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1400 Crescent Green, Suite 300
Cary, NC 27518

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Gianmarco Bruno | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7634167 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/570,987 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/28/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **251** 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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VOLPE AND KOENIG, P.C.
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA PA 19103

| | | |
|---|---|---|
| In re Application of | : | |
| HOWARD, Christopher Michael, et al. | : | |
| Application No.: 11/571,000 | : | DECISION ON |
| PCT No.: PCT/AU2004/000961 | : | |
| Int. Filing Date: 19 July 2004 | : | PETITION |
| Priority Date: 30 July 2003 | : | |
| Attorney Docket No.: MOR3-PT026 | : | UNDER 37 CFR 1.181 |
| For: ROPE TENSIONING DEVICE | : | |

This decision is in response to applicant's Petition to ReviveUnder 37 CFR 1.137(a), filed with the United States Patent and Trademark Office on 29 October 2008. It has been treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181.

## BACKGROUND

On 20 December 2006, applicant filed a national phase entry into the United States for PCT/AU2004/000961, accompanied by a declaration of the inventor and fees. A copy of the international application was transmitted to the Office on 10 February 2005.

On 02 September 2008, the Office mailed Notification of Abandonment (Form PCT/DO/EO/909) indicating the application went abandoned for failure to furnish a copy of the international application by 30 months.

On 29 October 2008, applicant submitted the instant petition.

## DISCUSSION

The Notification of Abandonment issued in error. A copy of the international application had been previously transmitted to the Office and a copy of the application accompanied applicant's 20 December 2006 submission. Further, applicant paid the basic national fee, search fee, and examination fee and furnished a declaration of the inventor.

The fee for the petition to revive under 37 CFR 1.137(a) will be refunded to deposit account no. 22-0493, as authorized.

## CONCLUSION

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

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 02 September 2008, is **VACATED**.

This application is being forwarded to the National Stage Processing Division of the Office of Patent Application Processing for continued processing. The application has a 35 USC 371(c)(1), (c)(2) and (c)(4) date of 20 December 2006.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

14 OCT 2008

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

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| He et al | : | |
| Application No.: 11/571,001 | : | |
| PCT No.: PCT/EP05/006002 | : | |
| Int. Filing Date: 3 June 2005 | : | PETITION UNDER |
| Priority Date: 4 June 2004 | : | |
| Attorney's Docket No.: 33840US PCT | : | |
| For: BIOMARKERS FOR THE... | : | |
| CLOZAPINE TREATMENT | : | 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 C.F.R. 1.137(b)," filed on 20 December 2006.

## BACKGROUND

On 3 June 2005, this international application was filed, claiming an earliest priority date of 4 June 2004.

The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 4 December 2006. This international application became abandoned with respect to the United States at midnight on 4 December 2006 for failure to pay the required basic national fee.

On 20 December 2006, applicant filed the instant petition under 37 CFR 1.137(b) and a Transmittal letter for entry into the national stage in the United States, which was accompanied by the basic national fee and the petition fee. However, no executed declaration was filed at such time.

## DISCUSSION

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

information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

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

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

## DECISION

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

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

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

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

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OFFICE OF PETITIONS

Applicant: Inoue
Appl. No.: 11/571,019
International Filing Date: June 21, 2005
Title: APPARATUS FOR PRODUCING IC CHIP PACKAGE
Attorney Docket No.: 06920/0205900-US0
Pub. No.: 2008/0310938 A1
Pub. Date: December 18, 2008

This is a decision on the request for corrected of patent application publication under 37 CFR 1.221(b), received on February 13, 2009, for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication contains material errors on the front page of the publication wherein the foreign priority data is missing.

37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. [1]

The error in the foreign priority data on the front page of the publication is an Office mistake, but it is not a material mistake as required by 37 CFR 1.221(b). The error in the foreign priority data is not a material mistake because it does not affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. The specification and claims were accurately published, thus one can read and understand the content of the application. The error also does not affect the use of the patent application publication as a prior art reference, because the foreign priority date is not useable as a reference date. Additionally, the first paragraph of the specification contains the foreign priority data.

[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 September 9, 2008 and September 23, 2008 Filing Receipts were mailed by the Office, which improperly listed the foreign priority information. 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 prior to export of the publication to the publisher.

It would greatly benefit the Office if **applicant did not provide copies of papers**, which were previously submitted and/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.

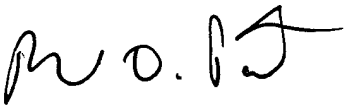
A guide for filing a request for a Pre-Grant Publication, such as a request for republication may be found on the link below:

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

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

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



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

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09 APR 2009

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SAUL EWING LLP
CENTRE SQUARE WEST
1500 MARKET STREET, 38TH FLOOR
PHILADELPHIA, PA 19102-2189

In re Application of PROUX et al.
Application No.: 11/571,023
PCT No.: PCT/GB05/02464
Int. Filing: 22 June 2005
Priority Date: 24 June 2004
Attorney Docket No.: 5459-126US/P32
For: A METHOD FOR IMPROVING THE PERFORMANCE OF A FILE SYSTEM IN A COMPUTING DEVICE

: DECISION ON PETITION
: UNDER 37 CFR 1.47(a)

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 05 February 2009, to accept the application without the signature of the joint inventor GUILLAUME PROUX. Applicant's request for a four month extension of time is granted.

## BACKGROUND

On 20 December 2006, 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 06 August 2008, 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 05 February 2009, applicant filed a petition under 37 CFR 1.47(a) along with a declaration, executed by the joint inventor on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a), in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), requested the acceptance of the application without the signature of inventor GUILLAUME PROUX alleging that Mr. PROUX refused to sign the application.

## DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(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).

Petitioner satisfied Item (1) with the payment of the petition fee.

With respect to Item (2) above, Petitioner submitted the declaration of Sophia Koen, the Patent Administrator for Symbian Software Limited. Ms. Koen states that she made numerous attempts to reach Mr. Proux by email to obtain his signature on the declaration/power of attorney and attempted to reach him via facsimile, without success.

Inventor's Refusal to Sign

Ms. Koen's declaration indicates that she forwarded the *declaration and power of attorney and assignment documents* to applicant via email, requesting that the documents be executed. It appears that only the declaration/POA and assignment referring to this national stage application were sent to Mr. PROUX. There is no evidence that a complete copy of the application papers for PCT/GB05/02464 including the specification, claims, declaration and any drawings were presented to the nonsigning inventor. It is clear from the emails and the faxed letter that a complete copy of the above-identified application, including specification, claims, drawing(s) and declaration were not sent to Mr. PROUX for his signature. Such presentation of the complete copy of the application is required. See Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal.[1]

From the evidence presented one cannot conclude that Mr. PROUX refuses to sign the application papers. The action taken by petitioner is not sufficient to prove that Mr. PROUX refuses to sign the application papers.

Petitioner has not satisfied (3) as Petitioner has not provided the last known address for the nonsigning inventor but provided two different addresses for the nonsigning inventor.

With regard to Item (4), a review of the declaration reveals that the declaration executed by inventor Roberts has been altered with regard to his residence and mailing address. The USPTO does not accept a declaration that has been altered.

Section 602.01 of the MPEP states the following:

> The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required....

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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.
(Emphasis added.)

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether non-initialed and/or non-dated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration.

The change made in the declaration executed by inventor Roberts was not dated and initialed or signed. Therefore, a new acceptable oath or declaration executed by, in compliance with 37 CFR 1.497(a) and (b), is required to satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States.

In sum, Petitioner has satisfied Item (1). The last known address of the nonsigning inventor is required to satisfy Item (3). A new declaration, executed by the joint inventor Roberts, is required to satisfy Item (4).

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 11/571,023 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and Mr. PROUX's refusal to sign, either in writing or by telephone, these documents.

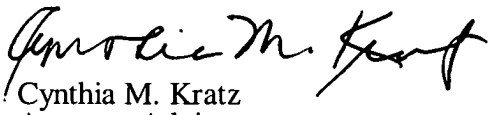
As set forth above, Items (2), (3) and (4) are not yet satisfied. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

## CONCLUSION

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

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

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



Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Office of PCT Legal Administration
Telephone: (571) 272-3286
Facsimile (571) 272-0459

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PHILADELPHIA, PA 19102-2189

| | |
|---|---|
| In re Application of PROUX et al. | : |
| Application No.: 11/571,023 | : DECISION ON PETITION |
| PCT No.: PCT/GB05/02464 | : |
| Int. Filing: 22 June 2005 | : UNDER 37 CFR 1.47(a) |
| Priority Date: 24 June 2004 | : |
| Attorney Docket No.: 5459-126US/P32 | : |
| For: A METHOD FOR IMPROVING THE PERFORMANCE OF A FILE SYSTEM IN A COMPUTING DEVICE | : |

This is a decision on applicant's renewed petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 09 June 2009.

## BACKGROUND

On 20 December 2006, 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 06 August 2008, 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 05 February 2009, applicant filed a petition under 37 CFR 1.47(a) along with a declaration, executed by the joint inventor on behalf of the nonsigning inventor. The petition requested the acceptance of the application without the signature of inventor PROUX alleging that Mr. PROUX refused to sign the application.

On 09 April 2009, a decision dismissing the petition was mailed.

## DISCUSSION

Petitioner has now presented the declaration signed by inventor Guillaume Proux and the joint inventors. A review of the declaration reveals that the declaration identifies and is executed by all the inventors named in the international application. The declaration states the residency, citizenship and mailing address of each inventor.

The petition under 37 CFR 1.47(a) is considered moot as declaration executed by the previously unavailable inventor has now been submitted. The declaration is acceptable under 37 CFR 1.497(a) and (b).

## CONCLUSION

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

The declaration, executed by the joint inventors and submitted on 09 June 2009, is in compliance with 37 CFR 1.497(a) and (b) and is acceptable.

This application is being forwarded to United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is 09 June 2009.

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

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

22 SEP 2008

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

| | | |
|---|---|---|
| In re Application of | : | |
| Schuebeler | : | |
| Application No.: 11/571,026 | : | |
| PCT No.: PCT/EP2005/002251 | : | |
| Int. Filing Date: 03 March 2005 | : | DECISION |
| Priority Date: 18 June 2004 | : | |
| Attorney Docket No.: 33849 US PCT | : | |
| For: Analysis Of Methylated Nucleic Acid | : | |

The petition to revive under 37 CFR 1.137(b) filed on 20 December 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 for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of the basic national fee, and has paid the petition 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.

The $130.00 surcharge under 37 CFR 1.492(h) is being charged to counsel's Deposit Account 19-0134, per the authority contained in the Transmittal Letter filed on 20 December 2006.

This application is being forwarded to the Office of Patent Application Processing for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **20 December 2006**.

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

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OFFICE OF PETITIONS

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BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

Applicant: Costa, et al.
Appl. No.: 11/571,030
International Filing Date: January 6, 2005
Title: METHODS OF INHIBITING TUMOR CELL PROLIFERATION WITH FOXM1 siRNA
Attorney Docket No.: 04-519-B
Pub. No.: US 2009/0075376 A1
Pub. Date: March 19, 2009

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on April 7, 2009, for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication contains material errors on the front page of the publication wherein the name of the first inventor Robert Costa is incorrectly spelled as Robert Cossta.

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 on the front page of the publication wherein the spelling of the first named inventor is incorrect may be an Office error, but it is not a material Office error under 37 CFR 1.221. The misprinting of the inventor's name does not affect the understanding of the application. 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

[1] Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

the 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.

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

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

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

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

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. |
|---|---|---|---|---|
| 11/571,037 | 09/02/2008 | Toshio Unno | YAM-124 | 8288 |

7590 01/29/2010

RABIN & Berdo, PC
1101 14TH STREET, NW
SUITE 500
WASHINGTON, DC 20005

| EXAMINER | |
|---|---|
| LIU, HENRY Y | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3654 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 01/29/2010 | 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.

Nimi James

Patent Publication Branch
Office of Data Management

UNITED STATES PATENT AND TRADEMARK OFFICE

23 AUG 2007

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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ROBERTS, MLOTKOWSKI & HOBBES
P. O. BOX 10064
MCLEAN VA 22102-8064

| | | |
|---|---|---|
| In re Application of | : | |
| PAETZ, et al. | : | |
| Application No.: 11/571,087 | : | |
| PCT No.: PCT/EP05/01459 | : | DECISION ON PETITION |
| Int. Filing Date: 14 February 2005 | : | |
| Priority Date: 18 February 2004 | : | UNDER 37 CFR 1.137(b) |
| Atty. Docket No.: 033171-127 | : | |
| For: ARRANGEMENT FOR SEALING AN OPENING OF A VEHICLE WITH A WINDOW AND AN ANTI-SPLINTER ELEMENT | : | |

The petition to revive under 37 CFR 1.137(b) filed 21 December 2006 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 February 2005 under 35 U.S.C. 363 and will be given a date of **21 December 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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Alexandria, Virginia 22313-1450
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STITES & HARBISON PLLC
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA, VA 22314

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Matthieu Rouget | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7576843 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/18/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/571,095 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/21/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **309** 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.

27 NOV 2007

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Alexandria, VA 22313-1450
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Eric M. Bram
Philips Intellectual Property & Standards
P.O. Box 3001
Briarcliff Manor, NY 10510

| | | |
|---|---|---|
| In re Application of | : | |
| GOUGH | : | |
| U.S. Application No.: 11/571,097 | : | DECISION ON PETITION |
| PCT No.: PCT/IB05/52165 | : | |
| Int. Filing Date: 29 June 2005 | : | UNDER 37 CFR 1.182 |
| Priority Date: 01 July 2004 | : | |
| Attorney's Docket No.: GB040136US1 | : | |
| For: A FABRIC SENSOR AND A GARMENT INCORPORATING THE SENSOR | : | |

This is a decision on applicant's "Petition to Correct Erroneously Filed Application Papers" filed on 15 November 2007 in the United States Patent and Trademark Office (USPTO). The petition is being considered under 37 CFR 1.182. As authorized, the $400.00 petition fee will be charged to deposit account number 14-1270.

## BACKGROUND

On 29 June 2005, applicant filed international application PCT/IB05/52165 which claimed priority to an earlier application filed 01 July 2004. A copy of the international application was transmitted by the International Bureau (IB) on 12 January 2006. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 01 January 2007.

On 21 December 2006, 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 Application Data Sheet; a copy of the international application. All of the filed papers referenced PCT/IB**03/00425**.

On 24 October 2007, applicant was mailed a "Notification of Abandonment" (Form PCT/DO/EO/909) for failure to respond to provide payment of the U.S. basic national fee prior to the expiration of thirty months from the priority date.

On 15 November 2007, applicant filed the present petition indicating that the wrong international application number had been entered while electronically filing the above-caption application and that the papers filed on 21 December 2006 were intended as the U.S. National stage entry of international application PCT/**IB05/52165**.

## DISCUSSION

Based on applicant's error, a national stage application file was created for PCT/IB03/00425, rather than for PCT/IB05/52165. Further, review of the application papers originally filed on 21 December 2006 reveals that none of the originally filed papers identified PCT/IB05/52165. Applicant has presently provided a statement indicating the correct pct number, as well as, a new Application Data Sheet. While applicant argues that the correct information was given in the executed declaration filed with the international application, all of the identifier information in the papers filed under 35 U.S.C. 371 on 21 December 2006, referenced international application PCT/IB03/00425. As such, none of the information provided on 21 December 2006 could be used to identify the correct international application. Therefore, the basic national fee cannot be associated with the correct international application no. PCT/IB05/52165 as of 01 January 2007, and thus, the application was properly **ABANDONED** for failure to timely pay the basic national fee.

In order to continue processing of the national stage application for PCT/IB05/52165, applicant must submit a petition to the Commissioner under 37 CFR 1.137(a) or (b) requesting that the application be revived. Any petition filed under 37 CFR 1.137(a) and/or a petition under 37 CFR 1.137(b) requesting that the application be revived must meet the criteria indicated in the recent revision of 37 CFR 1.137.

## CONCLUSION

Applicant's petition under 37 CFR 1.182 is **DISMISSED**.

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

0 1 FEB 2008

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

Eric M. Bram
Philips Intellectual Property & Standards
P.O. Box 3001
Briarcliff Manor, NY 10510

| | | |
|---|---|---|
| In re Application of | : | |
| GOUGH | : | |
| U.S. Application No.: 11/571,097 | : | DECISION ON PETITION |
| PCT No.: PCT/IB05/52165 | : | |
| Int. Filing Date: 29 June 2005 | : | UNDER 37 CFR 1.137(b) |
| Priority Date: 01 July 2004 | : | |
| Attorney's Docket No.: GB040136US1 | : | |
| For: A FABRIC SENSOR AND A GARMENT INCORPORATING THE SENSOR | : | |

The petition to revive under 37 CFR 1.137(b) filed 24 January 2008 in the above-captioned application is hereby **GRANTED** as follows:

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

A review of the application file reveals that applicant has now provided a statement of unintentional delay perfecting the prior payment of fees associated with PCT/IB03/00425. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

The application has an international filing date of 29 June 2005 under 35 U.S.C. 363 and will be given a date of **24 January 2008** 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 and the establishment of the above-captioned application as the U.S. National stage entry of international application PCT/IB05/52165.

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/571,109 | | Helmut Strecker | 11NS201658 | 9535 |

7590 01/31/2008

GENERAL ELECTRIC CO.
GLOBAL PATENT OPERATION
187 Danbury Road
Suite 204
Wilton, CT 06897-4122

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2882 | |
| NOTIFICATION DATE | DELIVERY MODE |
| 01/31/2008 | ELECTRONIC |

## 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

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LEYDIG VOIT & MAYER, LTC
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6731

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SEP 0 4 2008

Applicant: Banner, et al.
Appl. No.: 11/571,140
International Filing Date: July 1, 2005
Title: C-MET MODULATORS AND METHOD OF USE
Attorney Docket No.: 256061
Pub. No.: US 2007/0179130 A1
Pub. Date: August 2, 2007

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on September 20, 2007, for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication contains material errors on the front page of the application wherein the INID code and inventors name appear incorrectly. Additionally the assignee and provisional information is omitted.

37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. [1]

The errors in the front page of the application do not affect the understanding of the application. The mistakes do 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. As to the provisional data, it is noted that the correct information appears in the specification, as required by 37 CFR 1.78.

[1] Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application 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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27 MAR 2008

ASTRA ZENECA PHARMACEUTICALS LP
GLOBAL INTELLECTUAL PROPERTY
1800 CONCORD PIKE
WILMINGTON DE 19850-5437

In re Application of BERG et al.
Application No.: 11/571,183
PCT No.: PCT/SE05/00955
Int. Filing: 20 June 2005
Priority Date: 24 June 2004
Attorney Docket No.: 101491-1P US
For: NEW DERIVATIVES OF 5-ARYL-1H-PYRROLO [2,3B] PYRIDINE-3-CARBOXAMIDE OR 5-ARYL-1H-PYRROLO [2,3B] PYRIDINE-3-CARBOXLYIC ACID

DECISION ON

PETITION TO REVIVE

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 15 October 2007 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 has now been provided. The required petition fee of $1540 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 **15 October 2007.**

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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14 DEC 2007

CENTRAL COAST PATENT AGENCY, INC
3 HANGAR WAY SUITE D
WATSONVILLE, CA 95076

In re Application of TERMAN et al :
U.S. Application No.: 11/571,188 :
PCT Application No.: PCT/US2005/022638 :
Int. Filing Date: 27 June 2005 :
Priority Date Claimed: 29 June 2004 : DECISION
Attorney Docket No.: P1966US :
For: ENTEROTOXIN GENE CLUSTER (EGC) :
SUPERANTIGENS TO TREAT :
MALIGNANT DISEASE :

This is in response to applicant's "Petition under 37CFR§1.47(a)" filed 10 December 2007.

## BACKGROUND

On 27 June 2005, applicant filed international application PCT/US2005/022638, which claimed priority of an earlier United States application filed 29 June 2004. The thirty-month period for paying the basic national fee in the United States expired on 29 December 2006.

On 22 December 2006, 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 12 October 2007, 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 10 December 2007, 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 inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.
>
> * * *
>
> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition fails to state whether joint inventor Gregory Bohach cannot be found or refuses to sign the application papers. Furthermore, the petition fails to provide an affidavit from the person with firsthand knowledge of attempts to secure Bohach's signature. Such affidavit must supply the information noted above. Because an appropriate affidavit has not been furnished, it would not be reasonable to conclude at the present time that Bohach either cannot be found or 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 fails to state the last known address of the nonsigning inventor.

## CONCLUSION

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

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

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

24 JUL 2008

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3 HANGAR WAY SUITE D
WATSONVILLE, CA 95076

| | | |
|---|---|---|
| In re Application of TERMAN et al | : | |
| U.S. Application No.: 11/571,188 | : | |
| PCT Application No.: PCT/US2005/022638 | : | |
| Int. Filing Date: 27 June 2005 | : | |
| Priority Date Claimed: 29 June 2004 | : | DECISION |
| Attorney Docket No.: P1966US | : | |
| For: ENTEROTOXIN GENE CLUSTER (EGC) SUPERANTIGENS TO TREAT MALIGNANT DISEASE | : | |

This is in response to applicant's "Response to Decision" filed 10 July 2008.

## BACKGROUND

On 27 June 2005, applicant filed international application PCT/US2005/022638, which claimed priority of an earlier United States application filed 29 June 2004. The thirty-month period for paying the basic national fee in the United States expired on 29 December 2006.

On 22 December 2006, 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 12 October 2007, 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 10 December 2007, applicant filed a petition under 37 CFR 1.47(a).

On 14 December 2007, this Office mailed a decision dismissing the 10 December 2007 decision.

On 10 July 2008, 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.

Petitioner 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 Gregory Bohach refuses to sign the application papers. The petition adequately demonstrates that a bona fide attempt was made to present a copy of the application papers to Dr. Bohach for signature (see affidavit of David Terman and electronic mail message dated 18 November 2007). Furthermore, the petition sufficiently illustrates that Dr. Bohach refuses to sign. In particular, Dr. Bohach's failure to respond to repeated requests to return an executed declaration (see Terman affidavit) is deemed a constructive refusal to cooperate. Thus, it can be concluded with reasonable certainty that Dr. Bohach refuses to join in the application.

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

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 27 June 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 10 December 2007.

