee of $1540; and (3) a proper statement of unintentional delay.

The petition is **GRANTED**.

This application is being revived solely for purposes of continuity. As continuity has been established by this decision, the application is again abandoned in favor of continuing application No. 12/191,398.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: EVAN R. WITT
60 EAST SOUTH TEMPLE
1800 EAGKE GATE TOWER
SALT LAKE CITY, UT 84111

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Robin L. Teskin
Crowell & Moring, LLP
Intellectual Property Group
P.O. Box 14300
Washington, D.C. 20044-4300

| | | |
|---|---|---|
| In re Application of | : | |
| SETH et al. | : | |
| Application No.: 10/517,809 | : | DECISION ON PETITION |
| PCT No.: PCT/US03/04866 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 21 February 2003 | : | |
| Priority Date: 21 February 2002 | : | |
| Attorney Docket No.: 100338.54173US | : | |
| For: MODIFIED RELEASE FORMULATION OF AT LEAST ONE FORM OF TRAMADOL | | |

The petition to revive under 37 CFR 1.137(b) filed 13 December 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has submitted the basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration is required.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

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JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Greg Swords | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7655047 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/517,843 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/12/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **220** 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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POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Arvo Jonkka | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7584772 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/517,845 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/15/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **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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#4

Mark Chao, Ph.D.
Takeda Pharmaceuticals North America, Inc.
475 Half Day Road
Lincolnshire, IL 60069

In re Application of
KAMIYAMA, et al.
Application No.: 10/517,847
PCT No.: PCT/JP03/07545
Int. Filing Date: 13 June 2003
Priority Date: 14 June 2002
Atty. Docket No.: 3082US0P
For: PRODRUG AND PROCESS FOR PRODUCING SAME

DECISION ON PETITION

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 24 June 2005 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National Fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

The application has an international filing date of 13 June 2003 under 35 U.S.C. 363 and will be given a date of **24 June 2005** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

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PASADENA CA 91109-7068

MAILED

JAN 06 2010

OFFICE OF PETITIONS

In re Application of :
Frederick L. Jordan :
Application No. 10/517,901 :
Filed: December 10, 2004 :
Attorney Docket No. HO-P03088US2 :

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b) filed November 6, 2009, which is being treated as a request to withdraw from employment in a proceeding before the Office under 37 C.F.R. § 10.40.

The request is **DISMISSED**.

A review of the file record indicates that David A. Plumley does not have power of attorney in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

The request to change the correspondence address of record is not accepted in view of David A. Plumley not having power of attorney. See MPEP §§ 601.03 and 405.

Accordingly, all future communications from the Office will be directed solely to the current address of record until proper instructions have been received.

Additionally, petitioner contends that "A Power of Attorney by Assignee was filed on October 22, 2007 appointing the practitioners associated with Customer Number 23363." However, the request by the assignee, did not comply with 37 CFR 3.73(b). 37 CFR 3.73(b) provides that: (1) when an assignee seeks to take action in a matter before the Office, the assignee must establish its ownership of the property to the satisfaction of the Commissioner; (2) ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment submitted for recording) or by specifying (*e.g.*, reel and frame number) where such evidence is recorded in the Office; (3) the submission establishing ownership must be signed by a party authorized to act on behalf of the assignee; and (4) documents

submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office.

> *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.*

Therefore, as there is currently no Statement under 37 CFR 3.73(b) of record in the instant application, the Office cannot accept the October 22, 2007 Power of Attorney by Assignee.

Currently, a Notice of Appeal was filed in the above-identified application on June 4, 2009.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-7751.

Joan Olszewski
Petitions Examiner
Office of Petitions

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KLARQUIST SPARKMAN, LLP
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SUITE 1600
PORTLAND OR 97204

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AUG 31 2009

OFFICE OF PETITIONS

In re Application of :
Heinrich, et al. :
Application No. 10/517,905 : ON APPLICATION FOR
Filed: December 10, 2004 : PATENT TERM ADJUSTMENT
Atty Docket No. 899-65892-02 :

This is in response to the PETITION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.705(b), filed May 14, 2009. Applicants submit that the correct patent term adjustment to be indicated on the patent is at least nine hundred eighty-nine (989) days, not four hundred sixty-nine (469) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request 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 patentees are entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the

initial determination of patent term adjustment and a projected issuance date of the patent 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, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

---

[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.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Shirene Willis Brantley at (571) 272-3230.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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121 SW SALMON STREET
SUITE 1600
PORTLAND OR 97204

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MAR 26 2010

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| | | |
|---|---|---|
| In re Heinrich et al. | : | DECISION ON REQUEST |
| Patent No. 7,595,154 | : | FOR |
| Issue Date: September 29, 2009 | : | RECONSIDERATION OF |
| Application No. 10/517,905 | : | PATENT TERM ADJUSTMENT |
| Filed: December 10, 2004 | : | AND |
| Attorney Docket No. 899-65892-02 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on November 24, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand one hundred twenty-seven (1127) 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 one hundred twenty-seven (1127) days is **GRANTED to the extent indicated herein.**

The period of B delay in this case is 659 days, not 658 days as asserted by patentees. In an international application, the B period of delay is based on the failure of the Office to issue a patent within three years after the national stage commences under 35 U.S.C. 371(b) or (f). *See* 1.702(b). The national stage commenced in this application on December 10, 2004. Thus, period of B delay is 659 days, which is the number of days beginning on December 11, 2007, the day after the date three years after the date of commencement, and ending on September 29, 2009, the date the patent issued. *See* 1.703(b).

Patentees' assertion the patent term adjustment is 1127 days is based in part on an assertion the period of B delay is 658 days. The period of B delay is actually 659 days. As a result, the patent term adjustment is 1128, not 1127 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 37 CFR § 1.136.

Pursuant to patentees' authorization, deposit account no. 02-4550 will be charged the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand one hundred twenty-eight (1128)** days.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Shirene Willis Brantley at (571) 272-3230.

Anthony Knight
Supervisor
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,595,154 B2

DATED : **September 29, 2009** **DRAFT**

INVENTOR(S) : Heinrich 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 U.S.C. 154(b) by 535 days

Delete the phrase "by 535 days" and insert – by 1128 days--

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NXP INTELLECTUAL PROPERTY DEPARTMENT
M/S41-SJ
1109 MCKAY DRIVE
SAN JOSE, CA 95131

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OFFICE OF PETITIONS

In re Application of

Johannes H. A. Brekelmans :

Application No. 10/517,921

: DECISION ON PETITION

Filed: December 14, 2004

:

Attorney Docket No. NL02 0503 US

This is a decision on the petition under 37 CFR 1.137(b), filed September 13, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the Office action mailed March 6, 2007, which set a shortened period for reply of one (1) month from its mailing date. No extension of time pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the application became abandoned on April 7, 2007. A Notice of Abandonment was mailed on July 13, 2007.

The amendment filed September 13, 2007, is noted.

Deposit account 50-4019 will be charged $1,500.00 for the instant petition fee.

The application is being forwarded to Technology Center 2600, GAU 2618 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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| | | |
|---|---|---|
| In re Application of | : | |
| Manger et al. | : | |
| Application No. 10/517,942 | : | NOTICE |
| Filed: 08/04/2005 | : | |
| Attorney Docket No. 20174-008610US | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed on 5 January, 2006. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3231.

Douglas I. Wood
Attorney
Office of Petitions

16 JUN 20

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Mara E. Liepa
Merchant & Gould
P.O. Box 2903
Minneapolis, MN 55402-0903

| | | |
|---|---|---|
| In re Application of | : | |
| MCCLURKEN, et al. | : | DECISION ON PETITION |
| Application No.: 10/517,947 | : | |
| PCT No.: PCT/US03/15340 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 15 May 2003 | : | |
| Priority Date: 16 May 2002 | : | |
| Attorney Docket No.: 13045.36USWO | : | |
| For: FLUID-ASSISTED MEDICAL DEVICES, SYSTEMS AND METHODS | : | |

The petition to revive under 37 CFR 1.137(b) filed 14 December 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay from November 16, 2004 until the filing of this petition and the U.S. National Stage application was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. basic national fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for the preparation and mailing of a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant that an executed oath or declaration of the inventors and payment of the appropriate surcharge is required.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

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LADAS & PARRY LLP
26 WEST 61ST STREET
NEW YORK NY 10023

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| | | |
|---|---|---|
| In re Application of | : | |
| Momose et al. | : | |
| Application No. 10/517951 | : | DECISION |
| Filing or 371(c) Date: 05/02/2005 | : | ON PETITION |
| Patent No.: 7220304 | : | |
| Issue Date: 05/22/2007 | : | |
| Attorney Docket Number: U 015525-3 | : | |

This is a decision on the Petition for Correction of Assignee's Name, filed June 14, 2007, to correct the name of the assignee on the front page of the above-identified patent, and to correct an additional error putatively the fault of this Office, by way of a Certificate of Correction. The delay in treating this petition is regretted.

The Petition is **granted to the extent indicated herein**.

The petition was accompanied by a certificate of correction as required by 3.81(b), and the certificate of correction and processing fee. Further, Office assignment records reflect that SEIKO EPSON CORPORATION, and ORIENT CHEMICAL INDUSTRIES, LTD., are the assignees of record. As the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to correct the name of the assignee on the front page of the above-identified patent, to be processed.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for consideration of the additional error putatively the fault of this Office that was included on the Certificate of Correction filed with the present petition on May 10, 2007.

/Derek L. Woods/
Derek L. Woods
Attorney
Office of Petitions

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**OFFICE OF PETITIONS**

In re Patent No. 7,590,587 :
Duquette :
Issue Date: September 15, 2009 :
Application No. 10/517,960 : DECISION ON REQUEST FOR
Filed: December 14, 2004 : RECONSIDERATION OF
Attorney Docket No. 05-1124 : PATENT TERM ADJUSTMENT
Title: SYSTEM AND METHOD FOR :
ANALYZING AND DISPLAYING :
SECURITY TRADE TRANSACTIONS :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT", filed October 7, 2009. This petition is properly treated under 37 CFR 1.705(d). Patentee requests the final PTA calculation to increase total PTA from 528 days to 1,154 days.

The application for reconsideration of patent term adjustment is **Dismissed**.

The above-identified application matured into U.S. Patent No. 7,590,587 on September 15, 2009. The patent issued with a patent term adjustment of 528 days. This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See, 37 CFR 1.705(d).

Patentee requests recalculation of the patent term adjustment based on the decision in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentee asserts entitlement to an additional adjustment of 626 days of "B delay." Thus, patentee requests that the determination of patent term adjustment be increased to a total of one thousand one hundred fifty-four (1154) days (the sum of the period of three-year delay (641 days) and the period of examination delay (683 days)

minus overlap (15 days) minus applicant's delay (155 days)). Patentee does not dispute the 155-day reduction for applicant delay.

As stated in 37 CFR 1.703(b), the period of adjustment under § 1.702(b) is the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the periods under § 1.703(b)(1)-(4). The date of completion of all 35 U.S.C. 371 requirements, December 14, 2004, is the date used in calculating examination delay under 37 CFR 1.703(a), the date the national stage commenced under 35 U.S.C. 371(f), Tuesday, December 14, 2004, is used in determining the Three Year Delay under 37 CFR 1.703(b).

National stage commenced December 14, 2004. Accordingly, at the time of issuance of the patent, the application was pending three years and 641 days, December 15, 2007 to September 15, 2009.

At issue is whether patentees should accrue 641 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 683 days for Office failure to take certain actions within specified time frames (or examination delay).

The Office contends that the entire 641-day period of delay in issuance of the patent overlaps with the period of 683 days of examination delay. Patentee's 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. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

As 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 commenced 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 commenced, December 14, 2004, until the issuance of the patent on September 15, 2009. 683 days of patent term adjustment were accorded for Office delay pursuant to 37 CFR §1.702(a)(1) and (a)(2). Entry of both 641 days pursuant to 37 CFR §1.702(b) and 683 days pursuant to 37 CFR §1.702(a) is neither permitted nor warranted. The Office did not delay 683 days and then delay another 641 days. The greater period, 683 days, is the actual number of days issuance of the patent was delayed by the Office.

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment.

In view thereof, no adjustment 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 Petitions Attorney Charlema Grant, at (571) 272-3215.

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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MBHB/TRADING TECHNOLOGIES
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO, IL 60606

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Douglas Ray Duquette | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7590587 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/517,960 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/14/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1127** 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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SUITE 3200
CHICAGO, IL 60606

Mail Date: 05/17/2010

**Applicant** : Douglas Ray Duquette
**Patent Number** : 7590587
**Issue Date** : 09/15/2009
**Application No**: 10/517,960
**Filed** : 12/14/2004

: 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 **1154** 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).

04 AUG 2005

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Edward P. Dutkiewicz
640 Douglas Avenue
Dunedin, Florida 34698

In re Application of
MORATALLA
Application No.: 10/517,967
PCT No.: PCT/US03/03729
Int. Filing Date: 06 February 2003
Priority Date: 06 February 2002
Atty. Docket No.: MD82/04
For: DESICCANT DEHUMIDIFICATION SYSTEM

DECISION ON PETITION

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 14 December 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National Fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

The application has an international filing date of 17 June 2002 under 35 U.S.C. 363 and will be given a date of **14 December 2004** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the United States Designated/Elected Office (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

#5

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12 JAN 2006

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HAMRE, SCHUMANN, MUELLER & LARSON, P.C.
P.O. BOX 2902-0902
MINNEAPOLIS, MN 55402

| | |
|---|---|
| In re Application of<br>KREUTER<br>Application No.: 10/517,969<br>PCT No.: PCT/EP03/06249<br>Int. Filing Date: 13 June 2003<br>Priority Date: 13 June 2002<br>Attorney Docket No.: 02968.268USWO<br>For: PROTECTIVE COATING FOR DOCUMENTS | DECISION ON<br><br>PETITION UNDER<br><br>37 CFR 1.47(b) |

This is a decision on applicant's "PETITION UNDER 37 CFR §1.47(b)" filed in the United States Patent and Trademark Office (USPTO) on 10 August 2005.

## BACKGROUND

On 13 June 2003, applicants filed international application PCT/EP03/06249, which claimed a priority date of 13 June 2002. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 24 December 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 13 December 2004.

On 13 December 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 unexecuted declaration of the inventor.

On 15 June 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 inventor in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required. The NOTIFICATION set a two-month extendable period for reply.