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

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

24 JUL 2008

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

Gregory Bohach
Department of Microbiology
University of Idaho
Moscow, ID 83844-3052

In re Application of TERMAN et al
U.S. Application No.: 11/571,188
PCT Application No.: PCT/US2005/022638
Int. Filing Date: 27 June 2005
Priority Date Claimed: 29 June 2004
For: ENTEROTOXIN GENE CLUSTER (EGC) SUPERANTIGENS TO TREAT MALIGNANT DISEASE

Dear Gregory Bohach:

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

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

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

CENTRAL COAST PATENT AGENCY, INC
3 HANGAR WAY SUITE D
WATSONVILLE, CA 95076
Attorney Docket No.: P1966US

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CENTRAL COAST PATENT AGENCY, INC
3 HANGAR WAY SUITE D
WATSONVILLE CA 95076

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NOV 03 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| David S. Terman, et al. | : | |
| Application No. 11/571,188 | : | DECISION ON PETITION |
| Filed: December 22, 2006 | : | TO WITHDRAW |
| Attorney Docket No. P1966US | : | 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 21, 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 request was signed by Donald Boys on behalf of all attorneys of record who are associated with customer No. 24739. All attorneys/agents associated with the Customer Number 24739 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

There are no pending Office actions at the present time.

Telephone inquiries concerning 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.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

cc: DAVID S. TERMAN
3 HANGAR WAY, SUITE D
WATSONVILLE, CA 95076

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 |
|---|---|---|---|
| 11/571,188 | 12/10/2007 | David S. Terman | P1966US |

**CONFIRMATION NO. 1577**

**POWER OF ATTORNEY NOTICE**

24739
CENTRAL COAST PATENT AGENCY, INC
3 HANGAR WAY SUITE D
WATSONVILLE, CA 95076

*OC000000038584085*

Date Mailed: 11/03/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/21/2009.

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

/amwise/

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

17 APR 2007

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Greenblum & Bernstein, P.L.C.
1950 Roland Clarke Place
Reston, Virginia 20191

In re Application of
ENDO, Yoshiko
Application No.: 11/571,190
PCT No.: PCT/JP05/11698
Int. Filing Date: 21 June 2005
Priority Date: 24 June 2004
Attorney Docket No.: P31370
For: LIGHT SOURCE DEVICE

DECISION ON PETITION
UNDER 37 CFR 1.182

This decision is issued in response to applicant's "Petition under 37 CFR 1.182 Concerning Inventor Name Change" filed 13 February 2007. Applicant is requesting to change the name of the sole inventor from Yoshiko Kawamura to Yoshiko Endo due to marriage. The $400 petition fee will be charged to counsel's Deposit Account No. 19-0089.

## BACKGROUND

On 22 December 2006, applicant filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia: the basic national fee; a copy of the international application; and a preliminary amendment.

On 13 February 2007, applicant filed an executed declaration of inventor which was accompanied by an affidavit executed by Yoshiko Endo (formerly Yoshiko Kawamura).

## DISCUSSION

Section 605.04(b) of the Manual of Patent Examining Procedure states that:

> Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 35 U.S.C. 1.182 together with an appropriate petition fee.

Applicant is requesting to change the name of the sole inventor from Yoshiko Kawamura to Yoshiko Endo. Accordingly, the present submission has been treated as a petition under 37 CFR 1.182 to correct the name of the sole inventor. For such a petition to be grantable, MPEP § 605.04(c) states that "the petition must include an appropriate petition fee and an affidavit signed with both names and setting forth the procedure

whereby the change of name was effected, or a certified copy of the court order."

Here, applicant's submission included the authorization to charge Deposit Account No. 19-0089 for required fees. Based on this authorization, Deposit Account No. 19-0089 will be charged the requisite petition fee of $400, satisfying the petition fee requirement. As for the affidavit requirement, applicant has submitted a "Declaration of Yoshiko Endo Concerning Name Change" (affidavit) regarding the name change. This affidavit states that the inventor's surname was changed, and that her name was legally changed to Yoshiko Endo as a result of marriage.

## CONCLUSION

Applicant's petition under 37 CFR 1.182 to change the name of record for inventor Yoshiko Kawamura to Yoshiko Endo is **GRANTED**.

Based on the above, the declaration filed 13 February 2007 is acceptable in compliance with 37 CFR 1.497.

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.

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

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27 FEB 2008

Matthias Scholl
14781 Memorial Drive
Suite 1319
Houston, Texas 77079

In re Application of
BYLICKI et al.
Application No.: 11/571,202
PCT No.: PCT/PL03/00105
Int. Filing Date: 09 October 2003
Priority Date: 28 October 2002
Attorney Docket No.: LKOR-00301-NUS
For: METHOD OF OBTAINING HIGH-QUALITY PRODUCTS FROM POLYOLEFINE WASTE MATERIAL OR POLYOLEFINES

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 22 December 2006 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
Fax: (571) 273-0459

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MARSH, FISCHMANN & BREYFOGLE LLP
3151 SOUTH VAUGHN WAY
SUITE 411
AURORA CO 80014

02 MAR 2007

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Domen | : | |
| Application No.: 11/571,210 | : | |
| PCT No.: PCT/FR2005/001586 | : | |
| Int. Filing Date: 23 June 2005 | : | PETITION UNDER |
| Priority Date: 24 June 2004 | : | |
| Attorney's Docket No.: 50053-00001 | : | |
| For: IMPROVED COOLING DEVICES VARIOUS APPLICATIONS | : | 37 CFR 1.137(b) |

This decision is in response to applicant's "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. 1.137(b)," filed on 12 January 2007.

## BACKGROUND

On 23 June 2005, this international application was filed, claiming an earliest priority date of 24 June 2004.

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 December 2006. This international application became abandoned with respect to the United States at midnight on 24 December 2006 for failure to pay the required basic national fee.

On 12 January 2007, applicant filed the instant petition under 37 CFR 1.137(b) and a Transmittal letter for entry into the national stage in the United States, which was accompanied by the basic national fee and the petition fee. However, no executed declaration was filed at such time.

## DISCUSSION

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

information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

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

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

## DECISION

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

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

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

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LATHROP & GAGE LLP
4845 PEARL EAST CIRCLE
SUITE 201
BOULDER CO 80301

MAILED

JUN 09 2010

OFFICE OF PETITIONS

Applicant: Petrenko, Victor
Appl. No.: 11/571,231
International Filing Date: June 22, 2005
Title: PULSE SYSTEMS AND METHODS FOR DETACHING ICE
Attorney Docket: 457675
Pub. No.: US 2009/0199569 A1
Pub. Date: August 13, 2009

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on October 12, 2009, for the above-identified application.

The patent issued on April 27, 2010.

The request is DISMISSED as moot.

Since the application has been issued as a patent, the request is deemed moot.

Inquiries relating to this matter may be directed to Michael Cygan at (571) 272-7700, or to the undersigned at (571) 272-7709.

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

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14 JAN 2008

CHALKER FLORES, LLP
2711 LBJ FRWY
Suite 1036
DALLAS TX 75234

In re Application of KELLY
Application No.: 11/571,233
PCT No.: PCT/IE05/00073
Int. Filing: 28 June 2005
Priority Date: 28 June 2004
Attorney Docket No.: TOMK:1000
For: DOOR JAMB FINGER GUARD

DECISION ON

PETITION TO REVIVE

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 14 December 2007 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 $155 has been provided. The required petition fee of $770 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 December 2007.

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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**VICTORIA DONNELLY**
**PO BOX 24001**
**HAZELDEAN RPO**
**KANATA ON K2M 2C3 CA CANADA**

MAILED

JUL 15 2010

OFFICE OF PETITIONS

In re Application of :
Jack Grzegorz Zoladek, et al. :
Application No. 11/571,273 : DECISION ON PETITION
Filed: December 25, 2006 :
Attorney Docket No. NET-002-US :

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

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before March 3, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed December 3, 2009. Accordingly, the date of abandonment of this application is March 4, 2010. The Notice of Abandonment was mailed March 22, 2010.

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 $755 and the publication fee of $300, (2) the petition fee of $810; and (3) a proper statement of unintentional delay.

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

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.

The Revocation Power of Attorney that was filed on September 28, 2009 and resubmitted on June 8, 2010 was not accepted because it was not accompanied by a statement under 37 CFR 3.73(b).

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

This application is being referred to the Office of Data Management for processing into a patent.

Terri Johnson
Petitions Examiner
Office of Petitions

cc: **EUGENE J.A. GIERCZAK**
**40 KING STREET WEST, SUITE 5800**
**TORONTO, ONTARIO M5H 3S1**

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07 AUG 2007

DEKEL PATENT LTD., DAVID KLEIN
BEIT HAROF'IM
18 MENUHA VENAHALA STREET, ROOM 27
REHOVOT 76209 IL ISRAEL

| | | |
|---|---|---|
| In re Application of | : | |
| Yoav Paltieli | : | |
| Application No.: 11/571,274 | : | DECISION ON PETITION |
| PCT No.: PCT/Il2005/000183 | : | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 13 February 2005 | : | |
| Priority Date: 13 February 2004 | : | |
| Attorney Docket No.: 1386PAL-US | : | |
| | : | |

For: PERFORMING TASKS WITH SENSORS

The petition to revive under 37 CFR 1.137(b) filed December 26, 2006 in the above-captioned application is hereby GRANTED as follows:

On 13 February 2005, applicant file PCT/IL2005/000183 with RO/US. No fees were submitted at this time. International application became abandoned as to the United States for failure to pay the basic national fee and provide documents required by 35 U.S.C. 371©).

On December 26, 2006 Applicant filed the present petition 37 CFR 1.137(b).

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

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

With regard to item (2), 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.

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

Richard Cole
PCT Legal Examiner
Office PCT Legal Administration
Tel.: 571-272-3281
Facsimile: 571-273-0459

Charles Smoot
Paralegal
Office of PCT Legal Administration
Tel.: 571-272-3299

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

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Nobuharu Mashima | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7626554 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/01/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/571,277 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/26/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **122** 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 JAN 2007

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Marsh Fischmann & Breyfogle LLP
3151 South Vaughn Way
Suite 411
Aurora, CO 80014

In re Application of :
ERIKAWA et al. :
Application No.: 11/571,322 : DECISION ON PETITION
PCT No.: PCT/JP04/09106 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 28 June 2004 :
Priority Date: None :
Attorney Docket No.: 50354-00001 :
For: E-MAIL COMMUNITY SYSTEM,
PROGRAM AND RECORDED MEDIUM

The petition to revive under 37 CFR 1.137(b) filed 18 January 2007 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "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
Fax: (571) 273-0459

15 AUG 2008

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BERESKIN AND PARR
40 KING STREET WEST
BOX 401
TORONTO ON M5H 3Y2 CA CANADA

In re Application of CONRAD
Application No.: 11/571,323
PCT No.: PCT/CA05/01579
Int. Filing: 18 October 2005
Priority Date: 26 October 2004
Attorney Docket No.:14308-20
For: METHOD FOR THE AUTOMATED PRODUCTION OF THREE-DIMENSIONAL OBJECTS AND TEXTURED SUBSTRATES FROM TWO-DIMENSIONAL ....

DECISION ON

PETITION TO REVIVE

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 13 August 2008 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 declaration, in response to the 13 December 2007 Notification of Missing Requirements, has now been provided. The required petition fee of $770 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.

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 13 August 2008.

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

**MAILED**

MAR 16 2009

OFFICE OF PETITIONS

In re Application of :
**LINE**, Bruce R. et al. :
Application No. 11/571,340 : DECISION ON PETITION
Filed: January 08, 2008 : TO WITHDRAW
Attorney Docket No. **069944-0702** : 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 27, 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 Gilberto M. Villacorta on behalf of all attorneys of record who are associated with customer No. 22428. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the first named inventor Bruce R. Line at the address indicated below.

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: **BRUCE R. LINE**
**7 DEEP RUN COURT**
**COCKEYSVILLE, MD 21030**

UNITED STATES PATENT and TRADEMARK OFFICE

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

05 JUL 2007

Dorsey & Whitney LLP
Intellectual Property Department
250 Park Avenue
New York, New York 10177

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Vasilescu et al | : | |
| Application No.: 11/571,341 | : | |
| PCT No.: PCT/US2005/001671 | : | |
| Int. Filing Date: 13 January 2005 | : | PETITION UNDER |
| Priority Date: 13 January 2004 | : | |
| Attorney's Docket No.: 036130/US/2-475396-192 | : | |
| For: METHOD SYSTEM, STORAGE... | : | |
| INDEPENDENT COMPONENT ANALYSIS | : | 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 C.F.R. 1.137(b)," filed on 27 December 2006.

## BACKGROUND

On 13 January 2005, this international application was filed, claiming an earliest priority date of 13 January 2004.

The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 13 July 2006. This international application became abandoned with respect to the United States at midnight on 13 July 2006 for failure to pay the required basic national fee.

On 27 December 2006, applicants filed the instant petition under 37 CFR 1.137(b) and a Transmittal letter for entry into the national stage in the United States, which was accompanied by the basic national fee and the petition fee. However, no executed declaration was filed at such time.

## DISCUSSION

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

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

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

## DECISION

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

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

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

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26 OCT 2007

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

| | |
|---|---|
| In re Application of | : DECISION ON |
| Nordin et al | : |
| Application No.: 11/571,391 | : |
| PCT No.: PCT/SE2005/000921 | : |
| Int. Filing Date: 15 June 2005 | : PETITION UNDER |
| Priority Date: 30 June 2004 | : |
| Attorney's Docket No.: 08226/0205911-US0 | : |
| For: COMMUNICATION PLATORM ... | : |
| COMMUNICATION DEVICE | : UNDER 37 CFR 1.182 |

This decision is in response to the "REQUEST TO RESCIND PRELIMINARY AMENDMENT" received 04 October 2007, which is being treated as a petition under 37 CFR 1.182 requesting to rescind the preliminary amendment filed 28 December 2006. The petition fee under 37 CFR 1.182 has not been paid.

## BACKGROUND

On 28 December 2006 applicants 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 U.S. basic national fee. However, no executed oath or declaration accompanied the international application at that time.

Also, included with the filing on 28 December 2006 was a preliminary amendment amending the claims.

On 04 October 2007, applicants filed the current petition.

## DISCUSSION

Section §714 of the Manual of Patent Examining Procedure (M.P.E.P.), **Amendments, Applicant's Action**, set forth the requirements for amending parts of a patent application, the relevant sections states, in part:

**37 CFR 1.121(c):**

c)*Claims*. Amendments to a claim must be made by rewriting the entire claim with all changes (*e.g.*, additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).
(1)*Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (*e.g.*, Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2)*When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn—currently amended."

(3)*When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, *i.e.*, without any underlining.

(4)*When claim text shall not be presented; canceling a claim.*
(i)No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."
(ii)Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.
(5)*Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

Furthermore, section 714.01(e) discusses amendments before a first office action and section 1121of the MPEP discusses the content of a patent application before publication.

Applicants may correct their improper Preliminary Amendment under 37 CFR 1.121 and this is the proper avenue for this category of correction.

As such, the PCT Legal Administration cannot rescind the improper Preliminary Amendment filed by the applicants. However, applicants have proper relief under 37 CFR 1.121.

## DECISION

The petition under 37 CFR 1.182 is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182". Failure to respond will result in the ABANDONMENT of the application. Extensions of time may be obtained under 37 CFR 1.136(a).

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

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3276
Fax: (571) 273-0459

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STITES & HARBISON PLLC
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA, VA 22314

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Jean-Marie Basset | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7635794 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/571,395 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/06/2008 | : 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.

0 6 JAN 2009

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Howrey LLP-CA
c/o IP Docketing Department
2941 Fairview Park Drive, Suite 200
Falls Church, VA 22042-2924

In re Application of
MUIR et al.
Application No.: 11/571,422
PCT No.: PCT/AU05/00966
Int. Filing Date: 30 June 2005
Priority Date: 02 July 2004
Attorney Docket No.:05796.0024.PCUS00
For: USE OF METAL COMPLEXES

: DECISION ON REQUEST

This decision is issued in response to applicants' "Request to Correct Inventorship" filed 07 November 2008, which is being treated as a request under 37 CFR 1.497(d).

## BACKGROUND

On 30 June 2005, applicants filed international application PCT/AU05/00966 which claimed a priority date of 02 July 2004. The published international application identified five applicants/inventors for the United States: Benjamin Ward Muir, Michael C. Barden, Dennis Brian Rylatt, N. Joe Maeji, Carmel Judith Hillyard, and Alain-Dominique Jean-Pierre Gorse. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 07 January 2007.

On 28 December 2006, 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; a copy of the international application; and a preliminary amendment.

On 14 January 2008, applicants filed a declaration executed by: Benjamin Ward Muir, Michael C. Barden, Dennis Brian Rylatt, N. Joe Maeji, Carmel Judith Hillyard, Alain-Dominique Jean-Pierre Gorse and Raisa Leonidovna Monteiro.

On 07 August 2008, 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 the declaration was defective because the sixth inventor (Raisa Leonidovna Monteiro) was not identified on the international application. The notification set a two-month time limit in which to respond.

On 07 November 2008, applicants filed the present request under 37 CFR 1.497(d) to add Raisa Leonidovna Monteiro as an inventor.

## DISCUSSION

The present submission seeks to correct the inventorship so as to add inventor Raisa Leonidovna Monteiro to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), 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; and
> >
> > (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).
> >
> > (4) any new oath or declaration required by paragraph (f) of this subsection.

With respect to the adding Raisa Leonidovna Monteiro to the application, applicants' 07 November 2008 submission satisfies requirements (1) and (2).

Regarding item (3), applicants have submitted a document entitled "Consent of Assignee to Add an Inventor." This document states that the assignee consents to the addition of Raisa Leonidovna Monteiro as inventor herein. However, pursuant to 37 CFR 1.497(d)(3), the consent of the assignee must be submitted in compliance with 37 CFR 3.73(b) (see MPEP 201.03(II)(D)). Here, the statement executed by the assignee does not comply with the requirements of 37CFR 3.73(b)(2). Specifically, the person (N. Joe Maeji) signing the "Consent of Assignee to Add an Inventor" does not have apparent authority to act on behalf of the assignee or states that he is authorized to act on behalf of the assignee.

Additionally, the assignee must establish its ownership to the application in accordance with 37 CFR 3.73. See Manuel of Patent Examining Procedure (MPEP) §324 and Statement under 37 CFR 3.73(b) (Form PTO/SB/96). Applicants must provide such consent before item (3) can be considered satisfied.

For the reasons discussed above, it is inappropriate, at this time, to grant applicants request for correction of inventorship.

## CONCLUSION

Applicants' request to add inventor Raisa Leonidovna Monteiro under 37 CFR 1.497(d) is DISMISSED without prejudice. The inventors of record remain the inventor named on the international application.

Applicants must file a proper response to this decision within **TWO (2) MONTHS** from the mail date indicated above. A proper response must include a written consent of assignee in compliance with 37 CFR 3.73(b). Failure to file a timely and proper response will result in abandonment of the application. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, 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.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

12 MAR 2009

Commissioner for Patents
United States Patent and Trademark Office
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Howrey LLP-CA
c/o IP Docketing Department
2941 Fairview Park Drive, Suite 200
Falls Church, VA 22042-2924

In re Application of
MUIR et al.
Application No.: 11/571,422
PCT No.: PCT/AU05/00966
Int. Filing Date: 30 June 2005
Priority Date: 02 July 2004
Attorney Docket No.:05796.0024.PCUS00
For: USE OF METAL COMPLEXES

DECISION ON REQUEST

In a decision mailed by this Office on 06 January 2009, applicants' request to correct inventorship was dismissed without prejudice for failure to satisfy all the requirements of 37 CFR 1.497(d). Specifically, applicants had not provided the required consent of the assignee to the requested change in inventorship.

On 26 January 2009 and 10 March 2009, applicants filed the renewed request under 37 CFR 1.497(d) considered herein. The submission included the consent of the assignee to the requested correct of inventorship, in the form required under 37 CFR 1.497(d)(3) and 3.73(b).

Applicants' request to correct inventorship under 37 CFR 1.497(d) is **GRANTED**. The inventorship herein is corrected to add Raisa Leonidovna Monteiro as an additional inventor of record.

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.

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

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INGRASSIA FISHER & LORENZ, P.C.
7010 E. COCHISE ROAD
SCOTTSDALE, AZ 85253

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Joachim Schafer | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7661496 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/571,447 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/29/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **392** 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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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

Mail Date: 05/03/2010

| | | |
|---|---|---|
| **Applicant** | : Shigetaka Kasuga | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7667171 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/23/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/571,461 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/29/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **511** 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**
**SUITE 500**
**3000 K STREET NW**
**WASHINGTON, DC 20007**

COPY MAILED

DEC 07 2009

OFFICE OF PETITIONS

In re Application of :
**FEUERBACH,** Dominik :
Application No. 11/571,536 : DECISION ON PETITION
Filed: January 19, 2007 : TO WITHDRAW
Attorney Docket No. **093286-0120** : 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 15, 2009.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to Foley and Lardner LLP has been revoked by the assignee of the patent application on November 20, 2009. 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: **FANELLI STRAIN & HAAG PLLC**
**1455 PENNSYLVANIA AVE., N.W.**
**SUITE 400**
**WASHINGTON DC 20004**

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/571,540 | 01/02/2007 | Steven G.E. Aerts | DE040187US1 | 6732 |

24737 7590 05/04/2010

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

| EXAMINER | |
|---|---|
| RAJAN, KAI | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3769 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/04/2010 | 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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BRIARCLIFF MANOR NY 10510

| | | |
|---|---|---|
| *In re* Application of: | : | |
| AERTS, STEVEN G.E. | : | |
| Serial No.: 11/571,540 | : | DECISION ON PETITION |
| Filed: Jan. 2, 2007 | : | |
| Docket: DE040187US1 | : | |
| Title: WEARABLE DEVICE | : | |

This is a decision on the petition filed on April 26, 2010 seeking withdrawal of the finality of the Office action mailed February 24, 2010. This petition is being considered pursuant to 37 CFR §1.181. No fee is required.

The petition is granted.

It is noted that the record shows that at least claim 11 was not amended in the amendment filed on November 19, 2009. Therefore, the rejection of at least claim 11 was not necessitated by the amendment filed on November 19, 2009. As such, the finality of the Office action issued on February 24, 2010 is premature and thus the finality of the action is hereby withdrawn. The Office action mailed on February 24, 2010 has been designated as non-final Office action. Since the finality is being withdrawn, the Rule 116 amendment filed on April 26, 2010 responding to the Office action of February 24, 2010 will be treated as a 37 CFR § 1.111 amendment. The amendment filed on April 26, 2010 has been entered as Rule 111 amendment.

In finding petitioner's points of argument persuasive, the requested relief is granted. The finality of the last Office action mailed February 24, 2010 is hereby withdrawn. The requested relief is granted.

Any questions regarding this decision should be directed to Special Program Examiner, Henry Yuen, at 571-272-4856.

PETITION GRANTED.

Donald T. Hajec, Director
Technology Center 3700

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21 FEB 2008

THADDIUS J. CARVIS
102 North King Street
Leesburg, VA 20176

| | | |
|---|---|---|
| In re Application of: | : | |
| VALENTINE, James, M., et al. | : | |
| U.S. Application No.: 11/571584 | : | DECISION ON PETITION |
| PCT No.: PCT/US2005/023354 | : | |
| International Filing Date: 01 July 2005 | : | |
| Priority Date: 01 July 2004 | : | |
| Atty Docket No.: CDT PA114-115 US | : | |
| For: FUEL ADDITIVE CONCENTRATE DOSING SYSTEM | : | |

This decision is issued in response to the petition under 37 CFR 1.181 filed 30 November 2007. No petition fee is required.

## BACKGROUND

On 01 July 2005, applicants filed international application PCT/US2005/023354. The international application claimed a priority date of 01 July 2004, and it designated the United States. The deadline for entry into the U.S. national stage and submission of the basic national fee was thirty months from the priority date, i.e., 03 January 2007 (the USPTO was closed on 01 January 2007 and 02 January 2007).

On 03 January 2007, 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 25 June 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 30 November 2007, applicant filed the petition under 37 CFR 1.181 considered herein. The petition asserts that a timely response to the Notification Of Missing Requirements was submitted by facsimile on 16 July 2007. The petition includes a copy of the materials purportedly filed on 16 July 2007, including an executed declaration.

## DISCUSSION

The present petition states that a response to the Notification Of Missing Requirements, including an executed declaration and the authorization to charge Deposit Account No. 50-2735

the required surcharge, was filed by facsimile on 16 July 2007. However, the application file does not contain such responsive materials.

The present petition includes a copy of the facsimile purportedly filed on 16 July 2007. These materials include an executed declaration and a cover letter that identifies the present application, itemizes the attached materials (including the executed declaration), authorizes a charge to Deposit Account No. 50-2735 for the required surcharge, and certifies that the materials are being submitted by facsimile on 16 July 2007 to the PCT Operations Office. The cover letter was executed by counsel, Thaddius J. Carvis. The present petition also includes a copy of the "Auto-Reply Facsimile Transmission" confirmation report generated by the USPTO, confirming receipt of an eight-page facsimile transmission on 16 July 2007 and confirming that such transmission included as a cover letter the cover letter provided by applicants with the present petition.

37 CFR 1.8(b) states the following:

> 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 which, as noted above, includes a cover letter which certifies that the enclosed materials were being transmitted to the USPTO by facsimile on 16 July 2007.

With regard to item (3), as noted above, the present petition includes a copy of the "Auto-Reply Facsimile Transmission" confirmation report generated by the USPTO confirming transmission to the USPTO facsimile number of an eight-page submission in the present application on 16 July 2007. The confirmation report also makes clear that the facsimile transmission included the cover letter provided by applicant with the present petition. The petition also states that the enclosed materials are true copies of the papers originally filed by facsimile on 16 July 2007, and the petition is executed by Thaddius J. Carvis, the attorney who signed the certification contained in the materials filed 16 July 2007 (and a person who would therefore be presumed to have personal knowledge of such transmission). The statements in the

petition, in combination with the facsimile confirmation report, satisfy the requirements of item (3) above.

Based on the above, the present petition satisfies the requirements of 37 CFR 1.8(b). Accordingly, the materials accompanying the present petition (including the executed declaration) are appropriately treated, for purposes of timeliness, as having been filed on 16 July 2007 as a timely response to the Notification of Missing Requirements mailed 25 June 2007. It is noted that, for all other purposes, these materials will be treated as having been filed on 30 November 2007, the filing date of the present petition (see 37 CFR 1.8(a)).

The executed declaration is in compliance with 37 CFR 1.497.

## CONCLUSION

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

Pursuant to 37 CFR 1.8, for purposes of timeliness, the materials accompanying the present petition, including the executed declaration and surcharge payment authorization, are treated as having been submitted on 16 July 2007 as a timely response to the Notification Of Missing Requirements mailed 25 June 2007. Accordingly, no extension fees are required with respect to this submission.

Deposit Account No. 50-2735 will be charged the $130 surcharge for filing the declaration later than thirty months after the priority date.

This application is being returned 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) is 30 November 2007.

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

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STITES & HARBISON PLLC
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA, VA 22314

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Christophe Coperet | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7638672 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/29/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/571,602 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/01/2007 | : 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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12 JAN 2010

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Mark D. Saralino (PAN)
Renner, Otto, Boisselle & Sklar, LLP
1621 Euclid Avenue
19th Floor
Cleveland OH 44115

In re Application of :
MITSUI et al. :
U.S. Application No.: 11/571,612 :
PCT No.: PCT/JP2005/012570 :
Int. Filing Date: 07 July 2005 : DECISION ON PETITION
Priority Date: 08 July 2004 : (37 CFR 1.182)
Attorney Docket No.: OKUDP0208US :
For: RECORDING APPARATUS :

This decision is issued in response to applicants' "Petition under 37 CFR 1.182 Requesting Corrected Domestic Priority Data" filed 08 December 2009. The petition seeks to correct the international application number on the national stage application papers filed 04 January 2007 so as to allow such materials to be treated as the U.S. national stage of PCT/JP2005/012570. The $400 petition fee has been submitted.

## BACKGROUND

On 07 July 2005, applicants filed international application PCT/JP2005/012570, which claimed a priority date of 08 July 2004. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 08 January 2007.

On 04 January 2007, applicants filed electronically a U.S. national stage application that included, among other materials, payment of the U.S. basic national fee. The submission was assigned U.S. application number 11/571,612.

The materials filed 04 January 2007 included a copy of the international application that identified the application as a U.S. national stage of PCT/JP2005/012570, filed 07 July 2005. (The submission also included an application data, preliminary amendment, and executed declaration which identified the international application PCT/JP2005/012570.) The bibliographic data entered by applicants as part of the electronic filing identified the application as a U.S. national stage of PCT/US2005/012570. Thus, applicants' 04 January 2007 filing included conflicting instruction that identified the submission as a U.S.

national stage of two different international applications: PCT/JP2005/012570 and PCT/US2005/012570.

Based on United States Patent and Trademark Office (USPTO) processing procedures, the application file was initiated in the USPTO PALM system as a U.S. national of PCT/US2005/012570, the international application number set forth in the bibliographical data provided by applicant when filing the electronic application.

On 20 October 2009, the USPTO mailed a Notification Of Acceptance indicating that the application was a national stage of PCT/US2005/012570 (the filing receipt also listed the application as a national stage of PCT/US2005/012570).

On 08 December 2009, applicants filed the present petition.

## DISCUSSION

As noted above, the bibliographical data provided by applicant incorrectly identified the international application to which the submission was directed. Correction of this error is required before the materials filed 04 January 2007 can be treated as having been directed to international application PCT/JP2005/012570, as necessary to avoid abandonment of the international application with respect to the United States.

In the present petition filed 08 December 2009, applicants confirm that the listing of international application PCT/US2005/012570 set forth in the bibliographical data (and other documents) provided by applicant was the result of a typographical error, and that the correct international application is PCT/JP2005/012570. It is noted that the correct international application number was listed on the copy of the international application filed 04 January 2007, and it is accompanied by payment of the required petition fee that properly identifies the application as the national stage of PCT/JP2005/012570. These materials satisfy the requirements for a grantable petition to correct the typographical error in the bibliographical data filed 04 January 2007 and to permit such materials to be treated as having been directed to international application PCT/JP2005/012570.

The petition to treat the present application as a national stage of PCT/JP2005/012570 is granted. The Notification Of Acceptance and filing receipt mailed 20 October 2009 (both of which indicate that the application is a national stage of PCT/US2005/012570), are appropriately vacated.

## CONCLUSION

Applicants' petition under 37 CFR 1.182 is **GRANTED**.

The Notification Of Acceptance and filing receipt mailed 20 October 2009 are hereby **VACATED** based on their identification of the present application as a national stage of PCT/US2005/012570.

This application is being returned to the National Stage Processing Branch of the Office Of PCT Operations for processing in accord with this decision, including: (1) correcting USPTO records so as to identify the present application as a national stage of PCT/JP2005/012570; (2) issuing a corrected Notification Of Acceptance; and (3) issuing a corrected filing receipt which properly identifies the application as a national stage of PCT/JP2005/012570 and include the proper priority information.

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

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**ALBIHNS STOCKHOLM AB**
**BOX 5581, LINNEGATAN 2**
**SE-114 85 STOCKHOLM SE**
**SWEDEN**

MAILED

AUG 17 2009

OFFICE OF PETITIONS

In re Application of :
Johnny HEDEROTH :
Application No. 11/571,619 : DECISION ON PETITION
Filed: January 8, 2008 :
Docket No. 191227 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 30, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, December 24, 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 March 25, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1620; and (3) the required 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 $1110 extension of time fee submitted with the petition on June 30, 2009, was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's Deposit Account No. 50-1249.

Telephone inquiries concerning this decision should be directed to Diane Goodwyn at (571) 272-6735.

This application is being referred to Technology Center AU 2831 for appropriate action by the Examiner in the normal course of business.

Thurman K. Page
Petitions Examiner
Office of Petitions

2 0 NOV 2007

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION - WEST BLDG.
WINTON HILL BUSINESS CENTER - BOX 412
6250 CENTER HILL AVENUE
CINCINNATI OH 45224

In re Application of MCLAUGHLIN et al.
Application No.: 11/571,623
PCT No.: PCT/US04/43771
Int. Filing: 29 December 2004
Priority Date: 12 March 2004
Attorney Docket No.: Z-3507/JW
For: SHAVE GEL PRODUCTS

DECISION ON

PETITION TO REVIVE

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 04 January 2007 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 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 basic national fee of $300 has now 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, including issuance of a Notification of Missing Requirements 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, is required.

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

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

11/20/2007 SBASHEIR 00000002 162485 11571623
01 FC:1453 1500.00 DA

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

COPY MAILED

DEC 10 2008

In re Application of :
Yukihiko Hara, et al. :
Application No. 11/571,626 : DECISION ON PETITION
Filed: January 4, 2007 : TO WITHDRAW
Attorney Docket No. 100799.0008US : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 3, 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 petitioner has not certified that (1) he has given reasonable notice to the client, prior to the expiration of the response period, that the practitioners(s) intends to withdraw from employment; (2) delivered to the client or duly authorized agent of 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. Practitioners are not permitted to withdraw from representation as practitioners of record unless all the certifications are made. It is also noted that submitting false certification may violate a practitioner's duty under 37 CFR 10.23(b)(4) and (b)(5).

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.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

Enclosure: Form/PTO/SB/83

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

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

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MAR 0 2 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Yukihiko Hara, et al. | : | |
| Application No. 11/571,626 | : | DECISION ON PETITION |
| Filed: January 4, 2007 | : | TO WITHDRAW |
| Attorney Docket No. 100799.0008US | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 16, 2009.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Rutan & Tucker, LLP has been revoked by the applicant of the patent application on February 5, 2009. 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.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

cc: ROBERT D. FISH
FISH & ASSOCIATES, PC
2603 MAIN STREET
SUITE 1000
IRVINE, CA 92614-6232

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/571,626 | 08/15/2007 | Yukihiko Hara | 100799.0008US |

**CONFIRMATION NO. 8022**

**POWER OF ATTORNEY NOTICE**

34284
Rutan & Tucker, LLP.
611 ANTON BLVD
SUITE 1400
COSTA MESA, CA 92626

*OC000000034735811*

Date Mailed: 02/25/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 02/05/2009.

- The Power of Attorney to you in this application has been revoked by the applicant. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

/amwise/

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

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

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Balint Gabos | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7648992 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/19/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/571,637 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/04/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **100** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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

Mail Date: 05/17/2010

**Applicant** : Balint Gabos
**Patent Number** : 7648992
**Issue Date** : 01/19/2010
**Application No**: 11/571,637
**Filed** : 01/04/2007

: 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 **174** 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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10 MAR 2008

Fish & Richardson, P.C.
P.O. Box 1022
Minneapolis, MN 55440-1022

In re Application of :
ZEHM : DECISION ON PETITION
Serial No.: 11/571,657 :
PCT No.: PCT/EP05/06220 : UNDER 37 CFR 1.47(b)
Int. Filing Date: 09 June 2005 :
Priority Date: 07 July 2004 :
Atty Docket No.: 21873-002US1 :
For: MARKING DEVICE, CIGARETTE ROD :
MAKING MACHINE AND MARKING METHOD:

This decision is in response to the "Petition For Filing of Patent Application by Assignee Under 37 C.F.R.§1.47(b)" filed 11 February 2008 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 09 June 2005, applicant filed international application PCT/EP05/06220 which claimed priority to an earlier application filed 07 July 2004. A copy of the international application was transmitted to the United States by the International Bureau (IB) on 12 January 2006. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 07 January 2007.

On 04 January 2007, 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 English translation of the international application as filed. An executed oath or declaration as required by 35 U.S.C. 371 (c)(4) was not filed.

On 09 November 2007, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an executed oath or declaration of the inventor, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. In addition, applicant was notified of the need to provide a surcharge of $130.00 for filing the oath or declaration later than the appropriate 20 or 30 months from the earliest priority date. (37 CFR 1.492(e)). Applicant was given two months to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 11 February 2008, applicant responded with the present petition.

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(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 non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant has satisfied items (1), (3) and (5).

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature."

In the present case it appears that Mr. Zehm was not sent a complete set of application papers, but merely a declaration and assignment document. However, it is impossible to discern what was mailed to the inventor and what he allegedly signed for as the exhibits submitted by applicant are not in English. In addition, it does not appear that Mr. Andreas Rutetzki, who has executed the filed statement of facts has firsthand knowledge of what was sent to the inventor. As such, it is not possible to consider his subsequent silence as a refusal for the purposes of 37 CFR 1.47.

Regarding item (4), while applicant has provided an oath or declaration executed on behalf of the non-signing inventor, it is not clear that the individual executing the declaration on behalf of the corporate assignee and the non-signing inventor is empowered to do so. Mr. Joerg Thiesen is identified as the "Head of Development & Manufacturing Printing System." It is unclear whether he is a corporate officer or if he is in fact able to execute legal documents on behalf of Wolke Inks & Printers GmbH.

As to item (6), applicant has not provided a statement that granting of the petition is necessary to preserve the rights of the parties or to prevent irreparable damages.

In light of the above, it is not possible to grant applicant's petition at this time.

## CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a

cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Fish & Richardson, P.C.
P.O. Box 1022
Minneapolis, MN 55440-1022

In re Application of :
ZEHM : DECISION ON PETITION
Application No.: 11/571,657 :
PCT No.: PCT/EP05/06220 : UNDER 37 CFR 1.47(b)
Int. Filing Date: 09 June 2005 :
Priority Date: 07 July 2004 :
Atty Docket No.: 21873-002US1 :
For: MARKING DEVICE, CIGARETTE ROD :
MAKING MACHINE AND MARKING METHOD :

This decision is in response to the renewed petition under 37 CFR § 1.47(b) filed 10 October 2008 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 10 March 2008, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(b) to proceed without the signature of inventor Dirk Zehm. Applicant was afforded two months to file any request for reconsideration.

On 10 October 2008, applicant responded with the present renewed petition accompanied by a petition for a five-month extension of time and payment of the extension of time fee. The response is considered timely filed.

## DISCUSSION

As detailed in the decision mailed 10 March 2008, a petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(g); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the non-signing inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as an agent for the non-signing inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. Applicant previously satisfied items (1), (3) and (5).

With the filing of the present renewed petition and supporting documentation, applicant has satisfied the remaining items and it is proper to grant applicant's renewed petition at this time.

## CONCLUSION

For the reasons stated above, applicant's renewed petition under 37 CFR 1.47(b) is **GRANTED**.

The application has an international filing date of 09 June 2005 under 35 U.S.C. 363, and will be given a date of **10 October 2008** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

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

10 DEC 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mr. Dirk Zehm
AM Haar 40
Paulushofen
GERMANY
92339

In re Application of
ZEHM
Application No.: 11/571,657
PCT No.: PCT/EP05/06220
Int. Filing Date: 09 June 2005
Priority Date: 07 July 2004
Atty Docket No.: 21873-002US1
For: MARKING DEVICE, CIGARETTE ROD
MAKING MACHINE AND MARKING METHOD

Dear Mr. Zehm:

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 A. Walters
Fish & Richardson, P.C.
1425 K Street, N.W., 11th Floor
Washington, DC 20005-3500
United States of America

UNITED STATES PATENT AND TRADEMARK OFFICE

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

GIFFORD, KRASS, SPRINKLE,ANDERSON & CITKOWSKI, P.C
PO BOX 7021
TROY, MI 48007-7021

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Ramiro Tarazona de La Asuncion | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7575391 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/18/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/571,668 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/05/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **327** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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

Furr Law Firm
2622 Debolt Road
Utica, OH 43080

In re Application of :
MATEO DELGADO et al. :
Application No.: 11/571,682 : DECISION ON PETITION
PCT No.: PCT/ES2004/000321 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 05 July 2004 :
Priority Date: None :
Attorney Docket No.: 075-6000 :
For: METHOD FOR THE WITHDRAWAL OF FUNDS AT CASH DISPENSERS WITHOUT A CARD, BY MEANS OF A PAYMENT ORDER VIA SMS :

The petition to revive under 37 CFR 1.137(b) filed 15 October 2009 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 declaration of inventorship (Form PTO/SB/01) 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

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

**FURR LAW FIRM**
**2622 DEBOLT ROAD**
**UTICA OH 43080**

COPY MAILED
MAR 12 2010

| | | |
|---|---|---|
| In re Application of | : | |
| Aurora Mateo DELGADO, et al | : | |
| Application No. 11/571,682 | : | NOTICE |
| Filed: October 15, 2009 | : | |
| Attorney Docket No. 075-6000 | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to Diane Goodwyn at (571) 272-6735.

Thurman K. Page
Petitions Examiner
Office of Petitions

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27 FEB 2008

LAW OFFICES OF WILLIAM H. HOLT
12311 HARBOR DRIVE
WOODBRIDGE, VA 22192

In re Application of McCAUSLAND et al :
U.S. Application No.: 11/571,688 :
PCT Application No.: PCT/GB2005/050097 :
Int. Filing Date: 23 June 2005 : DECISION
Priority Date Claimed: 07 July 2004 :
Attorney Docket No.: McCAUSLAND-15865 :
For: PRECIPITATION OF SILICA IN A BAYER PROCESS :

This is in response to applicant's "Response to 371 Formalities Letter and Petition Under Rule 1.47" filed 19 February 2008.

## BACKGROUND

On 23 June 2005, applicant filed international application PCT/GB2005/050097, which claimed priority of an earlier United Kingdom application filed 07 July 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 12 January 2006. The thirty-month period for paying the basic national fee in the United States expired on 07 January 2007.

On 05 January 2007, 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 November 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 19 February 2008, 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 Linda McCausland 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 (including specification, claims, drawings, and oath/declaration) to Ms. McCausland for signature. In particular, although the affidavit of Peter Mansfield states that "the papers" were sent to Mc. McCausland on 30 October 2006, Mr. Mansfield's affidavit neither states that a copy of the application papers were included in the mailing nor is accompanied by a copy of the cover letter. Furthermore, the petition does not sufficiently illustrate that Ms. McCausland refuses to sign. More particularly, Ms. McCausland communicated her willingness to sign during telephone conversations with Mr. Mansfield on 12 December 2006 and 15 January 2007. In addition, copies of purported reminder electronic mail messages have not been provided. Thus, it would not be reasonable to conclude at the present time that Ms. McCausland's behavior evidences a refusal 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 Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

18 JUL 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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LAW OFFICES OF WILLIAM H. HOLT
12311 HARBOR DRIVE
WOODBRIDGE, VA 22192

In re Application of McCAUSLAND et al :
U.S. Application No.: 11/571,688 :
PCT Application No.: PCT/GB2005/050097 :
Int. Filing Date: 23 June 2005 : DECISION
Priority Date Claimed: 07 July 2004 :
Attorney Docket No.: McCAUSLAND-15865 :
For: PRECIPITATION OF SILICA IN A BAYER PROCESS :

This is in response to applicant's " Renewed Petition Under 37 CFR 1.47(a)" filed 27 June 2008.

## BACKGROUND

On 23 June 2005, applicant filed international application PCT/GB2005/050097, which claimed priority of an earlier United Kingdom application filed 07 July 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 12 January 2006. The thirty-month period for paying the basic national fee in the United States expired on 07 January 2007.

On 05 January 2007, 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 November 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 19 February 2008, applicant filed a petition under 37 CFR 1.47(a).

On 27 February 2008, this Office mailed a decision dismissing the 19 February 2008 petition.

On 27 June 2008, applicant filed the present renewed petition under 37 CFR 1.47(a).

## DISCUSSION

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

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

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

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

The petition states that joint inventor Linda McCausland refuses to sign the application papers. However, the petition adequately demonstrates that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to Ms. McCausland for signature (see affidavit of Peter Mansfield, p.2). Furthermore, the petition sufficiently illustrates that Ms. McCausland refuses to sign. In particular, Ms. McCausland's failure to return an executed declaration in response to repeated communications constitutes a constructive refusal to cooperate (see communications dated 18 October 2006, 30 October 2006, and 18 December 2006.) Therefore, it can be concluded with reasonable certainty that Ms. McCausland refuses to join in the application.

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 23 June 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 19 February 2008.