On 10 August 2005, applicants submitted the instant petition under 37 CFR 1.47(b), which was accompanied by, *inter alia*: a declaration of inventor executed by Dennis J. Warwick as representative of the non-signing inventor; a declaration of facts from Cassandra Voigt; Federal Express tracking reports; a copy of a translated redacted employment contract between Mr. Kreuter and DataCard Deutschland Gmbh of Dusseldorf Germany (hereinafter "DC Germany"); a

declaration of facts by Heiner Bohnsack; a declaration of facts by James A. Larson; and an authorization from a Corporate Attorney of DataCard Corporation of Minnetonka, Minnesota (hereinafter "DCC") for Dennis J. Warwick to sign on behalf of DCC.

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Items (1), (2), (3), (5) and (6) have been met. 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 50-3478.

Item (4) has not been met. Authorization for Dennis J. Warwick to sign the declaration of inventors on behalf of DCC is given by Cassandra Voigt, identified as a "corporate attorney." However, a corporate attorney is not an officer of the company. See MPEP § 409.03(b).

## CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

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

12 MAY 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of<br>KREUTER<br>Application No.: 10/517,969<br>PCT No.: PCT/EP03/06249<br>Int. Filing Date: 13 June 2003<br>Priority Date: 13 June 2002<br>Attorney Docket No.: 02968.268USWO<br>For: PROTECTIVE COATING FOR DOCUMENTS | :<br>:<br>:<br>:<br>:<br>:<br>:<br>:<br>:<br>: | DECISION ON<br><br>PETITION UNDER<br><br>37 CFR 1.47(b) |

This is a decision on applicant's "RENEWED PETITION UNDER 37 CFR §1.47(b)" filed via facsimile transmission in the United States Patent and Trademark Office (USPTO) on 13 March 2006.

## BACKGROUND

On 13 June 2003, applicants filed international application PCT/EP03/06249, which claimed a priority date of 13 June 2002. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 24 December 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 13 December 2004.

On 13 December 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 unexecuted declaration of the inventor.

On 15 June 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 inventor in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required. The NOTIFICATION set a two-month extendable period for reply.

On 10 August 2005, applicants submitted a petition under 37 CFR 1.47(b), which was accompanied by, *inter alia*: a declaration of inventor executed by Dennis J. Warwick as representative of the non-signing inventor; a declaration of facts from Cassandra Voigt; Federal Express tracking reports; a copy of a translated redacted employment contract between Mr.

Kreuter and DataCard Deutschland Gmbh of Dusseldorf Germany (hereinafter "DC Germany"); a declaration of facts by Heiner Bohnsack; a declaration of facts by James A. Larson; and an authorization from a Corporate Attorney of DataCard Corporation of Minnetonka, Minnesota (hereinafter "DCC") for Dennis J. Warwick to sign on behalf of DCC.

On 12 January 2006 (the date-stamp mistakenly indicates the date as 12 January 2005), a decision was mailed dismissing applicant's petition under 37 CFR 1.47(b) without prejudice. Specifically, it was noted that applicant failed to provide an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor. In particular, it was noted that it was not clear that the person signing the declaration on behalf of the 37 CFR 1.47(b) applicant did not have authorization.

On 13 March 2006, applicant filed the instant renewed petition under 37 CFR 1.47(b) which was accompanied by a declaration of Andrea Snook.

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

As noted in the decision mailed 12 January 2006, items (1), (2), (3), (5) and (6) have been met.

Item (4) has now been met as well. Authorization for Dennis J. Warwick to sign the declaration of inventors on behalf of DCC is given by Andrea Snook, identified as a "Secretary", i.e., an officer of the company. See MPEP § 409.03(b).

## CONCLUSION

For the above reasons, applicants' renewed petition under 37 CFR 1.47(b) is **GRANTED**.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office

of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of **10 August 2005**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
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12 MAY 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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Rudiger Kreuter
Heinrich-Delp-Str. 290
64297 Darmstadt
Germany

In re Application of
KREUTER, Rudiger
Application No.: 10/517,969
PCT No.: PCT/EP03/06249
Int. Filing Date: 13 June 2003
Priority Date: 13 June 2002
Attorney Docket No.: 02968.268USWO
For: PROTECTIVE COATING FOR DOCUMENTS

Dear Mr. Kreuter:

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. 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
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23 FEB 2006

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| | | |
|---|---|---|
| In re Application of | : | |
| TRIFONI, et al. | : | DECISION ON PETITION |
| Serial No.: 10/517,982 | : | |
| PCT No.: PCT/EP03/06327 | : | UNDER 37 CFR 1.47(a) |
| Int. Filing Date: 16 June 2003 | : | |
| Priority Date: 17 June 2002 | : | |
| Atty Docket No.: 267.184 | : | |
| For: MEMBRANE ELECTROCHEMICAL GENERATOR | : | |

This decision is in response to applicant's "PETITION UNDER RULE 47(a)" filed 09 June 2005 to accept the application without the signatures of joint inventors, Eduardo Trifoni and Matteo Lenardon.

## BACKGROUND

On 16 June 2003, applicant filed international application PCT/EP03/06327 which claimed priority to a previous application filed 17 June 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, 17 December 2004.

On 13 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; a preliminary amendment; and an Information Disclosure Statement. In addition, applicant filed combined declaration and power of attorney executed by seven of the nine inventors listed on the published international application.

On 09 June 2005, applicant filed the present petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Eduardo Trifoni and Matteo Lenardon.

On 13 July 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

## 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 (3) and (4).

Regarding item (1), applicant has only provided payment of $130.00 for the petition fee. Applicants are advised that pursuant to 37 CFR 1.17(g) the petition fee is $200.00.

Regarding item (2) above, petitioner states that Eduardo Trifoni and Matteo Lenardon have 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.

Petitioner states that Eduardo Trifoni and Matteo Lenardon have refused to sign the application. A review of the present petition reveals that applicant has not satisfied item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, drawings, and

oath/declaration to Eduardo Trifoni and Matteo Lenardon. The declaration of Annie Tuosto states that she mailed a copy of the application and an assignment document to Mr. Trifoni on 08 July 2004 and Mr. Lenardon on 09 September 2004. Both sets of papers were mailed prior to applicant entering the national stage in the United States and do not appear to have contained a declaration for the purposes of entering the national stage in the United States but merely an assignment document. As detailed above, the inventors must be presented with an oath or declaration for execution. As to Mr. Lenardon, his silence cannot be constituted as a refusal in the immediate circumstances as it is unclear whether he received the papers and whether they did in fact contain an oath or declaration for execution. In cases where it is argued that the non-action of an inventor should be considered a refusal to cooperate it is especially important to provide proof of delivery of the papers, as well as, a firsthand statement of the preparation and mailing of the papers.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, drawings and oath/declaration) were sent to Eduardo Trifoni and Matteo Lenardon, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration. All documentary evidence should be translated into English.

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)." Applicant is advised that in order for the renewed petition to be considered applicant must provide payment of the remaining $70.00. 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.

Anthony Smith

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29 AUG 2006

#15

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of :
TRIFONI, et al. : DECISION ON PETITION
Serial No.: 10/517,982 :
PCT No.: PCT/EP03/06327 : UNDER 37 CFR 1.47(a)
Int. Filing Date: 16 June 2003 :
Priority Date: 17 June 2002 :
Atty Docket No.: 267.184 :
For: MEMBRANE ELECTROCHEMICAL :
GENERATOR :

This decision is issued in response to applicant's "Renewed Petition Under Rule 37 CFR 1.47(a)" filed 10 May 2006 to accept the application without the signatures of joint inventors, Eduardo Trifoni and Matteo Lenardon.

## BACKGROUND

On 16 June 2003, applicant filed international application PCT/EP03/06327 which claimed priority to a previous application filed 17 June 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, 17 December 2004.

On 13 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; a preliminary amendment; and an Information Disclosure Statement. In addition, applicant filed combined declaration and power of attorney executed by seven of the nine inventors listed on the published international application.

On 09 June 2005, applicant filed a petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Eduardo Trifoni and Matteo Lenardon.

On 13 July 2005, applicant was mailed a "Notification of Missing Requirements under 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

In a Decision dated 23 February 2006, applicant's petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 10 May 2006, applicant filed a renewed petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Eduardo Trifoni and Matteo Lenardon.

## 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), (3) and (4).

Regarding item (2) above, petitioner states that Eduardo Trifoni and Matteo Lenardon have 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. Eduardo Trifoni

Petitioner states that Eduardo Trifoni has refused to sign the application. A review of the present petition reveals that applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, drawings, and oath/declaration to Eduardo Trifoni. The declaration of Annie Tuosto states that she mailed a copy of the application and an assignment document to Mr. Trifoni on 08 July 2004. As stated in the previous decision, the application papers were mailed prior to applicant entering the national stage in the United States and do not appear to have contained a declaration for the purposes of entering the national stage in the United States but merely an assignment document. Further, it appears from Eduardo Trifoni's letter dated 27 November 2004 that he is refusing to execute the assignment. The refusal to sign the assignment is not a refusal to execute the application. As detailed above, the inventors must be presented with an oath or declaration for execution.

B. Matteo Lenardon

Petitioner states that Matteo Lenardon has refused to sign the application. A review of the present petition reveals that applicant has shown that a bona fide attempt was made to present the application papers, including the specification, claims, drawings, and oath/declaration to Matteo Lenardon. The declaration of Annie Tuosto states that she mailed a copy of the application and an assignment document to Mr. Lenardon on 09 September 2004. As stated in previous decision, the application papers were mailed prior to applicant entering the national stage in the United States and do not appear to have contained a declaration for the purposes of entering the national stage in the United States. As detailed above, the inventors must be presented with an oath or declaration for execution. Further, it is unclear whether Matteo Lenardon was refusing to execute the application or the assignment. It is noted that a complete translation of the 09 September 2004 has not been provided.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, drawings and oath/declaration) were sent to Eduardo Trifoni and Matteo Lenardon, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

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)." 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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16 MAR 2007

#17

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| In re Application of | : | |
| TRIFONI, et al. | : | DECISION ON PETITION |
| Serial No.: 10/517,982 | : | |
| PCT No.: PCT/EP03/06327 | : | UNDER 37 CFR 1.47(a) |
| Int. Filing Date: 16 June 2003 | : | |
| Priority Date: 17 June 2002 | : | |
| Atty Docket No.: 267.184 | : | |
| For: MEMBRANE ELECTROCHEMICAL GENERATOR | : | |

This decision is issued in response to applicant's (second) "Renewed Petition Under Rule 37 CFR 1.47(a)" filed 31 January 2007 to accept the application without the signatures of joint inventors, Eduardo Trifoni and Matteo Lenardon. Additionally, this decision is issued in response to applicant's "Petition under 37 CFR 1.182" filed 08 March 2007.

## BACKGROUND

On 16 June 2003, applicant filed international application PCT/EP03/06327 which claimed priority to a previous application filed 17 June 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, 17 December 2004.

On 13 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; a preliminary amendment; and an Information Disclosure Statement. In addition, applicant filed a declaration and power of attorney executed by seven of the nine inventors listed on the published international application.

On 09 June 2005, applicant filed a petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Eduardo Trifoni and Matteo Lenardon.

On 13 July 2005, applicant was mailed a "Notification of Missing Requirements under 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing

date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

In a Decision dated 23 February 2006, applicant's petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 10 May 2006, applicant filed a renewed petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Eduardo Trifoni and Matteo Lenardon. In a Decision dated 29 August 2006, applicant's petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 31 January 2007, applicant filed a second renewed petition under 37 CFR 1.47(a).

On 08 March 2007, applicant filed a "Petition under 37 CFR 1.182."

## DISCUSSION

A. Petition under 37 CFR 1.181

Applicant states in their present petition that a renewed petition under 37 CFR 1.47(a) was received by the USPTO on 17 October 2006. A review of the application file reveals that the renewed petition under 37 CFR 1.47(a) is not located therein. Section 503 of the Manual of Patent Examining Procedure under the heading "Return Postcard" states, in part:

> "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

Here, applicants have provided a copy of their date-stamped filing receipt. The receipt identifies the application by the title of invention; applicant's name; and docket number. The evidence submitted by applicants, consisting of a postcard receipt with a PCT/PTO mailroom date stamp of 17 October 2006 which itemizes all the papers filed on said date. The postcard receipt bearing the applicant's name, title of invention, and attorney docket number is sufficient to indicate that the above papers were received on 17 October 2006.

B. Renewed Petition under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint 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.

A review of the papers filed 31 January 2007 reveals that petitioner has paid the requisite petition fee, provided sufficient proof that the non-signing inventor (Eduardo Trifoni and Matteo Lenardon) refused to sign, stated the last known address of the non-signing inventor (Eduardo Trifoni and Matteo Lenardon), and provided an acceptable declaration. Accordingly, all of the requirements of items (1), (2), (3), and (4) above have been satisfied.

C. Petition under 37 CFR 1.182.

Applicant states in the present petition that Antonino Toro (not Toro Antonino as listed on the published international application) is the correct name of the eighth inventor. 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(a) is not required. In that this is clearly more than a mere typographical error or a phonetic misspelling of applicant's given name on the published international application, a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Accordingly, applicant's explanation of the difference in the spelling of the eighth inventor's name is accepted and noted for the record. The petition under 37 CFR 1.182 is granted and the declaration submitted on 13 December 2004 is accepted.

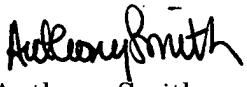
## CONCLUSION

For the reasons above, applicant's petition under 37 CFR 1.47(a) is **GRANTED**.

Applicant's petition under 37 CFR 1.181 and 37 CFR 1.182 are **GRANTED**.

The application has an international filing date of 16 June 2003 under 35 U.S.C. 363, and will be given a date of 13 December 2004 under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record. A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.



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28 FEB 2006

#7

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6th Floor, 330 University Avenue
Toronto, Ontario
CANADA, M5G 1R7

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| In re Application of | : | |
| GREEN, et al. | : | DECISION ON PETITIONS |
| Application No.: 10/517,987 | : | |
| PCT No.: PCT/CA03/00934 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 20 June 2003 | : | |
| Priority Date: 20 June 2002 | : | AND 37 CFR 1.47(a) |
| Attorney Docket No.: 7865-218 MIS:jb | : | |
| For: COLOUR REDUCTION IN CANOLA PROTEIN ISOLATE | : | |

This decision is in response to applicant's filing of 16 January 2006 in the United States Patent and Trademark Office (USPTO). The filing includes a petition under 37 CFR 1.137(b) for revival of the present application and a petition under 37 CFR 1.47(a) to accept the application without the signature of inventor Lei Xu.