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

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

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

18 JUL 2008

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

Linda McCausland
20 Shepherd Gardens
Abingdon, Oxon
OX 14 5PR
United Kingdom

In re Application of McCAUSLAND et al
U.S. Application No.: 11/571,688
PCT Application No.: PCT/GB2005/050097
Int. Filing Date: 23 June 2005
Priority Date Claimed: 07 July 2004
For: PRECIPITATION OF SILICA IN A BAYER PROCESS

Dear Linda McCausland:

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

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

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

LAW OFFICES OF WILLIAM H. HOLT
12311 HARBOR DRIVE
WOODBRIDGE, VA 22192
Attorney Docket No.: McCAUSLAND-15865

17 JUN 2008

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LAW OFFICES OF WILLIAM H. HOLT
12311 HARBOR DRIVE
WOODBRIDGE, VA 22192

| | | |
|---|---|---|
| In re Application of MCCAUSLAND et al | : | |
| U.S. Application No.: 11/571,718 | : | |
| PCT Application No.: PCT/GB2005/050104 | : | DECISION |
| Int. Filing Date: 06 July 2005 | : | |
| Priority Date Claimed: 07 July 2004 | : | |
| Attorney Docket No.: McCAUSLAND-15862 | : | |
| For: FORMATION OF SUGAR COATINGS | : | |

This is in response to applicant's "Petition Under Rule 1.47" filed 02 May 2008.

## BACKGROUND

On 06 July 2005, applicant filed international application PCT/GB2005/050104, which claimed priority of an earlier United Kingdom application filed 07 July 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 12 January 2006. The thirty-month period for paying the basic national fee in the United States expired on 07 January 2007.

On 05 January 2007, 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 November 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 02 May 2008, 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 declarations signed by the available inventors, each on his own behalf and on behalf of the nonsigning inventor. However, the declarations are improper because each declaration fails to list all of the four inventors as required by 37 CFR 1.497(a)(3).

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 Linda McCausland refuses to sign the application papers. However, petitioner has not demonstrated that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to McCausland for signature. Although the letter from Peter Mansfield dated 24 April 2007 states that declaration and assignment papers were sent to McCausland on 22 December 2006, there is no indication that the specification, claims, and drawings were ever sent to McCausland prior to the purported refusal. Furthermore, petitioner has not sufficiently illustrated that McCausland refuses to sign. In particular, a copy of a cover letter (sent to McCausland with the complete copy of the application papers or sent to McCausland subsequent to McCausland's receipt of a complete copy of the application papers) requesting McCausland's signature must be provided along with an affidavit from the person with firsthand knowledge of such letter. Thus, it would not be reasonable to conclude at the present time that McCausland 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 the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(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 Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

27 AUG 2008

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

LAW OFFICES OF WILLIAM H. HOLT
12311 HARBOR DRIVE
WOODBRIDGE, VA 22192

In re Application of MCCAUSLAND et al :
U.S. Application No.: 11/571,718 :
PCT Application No.: PCT/GB2005/050104 : DECISION
Int. Filing Date: 06 July 2005 :
Priority Date Claimed: 07 July 2004 :
Attorney Docket No.: McCAUSLAND-15862 :
For: FORMATION OF SUGAR COATINGS :

This is in response to applicant's "Renewed Petition 37 CFR 1.47(a)" filed 18 August 2008.

## BACKGROUND

On 06 July 2005, applicant filed international application PCT/GB2005/050104, which claimed priority of an earlier United Kingdom application filed 07 July 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 12 January 2006. The thirty-month period for paying the basic national fee in the United States expired on 07 January 2007.

On 05 January 2007, 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 November 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 02 May 2008, applicant filed a petition under 37 CFR 1.47(a).

On 17 June 2008, this Office mailed a decision dismissing the 02 May 2008 petition.

On 18 August 2008, 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.

With regard to item (1) above, the renewed petition is accompanied by declarations signed by the available inventors, each on his own behalf and on behalf of the nonsigning inventor.

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

> Where 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 Linda McCausland refuses to sign the application papers. The petition adequately demonstrates that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to Ms. McCausland for signature (see affidavit of Peter Mansfield, p.2). Furthermore, the petition sufficiently illustrates that Ms. McCausland refuses to sign. In particular, Ms. McCausland's failure to return an executed declaration in response to repeated communications constitutes a constructive refusal to cooperate (see communications dated 22 December 2006 and 02 February 2007.) Therefore, it can be concluded with reasonable certainty that Ms. McCausland 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 renewed petition states the last known address of the nonsigning inventor.

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 06 July 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 18 August 2008.

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

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

27 AUG 2008

Linda McCausland
20 Shepherd Gardens
Abingdon, Oxon
OX 14 5PR
United Kingdom

In re Application of McCAUSLAND et al
U.S. Application No.: 11/571,718
PCT Application No.: PCT/GB2005/050104
Int. Filing Date: 06 July 2005
Priority Date Claimed: 07 July 2004
For: FORMATION OF SUGAR COATINGS

Dear Linda McCausland:

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

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

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

LAW OFFICES OF WILLIAM H. HOLT
12311 HARBOR DRIVE
WOODBRIDGE, VA 22192
Attorney Docket No.: McCAUSLAND-15862

29 JAN 2008

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

MADSON & AUSTIN
15 WEST SOUTH TEMPLE
SUITE 900
SALT LAKE CITY, UT 84101

In re Application of MULLER :
U.S. Application No.: 11/571,738 :
PCT Application No.: PCT/EP2005/007240 :
Int. Filing Date: 29 June 2005 : DECISION
Priority Date Claimed: 06 July 2004 :
Attorney Docket No.: 3627.2.1 :
For: METHOD AND SYSTEM FOR :
AUTOMATIC COLOR DETERMINATION... :

This is in response to applicant's "Petition Under 37 C.F.R. § 1.182" filed 18 January 2008.

## BACKGROUND

On 29 June 2005, applicant filed international application PCT/EP2005/007240, which claimed priority of an earlier Germany application filed 06 July 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 12 January 2006. The thirty-month period for paying the basic national fee in the United States expired on 06 January 2007.

On 05 January 2007, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US) via the EFS-Web electronic filing system of the USPTO. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 14 November 2007, the DO/EO/US mailed a Notice of Acceptance of Application under 35 U.S.C. 371 (Form PCT/EO/EO/903), which listed the international application number as "PCT/DE06/02978".

On 18 January 2008, applicant filed the present petition under 37 CFR 1.182.

## DISCUSSION

A review of the application papers filed 05 January 2007 reveals that the incorrect international application number was listed on the Transmittal Letter (Form PTO-1390) and entered into the EFS-Web system. The petition states that the correct international application number should be PCT/EP2005/007240 and that applicant mistakenly used the international publication number for the international application number. The content of international application number PCT/EP2005/007240 is consistent with the specification, claims, abstract, title, and inventorship information filed with the national stage papers on 05 January 2005. Applicant's explanation for the error is accepted.

## CONCLUSION

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

The Notice of Acceptance of Application under 35 U.S.C. 371 (Form PCT/EO/EO/903) mailed 14 November 2007 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 29 June 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 05 January 2007.

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/EO/EO/903), which should list the international application number as "PCT/EP05/07240".

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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ALEXANDRIA, VA 22313-1450
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31 MAR 2008

BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD MI 48075

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| In re Application of | : | DECISION ON |
| BRUSLETTO et al | : | |
| Int. Application: PCT/NO2005/000212 | : | |
| Application No.: 11/571,761 | : | REQUEST UNDER |
| Int. Filing Date: 16 June 2005 | : | |
| Priority Date: 08 July 2004 | : | |
| Attorney's Docket No.: PROTO110PUSA | : | |
| For: PROCESS FOR PRODUCING FUEL PELLETS | : | 37 CFR 1.497(d) |

This is a decision on petitioner's "AMENDMENT, PETITION AND FEE TO CORRECT ORIGINAL ERRONEOUSLY NAMED INVENTOR(S) UNDER 37 CFR 1.48(a)" filed on 23 August 2007, which is being treated as a request under 37 CFR 1.497(d) to add co-inventors Odd Egil Solheim and Hans Rasmus Holte in the executed declaration. A petition fee of $130.00 as been charged to petitioner's Deposit Account No. 02-3978 as authorized in the petition.

## BACKGROUND

On 16 June 2005, applicant filed international application No. PCT/NO2005/000212 and claiming a priority date of 08 July 2004.

On 08 January 2007, applicant filed the aforementioned application papers for entry into the national stage in the United States of America. Filed with the applications papersinter alia, the requisite basic national fee.

On 15 March 2007, applicant filed a first executed declaration that only had Rune Brusletto.

On 23 August 2007, petitioner filed, inter alia, a request under 37 CFR 1.497(d) and a second executed declaration that added Odd Egil Solheim and Hans Rasmus Holte as co-inventors, who were not listed in the international application.

## DISCUSSION

A submission under 37 CFR 1.497(d) must include:

(1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

(2) the fee set forth in § 1.17(I); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied items (1) - (2) under 37 CFR 1.497(d), but not item (3).

With respect to item (1), the statements submitted on 08 January 2007 by Odd Egil Solheim and Hans Rasmus Holte are sufficient because the statements state that the error in inventorship occurred without a deceptive intent.

With respect to item (2), the processing fee of $130.00 has been charged to the Deposit Account No.: 02-3978.

With respect to item (3), Arbaflame Technology AS., the assignee, has established the right of the Assignee to take action by specifying the reel and frame number. However, the consent is a general statement and does not specifically state that Arbaflame Technology AS. consents to the addition Odd Egil Solheim and Hans Rasmus Holte as co-inventors to the above patent application as filed in the executed declaration.

Accordingly, the request does not meet the requirements under 37 CFR 1.497(d).

## CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request 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 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 Administrative Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

12 MAY 2009

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P.O BOX 1450
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1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD MI 48075

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| In re Application of | : | DECISION ON |
| BRUSLETTO et al | : | |
| Application No.: 11/571,761 | : | |
| Int. Application: PCT/NO2005/000212 | : | REQUEST UNDER |
| Int. Filing Date: 16 June 2005 | : | |
| Priority Date: 08 July 2004 | : | |
| Attorney's Docket No.: PROTO110PUSA | : | |
| For: PROCESS FOR PRODUCING FUEL PELLETS | : | 37 CFR 1.497(d) |

This is a decision on applicants' "RENEWED REQUEST UNDER 37 CFR 1.497(d)" filed on 27 May 2008.

## BACKGROUND

In a decision from this Office mailed on 31 March 2008, the decision indicated that the request was dismissed because the request did not satisfy item (3) of 37 CFR 1.497(d).

On 27 May 2008, applicants filed the current renewed request, which included, *inter alia*, an amended consent of the assignee to the correction of the Inventorship.

## DISCUSSION

A review of the renewed request reveals that applicant has satisfied item (3) of 37 CFR 1.497(d). In regard to item (3), the assignee Arbaflame Technology AS, consents to the addition of Odd Egil Solheim and Hans Rasmus Holte as joint-inventors to the above patent application.

Accordingly, applicant is deemed to satisfy requirements (1), (2), and (3) under 37 CFR 1.497(d).

## CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **GRANTED.**

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing consistent with this decision. The 35 USC 371 (c)(1), (c)(2), and (c)(4) date of this application is **23 August 2007**.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

22 JUL 2008

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Alexandria, VA 22313-1450
www.uspto.gov

SANCHELIMA & ASSOCIATES, P.A.
JESUS SANCHELIMA, ESQ.
235 S.W. LE JEUNE ROAD
MIAMI FL 33134

In re Application of :
IRURITA :
Application No.: 11/571,847 :
PCT No.: PCT/ES05/00387 : DECISION ON PETITION
Int. Filing Date: 06 July 2005 :
Priority Date: 13 July 2004 : UNDER 37 CFR 1.137(b)
Atty. Docket No.: 260604 :
For: BOTTLE CLOSURE SYSTEM AND CAP THAT :
CAN BE INCORPORATED IN SAID CLOSURE :

The petition to revive under 37 CFR 1.137(b) filed 09 July 2008 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the national phase application, from the date of abandonment to the present time, 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 06 July 2005 under 35 U.S.C. 363 and will be given a date of **09 July 2008** 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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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

0 4 MAY 2007

BLACKWELL SANDERS PEPER MARTIN LLP
720 OLIVE STREET
SUITE 2400
ST. LOUIS MO 63101

In re Application of CUCA et al.
Application No.: 11/571,863
PCT No.: PCT/US05/24200
Int. Filing: 08 July 2005
Priority Date: 08 July 2004
Attorney Docket No.: 718689.141
For: DELIVERY SYSTEM

DECISION ON

PETITION TO REVIVE

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 09 January 2007 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 $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 1 March 2007.

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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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**19 JUN 2007**

Laura A. Cruz
Christensen O'Connor Johnson Kindness, PLLC
1420 Fifth Avenue, Suite 2800
Seattle, WA 98101

| | | |
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| In re Application of | : | |
| KABASAWA | : | |
| U.S. Application No.: 11/571,870 | : | |
| PCT No.: PCT/JP05/08591 | : | DECISION ON PETITION |
| Int. Filing Date: 11May 2005 | : | |
| Priority Date: 12 July 2004 | : | UNDER 37 CFR 1.182 |
| Attorney's Docket No.: YKIA128790 | : | |
| For: OPTICAL PICKUP DEVICE AND OPTICAL DISK DEVICE | : | |

This decision is in response to applicant's "Petition Under 35 C.F.R. § 1.182 And/Or Request to Correct Misidentified Application" filed 14 March 2007 in the United States Patent and Trademark Office (USPTO) to correct the error in the Transmittal Letter (Form PTO-1390) filed 09 January 2007.

## BACKGROUND

On 11 May 2005, applicant filed international application PCT/JP05/08591, which claimed priority of an earlier application filed 12 July 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 19 January 2006. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 12 January 2007.

On 09 January 2007, 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 executed declaration of the inventor, an application data sheet and an information disclosure statement. The transmittal letter identified the international application number as PCT/JP05/08590.

On 14 March 2007, applicant filed the present petition under 37 CFR 1.182.

On 23 May 2007, applicant was mailed a "Notice of Acceptance" (Form PCT/DO/EO/903) indicating that the present application was a U.S. National stage entry of PCT/JP05/08591.

## DISCUSSION

The identifying information provided on the transmittal letter filed by applicant on 09 January 2007, i.e., the title, applicant-inventor information, priority date, and international filing date, as well as that of the concurrently filed application data sheet and executed declaration, all correspond to that of PCT/JP05/08591. For these reasons, as well as the explanation provided in the present petition, it has been concluded that the national stage papers filed 09 January 2007 sufficiently identified international application PCT/JP05/08591. Pursuant to petitioner's request, the national stage papers assigned U.S. application number 11/571,870 will be treated as a U.S. national stage submission for PCT/JP05/08591.

## CONCLUSION

For the reasons above, applicant's "Petition Under 37 CFR 1.182" is **GRANTED**.

As authorized, the $400.00 petition fee will be charged to deposit account 03-1740.

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 11/571,870 as the U.S. national stage application of PCT/JP05/08591.

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

UNITED STATES PATENT and TRADEMARK OFFICE

17 MAR 2009

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

Goudreau Gage Dubuc
2000 McGill College, Suite 2200
Montreal, Quebec H3A 3H3

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| In re Application of | : | DECISION ON |
| HURTUBISE et al | : | |
| Application No. 11/571,871 | : | |
| PCT No.: PCT/CA2005/001064 | : | |
| Int. Filing Date: 08 July 2005 | : | |
| Priority Date: 09 July 2004 | : | PETITION UNDER |
| Attorney's Docket No.: 771/13889.6 | : | |
| For: VITAL SIGN MONITORING SYSTEM | : | |
| AND METHOD | : | 37 CFR 1.137 (b) |

This decision is in response to applicant's' "PETITION TO AN UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 CFR 1.137(b)," filed on 07 January 2009.

## BACKGROUND

On 08 July 2005, this international application was filed, claiming an earliest priority date of 09 July 2004. The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 09 January 2007.

On 09 January 2007, 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 28 November 2007, 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 21 November 2008, the United States Patent and Trademark Office mailed the Notification of Abandonment (PCT/DO/EO/909) since applicant has failed to respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed 11/28/2007 within the time period set therein.

On 07 January 2009, applicants filed the instant petition under 37 CFR 1.137(b), which was accompanied by the petition fee and a properly executed declaration.

## DISCUSSION

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

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 **07 January 2009.**

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
Alexandria, VA 22313-1450
www.uspto.gov

20 AUG 2007

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

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| In re Application of | : | |
| Park et al. | : | |
| Application No.: 11/571,906 | : | |
| PCT No.: PCT/KR05/01310 | : | |
| Int. Filing Date: 10 May 2005 | : | DECISION |
| Earliest Priority Date: 10 May 2004 | : | |
| Attorney Docket No.: 5413LGH-1 | : | |
| For: Skin Aging Treatment Comprising Paeoniflorin | : | :: |

The petition to revive under 37 CFR 1.137(b) filed 10 January 2007 in the above-captioned application is hereby **DISMISSED** without prejudice.

This international application became abandoned with respect to the national stage in the United States as of midnight on 10 November 2006 for failure to timely pay the basic national fee.

Inspection of the petition reveals that it has been signed by a corporate officer who does not appear to be a registered patent practitioner. As such, it would not be appropriate to treat the merits of the petition at this time.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

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

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

2 6 NOV 2007

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SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER, CO 80202

| | | |
|---|---|---|
| In re Application of | : | |
| Park et al. | : | |
| Application No.: 11/571,906 | : | |
| PCT No.: PCT/KR05/01310 | : | |
| Int. Filing Date: 10 May 2005 | : | DECISION |
| Earliest Priority Date: 10 May 2004 | : | |
| Attorney Docket No.: 5413LGH-1 | : | |
| For: Skin Aging Treatment Comprising Paeoniflorin | : | |

The renewed petition to revive under 37 CFR 1.137(b) filed on 08 October 2007 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 for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of the basic national fee, and has paid the petition 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.

The $130.00 surcharge under 37 CFR 1.492(h) is being charged to Deposit Account no. 19-1970, as authorized by the Transmittal Letter filed on 10 January 2007.

This application is being forwarded to the Office of Patent Application Processing for further processing. The date of this application under 35 U.S.C. 371(c)(1), (2) and (4) is **10 January 2007**.

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

0 3 OCT 2008

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27542
SAND & SEBOLT
Aegis Tower, Suite 1100
4940 Munson Street, N.W.
Canton, OH 44718-3615

In re Application of :
KUMAR *et al* :
U.S. Application No.: 11/571,915 :
PCT No.: PCT/IB2005/052366 :
Int. Filing Date: 15 July 2005 :
Priority Date: 16 July 2004 : **DECISION**
Docket No.: 1386008US1AN :
(formerly 117210.00076) :
For: COMPACT HANDSET :
COMMUNICATION AND :
PROCESSING DEVICE AND :
METHODS :

This decision is in response to the "Revocation and Power of Attorney . . ." filed on 18 December 2007 and again on 14 July 2008.

## DISCUSSION

37 CFR 1.36(a) states that a power of attorney may be revoked at any stage in the proceedings of a case by an applicant or assignee. Section 402.05 of the Manual of Patent Examining Procedure (MPEP) discusses revocation and states:

> Revocation of the power of attorney becomes effective on the date that the revocation is RECEIVED in the Office (not on the date of ACCEPTANCE).

Here, the request for revocation and power of attorney[1] to the attorneys and/or patent agents associated with customer number 27542 was signed by the assignee of the subject application. A statement under 37 CFR 3.73(b) was also provided on 14 July 2008 signed by the President of the assignee, Kyber Technologies Corporation.

A review of the application verifies that an assignment to Kyber Technologies Corporation has been made. The correspondence address and attorney docket

[1] The request to withdraw as attorney of record filed on 13 November 2007 by former counsel will not be addressed. A copy of this decision will be provided to the former counsel.

number have also been changed.

## CONCLUSION

Applicants' request for revocation has been **GRANTED**.

This application will be forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing.

A copy of this decision will be forwarded to applicants' former counsel.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

cc: Sott M. Oldham
HAHN LOESER & PARKS, LLP
One Gojo Plaza, Suite 300
Akron, OH 44311

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10 MAY 2010

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27542
SAND & SEBOLT
Aegis Tower, Suite 1100
4940 Munson Street, N.W.
Canton, OH 44718-3615

In re Application of
KUMAR *et al*
U.S. Application No.: 11/571,915
PCT No.: PCT/IB2005/052366
Int. Filing Date: 15 July 2005
Priority Date: 16 July 2004
Docket No.: 1386008US1AN
For: COMPACT HANDSET COMMUNICATION AND PROCESSING DEVICE AND METHODS

**DECISION**

This is a decision on the request to add an inventor filed 19 April 2007 which is treated as a petition under 37 CFR 1.497(d).

## BACKGROUND

On 10 January 2007, applicants filed papers to enter the national stage of PCT/IB2005/052366 which was accompanied by, *inter alia*, a declaration executed by Rajendra KUMAR as the sole inventor.

On 19 April 2007, applicants submitted a petition to add an inventor which was accompanied by, *inter alia*, a statement by the inventor to be added, a declaration executed by two inventors, and a consent of the assignee.

On 15 March 2010, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 (Form PCT/DO/EO/903) indicating that the application completed all 35 U.S.C. 371 requirements on 19 April 2007. A filing receipt was also mailed indicating a "Filing or 371(c) Date" of "04/19/2007."

## DISCUSSION

Applicants request to add John W. MORRISON II as an inventor in the above-captioned application. However, a review of the international publication ("WO 2006/008715") shows that Mr. MORRISON is already listed as an inventor.

Accordingly, a petition to add an inventor is not required.

## CONCLUSION

Applicants' request to add Mr. MORRISON as an inventor under 37 CFR 1.497(d) is **DISMISSED** as **MOOT**.

The declaration filed 19 April 2009 is **DEFECTIVE** because it is a composite declaration. It is composed of one page 1 of 2 and two pages 2 of 2. Each page 2 of 2 lists the same inventors, but was separately executed.

While it is acceptable for inventors to execute separate copies of the oath or declaration, the complete copy presented to each inventor must be returned to the Office. *See* MPEP § 605.04(a). **A complete copy of the declaration presented to each inventor is required**.

The Form PCT/DO/EO/903 and filing receipt mailed 15 March 2010 contain erroneous information and are both **VACATED**.