## BACKGROUND

On 20 June 2003, applicant filed international application PCT/CA03/00934 which claimed priority to an earlier application filed 20 June 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 31 December 2003. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States was set to expire at midnight on 20 December 2004.

On 15 December 2004, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and an Application Data Sheet. An executed oath or declaration of the inventors as required by 35 U.S.C. 371 (c)(4) was not filed.

On 13 June 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) advising applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. Applicant was afforded two months to file the proper reply and advised that this time could be extended with a petition and payment of the appropriate extension of time fee.

On 16 January 2006, applicant filed the present response including the petitions under 37

CFR 1.137(b) and 37 CFR 1.47(a) considered herein.

## DISCUSSION

### I. Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the requisite $200 petition fee required by 37 CFR 1.17(g); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; and (4) an oath or declaration executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor(s). Items 1-3 above have been satisfied.

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, applicant filed declarations executed by three of the four inventors with the signature block of the nonsigning inventor Lei Xu left blank. Additionally, applicant included a second set of declarations signed by inventors Brent E. Green and Kevin Segall where their signature blocks were amended to show that they were executing the declaration on behalf of Lei Xu. As stated by applicant, a similar declaration executed by inventor Radka Milanova has not been filed. Because applicant submitted the declarations specifically executed on behalf of Lei Xu by two of the three joint inventors, the presumption that Radka Milanova, Brent E. Green and Kevin Segall executed the declaration on their own behalf and on behalf of Lei Xu cannot be applied to the original set of declarations. In order to proceed, applicant must submit a declaration executed by Lei Xu, thus perfecting the original set of declarations; a declaration executed by Radka Milanova on behalf of Lei Xu or a declaration executed by Brent E. Green and Kevin Segall on behalf of Radka Milanova; along with a sufficient showing that the inventor could not be located or refused to execute the declaration. Until one of said declarations is submitted, item (4) is not satisfied.

For the reasons stated above it is not possible to grant applicant's petition under 37 CFR 1.47(a) at this time.

### II. Petition Under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the

petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required). Applicant has satisfied items 2-4.

With regard to item 1, the proper response was the submission of an executed oath or declaration of the inventors which complies with 37 CFR 1.497 (a) and (b) or a grantable petition under 37 CFR 1.47. As discussed above, applicant has not submitted a compliant declaration or grantable petition under 37 CFR 1.47(a).

For the reasons stated above, the petition for revival cannot be granted at this time and the application remains abandoned.

## CONCLUSION

For the reasons stated above, the petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a) are **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b) and Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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28 AUG 2006

#9

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28 AUG 2006

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CANADA, M5G 1R7

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|---|---|---|
| In re Application of | : | |
| GREEN, et al. | : | DECISION ON RENEWED |
| Serial No.: 10/517,987 | : | |
| PCT No.: PCT/CA03/00934 | : | PETITION UNDER |
| Int. Filing Date: 20 June 2003 | : | |
| Priority Date: 20 June 2002 | : | 37 CFR 1.47(a) AND |
| Atty Docket No.: 7865-218 MIS:jb | : | |
| For: COLOUR REDUCTION IN CANOLA PROTEIN ISOLATE | : | 37 CFR 1.137(b) |

This decision is in response to applicant's "Renewed Petition Under 37 C.F.R. 1.137(b) and Renewed Petition Under 37 C.F.R. 1.47(a)" filed 05 May 2006.

## BACKGROUND

On 28 February 2006, applicant was mailed a decision dismissing applicant's petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a). 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 05 May 2006, applicant filed the present renewed petition under 37 CFR 1.137(b) and 37 CFR 1.47(a) accompanied by a petition for a one-month extension of time and payment of the appropriate extension of time fee. Applicant's renewed petitions are therefore timely filed.

## DISCUSSION

### I. Renewed Petition Under 37 CFR 1.47(a)

As detailed in the decision mailed 28 February 2006, a petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant previously satisfied items 1-3 as to non-signing inventor Lei Xu.

Applicant has presently submitted declarations executed by joint inventors Brent E. Green and Kevin I. Segall executed on behalf of joint inventor Radka Milanova. Applicant previously submitted declarations executed by Brent E. Green, Kevin I. Segall and Radka Milanova with the signature space for Lei Xu left blank, as well as, declarations executed by Brent E. Green and Kevin I. Segall executed on behalf of Lei Xu. The combination of these declarations prefects the requirements of 37 CFR 1.497(a)-(b).

Applicant's original petition included an e-mail from Ms. Margo Osinski detailing her firsthand attempts to obtain the signature of Radka Milanova on the declaration being executed on behalf on Lei Xu. It is clear from her execution of the original declaration that Ms. Milanova understood which application she was being asked to execute. Ms. Osinski states that she sent the documents to Ms. Milanova and confirmed receipt by her through e-mail. To date Ms. Milanova has not returned the declaration executed on behalf of Lei Xu. As such, her silence constitutes a refusal to execute on behalf of Lei Xu and it is proper to grant applicant's renewed petition at this time.

**II. Renewed Petition Under 37 CFR 1.137(b)**

As applicant has supplied the proper reply in the form of a granted renewed petition under 37 CFR 1.47(a) it is proper to grant applicant's renewed petition under 37 CFR 1.137(b) at this time.

**CONCLUSION**

For the reasons discussed above, applicant's renewed petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a) are **GRANTED**.

The application has an international filing date of 20 June 2003 under 35 U.S.C. 363, and will be given a date of **05 May 2006** 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.

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28 AUG 2006

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CANADA

In re Application of
GREEN, et al.
Serial No.: 10/517,987
PCT No.: PCT/CA03/00934
Int. Filing Date: 20 June 2003
Priority Date: 20 June 2002
Atty Docket No.: 7865-218 MIS:jb
For: COLOUR REDUCTION IN CANOLA PROTEIN ISOLATE

Dear Mr. Xu:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor. As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternately, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, the law firm of record (see below) would presumably assist you. Joining in the application would entail the filing of the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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**OFFICE OF PETITIONS**

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DALLAS TX 75202-3789

In re Application of :
David Paul Briscoe :
Application No. 10/518,000 : DECISION ON PETITION
Filed: December 10, 2004 : TO WITHDRAW
Attorney Docket No. 25791.107.05 : 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 18, 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 undersigned at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: TODD MATTINGLY
KING & SPALDING, LLP
1100 LOUISANIA STREET
SUITE 4000
HOUSTON, TX 77002

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VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Kauko Janka | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7624596 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/01/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/518,006 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/14/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **819** 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.

#6

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12 JAN 2006

Browdy and Neimark, P.L.L.C.
624 Ninth Street, NW
Suite 300
Washington, D.C. 2001-5303

In re Application of
BIKHOVSKY et al.
Application No.: 10/518,022
PCT No.: PCT/IL03/00520
Int. Filing Date: 18 June 2003
Priority Date: 18 June 2002
Attorney Docket No.: BIKHOVSKY2
For: ELECTRICAL HEATING DEVICE, PARTICULARLY FOR HEATING PATIENT BODY

DECISION ON
PAPERS UNDER 37 CFR 1.42

This decision is in response to the declaration filed 26 August 2005, which is being treated as a request under 37 CFR 1.42. No petition fee is required.

## BACKGROUND

On 18 June 2003, applicants filed international application PCT/IL03/00520, which claimed a priority date of 18 June 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 24 December 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, 18 December 2004.

On 15 December 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 30 June 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 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 26 August 2005, applicants filed a declaration executed by: Dirth Bar-Adon as an inventor and Sergey Bihovsky on behalf of the deceased inventor, David Bikhovsky.

## 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 26 August 2005 is executed by Sergey Bihovsky on behalf of the deceased inventor, David Bikhovsky. The declaration submitted appears to have been executed by the proper party under 37 CFR 1.42, however, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

37 CFR 1.497(b)(2) states the following:

> (2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(b)(2), the declaration must also provide residence, citizenship, and post office address for the executor. The declaration filed on 26 August 2005 does not include the residence and post office address for the executor. 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**.

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
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459

24 MAR 2006

#8

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Browdy and Neimark, P.L.L.C.
624 Ninth Street, NW
Suite 300
Washington, D.C. 20001-5303

In re Application of
BIKHOVSKY et al.
Application No.: 10/518,022
PCT No.: PCT/IL03/00520
Int. Filing Date: 18 June 2003
Priority Date: 18 June 2002
Attorney Docket No.: BIKHOVSKY2
For: ELECTRICAL HEATING DEVICE, PARTICULARLY FOR HEATING PATIENT BODY

DECISION ON
PAPERS UNDER 37 CFR 1.42

This decision is in response to applicants' "Reply to Decision of January 12, 2006, and Submission of Declaration under 37 CFR 1.42 and 1.497(b)(2)" filed 10 March 2006, which is being treated as a renewed request under 37 CFR 1.42. No petition fee is required.

## BACKGROUND

On 18 June 2003, applicants filed international application PCT/IL03/00520, which claimed a priority date of 18 June 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 24 December 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, 18 December 2004.

On 15 December 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 30 June 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 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 26 August 2005, applicants filed a declaration executed by: Dirth Bar-Adon as an inventor and Sergey Bikhovsky on behalf of the deceased inventor, David Bikhovsky. In a decision dated 12 January 2006, applicants' request under 37 CFR 1.42 was refused.

On 10 March 2006, 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 submitted on 10 March 2006 is executed by Sergey Bikhovsky as the "executor" of the deceased inventor, David Bikhovsky. The declaration provides the residence, post office address, and country of citizenship for the deceased inventor and the executor. Therefore, the declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b).

## CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

The application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459

#4

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Tracey S. Truitt
Hovey Williams LLP
2405 Grand Blvd., Ste. 400
Kansas City, MO 64108

In re Application of REPASKY et al :
U.S. Application No.: 10/518,038 :
PCT Application No.: PCT/IB03/00695 :
Int. Filing Date: 24 February 2003 : DECISION
Priority Date Claimed: 25 February 2002 :
Attorney Docket No.: 34876-CNT1 :
For: A PROCESS AND APPARATUS FOR THE :
PRODUCTION OF SYNTHESIS GAS :

This is in response to applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 10 December 2004.

## BACKGROUND

On 24 February 2003, applicant filed international application PCT/IB03/00695, which claimed priority of an earlier United States application filed 25 February 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 28 August 2003. The thirty-month period for paying the basic national fee in the United States expired on 25 August 2004.

International application PCT/IB03/00695 became abandoned as to the United States for failure to timely pay the basic national fee.

On 10 December 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 basic national fee under 35 U.S.C. 371.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 24 February 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 10 December 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

19 JUL 2005
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Tracey S. Truitt
Hovey Williams LLP
2405 Grand Blvd., Ste. 400
Kansas City, MO 64108

In re Application of REPASKY et al :
U.S. Application No.: 10/518,038 :
PCT Application No.: PCT/IB03/00695 :
Int. Filing Date: 24 February 2003 : COMMUNICATION
Priority Date Claimed: 25 February 2002 :
Attorney Docket No.: 34876-CNT1 :
For: A PROCESS AND APPARATUS FOR THE :
PRODUCTION OF SYNTHESIS GAS :

This application is before the Office of PCT Legal Administration for consideration of issues arising under 35 U.S.C. 371.

## BACKGROUND

On 24 February 2003, applicant filed international application PCT/IB03/00695, which claimed priority of an earlier United States application filed 25 February 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 28 August 2003. The thirty-month period for paying the basic national fee in the United States expired on 25 August 2004.

International application PCT/IB03/00695 became abandoned as to the United States for failure to timely pay the basic national fee.

On 10 December 2004, applicant filed a petition under 37 CFR 1.137(b).

On 27 May 2005, this Office mailed a decision granting the 10 December 2004 petition and according the application a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 10 December 2004.

## DISCUSSION

A review of the application file reveals that the executed declaration contained therein applies to U.S. Application Number 10/083,778 and not to the present national stage application.

BEST AVAILABLE COPY

Although the present application claims priority to U.S. Application Number 10/083,778, a copy of the declaration for a prior nonprovisional application may not be used for a national stage application. See MPEP 602.05(a), which specifies that a continuation application filed under 37 CFR 1.53(b) may be filed with a copy of a declaration from a prior nonprovisional application. MPEP 201.06(c) states in relevant part, "37 CFR 1.53(b) is the section under which all applications are filed EXCEPT: (1) an application resulting from entry of an international application into the national stage under 35 U.S.C. 371 and 37 CFR 1.494 or 37 CFR 1.495. . . ."

## CONCLUSION

The paragraph in the decision mailed 27 May 2005 specifying the date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is herby VACATED.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this communication, including preparation and mailing of a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which should indicate that an oath or declaration in compliance with 37 CFR 1.497 must be submitted.

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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**MORRISON & FOERSTER, LLP**
**1650 TYSONS BOULEVARD, SUITE 400**
**MCLEAN, VA 22102**

COPY MAILED

FEB 0 4 2008

OFFICE OF PETITIONS

In re Application of :
**ANTARKAR**, et al. :
Application No. 10/518,044 : DECISION ON PETITION
Filed: August 17, 2005 : TO WITHDRAW
Attorney Docket No. **578832000100** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 29, 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 January 29, 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 the undersigned at (571) 272-7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **DARBY & DARBY**
**P O BOX 770**
**CHURCH STREET STATION**
**NEW YORK, NY 10008-0770**

UNITED STATES PATENT AND TRADEMARK OFFICE

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YOUNG & THOMPSON
209 Madison Street
Suite 500
Alexandria, VA 22314

Mail Date: 08/03/2010

| | | |
|---|---|---|
| **Applicant** | : Dominique Ausserre | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7652762 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/518,075 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/02/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1026** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

21 JUN 2005

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Rodney L. Skoglund
Renner, Kenner, Greive,
Bobak, Taylor & Weber
First National Tower, 4th Floor
Akron, OH 44308

| | | |
|---|---|---|
| In re Application of | : | |
| Tsang | : | |
| Application No.: 10/518,086 | : | |
| PCT No.: PCT/GB03/01987 | : | |
| Int. Filing Date: 08 May 2003 | : | DECISION |
| Priority Date: 11 May 2002 | : | |
| Attorney Docket No.: GIL.P.US0032 | : | |
| For: Fitting Protector | : | |

The petition to revive under 37 CFR 1.137(b) filed 07 December 2004 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 required reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." This statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that the basic national fee of $395.00 was provided. The required petition fee has also been paid. Thus, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

Counsel's Deposit Account No. 18-0987 is being charged $65.00 for the surcharge under 37 CFR 1.492(h), as authorized by the Transmittal Letter filed on 07 December 2004.

This application is being forwarded to the United States Designated/Elected Office for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **07 December 2004**.

Boris Milef
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3283
Fax: (571) 273-0459

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Paper No.

OBLON, SPIVAK, MCCLELLAND
MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

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JUL 23 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,445,161 | : | |
| Fujio Inoue | : | DECISION DISMISSING |
| Application No. 10/518,087 | : | REQUEST FOR |
| Issue Date: November 4, 2008 | : | RECONSIDERATION OF |
| Filed: December 16, 2004 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. | : | UNDER 37 CFR 1.705 |
| 261277US90PCT | : | |

This is in response to the PETITION UNDER 37 C.F.R. § 1.705(d) AND REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT, filed January 5, 2009. Patentee requests that the determination of patent term adjustment be corrected from five hundred twenty (520) days to eight hundred forty-four (844) days.

The request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. § 154(b) of 520 days.

**BACKGROUND**

This application was filed on December 16, 2004. On July 15, 2008, the Office mailed a notice that the initial determination of patent term adjustment under 35 U.S.C. 154(b) to date is 556 days[1]. On November 4, 2008, the application matured into U.S. Patent No. 7,445,161, with a revised patent term adjustment of 520 days. The Office determined that the 324 days of Office

[1] 579 days of Office delay was reduced by 23 days of Office delay for a patent term adjustment of 556 days. No request for reconsideration of this initial determination was filed.

delay pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b)[2,3] overlaps with the 579 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1)[4,5] accorded prior to the issuance of the patent. As such, the Office allowed only entry of the adjustment of 579 days. No additional days of patent term adjustment were entered at issuance under the three-year pendency provision. Given the applicant delay of 59 days, the patent issued with a revised patent term adjustment of 520 (579 - 59) days.

On January 5, 2009,[6] 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 844 days under the courts interpretation of the

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[2] Pursuant to 35 U.S.C. 154(b)(1)(B), 37 CFR 1.702(b) provides, in pertinent part, that:

> Failure to issue a patent within three years of the actual filing date of the application. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including:
>
> (i) any time consumed by continued examination of the application requested by the applicant under section 132(b).

[3] As of the issuance of the patent on December 16, 2004, the application was pending three years and 324 days.

[4] 37 CFR § 1.702, provides grounds for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999 (original applications, other than designs, filed on or after May 29, 2000).

> (a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:
>
> (1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

[5] A first Office action was not mailed until September 18, 2007, fourteen months and 579 days after the application filing date, December 16, 2004.

[6] As January 4, 2009, fell on a Sunday, the instant request for reconsideration was timely filed on Monday, January 5, 2009.

overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentee asserts that pursuant to Wyeth, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." Patentee maintains that the total non-overlapping PTO delay under §154(b)(1)(A) & (B) is 903 (579 + 324) days as these periods do not occur on the same day. Further, given the applicant delay of 59 days, patentee asserts entitlement to 844 (903 - 59) days of patent term adjustment.

**OPINION**

Patentee's interpretation of the period of overlap has been considered, but found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

> to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*[7] *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

---

[7] 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.

> 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).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the application filing date under 35 U.S.C. 111(a), December 16, 2004, and ending on the date the application issued as a patent,

November 4, 2008 (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), 579 days of patent term adjustment were accorded during the pendency of the application for Office delay. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 324 days of patent term adjustment accrued for Office issuance of the patent more than 3 years after the filing date of the application.

All of the 324 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 579 days of patent term adjustment under 37 CFR 1.702(a)(1). Entry of both the 579 days and the 324 days is neither permitted nor warranted. 579 days is the actual number of days issuance of the patent was delayed.

**CONCLUSION**

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent is 520 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 Senior Petitions Attorney Douglas I. Wood, at (571) 272-3231.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No.

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 22314

MAILED

APR 16 2010

OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,445,161 | : DECISION ON REQUEST |
| Fujio Inoue | : FOR |
| Issue Date: November 4, 2008 | : RECONSIDERATION OF |
| Application No. 10/518,087 | : PATENT TERM ADJUSTMENT |
| Filed: December 16, 2004 | : and |
| Atty Docket No. | : NOTICE OF INTENT TO ISSUE |
| 261277US90PCT | : CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on September 17, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by eight hundred forty-four (844) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by eight hundred forty-four (844) days is **GRANTED**.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **eight hundred forty-four (844)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,445,161 B2

DATED : **November 4, 2008** **DRAFT**

INVENTOR(S) : Inoue

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 520 days.

Delete the phrase "by 520 days" and insert – by 844 days--

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**ALBIHNS STOCKHOLM AB**
**BOX 5581, LINNEGATAN 2**
**SE-114 85 STOCKHOLM; SWEDENn**
**STOCKHOLM SE SWEDEN**

COPY MAILED

OCT 18 2006

OFFICE OF PETITIONS

In re Application of :
**ANDERSSON**, et al. :
Application No. 10/518,088 : DECISION ON PETITION
Filed: October 24, 2005 : TO WITHDRAW
Attorney Docket No. 67182-77540 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 29, 2006.

The request is **NOT APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request to withdraw less than all attorneys appointed by customer number 26288 cannot be approved. The addition and/or deletion of a practitioner from the list of practitioners associated with a Customer Number should be made by submitting a "Request for Customer Number Data Change" (PTO/SB/124) which will result in the addition or deletion of such practitioner from the list of persons authorized to represent any applicant or assignee of the entire interest who appointed all of the practitioners associated with such Customer Number. See MPEP 403 Section I. Customer Number Practice. The correspondence address of record remains unchanged.

Telephone inquiries concerning this decision should be directed to Monica A. Graves at 571-272-7253.

David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 8910
RESTON VA 20195

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APR 16 2008

In re Application of :
**ANDERSSON**, et al. :
Application No. 10/518,088 : DECISION ON PETITION
Filed: October 24, 2005 :
Attorney Docket No. **10400-000297/US** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 22, 2007, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely pay the issue and publication fees on or before May 14, 2007, as required by the Notice of Allowance and Fee(s) Due, mailed February 13, 2007. Accordingly, the date of abandonment of this application is May 15, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $1400, the publication fee of $300, (2) the petition fee of $1500; and (3) an adequate statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253.

This application is being referred to the Office of Data Management for processing into a patent.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

09 SEP 2005

#9

UNITED STATES PATENT AND TRADEMARK OFFICE

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DAVID B. WALLER & ASSOCIATES
5677 OBERLIN DRIVE
SUITE 214
SAN DIEGO CA 92121

In re Application of BUGRIM et al.
Application No.: 10/518,103
PCT No.: PCT/US03/19325
Int. Filing: 18 June 2003
Priority Date: 18 June 2002
Attorney Docket No.: GENE.003.PCT
For: METHODS FOR IDENTIFYING COMPOUNDS FOR TREATING DISEASE STATES

DECISION ON

PETITION TO VACATE NOTICE

OF ABANDONMENT

This is a decision on applicant's "Petition For Withdrawal of Holding of Abandonment under 37 CFR 1.181" filed in the United States Patent and Trademark Office ( USPTO) on 04 August 2005.

On 20 July 2005, a Notification of Abandonment (FORM PCT/DO/EO/909) was mailed to applicant indicating that applicant had failed to provide the full U.S. basic national fee by 30 months.

On 04 August 2005, applicant filed a "Petition for Withdrawal of Holding of Abandonment under 37 CFR 1.181" indicating that the basic national fee was filed on 10 December 2004 with the original national stage application and was unaware of the increased of the filing fees which occurred on 08 December 2004.

## DISCUSSION

Effective 08 December 2004, the basic national filing fee is $300 ($150 for small entity)[1]. On 10 December 2004, applicant filed a transmittal letter requesting entry into the national stage along with a check for $100 for the basic national fee.

A review of the application file reveals that the basic national fee of $300 was not paid with the filing of the request for national stage application on 10 December 2004. Applicant provided $100, the amount of the basic national filing fee prior to 08 December 2004, where the USPTO prepared the international preliminary examination report (IPER) and where all claims satisfied the provisions of PCT Article 33(1)-(4).

In the instant case, international application PCT/US03/19325 did not have an IPER prepared in the USPTO, which satisfied the provisions of PCT Article 33(1)-(4). A review of

[1]Advance Notice Regarding Changes to Patent Fees Under the Consolidated Appropriations Act, 2005 was posted on the USPTO website on December 2, 2004. The public was advised to monitor the USPTO's Internet Web site frequently for current patent fee information pending enactment of the Act. On 08 December 2004, the Act was enacted into law and the basic national fee under 37 CFR 1.492(a) was changed to $300.

USPTO records does not indicate that a Demand was filed nor were the appropriate fees paid for an IPER. As of 08 December 2004, the basic national filing fee is $300 [2]. On 10 December 2004, applicant filed a request for national stage entry and paid $100 by check for the basic national fee. Applicant did not authorize the charging of any additional fees, which may be required, to his deposit account.

The basic national filing fee of $300 was not paid by the expiration of the thirty month period from the priority date or by 18 December 2004. Since the full basic national fee of $300 was not paid by the expiration of the thirty month period, the international application was abandoned. The Notification of Abandonment (FORM PCT/DO/EO/909) mailed on 20 July 2005 remains in effect. Applicant may wish to consider filing a petition to revive under 37 CFR 1.137 to revive the international application.

## CONCLUSION

Applicant's "Petition For Withdrawal of Holding of Abandonment under 37 CFR 1.181" is **DISMISSED WITHOUT PREJUDICE**. The application remains abandoned.

This application will be held in the PCT Legal Office to await applicant's further response.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571) 272-3286
Facsimile: (571) 273-0459

[2] Applicant is advised that the national stage search and examination fees pursuant to 37 CFR 1.492(b) and (c) apply to the national stage application. Fees can be found at the USPTO website (www.uspto.gov).

21 OCT 2005

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

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DAVID B. WALLER & ASSOCIATES
5677 OBERLIN DRIVE
SUITE 214
SAN DIEGO CA 92121

In re Application of BUGRIM et al.
Application No.: 10/518,103
PCT No.: PCT/US03/19325
Int. Filing: 18 June 2003
Priority Date: 18 June 2002
Attorney Docket No.: GENE.003.PCT
For: METHODS FOR IDENTIFYING COMPOUNDS FOR TREATING DISEASE STATES

DECISION ON

PETITION TO VACATE NOTICE

OF ABANDONMENT

The petition to revive under 37 CFR 1.137(b) filed 14 October 2005 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that the basic national fee of $150 has been provided. The required petition fee of $750 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 14 October 2005.

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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**DAVID B. WALLER & ASSOCIATES**
**5677 OBERLIN DRIVE**
**SUITE 214**
**SAN DIEGO, CA 92121**

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APR 10 2008

OFFICE OF PETITIONS

In re Application of
**BUGRIM,** Andrei et al.
Application No. 10/518,103
Filed: October 14, 2005
Attorney Docket No. **GENE.003.PCT**

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 December 21, 2007 and resubmitted February 29, 2008.

The request is **NOT APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request cannot be approved because 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.

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, (agent has accepted a position with law firm and cannot transfer file to firm), does not meet any the conditions set forth in 37 CFR 10.40.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4231.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **GENEGO, INC.**
**ATTN: YURI NIKOLSY**
**500 RENAISSANCE DRIVE**
**SUITE 106**
**ST. JOSEPH, MICHIGAN 49085**

UNITED STATES PATENT AND TRADEMARK OFFICE

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**DAVID B. WALLER & ASSOCIATES**
**5677 OBERLIN DRIVE**
**SUITE 214**
**SAN DIEGO, CA 92121**

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JUN 02 2008

OFFICE OF PETITIONS

In re Application of :

**BUGRIM,** Andrei :
Application No. 10/518,103 : DECISION ON PETITION
Filed: October 14, 2005 : TO WITHDRAW
Attorney Docket No. **GENE.003.PCT** : FROM RECORD
:

This is a decision on the renewed Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 25, 2008.

The request is **APPROVED.**

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by David B. Waller, the sole attorney of record. David B. Waller has been withdrawn as attorney or agent of record. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence address of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor.

There are no outstanding office actions at this time.

Telephone inquiries concerning this decision should be directed to Michelle R. Eason at 571-272-4231.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **ANDREI BUGRIM**
**1011 PEARL STREET**
**ST. JOSEPH, MICHIGAN 49085**

cc: **GENEGO, INC.**
**YURI NIKOLSKY**
**4628 RANCHO REPOSO**
**DEL MAR, CA 92014**

03 OCT 2005

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

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PATENT DEPT
EXELIXIS, INC.
170 HARBOR WAY
P.O. BOX 511
SOUTH SAN FRANCISCO, CA 94083-0511

| | | |
|---|---|---|
| In re Application of | : | |
| BANNEN, Lynne Canne et al. | : | |
| Application No.: 10/518,110 | : | DECISION |
| PCT No.: PCT/US03/18262 | : | |
| Int. Filing Date: 11 June 2003 | : | ON REQUEST UNDER |
| Priority Date: 12 June 2002 | : | |
| Attorney's Docket No.: EX02-039C-US | : | 37 CFR 1.497(d) |
| For: HUMAN ADAM-10 INHIBITORS | : | |

This decision is in response to "Response to the Notification of Missing Requirements," filed on 15 July 2005. It has been treated as a request under 37 CFR 1.497(d).

## BACKGROUND

On 11 June 2003, applicant filed international application PCT/US03/18262, which claimed a priority date of 12 June 2002. The deadline for entry into the national stage in the United States was midnight on 12 December 2004.

On 10 December 2004, applicant filed a submission for entry into the national stage in the United States, accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration of the inventors.

On 16 June 2005, the Office mailed Notification of Missing Requirements, indicating that the declaration listed an inventor not listed on the international application and requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration.

On 15 July 2005, applicant filed the instant request.

## DISCUSSION

Applicants file this request to add Richard George Khoury as an 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 satisfied. Applicants provided a statement by Richard George Khoury and the processing fee.

Item (3) has not been satisfied. Applicants must supply the consent of the assignee. Applicants have not satisfied 37 CFR 3.73(b). Applicants have not provided the assignment records, nor indicated where the assignment records can be located. Nonetheless, a check of Office records indicates that Exelixis assigned interests in this application to SmithKlineBeecham. If this is correct, the consent of SmithKlineBeecham is required. If there are any other assignees on this application, their consents are also required.