Applicants have **TWO (2) MONTHS** from the mail date of this decision to provide a declaration in compliance with 37 CFR 1.497(a) and (b). Extensions of time may be obtained under 37 CFR 1.136(a). **Failure to provide an acceptable declaration will result in the abandonment of the application.**

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail 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.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

15 MAR 2007

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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JONES DAY
ATTENTION: PETER G. THURLOW
222 EAST 41ST ST
NEW YORK NY 10017

In re Application of:
ROLION, Franck, et al.
U.S. App. No.: 11/571,924
Filing Date: 10 January 2007
Attorney's Docket No.: 005367-0062-999
For: CORRECTION SYSTEM WITH RUBBER ELASTIC TENSION ELEMENT FOR A GEAR MECHANISM CORRECTION TAPE

DECISION ON PETITION UNDER 37 CFR 1.182

This decision is issued in response to applicants' "Petition Under 37 CFR 1.182" filed January 18, 2007. Deposit Account No. 50-3013 will be charged the required $400 petition fee.

## BACKGROUND

On January 10, 2007, applicants filed a Transmittal Letter for entry into the national stage in the United States. The submission included the filing fee, a specification, claims, drawings, a Preliminary Amendment, and an Application Data Sheet (ADS). The transmittal letter identified the international application as EP 06 000 617.8. The first line of amended specification identified the application as a "national stage application of EP 06 000 617.8 filed on January 12, 2006." The ADS identified the application a "a national stage of PCT Application No. EP 06 000 617.8 filed on January 12, 2006.

These materials were assigned U.S. application number 11/571,924. Based on the ADS, transmittal letter, and amended specification, the application was created as a U.S. national stage filed under 35 U.S.C. 371.

On January 18, 2007, applicants filed the petition considered herein. The petition requests that the January 10, 2007 filing be corrected to a U.S. non-provisional application filed under 35 U.S.C. 111(a) claiming priority under 35 U.S.C. 119 to foreign application EP 06000617.8. The petition was accompanied by a Supplemental Preliminary Amendment and a revised ADS that no longer identify the present application as a national stage application.

## DISCUSSION

A review of the January 10, 2007 filing reveals that the submission does not reference or identify an international application filed under the PCT. Rather, the submission was directed to a foreign application filed in the European Patent Office, an application which cannot be the basis of a U.S. national stage application filed under 35 U.S.C. 371. As clarified in the present petition, applicants' intent herein was to initiate a U.S. non-provisional application claiming priority to the foreign application. As noted above, the January 10, 2007 filing included a specification, claims, and drawings, as required to initiate an application under 35 U.S.C. 111(a).

In the present circumstances, based on the statements herein, the materials filed January 10, 2007, and the lack of a referenced international application in the filed application papers, applicants' petition to have the materials filed by applicants on January 10, 2007 treated as a U.S. non-provisional application filed under 35 U.S.C. 111(a) is appropriately granted.

It is noted that the supplemental ADS filed 18 January 2007 includes a proper claim of priority to the prior-filed European application.

## CONCLUSION

Applicants' petition under 37 CFR 1.182 to convert the application from a national stage application under 35 U.S.C. 371 to an application filed under 35 U.S.C. 111(a) is **GRANTED**.

Deposit Account No. 50-3013 will be charged the required $400 petition fee.

The application is being referred to the Office Of Initial Patent Examination (OIPE) for further processing as an application filed under 35 U.S.C. 111(a) with a filing date of January 10, 2007.

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

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11 DEC 2007

CARLSON, GASKEY & OLDS
400 W. Maple, Suite 350
Birmingham, MI 48009

| | | |
|---|---|---|
| In re Application of | : | |
| SUNDEL et al | : | DECISION ON |
| Application No.: 11/571,931 | : | |
| PCT No.: PCT/US04/35496 | : | |
| Int. Filing Date: 26 October 2004 | : | PETITION UNDER |
| Priority Date: 30 July 2004 | : | |
| Attorney Docket No.: 60469-174PUS1; 000.05566US | : | |
| For: Minimizing the Stack ... | : | 37 CFR 1.181 |
| Vertical Shafts | : | |

This decision is in response to the "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED OFFICE," received 25 July 2007, which is being treated as a petition under 37 CFR 1.181 requesting that the executed Declaration was properly filed in the international stage for the above application.

## BACKGROUND

On 11 January 2007, 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. Applicants, however, did not appear to satisfy the requirement set forth by 35 U.S.C. 371(c)(4) because the executed Declaration appeared to be improper.

On 13 July 2007, 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 1.47(a) and (b), identifying the application by the International application number and international filing date... in the declaration submitted doesn't identify the international application number in the body of the declaration. The notice also indicated that the items above must be submitted within two (2) months from the date of this notice or 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

In response to the "NOTIFICATION OF MISSING REQUIREMENTS" mailed on 13 July 2007, applicants submitted on 25 July 2007 the instant petition stating the declaration was timely and properly submitted since it was filed with the International Application.

## DISCUSSION

A review of the file reveals that the USPTO received the executed Declaration submitted under PCT Rule 4.17 as part of the international application PCT/US04/35496, and the executed Declaration filed on 11 January 2007 was proper.

Accordingly, the "NOTIFICATION OF MISSING REQUIREMENTS" mailed on 13 July 2007 was in error.

## DECISION

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

The "NOTIFICATION OF MISSING REQUIREMENTS" mailed on 13 July 2007, is **VACATED** with the mailing of this decision.

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 is **11 January 2007**.

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
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LOWE, HAUPTMAN, HAM & BERNER, LLP (ITW)
1700 DIAGONAL ROAD
SUITE 300
ALEXANDRIA, VA 22314

Mail Date: 04/27/2010

| | | |
|---|---|---|
| **Applicant** | : Eric Vacher | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7661606 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/571,958 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/11/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **281** 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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17 MAR 2008

AKERMAN SENTERFITT
P.O. BOX 3188
WEST PALM BEACH, FL 33402-3188

| | | |
|---|---|---|
| In re Application of | : | |
| Simonson | : | |
| Application No.: 11/571,976 | : | |
| PCT No.: PCT/US2004/037392 | : | |
| Int. Filing Date: 10 November 2004 | : | DECISION |
| Earlier Priority Date: 10 November 2003 | : | |
| Attorney Docket No.: 5976-23-3US | : | |
| For: Artificial Facet Joint And Method | : | |

The petition to revive under 37 CFR 1.137(b) filed on 11 January 2007 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 for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of the basic national fee, and the petition fee has also been paid. 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 Office of Patent Application Processing for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

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

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

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OFFICE OF PETITIONS

In re Application of :
**ALLGEIER,** Hans et al. :
Application No. 11/572,007 : DECISION ON PETITION
Filed: February 27, 2007 : TO WITHDRAW
Attorney Docket No. **093286-0114** : 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 15, 2009.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to Foley and Lardner LLP has been revoked by the assignee of the patent application on November 20, 2009. 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: **FANELLI STRAIN & HAAG PLLC**
**1455 PENNSYLVANIA AVE., N.W.**
**SUITE 400**
**WASHINGTON DC 20004**

3 1 MAR 2008

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PRICE HENEVELD COOPER DEWITT & LITTON, LLP
695 KENMOOR, S.E.
P O BOX 2567
GRAND RAPIDS MI 49501

In re Application of :
Workman et al. :
Application No. 11/572,016 :
PCT No.: PCT/US05/24787 :
Int. Filing Date: 13 July 2005 : DECISION
Priority Date: 13 July 2004 :
Atty. Docket No.: TYM01P303A :
For: Fuel Supply System For A Vehicle :
Including A Vaporization Device For :
Converting Fuel And Water Into Hydrogen :

This is in response to the declaration of the inventors filed on 09 November 2007, which is being treated under 37 CFR 1.42.

## BACKGROUND

This international application was filed on 13 July 2005, claimed an earliest priority date of 13 July 2004, and designated the U.S. The International Bureau published the international application on 16 February 2006. The 30 month time period for paying the basic national fee in the United States expired at midnight on 13 January 2007. Applicants filed, *inter alia*, the basic national fee on 12 January 2007.

On 09 July 2007, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(h).

## DISCUSSION

Review of the declaration of the inventors filed on 09 November 2007 reveals that it indicates joint inventor James L. Knowlton to be "deceased." 37 CFR 1.42 provides in part that

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

Meanwhile, 37 CFR 1.497(b)(2), as amended effective 08 September 2000, provides that

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

that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

The declaration is signed on behalf of deceased joint inventor James L. Knowlton by Donalee Knowlton in the capacity of "legal representative." The declaration appears to provide citizenship, residence and postal address information for the legal representative, but it does not provide the citizenship (or last residential and postal addresses) of the deceased inventor, as required by 37 CFR 1.497(b)(2)(i.e., "the facts which the inventor would have been required to state"). Alternatively, if the information listed is intended to pertain to the deceased inventor, the declaration does not provide the required information for the legal representative.

## CONCLUSION

The declaration is **NOT ACCEPTED** under 37 CFR 1.42, 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. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42." Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

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

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

18 AUG 2008

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695 KENMOOR, S.E.
P O BOX 2567
GRAND RAPIDS MI 49501

In re Application of :
Workman et al. :
Application No. 11/572,016 :
PCT No.: PCT/US05/24787 :
Int. Filing Date: 13 July 2005 : DECISION
Priority Date: 13 July 2004 :
Atty. Docket No.: TYM01P303A :
For: Fuel Supply System For A Vehicle :
Including A Vaporization Device For :
Converting Fuel And Water Into Hydrogen :

This is in response to the renewed submission under 37 CFR 1.42 filed on 14 May 2008.

## DISCUSSION

In a Decision mailed on 31 March 2008, the declaration filed on 09 November 2007 was not accepted under 37 CFR 1.42, without prejudice, because

> The declaration is signed on behalf of deceased joint inventor James L. Knowlton by Donalee Knowlton in the capacity of "legal representative." The declaration appears to provide citizenship, residence and postal address information for the legal representative, but it does not provide the citizenship (or last residential and postal addresses) of the deceased inventor, as required by 37 CFR 1.497(b)(2)(i.e., "the facts which the inventor would have been required to state"). Alternatively, if the information listed is intended to pertain to the deceased inventor, the declaration does not provide the required information for the legal representative.

In response, applicants indicate that "insofar as both the inventor and the legal representative, who is the wife of the inventor, are both United States citizens and both reside and have the same mailing address, the previously filed Declaration does indeed provide the citizenship, residence, and mailing address for the inventor and the legal representative." Applicants have filed a new declaration document which explicitly and separately indicates the residence, postal address and citizenship for the deceased inventor and his legal representative. In view of the totality of the evidence of record, it would be appropriate to accept the declaration filed on 14 May 2008 for purposes of compliance with 37 CFR 1.42 and 37 CFR 1.497(a) and (b).

## DECISION

The declaration is **ACCEPTED** under 37 CFR 1.42.

This application is being forwarded to the Office of Patent Application Processing for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **14 May 2008**.

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

19 MAR 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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SYNNESTVEDT LECHNER & WOODBRIDGE LLP
PO BOX 592
112 NASSAU STREET
PRINCETON NJ 08542-0592

In re Application of :
FLOM, Michael et al. :
U.S. Application No.: 11/572,820 :
PCT No.: PCT/US2005/027362 :
Int. Filing Date: 29 July 2005 :
Priority Date: 29 July 2004 :
Attorney Docket No.: 5718-102US : **DECISION**
For: SYSTEM AND METHOD FOR CREATING DISTRIBUTED APPLICATIONS UTILIZING PORTABLE DEVICES AND PHYSICAL LOCATION OF THE PORTABLE DEVICE :

This is a decision on Request for Refund, filed in the United States Patent and Trademark Office on 16 August 2007.

## BACKGROUND

On 29 January 2007, applicants filed papers for entry into the national stage of PCT/US2005/027362, which included the payment of other than small entity fees of $600 for a national stage application.

On 16 August 2007, applicants filed this request for the refund of $300.

## DISCUSSION

In the papers filed 16 August 2007, applicants requested a refund of the $300 paid in 29 January 2007. 37 CFR 1.28 (a) states:

> (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.

The refund request has a receipt date of 16 August 2007, long past 29 April 2007, the expiration of the three-month time period for requesting a refund.

## CONCLUSION

For the above reason, applicants' request for a refund pursuant to 37 CFR 1.28(a) is **DISMISSED** without prejudice.

Any request for reconsideration of this matter should be filed within **TWO (2) MONTHS** of the mail date of this decision.

Further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed, 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

Phone: (571) 272-3292
Fax: (571) 273-0459

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Smith, Gambrell & Russell
1130 Connecticut Avenue, N.W., Suite 1130
Washington, DC 20036

In re Application of :
TSUJIHAMA, et al. :
Application No.: 11/572,022 : DECISION ON PETITION
PCT No.: PCT/JP05/13648 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 26 July 2005 :
Priority Date: 27 July 2004 :
Attorney Docket No.: N/A :
For: METHOD OF MOUNTING AXLE MODULE :

The petition to revive under 37 CFR 1.137(b) filed 11 April 2008 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
Fax: (571) 273-0459

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

MAILED

JUL 13 2009

OFFICE OF PETITIONS

In re Application of :
Thittwan Buranachokpaisan et al :
Application No. 11/572,028 : DECISION ON PETITION
Filed: January 12, 2007 :
Attorney Docket No. 33877-US-PCT :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 15, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the nonfinal rejection mailed October 29, 2008, is accepted as having been unintentionally delayed.

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

This application is being referred to Technology Center AU 1614 for appropriate action by the Examiner in the normal course of business on the reply received May 15, 2009.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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United States Patent and Trademark Office
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PFIZER INC.
PATENT DEPARTMENT
Building 114 M/S 114
EASTERN POINT ROAD
GROTON, CT 06340

Mail Date: 04/20/2010

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| **Applicant** | : Vladimir Genukh Beylin | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7655656 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/572,032 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/12/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **438** 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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**Rutan & Tucker, LLP**
**611 Anton Blvd.**
**Suite 1400**
**Costa Mesa, CA 92626**

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SEP 29 2008

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| | | |
|---|---|---|
| In re Application of | : | |
| Bruno Sidler | : | |
| Application No. 11/572,035 | : | DECISION ON PETITION |
| Filed: January 12, 2007 | : | TO WITHDRAW |
| Attorney Docket No. 101586.0001US | : | FROM RECORD |
| | : | |

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

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to Rutan & Tucker, LLP has been revoked by the assignee of the patent application on August 11, 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 Terri Williams at 571-272-2991.

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Fish & Richardson P.C.**
**P.O. Box 1022**
**Minneapolis, MN 55440-1022**

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01 OCT 2007

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24737
PHILLIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. Box 3001
Briarcliff Manor, NY 10510

In re Application of :
DEL PRADO PAVON, Javier *et al* :
U.S. Application No.: 11/572,045 :
PCT No.: PCT/IB2005/051425 :
Int. Filing Date: 02 May 2005 :
Priority Date: 04 May 2004 :
Attorney Docket No.: US040211 :
For: METHOD TO IMPROVE THROUGHPUT AND POWER CONSUMPTION EFFICIENCY IN WIRELESS COMMUNICATION SYSTEMS :

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

Applicants' petition to revive under 37 CFR 1.137(b) filed on 12 September 2007 is hereby **GRANTED** as follows:

The basic national fee and petition fee were previously submitted on 12 January 2007. Applicants make the required statement pursuant to 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A declaration in compliance with 37 CFR 1.497(a) and (b) was submitted on 12 January 2007. However, a surcharge fee of $65.00 pursuant to 37 CFR 1.492(h) is also required.

This application is being forwarded to the United States Designated/Elected Office for further processing including mailing a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) indicating that a surcharge fee is required.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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15 OCT 2007

SEAN J. EDMAN
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, Minnesota 55133-3427

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Eckert et al | : | |
| Int. Application: PCT/EP2004/007748 | : | |
| Application No.: 11/572,051 | : | |
| Int. Filing Date: 14 July 2004 | : | REQUEST UNDER |
| Priority Date: None | : | |
| Attorney's Docket No.: 59576US004 | : | |
| For: DENTAL COMPOSITION CONTAINING EPOXY | : | |
| FUNCTIONAL POLYMERIZABLE COMPOUNDS | : | 37 CFR 1.497(d) |

This is a decision on petitioner's "RESPONSE TO CORRECT INVENTORSHIP UNDER 37 CFR 1.48(a)" filed on 05 September 2007, which is being treated as a request under 37 CFR 1.497(d) to add joint inventors Dwight W. Jacobs and Roger A. Mader in the executed declaration.

## BACKGROUND

On 14 July 2004, applicants filed international application No. PCT/EP2004/007748.

On 12 January 2007, 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, and an executed declaration.

On 05 September 2007, applicants filed, inter alia, a second executed declaration and a request under 37 CFR 1.497(d) to add joint inventors Dwight W. Jacobs and Roger A. Mader in the executed declaration.

## DISCUSSION

A submission under 37 CFR 1.497(d) must include:

(1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

(2) the fee set forth in § 1.17(I); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied items (1) - (2) under 37 CFR 1.497(d) but not requirement (3).

With respect to item (1), the statements submitted on 05 September 2007 by Dwight W. Jacobs and Roger A. Mader are sufficient because the statements state that the error in inventorship occurred without a deceptive intent in the national stage application.

With respect to item (2), the processing fee of $130.00 has been charged to the Deposit Account No.: 13-3723.

With respect to item (3), 3M ESPE AG consents to the correction of inventorship to the above application. However, there is no copy of the executed assignment to the assignee, 3M ESPE AG, in the file. To establish the right of the Assignee to take action, applicants must either specifically submit a copy of the executed assignment or specify the reel and frame number. Note MPEP 324 and 37 CFR 3.73(b).

## CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. The proper reply is either a proper request under 37 CFR 1.497(d) overcoming the above stated defects. The failure to provide the proper reply will result in Abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". Extensions of time may be obtained under 37 CFR 1.136(a).

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

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

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27 MAY 2008

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SEAN J. EDMAN
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, Minnesota 55133-3427

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Eckert et al | : | |
| Application No.: 11/572,051 | : | |
| Int. Filing Date: 14 July 2004 | : | REQUEST UNDER |
| Int. Application: PCT/EP2004/007748 | : | |
| Priority Date: None | : | |
| Attorney's Docket No.: 59576US004 | : | |
| For: DENTAL COMPOSITION CONTAINING EPOXY | : | |
| FUNCTIONAL POLYMERIZABLE COMPOUNDS | : | 37 CFR 1.497(d) |

This is a decision on petitioner's "REQUEST FOR RECONSIDERATION OF APPLICANTS' REQUEST TO CORRECT INVENTORSHIP" filed on 14 December 2007, which is being treated as a renewed request under 37 CFR 1.497(d) to add joint inventors Dwight W. Jacobs and Roger A. Mader in the executed declaration.

## BACKGROUND

In a decision from this Office mailed on 15 October 2007, the decision indicated that the request was dismissed because item (3) of 37 CFR 1.497(d) was not satisfied.

On 14 December 2007, applicant filed the current request, which includes a copy of the assignment and applicants states that it was recorded at Reel: 019784, Frame 0427. Also, the request states that 3M IP to the requested change in inventorship.

## DISCUSSION

A submission under 37 CFR 1.497(d) must include:

(1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

(2) the fee set forth in § 1.17(I); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have now satisfied items (1) - (3) under 37 CFR 1.497(d).

With respect to item (3), 3M ESPE AG consents to the correction of inventorship to the above application. Applicants have specified the reel and frame number, Real 019784, Frame 047, satisfying item (3) of 37 CFR 1.497(d).

**CONCLUSION**

For the reasons above, the request under 37 CFR 1.497(d) is **GRANTED.**

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing consistent with this decision. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **12 January 2007**.

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

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3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL MN 55133-3427

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| In re Application of | : | |
| Bissinger et al. | : | |
| Application No. 11/572,071 | : | ON PETITION |
| Filed: January 12, 2007 | : | |
| Attorney Docket No. 59580US005 | : | |

This is a decision on the petition, filed October 30, 2009, 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 the most current assignment recorded January 12, 2007, Reel 018763 and Frame 0940 states the assignee's name as "3M ESPE AG" and the address as "Seefeld, Germany". Petitioner has submitted the address as "St. Paul, Minnesota".

Accordingly, since petitioner is requesting a correction of a previously recorded assignment that was not submitted for recordation to the Assignment Branch and since it is after payment of the issue fee, issuance of a certificate of correction would not be proper. *See* MPEP Section 307.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski
Petitions Examiner
Office of Petitions

[1] *See* Official Gazette of June 22, 2004

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Mail Date: 04/20/2010

| | | |
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| **Applicant** | : Peter Bissinger | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7662869 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/572,071 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/12/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **333** 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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ST. PAUL, MN 55133-3427

Mail Date: 04/20/2010

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| **Applicant** | : Peter Bissinger | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7662869 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/572,071 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/12/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **333** 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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Susan E. Shaw McBee
Womble, Carlyle, Sandridge & Rice
P.O. Box 7037
Atlanta, GA 30357-0037

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|---|---|---|
| In re Application of | : | |
| Singer | : | |
| Application No.: 11/572,085 | : | DECISION |
| PCT No.: PCT/EP05/07736 | : | |
| Int. Filing Date: 15 July 2005 | : | |
| Priority Date: 15 July 2004 | : | |
| Attorney's Docket No.: 2902162.8000 | : | |
| For: METHOD FOR PURIFYING AND ISOLATING NUCLEIC ACIDS USING CATIONIC DETERGENTS | : | |

This decision is in response to applicant's petition under 37 CFR 1.182, filed on the 16 May 2007, requesting correction of the International Application Number. The $400 petition fee has been charged to applicant's deposit account.

## BACKGROUND

On 15 July 2005, applicant filed international application PCT/EP05/07736 that claimed priority of an earlier German application which was filed 15 July 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 26 January 2006. Accordingly, the thirty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 15 January 2007.

On 12 January 2007, applicant filed a letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a translation of the international application, an information disclosure statement, a preliminary amendment and the basic national fee of $300 as required by 35 U.S.C. 371(c). These papers were assigned application number 11/572,085.

On 16 May 2007, applicant filed the current communication requesting correction of the International Application Number.

## DISCUSSION

The transmittal letter of 12 January 2007 identified the international application number as PCT/EP05/07763, the international filing date as 15 July 2005, the priority date as 15 July 2004, the title as "Method For Cleaning and Isolating Nucleic Acids Using Cationic Detergents" and the inventor as Thorsten Singer. The transmittal letter also indicated that a translation of the international application as filed is attached hereto. The copy of the international application filed was a translation of PCT/EP05/07736 having an international filing date of 15 July 2005. The title is "Method For Cleaning and Isolating Nucleic Acids Using Cationic Detergents" and the inventor is Thorsten Singer.