Additionally, the declaration does not comply with 37 CFR 1.497(a)-(b). Applicant has supplied one page 1, one pages 2 and additional inventor sheet. Applicants supplied one each of additional inventor sheets 1 of 4, 2 of 4 and 4 of 4, but three pages 3 of 4. The pages 3 of 4 list the same inventors, but were separately executed. While it is acceptable for inventors to execute different copies of the declaration, applicants must supply the full copy of the declaration executed by each inventor. Applicants may not piece together pages from different declarations to create a composite declaration. It appears there were at least three copies of the declaration executed. Applicants must supply complete declarations in compliance with 37 CFR 1.497(a)-(b).

## CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

A proper response including a declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration, 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 P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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#6

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

| | | |
|---|---|---|
| In re Application of | : | |
| BANNEN, Lynne Canne et al. | : | |
| Application No.: 10/518,110 | : | DECISION |
| PCT No.: PCT/US03/18262 | : | |
| Int. Filing Date: 11 June 2003 | : | ON REQUEST UNDER |
| Priority Date: 12 June 2002 | : | |
| Attorney's Docket No.: EX02-039C-US | : | 37 CFR 1.497(d) |
| For: HUMAN ADAM-10 INHIBITORS | : | |

This decision is in response to "Renewed Request Under 37 CFR 1.497(d)," filed on 26 October 2005.

## BACKGROUND

On 11 June 2003, applicants filed international application PCT/US03/18262, which claimed a priority date of 12 June 2002. The deadline for entry into the national stage in the United States was midnight on 12 December 2004.

On 10 December 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 and a declaration of the inventors.

On 16 June 2005, the Office mailed Notification of Missing Requirements, indicating that the declaration listed an inventor not listed on the international application and requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration.

On 15 July 2005, applicants filed a request to add an inventor.

On 03 October 2005, the Office mailed Decision On Request Under 37 CFR 1.497(d), refusing applicants' request.

On 26 October 2005, applicants filed the instant renewed petition.

## DISCUSSION

Applicants file this request to add Richard George Khoury as an 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 the consent of the assignee.

The 26 October 2005 declaration complies with 37 CFR 1.497(a)-(b).

## CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.497(d) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application. The application has a 35 U.S.C. §371(c)(1), (c)(2) and (c)(4) date of **26 October 2005**.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292
Facsimile: 571-273-0459

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MAR 24 2010

OFFICE OF PETITIONS

**ANDREA Q. RYAN**
**SANOFI-AVENTIS U.S. LLC**
**1041 ROUTE 202-206**
**MAIL CODE: D303A**
**BRIDGEWATER NJ 08807**

In re Application of :
Peter ARANYL, et al :
Application No. 10/518,114 : DECISION ON PETITION
Filed: March 21, 2005 :
Attorney Docket No. SSL0102 US PCT :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 22, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely pay the issue and publication fees on or before January 20, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed October 20, 2009, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on January 21, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a RCE, IDS, payment of the issue fee of $1510 and publication fee of $300; (2) the petition fee of $1620; and (3) the required statement of unintentional delay.

The issue and publication fees have been charged to Deposit Account 18-1982, since payment of these fees are required as a condition for revival.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-6735.

The application is being referred to Technology Center 1624 for further processing by the Examiner in the normal course of business.

/DCG/
Diane C. Goodwyn
Petitions Examiner
Office of Petitions

cc: BRIAN R. MORRILL
SANOFI-AVENTIS
ROUTE 202-206, P.O. BOX 6800
MAIL CODE D-303A,
BRIDGEWATER, NJ 08807

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ROGER PITT
KIRKPATRICK & LOCKHART NICHOLSON GRAHAM
599 LEXINGTON AVENUE, 33RD FLOOR
NEW YORK, NY 10022-6030

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JUN 23 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Pascal Amary et al | : | |
| Application No. 10/518,121 | : | DECISION ON PETITION |
| Filed: December 15, 2004 | : | TO WITHDRAW |
| Attorney Docket No. AMARY | : | 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 27, 2006.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to Roger Pitt and all attorneys/agents of record have been revoked by the assignee of the patent application on June 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 applicants.

This application is being referred to Technology Center AU 2877.

Telephone inquires concerning this decision should be directed to Wan Laymon at 571-272-3220.

Amelia Au
Petitions Examiner
Office of Petitions

cc: BROWN RUDNICK BERLACK & ISRAELS
BOX IP, 18TH FLOOR
ONE FINANCIAL CENTER
BOSTON, MA 02111

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**MORRISON & FOERSTER LLP**
**12531 HIGH BLUFF DRIVE**
**SUITE 100**
**SAN DIEGO, CA 92130-2040**

| | | |
|---|---|---|
| In re Application of | : | |
| SCHAAP, et al. | : | |
| Application No. 10/518,146 | : | DECISION ON PETITION |
| Filed: December 16, 2004 | : | TO WITHDRAW |
| Attorney Docket No. 4662-368 | : | 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 30, 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 first copied address below until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272- 6825.

Patricia Volpe
Petitions Examiner
Office of Petitions

cc: NIXON & VANDERHYE, PC
901 NORTH GLEBE ROAD, 11TH FLOOR
ARLINGTON, VA 22203

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OFFICE OF PETITIONS

JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

In re Patent No. 7,345,677 :
Issue Date: March 18, 2008 :
Application No. 10/518,152 : NOTICE
Filed: December 9, 2004 :
Attorney Docket No. 401370-999001

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Inquiries related to this communication should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

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JUN 13 2007

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DARBY & DARBY P.C.
P.O. BOX 770
CHURCH STREET STATION
NEW YORK NY 10008-0770

In re Application of :
Jenny Nyberg et al :
Serial No.: 10/518,159 : PETITION DECISION
Filed: January 18, 2005 :
Attorney Docket No.: 09857/0202181-US :

This is a decision on the PETITION FOR ACCEPTANCE OF COLOR DRAWINGS UNDER 37 CFR 1.84(a)(2). The petition was filed January 25, 2006. Entry of color drawings requires: 1) three sets of the color drawings, 2) a proper amendment to the specification indicating color photographs or drawings are present in the file, and 3) the required fee under 37 CFR 1.17(h).

A review of the application record indicates that the petition meets all of the requirements for acceptance of color drawings. This is not to be construed that all of the drawings are accepted, only that the color drawings are acceptable.

The petition is **GRANTED**.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile transmission at 571-273-8300.

William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

UNITED STATES DEPARTMENT OF COMMERCE
COMMISSIONER FOR PATENTS
P. O. BOX 1450
ALEXANDRIA, VA 22313-1450

Date : 4/28/2010
Patent No. : 7,654,266 B2
Serial No. : 10/518,160
Inventor(s) : Corbitt, Jr..
Issue Date : February 2, 2010
Title : **SURGICAL DRAPING SYSTEM**
Doc./File No. : **SPE-15375.001**

Re: Reconsideration for 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, inspection of the file of the application for the patent reveals that the Abstract, in the patent, is/are printed in accordance with the record in the Patent and Trademark Office, as passed to issued by the examiner. There being no fault on the part of the Patent and Trademark Office, it has no authority to issue a certificate of correction under the provision of 1.322. Therefore, no correction is in order here.

In view of the foregoing, your request in this matter is denied.

However, further consideration will be given this matter upon receipt of a request for **Reconsideration** w/supporting document(s) under the provisions of 1.323, accompanied by the appropriate fee which is presently $100 if necessary.

**Ernest C. White, *LIE* (703) 756-1590**
Mary F. Diggs, *Supervisor* (703) 756-1580
Decisions & Certificates of Correction Branch
**ernest.white@uspto.gov**

WAYNE D PORTER, JR
LAW OFFICES OF WAYNE D. PORTER, JR.
1370 ONTARIO STREET, SUITE 600
CLEVELAND OH 44113

ecw

30 SEP 2005

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Amy B. Goldsmith
Gottlieb, Rackman & Reisman, P.C.
270 Madison Avenue
New York, NY 10016-0601

| | | |
|---|---|---|
| In re Application of | : | |
| REGEV | : | |
| U.S. Application No.: 10/518,167 | : | |
| PCT No.: PCT/IL03/00517 | : | DECISION ON PETITION |
| Int. Filing Date: 17 June 2003 | : | |
| Priority Date: 18 June 2002 | : | UNDER 37 CFR 1.182 |
| Attorney's Docket No.: 6553-006 | : | |
| For: BULLET | : | |

This decision is in response to applicant's facsimile correspondence filed 02 August 2005 in the United States Patent and Trademark Office (USPTO). The correspondence is being treated as a petition under 37 CFR 1.182 to correct the error in the Transmittal Letter (Form PTO-1390) filed 15 December 2004.

## BACKGROUND

On 17 June 2003, applicant filed international application PCT/IL03/00517, which claimed priority of an earlier application filed 18 June 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 24 December 2003. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 18 December 2004.

On 15 December 2004, applicant filed a transmittal letter for entering the U.S. national stage under 35 U.S.C. 371 accompanied by: payment of the U.S. Basic National, Examination and Search Fees. The transmittal letter identified the international application number as PCT/US03/00517.

On 16 December 2004, applicant filed an additional transmittal letter for entering the U.S. national stage under 35 U.S.C. 371 accompanied by: payment of the U.S. Basic National. The transmittal letter correctly identified the international application number as PCT/IL03/00517.

On 02 August 2005, applicant filed papers seeking to cancel the filing of 16 December 2004 and enclosing a corrected Form PTO-1390. The submission is being treated as a petition under 37 CFR 1.182 to correct the international application number in the Form PTO-1390 filed 15 December 2004. As authorized, the $400.00 petition fee will be charged to deposit account no.: 07-1730.

## DISCUSSION

The identifying information provided on the transmittal letter filed by applicant on 15 December 2004, i.e., the title, applicant-inventor information, priority date, and international filing date all correspond to that of PCT/IL03/00517. For these reasons, as well as the explanation provided in the present petition, it has been concluded that the national stage papers filed 15 December 2004 sufficiently identified international application PCT/IL03/00517. Pursuant to petitioner's request, the national stage papers assigned U.S. application number 10/518,167 will be treated as a U.S. national stage submission for PCT/IL03/00517.

Regarding application 10/518,200 filed 16 December 2004, the end result for an international application designating the United States of America is a single U.S. national stage application. Therefore, the submission of two sets of national stage papers to enter the United States was improper. As detailed above, applicant has requested that the papers filed 15 December 2004 proceed as the U.S. national stage application for PCT/IL03/00517 and has provided a corrected Form PTO-1390. Therefore, the papers filed on 16 December 2004 in application number 10/518,200 will be transferred to the present file and the fees paid in that case refunded to deposit account no.: 07-1730.

## CONCLUSION

For the reasons above, applicant's "Petition Under 37 CFR 1.182" is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of U.S. application number 10/518,167 as the U.S. national stage application of PCT/IL03/00517; specifically, the preparation and mailing of a "Notification of Missing Requirements" (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventor.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

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**DARBY & DARBY P.C.**
**P. O. BOX 5257**
**NEW YORK NY 10150-5257**

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**OFFICE OF PETITIONS**

In re Application of :
**TENEMBAUM**, et al. :
Application No. 10/518,175 : DECISION ON PETITION
Filed: July 15, 2005 : TO WITHDRAW
Attorney Docket No. 04224/100L543-US1 : 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 9, 2006.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to Melvin C. Garner and the attorneys of DARBY & DARBY PC has been revoked by the assignee of the patent application on August 24, 2006. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **KAPLAN GILMAN GIBSON & DERNIER L.L.P.**
**900 ROUTE 9 NORTH**
**WOODBRIDGE, NJ 07095**

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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/518,175 | 07/15/2005 | Samuel S. Tenembaum | 04224/100L543-US1 |

**CONFIRMATION NO. 5717**

*OC000000021271642*

27538
KAPLAN GILMAN GIBSON & DERNIER L.L.P.
900 ROUTE 9 NORTH
WOODBRIDGE, NJ 07095

Date Mailed: 11/17/2006

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/24/2006.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

MONICA A GRAVES
OP (571) 272-7253

ATTORNEY/APPLICANT COPY

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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/518,175 | 07/15/2005 | Samuel S. Tenembaum | 04224/100L543-US1 |

**CONFIRMATION NO. 5717**

*OC000000021271641*

07278
DARBY & DARBY P.C.
P. O. BOX 5257
NEW YORK, NY 10150-5257

Date Mailed: 11/17/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/24/2006.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

---

MONICA A GRAVES
OP (571) 272-7253

FORMER ATTORNEY/AGENT COPY

25 AUG 2005



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Mark Chao, PhD, JD
Intellectual Property Department
TAKEDA PHARMACEUTICALS NORTH AMERICA
Suite 500, 475 Half Day Road
Lincolnshire, IL 60069

| | | |
|---|---|---|
| In re Application of: | : | |
| WATANABE, Tatsuya, et al. | : | DECISION ON PETITION FOR |
| U.S. Application No.: 10/518,184 | : | REVIVAL OF ABANDONED |
| PCT No.: PCT/JP03/07741 | : | APPLICATION UNDER |
| International Filing Date: 18 June 2003 | : | 37 CFR 1.137(b) |
| Priority Date: 19 June 2002 | : | |
| Attorney's Docket No.: 3057 US0P | : | |
| For: PREVENTIVES/REMEDIES FOR BONE AND JOINT DISEASE | : | |

The petition for revival under 37 CFR 1.137(b) filed 12 August 2005 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional"meets the requirements of 37 CFR 1.137(b)(3).

Applicant has authorized a charge to Deposit Account No. 50-0799 for the basic national fee and the petition fee, and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

It is noted that the original national stage papers filed 16 December 2004 included an executed declaration in compliance with 37 CFR 1.497.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 12 August 2005.

Richard M. Ross
PCT Petitions Attorney
Office Of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

#4

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27 JAN 2006

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
100 GALLERIA PARKWAY, NW
STE 1750
ATLANTA, GA 30339-5948

In re Application of WHITE et al :
U.S. Application No.: 10/518,188 :
PCT Application No.: PCT/US03/19290 :
Int. Filing Date: 19 June 2003 : DECISION
Priority Date Claimed: 19 June 2002 :
Attorney Docket No.: 062020-1800 :
For: ADSORBENTS, METHODS OF :
PREPARATION, AND METHODS OF USE :
THEREOF :

This is in response to applicant's "Petition Under 37 C.F.R. §1.47(a) Regarding Uncooperative Inventor" filed 18 January 2006.