Applicants also filed various other documents, including the international search report for PCT/EP05/07736. Based upon this evidence, it is concluded that applicants meant to request entry of international application PCT/EP05/07736. The office records have been corrected accordingly.

## CONCLUSION

The petition is **GRANTED**.

The application is being returned to the United States Designated/Elected Office for processing in accordance with this decision; that is, for the mailing of the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) requesting a new declaration indicating the proper International Application Number.

Debra Brittingham
PCT Special Programs Examiner
Office of PCT Legal Administration

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

Tel: (571) 272-3280
Fax: (571) 273-0459

15 MAY 2007

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

| | | |
|---|---|---|
| In re Application of | : | |
| PAGE, Mark et al. | : | DECISION ON |
| Application No.: 11/572,114 | : | |
| PCT No.: PCT/US05/33592 | : | PETITION |
| Int. Filing Date: 19 September 2005 | : | |
| Priority Date: 28 September 2004 | : | UNDER 1.47(a) |
| Attorney's Docket No.: 1842.078US1 | : | |
| For: Method and Apparatus For Gaming Machine Peripherals | : | |

This is in response to the petition under 37 CFR 1.47(a), filed 15 January 2007, to permit the applicants to file the above-captioned application on behalf of the non-signing inventor, Mark V. Page. The petition under 37 CFR 1.47(a) is DISMISSED.

## BACKGROUND

On 19 September 2005, applicants filed international application PCT/US05/33592, claiming a priority date of 28 September 2004. The thirty-month for paying the basic national fee in the United States expired at midnight on 28 March 2007.

On 15 January 2007, 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, a declaration and the instant petition to permit applicants to file the above-captioned application on behalf of the non-signing inventor, Mark V. Page. The petition included copies of e-mails from non-signing inventor Mark V. Page (Exhibits A and D), a copy of an e-mail from Ms. Pam Lowenthal (Exhibit C), a copy of a letter from Mr. Michael Blankstein (Executive Director Intellectual Property) to non-signing inventor Mark V. Page and a statement by Mr. Janal M. Kalis.

## DISCUSSION

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

As to items (1) and (2), applicants have submitted the correct fee of $200.00 under 37 CFR 1.17(g) and a statement of the last known address of the non-signing inventor.

With regard to item (3), applicants have filed a declaration executed by the other cooperating inventor and containing an unsigned signature block for the non-signing inventor. This declaration complies with 37 CFR 1.497(a)-(b) and is accepted. Hence, item (3) is satisfied.

With regard to item (4), the evidence submitted to show that inventor Mark V. Page has refused to sign is insufficient. The statement by Mr. Janal M. Kalis and, the e-mails from non-signing inventor Mark V. Page (Exhibits A and D) and Ms. Pamela Lowenthal (Exhibit C) do not indicate that a complete copy of the application was mailed to non-signing inventor Mark V. Page. The statement by Mr. Janal M. Kalis merely describes the standard procedure by which a copy of the application papers is presented to a non-signing inventor. Specifically, Mr. Janal M. Kalis states that a copy of the application papers was send to Ms. Pamela Lowenthal, which was then forwarded to the non-signing inventor Mark V. Page. However, a statement of facts by the person who presented the inventor with the application papers, Ms. Pamela Lowenthal, has not been provided.

The e-mails from non-signing inventor Mark V. Page (Exhibits A and D) and Ms. Pamela Lowenthal (Exhibit C) do not appear to refer to the copy of the application papers. For example, in the e-mail dated 02 August 2006 (Exhibit A), non-signing inventor Mark V. Page states that he is "reluctant to sign my last patent with WMS Gaming," (underlining added) thereby appearing to refer to an assignment document. In the e-mail dated 07 August 2006 (Exhibit B), Ms. Pamela Lowenthal states that "[w]e cannot get the document signed by Mark Page...I have the other two signatures," (underlining added), thereby appearing to refer to an oath or declaration document. Further, the letter from Mr. Michael Blankstein (Exhibit C) does not indicate that a copy of the application has been mailed to non-signing inventor Mark V. Page, but rather refers to declaration and power of attorney documents.

Although the evidence submitted shows that non-signing inventor Mark V. Page has certain grievances against his former employer (Exhibits A and D), WMS Gaming Inc. (assignee and owner of the instant application), the evidence does not indicate that non-signing inventor Mark V. Page was presented with a copy of the application. Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. Copies of documentary evidence such as a certified mail return receipt, cover letter of instructions, telegrams, etc., which support a finding that a complete copy of the application papers had been sent to the applicant should be made a part of the declaration or affidavit. In the instant case, a statement from Ms. Pamela Lowenthal should be presented.

## CONCLUSION

Applicant's petition to permit the applicants to file the above-captioned application on behalf of the non-signing inventor, Mark V. Page, 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.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

20 SEP 2007

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

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

| | | |
|---|---|---|
| In re Application of | : | |
| PAGE, Mark et al. | : | DECISION ON |
| Application No.: 11/572,114 | : | |
| PCT No.: PCT/US05/33592 | : | RENEWED PETITION |
| Int. Filing Date: 19 September 2005 | : | |
| Priority Date: 28 September 2004 | : | UNDER 1.47(a) |
| Attorney's Docket No.: 1842.078US1 | : | |
| For: Method and Apparatus For Gaming Machine Peripherals | : | |

This is in response to the "Renewed Petition Under 37 CFR 1.47(a)," filed 16 July 2007, to permit applicants to file the above-captioned application on behalf of the non-signing inventor, Mark V. Page.

## BACKGROUND

On 19 September 2005, applicants filed international application PCT/US05/33592, claiming a priority date of 28 September 2004. The thirty-month for paying the basic national fee in the United States expired at midnight on 28 March 2007.

On 15 January 2007, 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, a declaration and a "Petition Under 37 CFR 1.47(a)" to permit applicants to file the above-captioned application on behalf of the non-signing inventor, Mark V. Page.

On 15 May 2007, the Office mailed a "Decision on Petition Under 37 CFR 1.47(a)," dismissing the petition because applicants did not provide evidence that a complete copy of the application was mailed to non-signing inventor Mark Page.

On 16 July 2007, applicants filed the instant "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) a statement of the last known address of the missing inventor, (3) an oath or declaration by each applicant on his or her own behalf and on behalf of the non-signing joint inventor, and (4) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort.

As noted in the "Decision on Petition Under 37 CFR 1.47(a)," mailed 15 May 2007, items (1)-(3) have been satisfied.

With regard to item (4), the evidence submitted to show that inventor Mark V. Page has been presented with a complete copy of the application papers (specification, including claims, drawings and, oath or declaration) is insufficient. Although the declaration of Mr. Janal M. Kalis (a person having first-hand knowledge of presenting the complete application papers to non-signing inventor Mark V. Page) and the United States Postal Service certified mail receipts (see Exhibits F and H) indicate that a complete copy of the application was mailed to non-signing inventor Mark V. Page, it is unclear why the mail was returned to sender. It is noted that the address to which the mail was addressed is not the last known address of non-signing inventor Mark V. Page. Specifically, the last known address of non-signing inventor Mark V. Page, as stated in the petition filed 15 January 2007, is "3917 Alexander Ave., East Chicago, IN 46312" (underlining added). However, a review of the United States Postal Service certified mail receipts (see Exhibits F and H) shows that the mail was sent to "3917 Alexander Ave., East Chicago, IL 46312" (underlining added). Hence, because the address was incorrect it is unclear whether non-signing inventor Mark V. Page actually refused to accept delivery of the papers or the papers were merely delivered to the wrong address.

Furthermore, the copy of the e-mail sent to non-signing inventor Mark V. Page (see exhibit G) does not include an attachment icon showing that the complete application papers (specification, including claims, drawings, and oath or declaration) were presented to non-signing inventor Mark V. Page. Hence, item (4) has not been satisfied.

## CONCLUSION

Applicant's petition to permit the applicants to file the above-captioned application on behalf of the non-signing inventor, Mark V. Page, 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.

Leonard Smith
PCT Legal Examiner
Office of PCT Legal Administration

Stefan Staicovici
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-1208
Facsimile: (571) 273-0459

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25 MAR 2008

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

| | | |
|---|---|---|
| In re Application of: | : | |
| PAGE, Mark, et al. | : | DECISION ON SECOND |
| U.S. Application No.: 11/572,114 | : | RENEWED PETITION |
| PCT No.: PCT/US05/33592 | : | (37 CFR 1.47(a)) |
| Int'l Filing Date: 19 September 2005 | : | |
| Priority Date: 28 September 2004 | : | |
| Atty Docket No.: 1842.078US1 | : | |
| For: METHOD AND APPARATUS FOR GAMING MACHINE PERIPHERALS | : | |

This decision is issued in response to applicants' second renewed petition under 37 CFR 1.47(a) and filed 09 November 2007. No additional petition fee is required.

## BACKGROUND

The procedural background for the present application was set forth in the decisions mailed herein on 15 May 2007 and 20 September 2007, which dismissed applicants' petition under 37 CFR 1.47(a) for failure to satisfy the requirements of a grantable petition. Specifically, applicants had failed to provide an adequate showing that the non-signing inventor has refused to execute the application or cannot be located after diligent effort.

On 09 November 2007, applicants filed the second renewed petition considered herein.

## DISCUSSION

The previous decisions indicated that the materials provided by applicants did not adequately demonstrate that the non-signing inventor had been presented with a request for signature, accompanied by a copy of the complete application, and had refused to provide the requested signature. In the second renewed petition considered herein, applicants have provided additional materials, including a statement (with documentary support) showing that a request for signature accompanied by a copy of the complete application was delivered to the non-signing inventor via certified mail and that the non-signing inventor has failed to provide the requested signature.

The present submission, in combination with the previously filed materials, provides an acceptable showing that the non-signing inventor has refused to provide the requested signature. Applicants have therefore satisfied the final requirement for a grantable petition under 37 CFR 1.47(a).

## CONCLUSION

The renewed petition under 37 CFR 1.47(a) is **GRANTED**. The application is accepted without the signature of non-signing inventor Mark V. PAGE.

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 petition.

The application is being referred 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 15 January 2007.

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

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**KIRK HAHN**
**14431 HOLT AVE**
**SANTA ANA CA 92705**

COPY MAILED
FEB 25 2010

| | | |
|---|---|---|
| In re Application of | : | |
| Park et al. | : | |
| Application No. 11/572,131 | : | ON PETITION |
| Filed: January 15, 2007 | : | |
| Attorney Docket No. 36102-0002 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed December 14, 2009, to revive the above-identified application.

The petition is **GRANTED**.

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

This matter is being referred to Technology Center AU 1655 for further examination on the merits.

Liana Walsh
Petitions Examiner
Office of Petitions

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0 8 MAY 2009

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EDWARD LANGER
c/o SHIBOLETH YISRAELI ROBERTS ZISMAN & CO.
1 PENN PLAZA-SUITE 2527
NEW YORK NY 10119

| | | |
|---|---|---|
| In re Application of | : | |
| SHEINKMAN, et al. | : | |
| Application No.: 11/572,137 | : | DECISION ON PETITION |
| PCT No.: PCT/IL04/00631 | : | |
| Int. Filing Date: 14 July 2004 | : | UNDER 37 CFR 1.181 |
| Priority Date: None | : | |
| Attorney Docket No.: 2158 | : | |
| For: METHOD OF APPLYING ZINC-PHOSPHATE CONVERSION CRYSTAL COATING | : | |

This decision is in response to applicant's "Petition to Withdraw Holding of Abandonment Per 37 CFR 1.181 (a)" filed 20 April 2009 in the United States Patent and Trademark Office (USPTO). No petition fee is required.

## BACKGROUND

On 14 July 2004, applicant filed international application PCT/IL04/00631. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 19 January 2006. The deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 14 January 2007.

On 16 January 2007, 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 signed declaration of the inventors.

On 29 November 2007, applicant was mailed a "NOTIFICATION OF INSUFFICIENT FEES (DO/EO/US) (Form PCT/DO/EO/923) informing applicant that an additional fee payment of $220.00 was due for the present application. Applicant was afforded two months and the extendable time available under 37 CFR 1.136(a) to file a response.

On 20 November 2008, applicant was mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) informing applicant that applicant that above-identified application was abandoned as to the United States for failure to respond to the Form PCT/DO/EO/923 mailed 29 November 2007.

On 20 April 2009, applicant filed the present petition arguing that applicant had not received neither the Form PCT/DO/EO/923 nor the Form PCT/DO/EO/909 and requesting withdrawal of the holding of abandonment.

## DISCUSSION

A review of the application file, as well as applicant's present petition and supporting materials, finds that the Form PCT/DO/EO/923 was mailed in error. The international search report and written opinion for the underlying international application was prepared by the ISA/US and found that all claims satisfied the provisions of PCT Article 33(1)-(4). The claims were not amended upon the entering of the U.S. National stage, as such, no national stage search nor examination fee were required. In view of the above, it is proper to grant applicant's petition at this time to withdraw the holding of abandonment.

## CONCLUSION

For the reasons detailed above, applicant's petition under 37 CFR 1.181 is **GRANTED**.

The Form PCT/DO/EO/923 mailed 29 November 2007 and Form PCT/DO/EO/909 mailed 20 November 2008 are hereby **VACATED**.

The application has an international filing date of 14 July 2004 under 35 U.S.C. 363 and will be given a date of **16 January 2007** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

This application is being returned to the United States Designated/Elected Office (US/DO/EO) for further processing in accordance with this decision, namely the issuance of a "Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495" (Form PCT/DO/EO/903) and a filing receipt indicating the 371 date as detailed above.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

11 JUN 2009

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

Myers Bigel Sibley & Sajovec, P.A.
P.O. Box 37428
Raleigh, North Carolina 27627

In re Application of :
CLARK et al. :
Application No.: 11/572,152 : DECISION ON
PCT No.: PCT/GB05/02779 : PAPERS UNDER 37 CFR 1.42
Int. Filing Date: 15 July 2005 :
Priority Date: 16 July 2004 :
Attorney Docket No.: 149052-253 :
For: DETECTION OF CELLULAR STRESS

This decision is issued in response to applicants' declaration filed 21 September 2007, which is being treated as a request under 37 CFR 1.42. No petition fee is due.

## BACKGROUND

On 15 July 2005, applicants filed international application PCT/GB05/02779 which claimed a priority date of 26 July 2004 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 26 January 2006. The deadline for payment of the basic national fee was to expire 30 months from the priority date, 16 January 2007.

On 16 January 2007, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 12 September 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b). Additionally, the notification required applicants to state that "the content of the sequence listing information recorded in computer readable form is identical to the written (on paper of compact disc) sequence listing and where applicable, includes no new matter."

On 21 September 2007, applicants submitted a declaration executed by the five joint inventors and Helen Elizabeth Clark, on behalf of deceased inventor, Anthony John Clark.

## DISCUSSION

The required reply in the present circumstances is a proper response to the 12 September 2007 Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905), that is, (1) an acceptable declaration executed by the inventors; (2) a statement that "the content of the sequence listing information recorded in computer readable form is identical to the written (on paper of compact disc) sequence listing and where applicable, includes no new matter;" and (3) a $130 surcharge under 37 CFR 1.492(h). The sequence listing statement is not required.

The present submission includes the $130 surcharge and a declaration, which is being treated under 37 CFR 1.42.

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

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

The declaration submitted on 21 September 2007 is executed by Helen Elizabeth Clark as "legal representative" to the deceased inventor, Anthony John Clark. The declaration is executed by the proper party under 37 CFR 1.42, however, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

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

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

Pursuant to 37 CFR 1.497(b)(2), the citizenship for **both** the deceased inventor and the legal representative must be identified on the declaration (as well as the mailing address and residence information of the legal representative and all other information required under 37 CFR 1.497).

Here, the declaration filed on 21 September 2007 provides the citizenship for only one individual and it is unclear whether this information is for the legal representative or the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.42 and 37 CFR 1.497(b)(2).

## CONCLUSION

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

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) 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" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

0 1 SEP 2009

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Myers Bigel Sibley & Sajovec, P.A.
P.O. Box 37428
Raleigh, North Carolina 27627

In re Application of :
CLARK et al. :
Application No.: 11/572,152 : DECISION ON
PCT No.: PCT/GB05/02779 : PAPERS UNDER 37 CFR 1.42
Int. Filing Date: 15 July 2005 :
Priority Date: 16 July 2004 :
Attorney Docket No.: 9052-253 :
For: DETECTION OF CELLULAR STRESS

In a decision mailed by this Office on 11 June 2009, the declaration filed by applicant on behalf of deceased inventor Anthony John Clark was dismissed for failure to include all the information required under 37 CFR 1.497.

On 06 August 2009, applicant filed a response to the previous communication that was accompanied by a revised declaration. The declaration submitted on 06 August 2009 identifies the deceased inventor and states the deceased inventor's country of citizenship, is signed by Helen Elizabeth Clark as "Legal Representative," states her relationship to the deceased (i.e., Legal Representative), and provides the Legal Representative's country of citizenship and mailing address. Accordingly, the declaration complies with the requirements of 37 CFR 1.497(a)-(b) and 37 CFR 1.42.

The request for status under 37 CFR 1.42 is **GRANTED**.

The application will be forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision.

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

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**THE ECLIPSE GROUP LLP**
**10605 BALBOA BLVD., SUITE 300**
**GRANADA HILLS, CA 91344**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Shahriar Sarkeshik | : | DECISION ON PETITION |
| Application No. 11/572,207 | : | TO WITHDRAW |
| Filed: January 16, 2007 | : | FROM RECORD |
| Attorney Docket No. SS04001USU | : | |

This is a decision on the Requests to Withdraw as Attorney or Agent of Record under 37 C.F.R. § 1.36(b), filed October 22, 2009.

The request is **NOT APPROVED**.

The Office strongly encourages practitioner(s) requesting withdrawal from representation as practitioner of record in an application to review the record to determine whether he or she is, in fact, of record and how he or she was made of record. For example, the practitioner(s) should determine whether he or she was appointed by naming each practitioner individually or through the use of a Customer Number. If the practitioner(s) was appointed by a specific designation, then the Request should ask that each specified practitioner be withdrawn and should list each practitioner(s) in the Request.

In the instant application, the practitioner was not appointed via Customer Number. The request withdrawal by Customer Number; however, it appears the practitioner(s) were not appointed by a Customer Number upon filing of the instant application. Therefore, any subsequent request must reflect withdrawal of the associated practitioners in the same manner as appointed.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-6059. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Alicia Kelley
Petitions Examiner
Office of Petitions

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAR 19 2010

OFFICE OF PETITIONS

THE ECLIPSE GROUP LLP
10605 BALBOA BLVD., SUITE 300
GRANADA HILLS, CA 91344

In re Application of :
Shahriar Sarkeshik :
Application No. 11/572,207 :
Filed: November 13, 2007 :
Attorney Docket: SS04001USU :

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 January 8, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40 (c).

The request was signed by Jennifer H. Hamilton on behalf of all practitioners of record.

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

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

There are no outstanding Office actions that require a reply from the applicant.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-6059. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Alicia Kelley
Petitions Examiner
Office of Petitions

cc: SHAHRIAR SARKESHIK
19443 SUPERIOR ST.
NORTHRIDGE, CA 91324

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/572,207 | 11/13/2007 | Shahriar Sarkeshik | SS04001USU |

**CONFIRMATION NO. 5407**

**POWER OF ATTORNEY NOTICE**

34408
THE ECLIPSE GROUP LLP
10605 BALBOA BLVD., SUITE 300
GRANADA HILLS, CA 91344

Date Mailed: 03/18/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 01/08/2010.

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

/atkelley/

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

11 FEB 2008

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TROJAN LAW OFFICES
9250 WILSHIRE BLVD
SUITE 325
BEVERLY HILLS CA 90212

In re Application of :
KANNO, Minoru :
Application No.: 11/572,210 :
PCT No.: PCT/JP2005/013212 :
Int. Filing Date: 12 July 2005 : DECISION
Priority Date: 16 July 2004 :
Attorney Docket No.: 07-01-0435 :
For: CONNECTION STRUCTURE OF FUEL :
CARTRIDGE FOR FUEL CELL :

This decision is in response to applicants' submissions on 30 July 2007 and 17 January 2008.

## BACKGROUND

On 19 July 2007, the Office mailed a Notification Regarding Change of Power of Attorney, indicating that the power of attorney in this application had been revoked and that future correspondence would be held with the address of record.

On 30 July 2007, applicants filed a letter indicating that the above change was in error.

On 17 January 2008, applicants filed a power of attorney from the inventor changing the correspondence address back to the original address.

## DISCUSSION

The file does not include a request to change the correspondence address prior to the power of attorney filed on 17 January 2008. The address has been corrected to reflect customer no. 23388.

## CONCLUSION

As discussed above, applicants' petition to change the correspondence address is **GRANTED**.

This application is being referred to the National Stage Processing Branch of the Office of Patent Application Processing for further action consistent with decision, including the mailing of a Notification of Missing Requirements, indicating that an oath or declaration and the surcharge for late filing of search fee, examination fee or 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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APR 2 9 2010

CARLSON GASKEY & OLDS
400 W MAPLE STE 350
BIRMINGHAM MI 48009

| | | |
|---|---|---|
| In re Application of | : | |
| Dilip PRASAD et al. | : | DECISION ON PETITION |
| Application No. 11/572,236 | : | UNDER 37 CFR §1.181 |
| Filed: January 17, 2007 | : | |
| For: SHEAVE FOR USE IN | : | |
| AN ELEVATOR SYSTEM | : | |

This is a decision on applicant's petition under 37 CFR 1.181 filed January 15, 2010 to request the withdrawal of the objection to the drawings and the requirement for cross referencing of the PCT/US04/25211 application as et forth in the Office actions mailed on April 1, 2009 and November 17, 2009.

The petition is **GRANTED.**

Applicants allege that the drawings objection that requires an exactness that corresponds to the mathematical formula is unreasonable and has no basis. Applicant contends that the drawings need not satisfy some hypothetical scrutiny of an editor of a mathematics textbook, and that the drawings are adequate in showing a curved surface. As for the cross referencing requirement, applicant argues that the examiner's requirement is improper because the instant application is the national phase of the international application PCT/US04/25211, which means that the instant application is the same as the international application and the PCT application is not a prior application for purpose of priority claim.

A review of the record reflects that in the Office action mailed on April 1, 2009 the examiner objected to the drawings on the grounds that they failed to show a surface profile defined as the equation $y=x^n$, that the surface profiles as depicted appear to be linear and quadratic in sections whereas the quadratic sections appear to be better defined by $y=mx^n$, and that the drawings fail to show the width of the central portion 42 that is equal to the difference between the width w of the belt 24 and the width c of the belt guiding surface 26" as described on page 4 of the specification. The examiner also required that applicant references the PCT/US04/25211 application in the first sentence of the specification because the instant application appears to claim the subject matter disclosed in the prior PCT application. Applicant filed a response on July 1, 2009 amending some claims and part of the specification to overcome one issue of the drawing objection while traversing

the rest of the drawings objection as well as the cross referencing requirement. The drawing objection and the cross reference requirement were again made in the final Office action mailed on November 17, 2009.

37 C.F.R. 1.84 sets forth the standards for drawings, which states that:

> The scale to which a drawing is made must be large enough to show the mechanism without crowding when the drawing is reduced in size to two-thirds in reproduction. Indications such as "actual size" or "scale 1 /2" on the drawings are not permitted since these lose their meaning with reproduction in a different format.

A close review of the drawings shows that figures 2, 3 and 4 illustrate different surface profiles of a guiding surface of a sheave element. Each of the figures 2-4 has at least one different mathematical formula denoting a particular surface profile, which is in agreement with the Brief Description of the Drawings section that references a different embodiment for each of the figures 2, 3 and 4. Figure 2 shows a curved surface profile defined by the equation $y=x^n$, figure 3 shows an inclined surface profile defined by the equation $y=S(x)$, and figure 4 shows different surface profiles defined by equations $y=x^n$, and $y=mx+b$. It is clear that there is adequate detail shown in each drawing figure to illustrate a specific surface profile corresponds to a mathematical equation annotated on the drawing. It is also clear from rule 37 C.F.R. 1.84 cited above that drawings are not required to be drawn to scales due to the needs for reproduction in different formats. Therefore, the examiner's drawing objection regarding the surface profile corresponds to the equation $y=x^n$ is improper and hereby withdrawn.

Regarding the examiner's objection to the drawings for not showing the width of the central portion 42 based on the widths of the belt and the belt guiding surface as described on paragraph 21 on page 4 of the specification, it is noted that drawing figure 3 appears to correspond to the original filed claim 8 which recites that "the central portion of the belt guiding surface has a width that is equal to approximately two times the difference between the belt width and one-half the width of the belt guiding surface." Since the originally filed drawings and the originally filed claim 8 are considered to be parts of the original disclosure, the amended specification made on January 17, 2007 does not have antecedent basis. The problem is in the amended specification, not in the drawings. Therefore, this part of the drawings objection is improper and hereby withdrawn.

MPEP § 1893.03 (c) (III) states that:

> (a) national stage application submitted under 35 U.S.C.371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the international filing date of the international application. See also MPEP § 1893.03(b). Stated differently, since the international application is not an earlier application (it has the same filing date as the national stage), a benefit claim under 35 U.S.C. 120 in the national stage to the international application is inappropriate and may result in the submission being treated as an application filed under 35 U.S.C. 111(a). See MPEP § 1893.03(a). Accordingly, it is not necessary for the applicant to amend the first sentence(s) of the specification to reference the

international application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage.

MPEP § 1893.03 (c) (III) states that:

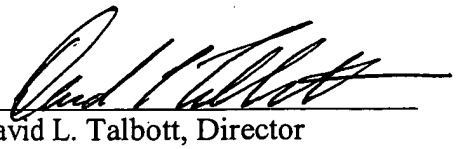
An international application designating the U.S. has two stages (international and national) with the filing date being the same in both stages. Often the date of entry into the national stage is confused with the filing date. It should be borne in mind that the filing date of the international stage application is also the filing date for the national stage application. Specifically, 35 U.S.C. 363 provides that "An international application designating the United States shall have the effect, from its international filing date under Article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title."

Regarding the examiner's requirement for cross referencing the PCT application, it is noted that applicant is correct in that the instant U.S. application is the national stage of the international application PCT/US04/25211. MPEP § 1893.03 (c) (III) explains that it is inappropriate for the national stage application filed under 35 U.S.C. 371 to claim priority benefit on the international application since the international application is not an earlier application due to the fact that it has the same filing date as the national stage. Therefore, the examiner's requirement for cross referencing the PCT application in the first line of the specification is improper, and hereby withdrawn.

Summary: The petition is **GRANTED.**

This application will be forwarded to the examiner for further action on the merits consistent with the decision herein.

Any questions regarding this decision should be directed to Supervisory Patent Examiner John Q. Nguyen at 571-272-6952.



David L. Talbott, Director
Technology Center 3600
571-272-5150

lm: 4/6/10

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STIENNON & STIENNON
612 W. MAIN ST., SUITE 201
P.O. BOX 1667
MADISON, WI 53701-1667

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Leo Kurkinen | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7662261 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/572,250 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/17/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **463** 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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ELI LILLY & COMPANY
PATENT DIVISION
P.O. BOX 6288
INDIANAPOLIS, IN 46206-6288

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Lisa Selsam Beavers | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7666871 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/23/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/572,283 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/18/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **13** 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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24 APR 2008

Nexus Law Group LLP
1500 - 701 West Georgia Street
Vancouver, BC V74-1C6
Canada

In re Application of :
RAND et al. :
Application No.: 11/572,292 : DECISION ON
PCT No.: PCT/CA05/01159 : PAPERS UNDER 37 CFR 1.42
Int. Filing Date: 22 July 2005 :
Priority Date: 22 July 2004 :
Attorney Docket No.: 50088-9 :
For: ADJUSTABLE PLANT POT SUPPORTS

This decision is issued in response to the declaration filed 07 January 2008 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

## BACKGROUND

On 22 July 2005, applicants filed international application PCT/CA05/01159 which claimed a priority date of 22 July 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 26 January 2006. The deadline for payment of the basic national fee was to expire 30 months from the priority date, 22 January 2007.

On 18 January 2007, 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; executed declaration; and an application data sheet.

On 15 November 2007, 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) indicating that the declaration was illegible and that a new oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. The notification set a two-month time limit in which to respond.

On 07 January 2008, applicants filed an executed declaration/power of attorney.

## DISCUSSION

35 U.S.C. 117 states:

> Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

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 07 January 2008 is executed by the first inventor and Ron ALOM as the "legal representative" of the deceased inventor, Enn Erisalu. The declaration submitted on 07 January 2008 appears to have been executed by the proper party under 37 CFR 1.42, however, the declaration is defective. Specifically, page 1 and page 2 are illegible.

Additionally, the declaration filed 07 January 2008 is not acceptable under 37 CFR 1.497. Specifically, the declaration lists the legal representative as Ron ALOM, whereas the international application lists the legal representative as RON ALONI. As stated in MPEP 201.03,

> a request under 37 CFR 1.48 will not be required: (B) Where a typographical or transliteration error in the spelling of an inventor's name is discovered, the Office should simply be notified of the error. A new oath or declaration is not required.

Applicants are required to provide an explanation of the typographical or transliteration error in the name of the legal representative. If the legal representative name is RON ALONI, as it appears on the published international application, a newly executed declaration is required.

## CONCLUSION

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

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) 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" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

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

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

24 NOV 2008

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1500 - 701 West Georgia Street
Vancouver, BC V74-1C6
Canada

In re Application of :
RAND et al. :
Application No.: 11/572,292 : DECISION ON
PCT No.: PCT/CA05/01159 : PAPERS UNDER 37 CFR 1.42
Int. Filing Date: 22 July 2005 :
Priority Date: 22 July 2004 :
Attorney Docket No.: 50088-9 :
For: ADJUSTABLE PLANT POT SUPPORTS

This decision is issued in response to applicants' "Renewed Submission under 37 CFR 1.42" filed 18 June 2008.

## BACKGROUND

On 22 July 2005, applicants filed international application PCT/CA05/01159 which claimed a priority date of 22 July 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 26 January 2006. The deadline for payment of the basic national fee was to expire 30 months from the priority date, 22 January 2007.

On 18 January 2007, 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; executed declaration; and an application data sheet.

On 15 November 2007, 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) indicating that the declaration was illegible and that a new oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. The notification set a two-month time limit in which to respond.

On 07 January 2008, applicants filed an executed declaration/power of attorney. In a Decision on Papers under 37 CFR 1.42 dated 24 April 2008, applicants' request was refused.

On 18 June 2008, applicants filed a "Renewed Submission under 37 CFR 1.42."

## DISCUSSION

35 U.S.C. 117 states:

> Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

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 18 June 2008 is executed by the first inventor and Ron Aloni as the "legal representative" of the deceased inventor, Enn Erisalu. However, the declaration is not in compliance with 37 CFR 1.497(a)(3). 37 CFR 1.497(a)(3) requires that the declaration must "identify each inventor and the country of citizenship of each inventor." Here, the declaration submitted failed to identify name of the second inventor in the appropriate signature box. Therefore, a new declaration executed by the first inventor and Ron Aloni, identifying Enn Erisalu and his/her citizenship, must be filed in order to fulfill the declaration requirement under 35 U.S.C. 371.

## CONCLUSION

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

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) 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" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

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

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

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17 MAR 2009

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1500 - 701 West Georgia Street
Vancouver, BC V74-1C6
Canada

In re Application of :
RAND et al. :
Application No.: 11/572,292 : DECISION ON
PCT No.: PCT/CA05/01159 : PAPERS UNDER 37 CFR 1.42
Int. Filing Date: 22 July 2005 :
Priority Date: 22 July 2004 :
Attorney Docket No.: 50088-9 :
For: ADJUSTABLE PLANT POT SUPPORTS

In a decision mailed by this Office on 24 November 2008, the declaration filed by applicant on behalf of deceased inventor Enn Erisalu was dismissed for failure to include all the information required under 37 CFR 1.497.

On 20 January 2009, applicant filed a response to the previous communication that was accompanied by a revised declaration. The declaration submitted on 20 January 2009 identifies the deceased inventor and states the deceased inventor's country of citizenship and residence, is signed by Ron Aloni as "Legal Representative," states his relationship to the deceased (i.e., Legal Representative), and provides the Legal Representative's country of citizenship and residency. Additionally, the declaration has been executed by the joint inventor, Austin Rand. Accordingly, the declaration complies with the requirements of 37 CFR 1.497(b)(2) and 37 CFR 1.42.

The request for status under 37 CFR 1.42 is **GRANTED**.

The application will be forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision.

Anthony R

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

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24 OCT 2007

BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD MI 48075

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Mark Gordon | : | |
| Application No.: 11/572,301 | : | |
| PCT No.: PCT/US2002/027867 | : | |
| Int. Filing Date: 18 March 2004 | : | PETITION UNDER |
| Priority Date: NA | : | |
| Attorney's Docket No.: FP10106PUSA | : | |
| For: CONE-HEAD THRUST SCREW | : | 37 CFR 1.137(b) |

This decision is in response to applicant's "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. 1.137(b)," filed on 18 January 2007.

## BACKGROUND

On 18 March 2004 this international application was filed.

The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 18 September 2006. This international application became abandoned with respect to the United States at midnight on 18 September 2006 for failure to pay the required basic national fee.

On 18 January 2007, applicant filed the instant petition under 37 CFR 1.137(b) and a Transmittal letter for entry into the national stage in the United States, which was accompanied by the basic national fee and the petition fee. However, no executed declaration was filed at such time.

On 23 June 2007, applicant submitted an executed declaration.

## DISCUSSION

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

information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

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

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

## DECISION

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

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **23 June 2007**.

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

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

Applicant: Taberski et al.
Appl. No.: 11/572,309
International Filing Date: July 19, 2005
Title: SMOKE ALARM SYSTEM
Attorney Docket No.: P/4348-118 V2520
Pub. No.: US 2008/0094233 A1
Pub. Date: April 24, 2008

MAILED

FEB 27 2009

OFFICE OF PETITIONS

This is a decision on the request for republication in order to amend the claims in patent application publication, received on June 4, 2008.

The request is DISMISSED.

Applicant requests that the patent application be republished to include an amendment to claims 12-16, 18, and 19.

A "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application in compliance with the Office 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.

The instant request is not in compliance with the Office electronic filing system requirements. Therefore, republication will not take place.

Furthermore, the instant request does not qualify as a request for corrected publication under 37 CFR 1.221(b), since it does not identify a material mistake in the publication made by the Office. The application was properly published based upon the claims on file with the Office at the time of publication, and no EFS-compliant copy of the application having different claims was included in the request.

It would greatly benefit the Office if **applicant did not provide copies of papers**, which were previously submitted and/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.

Any request for republication under 37 CFR 1.221(a) must be submitted via the EFS system as a "Pre-Grant Publication" and any questions or request for reconsideration of the decision should be addressed as follows:

By mail to: Mail Stop PGPUB
Commissioner for Patents
P.O. Box 1450
Alexandria, Va. 22313-1450

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

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

Inquiries relating to this matter may be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or to the undersigned at (571) 272-7709.

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

19 MAY 2008

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2200 ROSS AVENUE
SUITE 2800
DALLAS TX 75201-2784

| | | |
|---|---|---|
| In re Application of INGANAS | : | |
| Application No.: 11/572,313 | : | |
| PCT No.: PCT/SE05/01153 | : | DECISION ON |
| Int. Filing: 15 July 2005 | : | |
| Priority Date: 16 July 2004 | : | PETITION TO REVIVE |
| Attorney Docket No.:HO-PO3031US1 | : | |
| For: GRADING OF IMMUNE RESPONSES | : | UNDER 37 CFR 1.137(b) |

The petition to revive under 37 CFR 1.137(b) filed 18 January 2007 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 basic national fee of $300 has now 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, including issuance of a Notification of Missing Requirements 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
Office of PCT Legal Administration

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

United States Patent and Trademark Office

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17 SEP 2007

FULBRIGHT & JAWORSKI, LLP
2200 Ross Avenue, Suite 2800
Dallas, TX 75201-2784

In re Application of :
Bo Ek et al. :
Application No.: 11/572,316 :
PCT No.: PCT/SE05/01154 :
Int. Filing Date: 15 July 2005 : DECISION
Priority Date: 16 July 2004 :
Attorney Docket No.: HO-P03031US2 :
For: Sequential Method :

The petition to revive under 37 CFR 1.137(b) filed 18 January 2007 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 for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of the basic national fee, and has paid the petition fee. Thus, the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

It is noted that the declaration document accompanying the petition is unsigned, and no declaration pursuant to PCT Rule 4.17(iv) appears to have been filed.

This application is being forwarded to the United States Designated/Elected Office for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

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

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23 MAY 2007

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BEIT HAROF'IM
18 MENUHA VENAHALA STREET, ROOM 27
REHOVOT
ISRAEL

| | | |
|---|---|---|
| In re Application of VARTSKY et al | : | |
| U.S. Application No.: 11/572,318 | : | |
| PCT Application No.: PCT/IL2005/000407 | : | DECISION |
| Int. Filing Date: 19 April 2005 | : | |
| Priority Date Claimed: 10 April 2004 | : | |
| Attorney Docket No.: 1420MMG-US | : | |
| For: HIGH-SPEED TRUE RANDOM-NUMBER GENERATOR | : | |

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 January 2007.

## BACKGROUND

On 19 April 2005, applicant filed international application PCT/IL2005/000407, which claimed priority of an earlier United States application filed 10 April 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 27 October 2005. The thirty-month period for paying the basic national fee in the United States expired on 19 October 2006.

International application PCT/IL2005/000407 became abandoned as to the United States for failure to timely pay the basic national fee.

On 19 January 2007, applicant filed the present petition under 37 CFR 1.137(b).

## DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless

previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

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

With regard to item (3), applicant has provided the required statement.

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

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 19 April 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 19 January 2007.

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/572,343 | 08/29/2008 | Andrey Livchak | T4338-14465US01 | 7336 |

181 7590 02/23/2010

MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 3749 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 02/23/2010 | 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):

ipdocketing@milesstockbridge.com
sstiles@milesstockbridge.com

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1751 PINNACLE DRIVE
SUITE 500
MCLEAN VA 22102-3833

| | | |
|---|---|---|
| In re Application of | : | |
| LIVCHAK, ANDREY et al | : | DECISION ON REQUEST TO |
| Application No. 11/572,343 | : | PARTICIPATE IN PATENT |
| Filed: Aug. 29, 2008 | : | PCT/PROSECUTION HIGHWAY |
| Attorney Docket No. T4338-14465US01 | : | PROGRAM AND PETITION |
| For: CONTROL OF EXHAUST SYSTEMS | : | 37 CFR 1.102(d) |

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed Feb. 19, 2010 to make the above-identified application special.

The request and petition are granted.

A grantable request to participate in the PCT/PPH pilot program and petition to make special require:

(1) The U.S. application is (1) a national stage entry of the corresponding PCT application, or (2) a national stage entry of another PCT application which claims priority to the corresponding PCT application, or (3) a national application that claims domestic/foreign priority to the corresponding PCT application, or (4) a national application which forms the basis for the priority claim in the corresponding PCT application.
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the EPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
(3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the corresponding PCT/EPO application(s);
(4) Examination of the U.S. application has not begun;
(5) Applicant must submit a copy of all the international work product of the PCT office actions from each of the PCT/EPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;

(6) Applicant must submit an IDS listing the documents cited by the ISA/EPO examiner in the PCT/EPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PCT/PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application.

All other inquiries concerning the examination or status of the application should be directed to Steve McAllister, the SPE of Art Unit 3749, 571-272-6785 and also accessible in the PAIR system at http://www.uspto.gov/ebc.index.html.

The application is undergoing pre-examination processing. Once it is released for examination, the application will be forwarded to the examiner for action on the merits commensurate with this decision. Telephone inquiries concerning this decision should be directed to Henry C. Yuen, at 571-272-4856.

The petition is **granted.**

/Henry C. Yuen/

_____

Henry C. Yuen, Special Programs Examiner
Technology Center 3700 – Mechanical Engineering,
Manufacturing and Products
571-272-4856

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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON VA 20191

In re Application of:
PITONAK, REINHARD et al
Serial No. 11/572,352
Filed: Jan. 19, 2007
Docket: P31439
Title: CUTTING INSERT PROVIDED WITH STRUCTURED SURFACES

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition filed September 16, 2009 under 37 CFR 1.181 requesting correction of mail date for the Quayle Action mailed on September 17, 2009. This petition is being considered pursuant to 37 CFR §1.181. No fee is required.

The petition is dismissed.

In the petition, petitioner requests correction of the mailing date of the Quayle Action because SPE Boyer Ashley transmitted by facsimile a copy of the Quayle Action on September 16, 2009 not on September 17, 2009 as shown on the Quayle Action. To support his argument, petition also provided a copy of the fax of September 16, 2009 and the Quayle Action. Petitioner further argues that an interview summary from SPE Ashley indicating he was sending the Quayle Action on September 16, 2009 in order to avoid any gap in pendency. As such, petitioner requests that the mailing date of the Quayle Action be corrected to reflect the actual notification date of September 16, 2009.

The relevant record shows that:

1) On March 16, 2009, the examiner issued a final rejection, rejecting claims 1-11, 13-20, 22-27 and 29 and allowing claims 12, 21, 28 and 30. In addition, the examiner also objected to the drawings under 37 CFR § 1.83(a).
2) The applicant responded on May 18, 2009 with an amendment under 37 CFR 1.116 with additional supporting arguments. The applicant included a drawing correction by adding a new fig. 3A.
3) On June 8, 2009, the examiner issued an advisory action informing the applicant that they are not persuasive and will not be entered. Subsequently, on June 17, 2009, the examiner issued another advisory action informing the applicant that the Rule 116 amendment of May 18, 2009 will be entered for appeal purposes.
4) On July 16, 2009, the applicant filed a second Rule 116 amendment attempting to place the application in condition for allowance by adding the allowable subject matter of

claims 21 and 28 into claims 10 and 27, respectively. The applicant also presented the same proposed drawing correction by adding a new Fig. 3A.

5) Based on the examiner's telephone interview record provided with the petition, on September 16, 2009, the applicant's attorney, Mr. Miller called to express concern of the mailing date of the Ex Parte Quayle Action. The examiner informed Mr. Miller that a Quayle Action was submitted and counted; however, the Quayle action appears to be given a mail date of September 17 which is one day after the official abandonment date. Mr. Miller requested that the Quayle Action be transmitted via fax to the applicant on September 16, 2009 to ensure there was no gap in the pendency of the instant application.
6) On September 16, 2009, the current petition for correction of Quayle Action mail date and Conditional Notice of Appeal was filed. The examiner's Interview Summary Form was also attached with the petition to support the surrounding facts.
7) During the official USPTO mailing process in this case with the applicant's attorney's law firm, the e-mail Notification Date of the Ex Parte Quayle Action was officially accorded as September 17, 2009 with indication of electronic delivery mode.

## Analysis and Discussion

A review of the records in this case indicates that the applicant has filed two Rule 116 amendments on May 18, 2009 and July 16, 2009. It should be noted that this application is under final rejection. It is the applicant's responsibility to take the necessary action in an application under final Office action to provide a complete reply under 37 CFR § 1.113. Only upon receipt of the second Rule 116 amendment, did the examiner indicate the allowability of all pending claims in this case. However, the applicant still failed to placed the application in condition for allowance as required by 37 CFR § 1.116. 37 CFR § 1.116 and § 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal. Under the circumstances, the examiner has done all she could by issuing an Ex Parte Quayle Action on September 14, 2009 (according to the Interview Summary Form) to afford the applicant another opportunity to make drawing correction. In view of the official USPTO mailing procedures for electronic delivery mode in this case, a Notification Date of September 17, 2009 was accorded. Therefore, it is not possible to change the official mail date of the Ex Parte Quayle Action from September 17, 2009 to September 16, 2009. The requested relief cannot be granted.

Since the requested relief to change mail date of the Ex Parte Quayle Action of September 17, 2009 cannot be granted, the current petition filed on September 16, 2009 is construed as a Notice of Appeal as requested by petitioner. The fee for filing a Notice of Appeal has been charged to the Deposition Account No. 19-0089 as authorized at the page one of the petition. A two-month extension of time under 37 CFR § 1.136 is also charged to the Deposit Account as authorized on page two of the petition.