## BACKGROUND

On 19 June 2003, applicant filed international application PCT/US03/19290, which claimed priority of an earlier United States application filed 19 June 2002. The thirty-month period for paying the basic national fee in the United States expired on 19 December 2004.

On 16 December 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 03 August 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 18 January 2006, applicant filed the present petition under 37 CFR 1.47(a).

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2)

factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventors, each on his/her own behalf and on behalf of the nonsigning inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Robert Chiang refuses to sign the application papers. Petitioner has adequately shown that a bona fide attempt was made to present a copy of the application papers to Chiang for signature and that Chiang actually received such papers (see affidavit of Geoffrey Chase, ¶¶2,4). Furthermore, petitioner has sufficiently demonstrated that Chiang refuses to sign. Specifically, Chiang made an express oral refusal to sign during a conversation with Geoffrey Chase (see Chase affidavit, ¶3). Thus, it can be concluded with reasonable certainty that Chiang refuses to join in the application.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition does not state the last known address of the nonsigning inventor.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". 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

08 MAR 2006

#6

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THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
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ATLANTA, GA 30339-5948

In re Application of WHITE et al :
U.S. Application No.: 10/518,188 :
PCT Application No.: PCT/US03/19290 :
Int. Filing Date: 19 June 2003 : DECISION
Priority Date Claimed: 19 June 2002 :
Attorney Docket No.: 062020-1800 :
For: ADSORBENTS, METHODS OF :
PREPARATION, AND METHODS OF USE :
THEREOF :

This is in response to applicant's "Renewed Petition Under 37 C.F.R. §1.47(a)" filed 08 February 2006.

## BACKGROUND

On 19 June 2003, applicant filed international application PCT/US03/19290, which claimed priority of an earlier United States application filed 19 June 2002. The thirty-month period for paying the basic national fee in the United States expired on 19 December 2004.

On 16 December 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 03 August 2005, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 18 January 2006, applicant filed a petition under 37 CFR 1.47(a).

On 27 January 2006, this Office mailed a decision dismissing the 18 January 2006 petition.

On 08 February 2006, 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), (2), and (3) above.

With regard to item (4) above, the renewed petition states the last known address of the nonsigning inventor.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 19 June 2003, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 18 January 2006.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3303
Facsimile: 571-273-0459

08 MAR 2006

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Robert L. Chiang
11 Govenor Drive
Basking Ridge, NJ 07920

In re Application of WHITE et al
U.S. Application No.: 10/518,188
PCT Application No.: PCT/US03/19290
Int. Filing Date: 19 June 2003
Priority Date Claimed: 19 June 2002
For: ADSORBENTS, METHODS OF PREPARATION, AND METHODS OF USE THEREOF

Dear Robert L. Chiang:

You are named as a joint inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost set forth in 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you choose to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Bryan Tung
PCT Legal Examiner
PCT Legal Office
Telephone: 571-272-3303
Facsimile: 571-273-0459

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
100 GALLERIA PARKWAY, NW
STE 1750
ATLANTA, GA 30339-5948

Attorney Docket No.: 062020-1800

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RATNERPRESTIA
P.O. BOX 980
VALLEY FORGE, PA 19482

Mail Date: 04/28/2010

| | | |
|---|---|---|
| **Applicant** | : Fumiyasu Nomura | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7618526 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/17/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/518,194 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 09/20/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1093** 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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BUCKINGHAM, DOOLITTLE & BURROUGHS, LLP
3800 EMBASSY PARKWAY
SUITE 300
AKRON OH 44333-8332

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JAN 17 2007

OFFICE OF PETITIONS

Applicant: Vandrak et al.
Appl. No.: 10/518,202
International Filing Date: September 30, 2004
Title: GAS FIRED PORTABLE UNVENTED INFRARED HEATER
Attorney Docket No.: 30816-0094
Pub. No.: US 2005/0257786 A1
Pub. Date: November 24, 2005

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on January 23, 2006, for the above-identified application

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication contains material errors, as the line number "11" improperly appears in paragraphs [0065] and [0072], as "FIGS. 26-27" is misprinted as "FIGS. 2627" in paragraph [0070], "fitting 146" is misprinted as "filling 146" and "clip" is misprinted a "dip" in paragraph [0074].

37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. [1]

The errors in paragraphs [0065] and [0072] wherein the line number "11" improperly appears, paragraph [0070] wherein "FIGS. 26-27" is misprinted as "FIGS. 2627", paragraph [0072] wherein "fitting 146" is misprinted as "filling 146" and paragraph [0074] wherein "clip" is misprinted a "dip" are Office errors, but they are not a material Office errors under 37 CFR 1.221. The minor typographical errors do not affect the understanding of the application as the words are correctly spelled in the same paragraphs. The application is clearly understandable to

[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).

one of ordinary skill in the art reading the application and claims. 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.

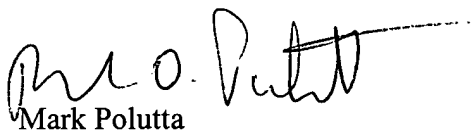
The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221 (a). Such a request for republication "must include a copy of the application compliance with the Office's electronic filing system requirements and be accompanied by the 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 Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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201 SOUTH COLLEGE STREET, SUITE 2350
CHARLOTTE NC 28244

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MAR 2 8 2007

OFFICE OF PETITIONS

In re Application of
Niederer
Application No.10/518,207
Filed: December 16, 2004
Attorney Docket Number: 420/13
Title of Invention: Compensating Disk Tension Controller

ON PETITION

This is a decision on the petition filed March 19, 2007, under 37 CFR 1.137(b) to revive the above-identified application.

This application became abandoned for failure to timely submit the issue fee, as required by the Notice of Allowance and Fee (s) Due which was mailed December 15, 2006. The Notice of Allowance and Fee (s) Due set a three (3) month statutory period for reply. Extensions of time were not available under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on March 16, 2007 This decision precedes the mailing of a Notice of Abandonment.

The requirements for a grantable petition under 37 CFR 1.137(b) have been met. This petition is hereby **Granted**.

This application is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

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Novartis Animal Health US Inc.
3200 Northline Avenue, Suite 300
Greensboro NC 27408

| | | |
|---|---|---|
| In re Application of | : | |
| DUCRAY, PIERRE | : | |
| Application No.: 10/518210 | : | DECISION ON |
| Filing or 371(c) Date: November 21, 2005 | : | PETITION |
| Attorney Docket Number: **H-32531A** | : | |

This is a decision in response to the "Petition to Withdraw Holding of Abandonment," filed February 12, 2009.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance, mailed September 19, 2008.

In view of the foregoing, the holding of abandonment for failure to timely pay the issue fee is hereby withdrawn and the application restored to pending status.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 308-9250 ext. 164.

Kendrick Sprain
Application Assistance Unit
Office of Data Management

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.: 20080227**

**DATE** : February 27, 2008

**TO SPE OF** : ART UNIT 1624

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/518213 Patent No.: 7300938 B2

A response is requested with respect to a request for a certificate of correction.

With respect to the change(s) requested to correct Office and/or Applicant's errors, should the patent read as shown in the certificate of correction attached herewith or the COCIN document(s), in IFW images for the above-identified patented application? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

If the response is for an IFW, within 7 days, please complete and forward the response, to the employee (named below) via scanning into application images, using document code **COCX**.

DO NOT SENT TO ATTORNEY

If the response is for a paper file wrapper, please complete the response and forward the response with the paper file wrapper, to the employee (named below), within **7** days, to:

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location 7580**

**You can fax the Directors/SPE response to 571-270-9990**

*LAMONTE NEWSOME*
**Certificates of Correction Branch**
**703-308-9390 ext. 112**

**Thank You For Your Assistance**

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**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

| | |
|---|---|
| ☑ **Approved** | **All** changes apply. |
| ☐ **Approved in Part** | Specify below which changes **do not** apply. |
| ☐ **Denied** | State the reasons for denial below. |

**Comments:** _____

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

**SPE** **1624 Art Unit**

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THOMSON LICENSING INC.
PO BOX 5312
PRINCETON NJ 08543-5312

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APR 16 2007

OFFICE OF PETITIONS

In re Application of :
Carl Christensen :
Application No. 10/518,226 : ON PETITION
Filed: December 16, 2004 :
Attorney Docket No. PU020288 :

This is a decision on the petition, filed April 13, 2007, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on March 23, 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 2138 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy
Petitions Examiner
Office of Petitions

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

28 MAR 2006

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23117
NIXON & VANDERHYE, P.C.
901 North Glebe Road, 11th Floor
Arlington, VA 22203

In re Application of :
HELLBERG, Richard :
Application No.: 10/518,238 :
PCT No.: PCT/SE03/01068 :
Int. Filing Date: 19 June 2003 : **DECISION**
Priority Date: 19 June 2002 :
Attorney Docket No.: 4147-98 :
For: EFFICIENT GENERATION OF RADIO FREQUENCY :

This decision is in response to applicant's "Request for Corrected Filing Receipt" filed on 16 December 2005 which is hereby **GRANTED** as follows:

A review of the above-captioned application reveals that the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 1.495 (Form PCT/DO/EO/903) on 29 November 2005 listing a date of receipt of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) and a date of receipt of all 35 U.S.C. 371 requirements of 25 August 2005. A filing receipt indicating a filing or 371 date of 25 August 2005 was also mailed.

However, applicant claims that these dates are incorrect as the declaration was submitted on 16 August 2005, not 25 August 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.

Applicant has provided a copy of the date-stamped postcard receipt for documents submitted 16 August 2005. The name of the applicant, docket number and the application number are listed on the postcard receipt. The postcard receipt indicates that a "Declaration (1 page) Assignment (2 Pages) Including Cover" were received in the USPTO. The postcard receipt is stamped "OIPE AUG 16 2005" across its face.

Moreover, a review of the file shows that the transmittal letter for the declaration and assignment located in the file is stamped as received on 16 August 2005. Accordingly, applicant has provided *prima facie* evidence that the declaration was received by the USPTO on 16 August 2005.

For this reason, the Form PCT/DO/EO/903 and filing receipt mailed 29 November 2005

are both **VACATED**.

This application is being forwarded to the DO/EO/US to mail a corrected filing receipt and Form PCT/DO/EO/903 indicating a filing or 371 date, date of receipt of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4), and date of receipt of all 35 U.S.C. requirements of **16 August 2005**.

The application will then be forwarded to Technology Center 2700 for further processing.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

08 SEP 2006

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Squire, Sanders & Dempsey LLP
8000 Towers Crescent Drive
14th Floor
Tysons Corner, VA 22182-2700

In re Application of :
KOHO, Kati A. :
Application No.: 10/518,242 :
PCT No.: PCT/IB02/02237 : DECISION ON PETITION
Int. Filing Date: 18 June 2002 : UNDER 37 CFR 1.182
Priority Date: None :
Attorney Docket No.: 60282.00224 :
For: METHOD FOR DEPOSITING A CREDIT ON AN ACCOUNT ASSOCIATED TO A TERMINAL SUBSCRIBED TO A COMMUNICATION NETWORK :

This decision is issued in response to applicants' "Response to Notification of Defective Response" dated 27 January 2006 and "Supplemental Response to Notification of Defective Response" dated 07 February 2006 which are being treated as a petition under 37 CFR 1.182. Applicants are requesting to change the name of the sole inventor from Kati A. Lehtinen to Kati A. KOHO due to marriage. The petition was accompanied by an affidavit signed by Kati A. KOHO using both her former name and present name. The $400 petition fee under 37 CFR 1.17(f) will be charged to Deposit Account No. 50-2222, as authorized.

## DISCUSSION

The Manual of Patent Examining Procedure at § 605.04(c) requires in cases where an inventor's name has been changed after the application has been filed and the inventor desires to change his or her name on the application, he or she must submit a petition under 37 CFR 1.182. The petition must include (1) the appropriate petition fee and (2) an affidavit signed by the inventor setting forth both names and the procedure whereby the change of name was effected, or a certified copy of the court order. The petition has been reviewed and is approved. The declaration submitted on 10 August 2005 is accepted.

## CONCLUSION

The petition under 37 CFR 1.182 to change the inventor's name from Kati A. Lehtinen to Kati A. KOHO is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

21 JUN 2005

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#3

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Benoit Castel
Young & Thompson
745 South 23rd Street
Arlington, VA 22202

| | | |
|---|---|---|
| In re Application of | : | |
| BRABEC et al. | : | |
| Application No.: 10/518,245 | : | DECISION ON PETITION |
| PCT No.: PCT/DE03/01954 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 12 June 2003 | : | |
| Priority Date: 14 June 2002 | : | |
| Attorney Docket No.: 4001-1193 | : | |
| For: MATERIAL FOR THE PRODUCTION OF A CONDUCTIVE ORGANIC FUNCTIONAL LAYER AND USE THEREOF | : | |

The petition to revive under 37 CFR 1.137(b) filed 16 December 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicants have submitted the basic national fee and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration is required.

Anthony Smith
Attorney-Advisor
Office PCT Legal Administration
Tel.: 571-272-3298
Facsimile: 571-273-0459

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VOLPE AND KOENIG, P.C.
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

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APR 0 8 2009

**OFFICE OF PETITIONS**

In re Application of
Martin S. Wilcox
Application No. 10/518,272
Filed: December 16, 2004
Attorney Docket No. CA0666

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), on March 25, 2009, to revive the above-identified application.

The application became abandoned for failure to respond to the Notice of Non-Compliant Amendment (37 CFR 1.121) mailed on January 24, 2008. A Notice of Abandonment was mailed October 1, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b), in that, petitioner has supplied (1) an amendment; (2) the petition fee of $1,620; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 2611 for review of the amendment filed with the present petition.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

21 JUN 2006

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LOWE HAUPTMAN GILMAN & BERNER, LLP
1700 DIAGNOSTIC ROAD, SUITE 300
ALEXANDRIA VA 22314

| | | |
|---|---|---|
| In re Application of | : | |
| GUIONNET et al. | : | |
| Application No.: 10/518,289 | : | |
| PCT No.: PCT/FR02/02368 | : | |
| Int. Filing Date: 05 July 2002 | : | DECISION |
| Priority Date: None | : | |
| Attorney Docket No.: 4590-363 | : | |
| For: METHOD FOR SERIAL PRODUCTION OF SECURE DOCUMENTS AND MACHINE THEREFOR | : | |

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 21 March 2006 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 05 July 2002, applicants filed international application PCT/FR02/02368, which designated the United States and does not claim priority to an earlier application. A copy of the international application was communicated from the International Bureau to the USPTO on 15 January 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 05 January 2005.

On 17 December 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, a translation of the application into English, and a declaration of inventors signed by four of the five joint inventors.

On 21 December 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(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage.

On 21 March 2006, applicants filed the instant petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a one-month extension of time, a statement of facts by Vladimir Chaverneff, a copy of a returned registered mail envelope, copies of internet searches for nonsigning inventor Sebastian Guionet, and the required surcharge.

## 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 of $200 has been charged to Deposited Account 07-1337. Accordingly, item (1) has been met.

Items (2) and (3) have been met as well.

Item (4) has not been met. The declaration of inventors filed 17 December 2004 is not in compliance with 37 CFR 1.69(b); specifically applicants have not used one of the pre-approved foreign language forms nor have applicants furnished the requisite statement attesting to the accuracy of the translation.

## 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, including a translation of the Figures, 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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19 SEP 2006

LOWE HAUPTMAN GILMAN & BERNER, LLP
1700 DIAGNOSTIC ROAD, SUITE 300
ALEXANDRIA VA 22314

| | | |
|---|---|---|
| In re Application of | : | |
| GUIONNET et al. | : | |
| Application No.: 10/518,289 | : | |
| PCT No.: PCT/FR02/02368 | : | |
| Int. Filing Date: 05 July 2002 | : | DECISION |
| Priority Date: None | : | |
| Attorney Docket No.: 4590-363 | : | |
| For: METHOD FOR SERIAL PRODUCTION OF SECURE DOCUMENTS AND MACHINE THEREFOR | : | |

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 17 July 2006 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 05 July 2002, applicants filed international application PCT/FR02/02368, which designated the United States and does not claim priority to an earlier application. A copy of the international application was communicated from the International Bureau to the USPTO on 15 January 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 05 January 2005.

On 17 December 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee, a translation of the application into English, and a declaration of inventors signed by four of the five joint inventors.

On 21 December 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(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage.

On 21 March 2006, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a one-month extension of time, a statement of facts by Vladimir Chaverneff, a copy of a returned registered mail envelope, copies of internet searches for nonsigning inventor Sebastian Guionet, and the required surcharge.

On 21 June 2006, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a) without prejudice because the declaration of inventors filed 17 December 2004 was not in compliance with 37 CFR 1.69(b).

On 17 July 2006, applicants submitted the instant renewed petition under 37 CFR 1.47(a), which was accompanied by a statement attesting to the accuracy of the translation of the declaration of inventors filed 17 December 2004.

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As noted in the decision mailed 21 June 2006, items (1)-(3) have been met.

As to item (4), the statement by Vladimir Chaverneff included with the instant submission satisfies 37 CFR 1.69(b).

## CONCLUSION

For the above reasons, applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to 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 **17 December 2004**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

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19 SEP 2006

SEBASTIEN GUIONNET
201, AVENUE CHARLES DE GAULLE
92200 NEUILLY SUR SIENE
FRANCE

In re Application of
GUIONNET et al.
Application No.: 10/518,289
PCT No.: PCT/FR02/02368
Int. Filing Date: 05 July 2002
Priority Date: None
Attorney Docket No.: 4590-363
For: METHOD FOR SERIAL PRODUCTION OF SECURE DOCUMENTS AND MACHINE THEREFOR

Dear Mr. Guionnet:

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

LOWE HAUPTMAN GILMAN & BERNER, LLP
1700 DIAGNOSTIC ROAD, SUITE 300
ALEXANDRIA VA 22314

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Date: 10/17/08

Patent No. : 7383938 B2
Ser. No. : 10/518,295
Inventor(s) : ORTH, HERIBERT
Issued : 06/10/08
Title : **DEVICE FOR PRODUCING STACKS**
Docket No. : **1825.004**

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.

Lamonte M. Newsome
For Mary Diggs, Supervisor
Decisions & Certificates
Of Correction Branch
(703) 305-8309 or (703) 308-9390 #112

**BOYLE FREDRICKSON S.C.**
**840 North Plankinton Avenue**
**MILWAUKEE WI 53203**

LMN

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P.O. Box 1450
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BOYLE FREDRICKSON S.C.
840 NORTH PLANKINTON AVENUE
MILWAUKEE, WI 53203

MAILED

FEB 12 2009

OFFICE OF PETITIONS

In re Patent No. 7,383,928 :
Issue Date: June 10, 2008 :
Application No. 10/518,295 : ON PETITION
Filed: June 30, 2005 :
Attorney Docket No. 1825-004 :

This is a decision on the petition filed October 28, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the April M. Wise at (571) 272-1642. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

/Carl Friedman/
Carl Friedman
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

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United States Patent and Trademark Office
P.O. Box 1450
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DYKEMA GOSSETT PLLC
FRANKLIN SQUARE, THIRD FLOOR WEST
1300 I STREET, NW
WASHINGTON DC 20005

MAIL

AUG 2 3 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Per Bergqvist
Application No. 10/518,296
Filed: December 16, 2004
For: **METHOD FOR THE AUTOMATIC MANAGEMENT OF TERMINAL-DEPENDENT INFORMATION**

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition filed December 16, 2004 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 petition fails to fully meet requirement (6) inasmuch as there is no clear discussion of the references or the patentable novelty over the references as required by 37 CFR §1.111 (b) and (c).

It is not sufficient for applicant to merely state that the foreign search found the references to be only "A" type references and therefore no discussion of the references are believed to be necessary.

Accordingly, the petition is **DENIED**.

Any request for reconsideration must be filed within **TWO MONTHS** of the date of this decision. Should applicant desire reconsideration, he/she should supplement this petition by supplying the information as outlined above. No further petition fee is required.

Dwayne Bost
Special Program Examiner
Technology Center 2600

UNITED STATES PATENT AND TRADEMARK OFFICE

8-4-09

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Patent No. : 7,455,374B2
Ser. No. : 10/518,311
Inventor(s) : Jurgen Nachbaur, et. al.
Issued: November 25, 2008
Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request 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: (703) 872-9306
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

A certificate of correction will issue to correct the remaining error noted in your request

Eva James
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) 756-1583 or 1580

Norris, McLaughlin & Marcus
875 Third Avenue, 18th floor
New York, NY 10022

ej

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No.

CANTOR COLBURN, LLP
20 Church Street
22nd Floor
Hartford CT 06103

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FEB 04 2009

**OFFICE OF PETITIONS**

In re Application of :
Leslie James Thomas : DECISION ON PETITION
Application No. 10/518,316 :
Filed: June 15, 2005 :
Attorney Docket No. CUL0011US :

This is a decision on the PETITION UNDER 37 CFR 1.137(b) TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION & RESPONSE TO OFFICE ACTION filed January 12, 2009.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to file a reply to the non-final Office action mailed May 7, 2008. 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 timely filed and no extension of time considered obtained, the application became abandoned effective August 8, 2008. A courtesy Notice of Abandonment was sent on December 12, 2008.

The petition includes the required reply in the form of an amendment, the statement of unintentional delay and payment of the petition fee. No terminal disclaimer is required.

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 $555 extension of time fee submitted with the petition on January 12, 2009 was submitted subsequent to the

maximum extendable period for reply, this fee is unnecessary and is being refunded.

Technology Center AU 3635 has been advised of this decision. The application is, thereby, forwarded to the examiner for consideration of the reply submitted on petition filed January 12, 2009.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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Alexandria, VA 22313-1450
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22 SEP 2006

Finnegan, Henderson, Farabow, Garrett & Dunner, L.L.P.
901 New York Avenue, NW
Washington, D.C. 20001-4413

In re Application of :
ZAOPO et al. :
Application No.: 10/518,352 : DECISION ON PETITION
PCT No.: PCT/EP02/07107 :
Int. Filing Date: 27 June 2002 :
Priority Date: None :
Attorney Docket No.: 05788.0337 :
For: POLYIMIDE OPTICAL WAVEGUIDES AND METHOD FOR THE PREPARATION THEREOF

This decision is issued in response to applicant's "Petition to Withdraw Holding of Abandonment under M.P.E.P. 711.03(c)" filed 12 September 2006, which is being treated as petition under 37 CFR 1.181. No petition fee is required.

## BACKGROUND

On 27 June 2002, applicant filed international application PCT/EP02/07107 which claimed no priority date. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 January 2004. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 27 December 2005.

On 17 December 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, and a preliminary amendment.

On 13 June 2005, the United States Designated Office (DO/EO/US) mailed a Notification Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that a signed oath/declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) together with a surcharge payment were required. The notification set a two-month time limit in which to respond.

On 03 August 2006, the United States Elected Office mailed a Notification of Abandonment under 37 CFR 1.495 (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 13 June 2005 within the time period set therein.

On 12 September 2006, applicant filed the present petition which was accompanied, among other things: a copy of the declaration and power of attorney filed 15 August 2005; a post card receipt dated 15 August 2005; and a transmittal letter dated 15 August 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 15 August 2005. A review of the present application reveals that the declaration and power of attorney filed 15 August 2005 is not located therein. Section 503 of the Manual of Patent Examining Procedure under the heading "RETURN POSTCARD" states, in part:

> "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

Here, applicant has provided a copy of their date-stamped filing receipt. The receipt identifies the application by applicant, title of invention, and application number. The receipt itemizes a declaration executed by the inventors. The receipt is stamped "Rec'd. OIPE AUG 15, 2005" across its face is sufficient to indicate that the declaration and power of attorney was in fact received in the Office on 15 August 2005.

## CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

This application will be given an international filing date of 27 June 2002 and a date of **15 August 2005** under 35 U.S.C. 371. The application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Yasushi Shioya | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7651717 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/518,372 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/28/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **957** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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FOLEY AND LARDNER LLP
150 EAST GILMAN STREET
P.O. BOX 1497
MADISON, WI 53701-1497

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FEB 22 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,553,499 | : | DECISION ON REQUEST FOR |
| KATARZYNA JURECZEK | : | RECONSIDERATION OF |
| Issue Date: June 30, 2009 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/518,386 | : | AND |
| Filed: May 3, 2005 | : | NOTICE OF INTENT TO ISSUE |
| Docket No. 1034433-000009 (078556-01 | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on August 31, 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 thirty-eight (1,038) 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 thirty-eight (1,038) days is **GRANTED**.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand thirty-eight (1,038) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,553,499 B2

DATED : Jun. 30, 2009 **DRAFT**

INVENTOR(S) : Jureczek

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 670 days

Delete the phrase "by 670 days" and insert – by 1,038 days--

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

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DEC 08 2009

OFFICE OF PETITIONS

In re Patent No. 7,547,700 :
Issued: June 16, 2009 :
Application No. 10/518,394 : PATENT TERM ADJUSTMENT
Filed: December 17, 2004 :
Dkt. No.: 03715.0144 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT-OST GRANT," filed July 30, 2009. This matter is being properly treated under 37 CFR 1.705(d).

Patentees request correction of the patent term adjustment from 430 days to 977 days. Patentees request this correction on the sole basis that the Office took in excess of three years to issue the above-referenced patent.

The application for patent term adjustment (PTA) under 37 CFR 1.705(d) is **DISMISSED**.

The above-identified application matured into U.S. Pat. No. 7,547,700 on June 16, 2009. The patent issued with a patent term adjustment of 430 days. The instant application of patent term adjustment is timely filed pursuant to 37 CFR 1.705(d). Patentees argue that in view of Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008), the patent is entitled to an adjustment of 977days (579 days pursuant to 35 USC 154(b)(1)(A) *plus* 547 days pursuant to 35 USC 154(b)(1)(B) *less* 149 days applicant delay).

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, patentees are entitled to the period of Office delay reduced by the period of applicant delay.

The Office asserts that as of the issuance of the patent on June 16, 2009, the application was pending three years and 546 days after national stage commenced under 35 U.S.C. 371(b) or (f) in an international application (December 19, 2007 to June 16, 2009). The Office agrees that certain action was not taken within the specified time frame, and thus, the application was pending 14 months and 579 days prior to the mailing of the non-final Office action on September 19, 2007. At issue is whether patentees should accrue 546 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 579 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that the period of 546 days of delay in issuance of the patent under 37 CFR 1.702(b) overlaps with the period of 579 days of examination delay under 37 CFR 1.702(a). 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:

35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

> To the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f)*[1] *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).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the relevant

---

[1] 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.

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.

In this instance, the relevant period under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay "overlap" under 35 U.S.C. 154(b)(2)(A) is the period during which the application was pending before the Office beginning on the date that national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, December 18, 2004, and ending on the date that the patent issued, June 16, 2009.

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1), the application was pending 14 months and 579 days prior to the issuance of the non-final Office action on September 19, 2007. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), the application was pending three years and 546 days prior to the issuance of the patent on June 16, 2009.

The 546 days of delay in issuance of the patent under 37 CFR 1.702(b) overlap with the 579 days of patent term adjustment under 37 CFR 1.702(a). Entry of both the 546 days and the 579 days is neither permitted nor warranted given that 579 days is the actual number of days issuance of the patent was delayed.

Accordingly, at issuance, having considered the 546 days of Office delay under the three-year pendency provision in conjunction with the 579 days of examination delay, reduced 149 days for applicant delay, the Office properly entered 430 days of patent term adjustment.

In view thereof, no adjustment to the patent term will be made.

No additional fees are due in connection with this matter.
Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

In re Patent No. 7,547,700
Issued: June 16, 2009
Application No. 10/518,394
Filed: December 17, 2004
Dkt. No.: 03715.0144

: DECISION ON APPLICATION FOR
: PATENT TERM ADJUSTMENT and
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION
:

This is a decision on the petition filed on February 4, 2010, which is being treated as a petition under 37 CFR 1.181 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 977 days. The petition is deemed timely, having been filed within two months of the mail date of the decision on petition mailed December 8, 2009. See, 37 CFR 1.181(f).

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 977 days is **GRANTED**.

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 977 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 : 7,547,700

DATED : **June 16, 2009** **DRAFT**

INVENTOR(S) : Vacher, 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 430 days

Delete the phrase "by 430 days" and insert – by 977 days--

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27709-3398

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**OFFICE OF PETITIONS**

In re Application of :
Bonney et al. :
Application No. 10/518,421 : ON APPLICATION FOR
Filed: December 17, 2004 : PATENT TERM ADJUSTMENT
Attorney Docket No. PB60210USW:

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION §1.705(b) filed December 10, 2008. Applicant requests that the determination of patent term adjustment be corrected from five hundred sixty-nine (569) days to eight hundred three (803) days. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that applicant is correct that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

> Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —
>
> (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is noted that a Request for Continued Examination (RCE) was filed in this application on August 11, 2008.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

In re Patent No. 7,500,444 :
Bonney et al. :
Issue Date: March 10, 2009 :
Application No. 10/518,421 : DECISION ON REQUEST FOR
Filed: December 17, 2004 : RECONSIDERATION OF
Attorney Docket No. PB60210USW : PATENT TERM ADJUSTMENT
Title: Actuation Indicator For :
A Dispensing Device :

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(b)" filed April 9, 2009. This petition will be treated under 37 CFR 1.705(d).

The request for reconsideration of patent term adjustment is **DISMISSED**.

On March 10, 2009, the above-identified application matured into US Patent No. 7,500,444 with a patent term adjustment of 565 days. This request for reconsideration of patent term adjustment (including the required fee) was timely filed within two months of the issue date of the patent. See 37 CFR 1.705(d).

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 35 U.S.C. §154(b)(1)(A) overlaps with a delay under 35 U.S.C. §154(b)(1)(B) only if the delays occur on the same day. Patentees maintain that the period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.703(b), 238 days, do not overlap with the 592 day period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a), as these periods do not occur on the same day.

Thus, patentees request that the determination of patent term adjustment be increased by 238 days to a total of eight hundred three (803) days (592+238-27 days for applicant delay).

However, it should be noted that the calculation of any over three year delay for an application filed pursuant to 35 USC 371 is calculated based upon the commencement date. In this instance the commencement date of the application was December 21, 2004. Thus, the application was pending three years and 234 days until the filing of the RCE on August 11, 2008. For purposes of this decision the Office will utilize, patentees' calculations. As the Office contends the 234 days overlaps with the 592 days for examination delay.

The 238 day period is calculated based on the application having been filed under 35 U.S.C. §371 on December 17, 2004, and a request for continued examination (RCE) having being filed on August 11, 2008. The filing of a RCE cuts-off the 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).

Accordingly, patentees contend the period of adjustment under § 1.702(b) is 238 days, counting the number of days beginning on December 17, 2007 and ending on August 11, 2008.

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 applicants failed to engage in reasonable efforts to conclude prosecution pursuant to 37 CFR §1.704.

The Office agrees that as of the issuance of the filing of the RCE on August 24, 2008, the application was pending three years and 238 days after its filing date. (It should however be noted that the three year delay for applications filed under 35 USC §371 are calculated based upon the commencement date.) The Office agrees that because certain actions were not taken within specified time frames, the patent is entitled to an adjustment of 592 days pursuant to 37 CFR 1.702(a). At issue is whether patentees should accrue an additional 238 days of patent term adjustment for the Office taking in excess of three years to issue the patent, as well as 238 days for Office failure to take

a certain action within a specified time frame (or examination delay).

The Office contends that 238 days overlap. 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 applicants. 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 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 or 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 during which the application was pending before the Office, December 17, 2004 to March 10, 2009 (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)). 592 days of patent term adjustment were accorded prior to the issuance of the patent for the Office failing to respond within a specified time frame. Otherwise, the Office took all actions set forth in 37 C.F.R. § 1.702(a) within the prescribed timeframes.

Accordingly, at issuance, the Office properly entered an overall adjustment of 592 days of patent term adjustment for the Office taking in excess of three years to issue the patent.

In view thereof, no adjustment to the patent term will be made because the correct adjustment of 565 days is properly set forth in the Letters Patent (adjustments totalling 592 days less reductions totalling 27 days).

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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).

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 Charlema Grant, Petitions Attorney, at (571) 272-3215.

Kery A Fries

Kery Fries
Senior Legal Advisor Attorney
Office of Patent Legal Administration

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SUITE 305
ALEXANDRIA, VA 22314

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Adalbert Huber | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7579079 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/25/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/518,464 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/18/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **347** 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.

06 JUL 2005

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP01 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

In re Application of
GHIDINI et al.
Application No.: 10/518,473
PCT No.: PCT/EP02/08541
Int. Filing: 31 July 2002
Priority Date: 24 April 2002
Attorney Docket No.: 05788.0333
For: OPTICAL DEVICES COMPRISING SERIES OF BIREFRINGENT WAVEPLATES

DECISION ON

PETITION UNDER

37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 20 December 2004 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "entire delay in filing the required fees, transmittal papers and documents to enter the national phase from the due date for entering the national phase until the filing of this petition, 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 $300 has been provided. 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 20 December 2004.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

Telephone: 571-272-3286
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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,435,742 | : | |
| Prat Quinones, et al. | : | DECISION ON |
| Issue Date: October 14, 2008 | : | REQUEST FOR RECONSIDERATION |
| Application No. 10/518,496 | : | OF |
| Filed: September 19, 2005 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. 09605.0044 | : | |

This is a decision on the "**POST GRANT APPLICATION FOR PATENT TERM ADJUSTMENT**," filed November 12, 2008, requesting that the patent term adjustment determination for the above-identified patent be changed from two hundred ninety-six (296) days to three hundred twenty-two(322)days. The petition will be treated under 37 CFR §1.705(d).

The request for reconsideration of patent term adjustment is **DISMISSED**.

On October 14, 2008, the above-identified application matured into U.S. Patent No. 7,435,742 with a patent term adjustment of 296 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).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Patentees argue that the determination of 296 days is in error in that pursuant to 35 U.S.C. §154(b) the Office failed to issue a patent within three years of the actual filing date of the above-referenced application in accordance with 37 CFR § 1.702(b) and failed to take a certain action within a time frame specified in 37 CFR § 1.702(a).

Patentees argue that the period of adjustment due to the Three Year Delay by the Office, pursuant to 37 CFR § 1.702(b), is 26 days. Patentees calculate this 26 day period based on the application having fulfilled requirements under 35 U.S.C. §371 on September 19, 2005, and the patent having not issued until October 14, 2008, three years and 26 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 June 21, 2002. Thirty months from that date is December 21, 2004. Accordingly, the period of adjustment under § 1.702(b) is 298 days, counting the number of days beginning on December 22, 2007 and ending on October 14, 2008 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)(1) of 383 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 on which the application was filed under 35 U.S.C. § 371. A non-final Office action was mailed on December 7, 2007, 14 months and 383 days after the application fulfilled requirements under 35 U.S.C. §371.

Under 37 CFR § 1.703(f), applicants 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 applicants 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 87 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 (26 days per patentees' calculation) and the period of Examination Delay (383 days, not in dispute) **to the extent that these periods of delay are not overlapping.**

Patentees contend that no portion of the Three Year Delay period overlaps with the period of 14 month examination delay.

Considering the Three Year Delay period is properly calculated based on the commencement date and is 298 days (December 22, 2007 to October 14, 2008), not 26 days, patentees assertion of entitlement to a patent term adjustment is considered to be 594 days (298 + 383 reduced by 0 overlap - 87 for applicant delay).

As discussed above, the Office states that the patent issued 3 years and 298 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 383 days is correct. At issue is whether Patentees should accrue 298 (per 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, 383 days for Office failure to take a certain action within a specified time frame (or examination delay).

The Office contends that 298 days overlap. 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. 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[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. 7,435,742, December 21, 2004 to October 14, 2008. (There were no periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)).

383 days of patent term adjustment were accorded prior to the issuance of the patent for the Office failing to respond within a specified time frame during the pendency of the application. During that time, the issuance of the patent was delayed by 383 days, not 383 + 298 days. The Office took 14 months and 383 days to issue a first Office action. Otherwise, the Office took all actions set forth in 37 C.F.R. § 1.702(a) within the prescribed timeframes. Nonetheless, given the initial 383 days of Office delay and the time allowed within the timeframes for processing and examination and applicant delay, the patent issued, three years and 298 days after its filing date. The Office did not delay 383 days then an additional 298 days. The 298 days attributable to the delay in the issuance of the patent overlaps with the adjustment of 383 days attributable to ground specified in § 1.702(a)(1). Entry of both periods is not warranted.

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.

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent is 296 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

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FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

| | |
|---|---|
| In re Patent No. 7,435,742 | : DECISION ON REQUEST |
| Prat Quinones et al. | : FOR |
| Issue Date: October 14, 2008 | : RECONSIDERATION OF |
| Application No. 10/518,496 | : PATENT TERM ADJUSTMENT |
| Filed: September 19, 2005 | : and |
| Atty Docket No. 09605.0044 | : NOTICE OF INTENT TO ISSUE |
| | : CERTIFICATE OF CORRECTION |

This is a decision on the reconsideration petition filed on November 24, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by five hundred ninety-four (594) 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 five hundred ninety-four (594) days is **GRANTED**.

The Office acknowledges previous submission of the $200.00 fee set forth in 37 CFR 1.18(e) on November 12, 2008. No additional fees are required.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **five hundred ninety-four (594)** days.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Shirene Willis Brantley at (571) 272-3230.

Anthony Knight
Supervisor
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,435,742 B2

DATED : **October 14, 2008** **DRAFT**

INVENTOR(S) : Prat Quinones 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 U.S.C. 154(b) by 296 days

Delete the phrase "by 296 days" and insert – by 594 days--

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SQUIRE, SANDERS & DEMPSEY L.L.P.
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8000 TOWERS CRESCENT
TYSONS CORNER, VA 22182

In re Application of :
Matti MYYRY et al. :
Application No. 10/518,520 : DECISION ON PETITION
Filed: December 21, 2004 :
Attorney Docket No. 60091.00366 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 14, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed April 11, 2007, which set a shortened statutory period for reply of three (3) months. 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). Since the amendment submitted does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b). A three (3) month extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is October 12, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810.00, and the submission required by 37 CFR 1.114; (2) the petition fee of $1,540.00; and (3) a proper statement of unintentional delay. Accordingly, the reply to the final Office Action of April 10, 2007 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571)-272-4231.

This application is being referred to Technology Center AU 2618 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.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

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Mailed: 8-30-07

WK

In re application of :
Oles et al. : DECISION ON
Serial No. 10/518,533 : PETITION
Filed: December 30, 2004 :
For: Method For Producing A Surfactant-Free Suspension Based On Nanostructured, Hydrophobic Particles, And Use Of The Same :

This is a decision on PETITION TO EXPUNGE UNDER 37 C.F.R. 1.59(b), filed March 7, 2007, which has been accepted as a timely petition under 1.59(b) and MPEP 724.02 and is before the Group Director of Technology Center for consideration.

**DECISION**

Petitioner requests that the amendment submitted on December 12, 2006 matched with the application be expunged. Each of the criteria for granting the request has been satisfied, see the MPEP 724.05.

The petition is **GRANTED.**

Section 1.59 has been amended to eliminate references to returning documents that have been expunged to recognize that, with electronic Official files, there will be nothing to return when a paper is expunged.

The Office is capturing electronic images of all documents that form the Official file. Where the image is generated from a physical source document, the originating document may be disposed of once the electronic image accuracy is verified. The paper source document will eventually be destroyed under a United States National Archives and Records Administration (NARA) approved schedule. Therefore, if a document is to be expunged from the record, the only operation that will be required will be removal of the image from the Official file.

Paragraph (a)(1) of §1.59 has been amended by deleting the phrase "and returned " from the first sentence, and deleting the second sentence. Paragraph (b) of §1.59 has been amended by deleting the phrase "and return " from each of the first and second sentences. The Office will

continue to provide notice in the Official file that a paper has been expunged and the Office will send a decision to the applicant notifying the applicant that the paper has been expunged.

The image of the document will be removed from the Official file.

Jacqueline M. Stone /mk

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

James J. Kelly
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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PO BOX 747
FALLS CHURCH, VA 22040-0747

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Juhana Enqvist | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7610371 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/27/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/518,553 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/22/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **583** 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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| | | |
|---|---|---|
| In re Patent No. 7,618,747 | : | DECISION ON REQUEST |
| Audemer et al. | : | FOR |
| Issue Date: November 17, 2009 | : | RECONSIDERATION OF |
| Application No. 10/518,560 | : | PATENT TERM ADJUSTMENT |
| Filed: August 31, 2005 | : | and |
| Atty Docket No. 13566.105013 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on January 19, 2010, 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 seventy-five (975) 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 **One thousand one hundred-thirteen (1113)** days.

The "B" delay period is 726 days, not 443 days. Patentee calculated this period based on the date this application fulfilled the requirements of 35 U.S.C. 371. However, in an international application, this period is based on the failure of the Office to issue a patent within three years after the national stage commenced under 35 U.S.C. 371(b) or (f). See 1.702(b). Further, in this instance, the national stage commencement date is Monday, November 22, 2004. The priority date of this application is June 21, 2002. As the requirements for early commencement were not met, the national stage commenced in this application at the end of the thirty-month

period. As the expiration of the 30-month period pursuant to 35 U.S.C. 371(b) fell on a Sunday, the period expired on the subsequent business day. See PCT Rule 80.5. Accordingly, the commencement date is Monday, November 22, 2004. Thus, "B" delay is 726 days, counting the number of days beginning on November 23, 2007 and ending on November 17, 2009, the date of issuance. See 1.703(b). Therefore, the patent term adjustment is 1113 (532 + 726 - 145) days.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **One thousand one hundred-thirteen (1113)** 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 : 7,618,747 B2

DATED : **November 17, 2009** **DRAFT**

INVENTOR(S) : Audemer 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 532 days

Delete the phrase "by 532 days" and insert – by 1113 days--

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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** | : Laurent Tessier | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7586465 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 10/518,567 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/25/2005 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **844** 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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DENVER, CO 80202

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OFFICE OF PETITIONS

In re Application of :
Pappalardo et al. : DECISION ON
Application No. 10/518,608 : PETITION
Filed: December 23, 2004 :
Atty Docket No. 02-CT-104/DP :

This is a decision on the PETITION TO CORRECT ORDER OF INVENTORS UNDER 37 C.F.R. § 1.182, filed July 5, 2005.

The petition is **GRANTED**.

The order of the names of the inventors has been changed as follows:

1. Salvatore PAPPALARDO
2. Francesco PULVIRENTI
3. Salvatore PRIVITERA
4. Leonardo SALA

Receipt of the petition fee of $400 is acknowledged.

Please find enclosed a corrected filing receipt.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Corrected Filing Receipt