## Conclusion

In view of the record, petitioner's request to correct the Ex Parte Quayle Action mail date cannot be granted.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extension of time under 37 CFR 1.136(a) is permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". The application is being forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3724 awaiting the response of the outstanding Ex Parte Quayle Action mailed on September 17, 2009. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DISMISSED

Donald T. Hajec, Director
Technology Center 3700

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30 OCT 2008

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WOODARD, EMHARDT, MORIARTY, MCNETT & HENRY LLP
111 MONUMENT CIRCLE, SUITE 3700
INDIANAPOLIS IN 46204-5137

| | | |
|---|---|---|
| In re Application of | : | |
| SMITH, Robert E. (deceased) | : | DECISION ON |
| Application No.: 11/572,399 | : | |
| PCT No.: PCT/US2005/026086 | : | PAPERS |
| Int. Filing Date: 22 July 2005 | : | |
| Priority Date: 23 July 2004 | : | UNDER 37 CFR 1.42 |
| Attorney's Docket No.: 6268-11 | : | |
| For: FURIN INHIBITORS | : | |

This is a decision on the submission filed by applicant on 17 July 2008. The indication that inventor Robert E. Smith is deceased has been treated as a request for status under 37 CFR 1.42.

## BACKGROUND

On 22 July 2005, applicant filed international application PCT/US2005/026086 which claimed a priority date of 23 July 2004 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 26 April 2007. The thirty-month period for paying the basic national fee in the United States expired at midnight on 23 January 2007.

On 19 January 2007, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee.

On 17 July 2008, applicant filed the instant submission which indicates that Robert E. Smith is deceased and Judith Smith is his legal heir. The indication that inventor Robert E. Smith is deceased has been treated as a request for status under 37 CFR 1.42.

## DISCUSSION

The declaration filed 17 July 2008 is not sufficient because it contains non-initialed alterations on the page signed by Judith Smith. 37 CFR 1.52(c). "The Office will not consider whether noninitialed and or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration." MPEP § 605.04(a). Item I.

## CONCLUSION

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

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

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

/Daniel Stemmer/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

28 JAN 2009

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INDIANAPOLIS IN 46204-5137

| | |
|---|---|
| In re Application of<br>SMITH (Deceased)<br>Application No.: 11/572,399<br>PCT No.: PCT/US05/26086<br>Int. Filing Date: 22 July 2005<br>Priority Date: 23 July 2004<br>Attorney Docket no.: 6268-11<br>For: FURIN INHIBITORS | DECISION ON<br><br>REQUEST<br><br>UNDER 37 CFR 1.42 |

This is a decision on applicant's request under 37 CFR 1.42 along with an executed declaration filed in the United States Patent and Trademark Office (USPTO) on 14 November 2008.

## BACKGROUND

On 19 January 2007, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee.

On 17 July 2008, applicant filed a declaration executed by the legal representative of the deceased inventor.

On 30 October 2008, a decision was mailed to applicant indicating that the declaration was unacceptable due to an alteration and that a newly executed declaration was required.

On 14 November 2008, applicant filed a newly executed declaration identifying Judith Smith as the legal representative of the deceased inventor Robert E. Smith.

## DISCUSSION

To meet the requirements for compliance with 37 CFR 1.497(a) and (b), the declaration must state the relationship and the country of citizenship for both the deceased inventor and the legal representative. In addition, the declaration must provide the residency and mailing address for both the deceased inventor and the legal representative.

The declaration (PTO/SB/01) submitted on 14 November 2008 identifies Judith Smith as the legal representative of the deceased inventor Robert E. Smith and states the relationship, country of citizenship, residency and mailing address for both the deceased inventor and the legal representative. The declaration meets the requirements for compliance with 37 CFR 1.497(a) and (b). Accordingly, it is appropriate, at this time, to accord the application status under 37 CFR 1.42.

## CONCLUSION

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

The declaration by the legal representative for deceased inventor Robert E. Smith submitted on 14 November 2008 is accepted as a proper declaration under 37 CFR 1.497(a) and (b).

The application will be forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is 14 November 2008.

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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120 South LaSalle Street, Suite 100
Chicago, IL 60603-3406

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Michael Kevin Schelb | : | |
| Application No. 11/572,401 | : | |
| PCT No.: PCT/NZ2005/000184 | : | PETITION UNDER |
| Int. Filing Date: 21 July 2005 | : | |
| Priority Date: 21 July 2004 | : | |
| Attorney's Docket No.: 5569-89838 | : | |
| For: A DOOR OPENER | : | 37 CFR 1.137 (b) |

This decision is in response to applicant's' "PETITION UNDER 37 CFR 1.137(b) TO REVIVE AN UNINTENTIONALLY ABANDONED APPLCATION," filed on 03 November 2008.

## BACKGROUND

On 21 July 2005, this international application was filed claiming an earliest priority date of 21 July 2004. 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 January 2007.

On 19 January 2007, applicants 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 28 January 2008, 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 09 October 2008, the United States Patent and Trademark Office mailed the Notification of Abandonment (PCT/DO/EO/909) since the application was abandoned because applicant failed to respond to the notification of MISSING REQUIREMENTS (Form PCT/DO/EO/905), mailed 01/28/2008 within the time period set therein.

On 03 November 2008, applicants filed the instant petition under 37 CFR 1.137(b), which was accompanied by the petition fee and a properly executed declaration.

## DISCUSSION

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

Petitioner has provided: (1) the proper reply by submitting a properly 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 **03 November 2008.**

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

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BERENBAUM, WEINSHIENK & EASON, P.C.
370 17TH STREET
SUITE 4800
DENVER, CO 80202

COPY MAILED
SEP 26 2008

Applicant: Mur
Appl. No.: 11/572,416
International Filing Date: January 19, 2007
Title: SPIROPIPERDYLFIFMACYCINS FOR THE TREATMENT OF MYCOBACTERIAL INFECTIONS
Attorney Docket No.: 14455.885US01
Pub. No.: 2007/02225266 A1
Pub. Date: September 27, 2007

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on October 26, 2007, for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication contains material errors on the front page of the publication wherein the application number for the Spanish application is erroneously printed as "P200401757" rather than the correct "P200401767".

37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. [1]

The error in the benefit claim to the Spanish Application on the front page of the publication is an Office mistake, in that the correct priority document should be "P200401767" rather than the printed P200401757", but it is not a material mistake 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 of a patent. The specification and claims were accurately published, thus one can read and understand the content of the application. The

[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).

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. Moreover, the correct priority date appears in the first paragraph of the specification.

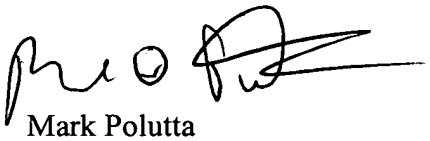
The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application compliance with the Office's electronic filing system requirements and be accompanied by the 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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24 JUL 2007

CATALYST LAW GROUP, APC
9710 SCRANTON ROAD, SUITE 170
SAN DIEGO CA 92121

| | | |
|---|---|---|
| In re Application of | : | |
| LATHROP | : | |
| Application No.: 11/572,417 | : | |
| PCT No.: PCT/US04/23045 | : | DECISION ON PETITION |
| Int. Filing Date: 16 July 2004 | : | |
| Priority Date: 18 July 2003 | : | UNDER 37 CFR 1.137(b) |
| Atty. Docket No.: 8029-003-US | : | |
| For: ELECTROTHERAPEUTIC DEVICE | : | |

The petition to revive under 37 CFR 1.137(b) filed 19 January 2007 in the above-captioned application is hereby **GRANTED** as follows:

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

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National Fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being 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

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**GIFFORD, KRASS, SPRINKLE,ANDERSON & CITKOWSKI, P.C**
**P.O. BOX 7021**
**TROY, MI 48007-7021**

**MAILED**

**JUL 14 2010**

**OFFICE OF PETITIONS**

In re Application of
**Rune FISKER**, et *al.*
Application No. 11/572,424
Filed: August 6, 2008
Attorney Docket No. **HOI-17502/16**

DECISION GRANTING PETITION
UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed July 13, 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 June 28, 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 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 should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 2872 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

cc: **GIFFORD, KRASS, SPRINKLE, ANDERSON & CITKOWSKI, P.C**
**2701 TROY CENTER DRIVE, SUITE 330**
**PO BOX 7021**
**TROY MI 48007-7021**

[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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Robert O Rice
Whirlpool Patents Company
Maildrop 0750
500 Rennaisance Drive Suite 102
St. Joseph, MI 49084

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Alessandro Boer | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7665317 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/23/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/572,446 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/22/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **407** 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 HOAG, LLP**
**PATENT GROUP (w/ISA)**
**155 SEAPORT BLVD.**
**BOSTON MA 02210-2600**

COPY MAILED
MAR 15 2010

In re Application of :
Gary R. Klinefelter :
Application No. 11/572,453 : DECISION DISMISSING PETITIONS
Filed: January 22, 2007 : UNDER 37 CFR 1.78(a)(3) AND (a)(6)
Attorney Docket No. ISA-013.05 :

This is a decision on the petition filed December 11, 2009, which is being treated under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 119(e) for the benefit of priority to the prior-filed nonprovisional and provisional 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) 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 Director may require additional where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

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

Further, 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. *See* MPEP Section 201.11, Reference to Prior Nonprovisional Applications. The amendment fails to (completely) comply with the provisions of 37 CFR 1.78(a)(2)(i) and is therefore unacceptable.

Before the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) can be granted, a renewed petition and either an Application Data Sheet or a substitute amendment to correct the above matters are required.

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

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

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

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

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/572,475 | 09/20/2007 | Perry Nylander | 13722 | 8850 |

25570 7590 09/21/2009

ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
Intellectual Property Department
P.O. Box 10064
MCLEAN, VA 22102-8064

| EXAMINER |
|---|
| CHIN, HUI H |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1796 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 09/21/2009 | ELECTRONIC |

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

The time period for reply, if any, is set in the attached communication.

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

lgallaugher@rmsclaw.com
dbeltran@rmsclaw.com
bdiaz@rmsclaw.com

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SEP 21 2009 bc
Mailed:

| | | |
|---|---|---|
| In re application of | : | |
| Nylander et al. | : | DECISION ON |
| Serial No. 11/572,475 | : | PETITION |
| Filed: September 20, 2007 | : | |
| For: SEMICONDUCTIVE POLYMER COMPOSITION | | |

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed June 10, 2009.

On December 29, 2008, a first office action was mailed to applicants, containing various grounds of rejections. Applicants responded to this office action with a response filed on April 29, 2009. A final rejection was then mailed June 10, 2009.

On August 13, 2009, the instant petition under 37 CFR 1.181 was filed to formally request the withdrawal of finality of the June 10, 2009 office action. As requested by the petitioner, the lateness, i.e. three (3) days, of the present petition is herein waived.

Petitioner's position for the withdrawal of the finality for the following reasons:
(1) The rejection fails to identify which claims are rejected.
(2) The Roy et al. document is newly cited and not precipitated by any amendment.
(3) There is no indication as to the status of the rejections made over the combination of Weaver et al. in view of Kawaski.
(4) The Examiner has failed to identify which claims are rejected over the combination of Weaver et al. in view of Tojo et al.
(5) The examiner failed to respond to a plethora of arguments presented in the April 29, 2009 response.

**DECISION**
Section 706.07 of the MPEP states "[b]efore final rejection is in order a clear issue should be developed between the examiner and applicant."

Section 706.07 of the MPEP states:
Before final rejection is in order a clear issue should be developed between the examiner and applicant.

706.07(a) Final Rejection, When Proper on Second Action
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).

37 CRF 1.104 states:

(b) Completeness of examiner 's action. **The examiner 's action will be complete as to all matters**, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

(c) Rejection of claims.

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (Emphasis added).

While the final office action does state "[i]n view of the Response, the rejections of claims 1-19 under 35 U.S.C. 102(b) and 103(a) are maintained" is set forth on page 2. There are several issues that lead of a general lack of clarity of the final office action. Specifically, paragraph 1 (page 2), states that "[c]laims 1, 12 and 16 have been canceled." However, this is not the case, as these claims have been amended and remain pending. Also, the reference to the Roy et al. reference in the Response to Arguments section is unclear. Is the Roy et al. reference now incorporated and part of the Weaver et al. rejection or was it being cited simply to rebut Applicants inherency argument? A significant amount of guessing would be required to determine the examiner's intentions in the final office action.

Accordingly, the petition for withdrawal of finality is **GRANTED.**

This application is being forwarded to the examiner to full consideration of the April 29, 2009 response and arguments. A supplemental office action, which clearly sets forth are pending grounds of rejections and fully addresses all of the arguments presented by the Applicant, will follow in due course.

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

ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
Intellectual Property Department
P.O. Box 10064
MCLEAN, VA 22102-8064

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GE HEALTHCARE BIO-SCIENCES CORP.
PATENT DEPARTMENT
101 CARNEGIE CENTER
PRINCETON, NJ 08540

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Suzanne Hancock | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7612189 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/03/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/572,510 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/23/2007 | : 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.

10 MAR 2008

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Allergan, Inc.
2525 Dupont Drive, T2-7H
Irvine, CA 92612-1599

In re Application of :
LI et al. :
Application No.: 11/572,512 : DECISION ON PETITION
PCT No.: PCT/US05/31613 :
Int. Filing Date: 01 September 2005 :
Priority Date: 01 September 2004 :
Attorney Docket No.: 17757PCTUS (BOT) :
For: DEGRADABLE CLOSTRIDIAL TOXINS

This decision is issued in response to the "Amendment and Petition to Correct/Add Inventor(s) under 37 CFR 1.48(a)" filed 17 July 2007.

## BACKGROUND

On 01 September 2005, applicant filed international application PCT/US05/31613 which designated the United States. The published international application identified six applicant/inventors with respect to the United States: Shengwen LI; Lance E. STEWARD; Ester FERNANDEZ-SALAS; Marcella A. GILMORE; Joseph A. FRANCIS: and Kei Roger AOKI. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 01 March 2007.

On 23 January 2007, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a declaration. The declaration only identified two of the six inventors of record herein. (Lance E. STEWARD; Ester FERNANDEZ-SALAS; Marcella A. GILMORE; and Joseph A. FRANCIS were omitted.)

On 17 July 2007, applicant filed "Amendment and Petition to Correct/Add Inventor(s) under 37 CFR 1.48(a)" which included: (1) a statement by Lance E. STEWARD; Ester FERNANDEZ-SALAS; Marcella A. GILMORE; and Joseph A. FRANCIS relating to an effort to add Lance E. STEWARD; Ester FERNANDEZ-SALAS; Marcella A. GILMORE; and Joseph A. FRANCIS as inventors (despite the fact that Lance E. STEWARD; Ester FERNANDEZ-SALAS; Marcella A. GILMORE; and Joseph A. FRANCIS are already named inventors); (2) a declaration executed by inventors Lance E. STEWARD; Ester FERNANDEZ-SALAS; Marcella A. GILMORE; and Joseph A. FRANCIS that does not identify Shengwen LI and Kei Roger AOKI as inventors; and (3) an authorization to charge the petition fee in the amount of $130 to Deposit Account no. 01-0885.

## DISCUSSION

The inventors of record for this application are, as set forth in the published international application, Shengwen LI; Lance E. STEWARD; Ester FERNANDEZ-SALAS; Marcella A. GILMORE; Joseph A. FRANCIS: and Kei Roger AOKI. The failure to list all six inventors on the declaration filed 23 January 2007 did not effect the inventorship herein. Accordingly, to the extent that applicants' submission seeks to add Lance E. STEWARD; Ester FERNANDEZ-SALAS; Marcella A. GILMORE; and Joseph A. FRANCIS as inventors, the submission is moot.

The declaration, however, filed on 23 January 2007 and 17 July 2007 are defective. Specifically, 37 CFR 1.497(a)(3) states that, among other information, the declaration must identify "each inventor and the country of citizenship of each inventor." Here, neither of the two declarations filed by applicants satisfy this requirement. The 23 January 2007 declaration identifies only two of the six inventors, whereas, the 17 July 2007 declaration identifies only four of the six inventors. Accordingly, neither of these declarations complies with 37 CFR 1.497(a)(3) and a newly executed declaration in compliance with 37 CFR 1.497(a)-(b) is required.

## CONCLUSION

Applicant's request to add Lance E. STEWARD; Ester FERNANDEZ-SALAS; Marcella A. GILMORE; and Joseph A. FRANCIS as an inventor is **DISMISSED as MOOT**, in that, Lance E. STEWARD; Ester FERNANDEZ-SALAS; Marcella A. GILMORE; and Joseph A. FRANCIS are already inventors of record for the present application.

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/572,512 | 07/17/2007 | Lance E. Steward | 17757PCTUS (BOT) | 9316 |

7590 08/29/2008

ALLERGAN, INC.
2525 DUPONT DRIVE, T2-7H
IRVINE, CA 92612-1599

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 1656 | |
| MAIL DATE | DELIVERY MODE |
| 08/29/2008 | 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.

Betty Powell

Patent Publication Branch
Office of Data Management

UNITED STATES PATENT AND TRADEMARK OFFICE

12 JAN 2010

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Sughrue Mion, PLLC
2100 Pennsylvania Avenue, N.W.
Suite 800
Washington, DC 20037

| | | |
|---|---|---|
| In re Application of | : | |
| GOTO, et al. | : | |
| Serial No.: 11/572,547 | : | DECISION ON PETITION |
| PCT No.: PCT/JP2005/013698 | : | |
| Int. Filing Date: 27 July 2005 | : | UNDER 37 CFR 1.181 |
| Priority Date: 30 July 2004 | : | |
| Attorney Docket No.: Q99713 | : | |
| For: LIGHT EMITTING ELEMENT AND MANUFACTURING METHOD THEREOF | : | |

This decision is in response to applicant's correspondence filed 23 October 2007 in the United States Patent and Trademark Office (USPTO). The correspondence is being treated as a petition under 37 CFR 1.181 to assign a 35 U.S.C. 371 date of 01 May 2007. No petition fee is required.

On 10 September 2007, applicant was mailed a "Notice of Acceptance" (Form PCT/DO/EO/903) indicating a date of completion of all 35 U.S.C. 371 requirements of 02 May 2007.

On 23 October 2007, applicant filed a letter with the USPTO stating that the declaration submitted in the application satisfying the last of the 35 U.S.C. 371 requirements was filed on 01 May 2007 and requesting a corrected Form PCT/DO/EO/903 and filing receipt.

A review of the application file finds that the executed declaration and payment of required fees was provided on 01 May 2007. Therefore applicant's petition under 37 CFR 1.181 is **GRANTED**.

It is noted that a corrected official filing receipt was mailed to applicant indicating a filing or 371(c) date of 01 May 2007 on 20 November 2007.

The Office of PCT Operations, National Stage will be notified of this decision for issuance of a corrected Form PCT/DO/EO/903 indicating a date of 01 May 2007 for the completion of all 35 U.S.C. 371 requirements.

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

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**PHILIPS INTELLECTUAL PROPERTY & STANDARDS**
**P.O. BOX 3001**
**BRIARCLIFF MANOR NY 10510**

MAILED

JUL 13 2009

OFFICE OF PETITIONS

In re Application of :
Godefridus Cornelis Goverde :
Application No. 11/572,584 : DECISION ON PETITION
Filed: January 24, 2007 :
Attorney Docket No. NL040829US1 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 15, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the nonfinal rejection mailed May 30, 2008, is accepted as having been unintentionally delayed.

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

This application is being referred to Technology Center AU 2875 for appropriate action by the Examiner in the normal course of business on the reply received May 15, 2009.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Christian Herzig | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7582700 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/01/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/572,616 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/24/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **418** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

15 MAY 2008

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BROUILLETTE & PARTNERS
METCALFE TOWER, 1550 METCALFE STREET
SUITE 800
MONTREAL QC H3A-1X6 CA CANADA

| | | |
|---|---|---|
| In re Application of | : | |
| LEBLANC | : | |
| Application No.: 11/572,627 | : | |
| PCT No.: PCT/CA05/00771 | : | DECISION ON PETITION |
| Int. Filing Date: 19 May 2005 | : | |
| Priority Date: 25 May 2004 | : | UNDER 37 CFR 1.137(b) |
| Atty. Docket No.: 09516-006 | : | |
| For: FLUSH VALVE LEAKAGE PREVENTION DEVICE | : | |

The petition to revive under 37 CFR 1.137(b) filed 24 January 2007 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 were satisfied with the filing of an executed declaration on 24 January 2007.

The application has an international filing date of 19 May 2005 under 35 U.S.C. 363 and will be given a date of **24 January 2007** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

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

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

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**Myers, Bigel, Sibley & Sajovec**
**P.O. Box 37428**
**Raleigh, NC 27627**

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APR 23 2008

OFFICE OF PETITIONS

In re Application of

Parag V. Karmarkar
Application No. 11/572,629
Filed: January 24, 2007
Attorney Docket No. 9450-3

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 February 19, 2008.

The request is **NOT APPROVED** because a revocation of power of attorney has been previously filed.

A review of the file record indicates that the power of attorney to and all attorneys/agents of record has been revoked by the assignee of the patent application on September 27, 2007. 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: Advanced Bionics Corporation
25129 Rye Canyon Road
Valencia, CA 91355

25 OCT 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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DR. MARK M. FRIEDMAN
C/O BILL POLKINGHORN - DISCOVERY DISPATCH
9003 FLORIN WAY
UPPER MARLBORO MD 20772

In re Application of
ROSENBLIT et al.
Application No.: 11/572,633
PCT No.: NONE
Deposit date: 25 January 2007
Attorney Docket No.: 1054/20
For: HIGH-QUALITY-FACTOR TUNABLE MICRODISK

DECISION ON RESPONSE

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

On 25 January 2007, applicant filed a request for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee. The papers were assigned serial number 11/572,633. However the international application **PCT/IL05/00785** as indicated on the electronic acknowledgement receipt differs from the PCT application number **PCT/IL05/00786** on the application data sheet and on the declaration submitted.

If applicant wishes that this application proceed, applicant must file a petition under 37 CFR 1.182 to correct the international application number.

A proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Such response should include a cover letter entitled "Petition Under 37 CFR 1.182."

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 PCT Legal Office.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

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30 NOV 2007

DR. MARK M. FRIEDMAN
C/O BILL POLKINGHORN - DISCOVERY DISPATCH
9003 FLORIN WAY
UPPER MARLBORO MD 20772

In re Application of
ROSENBLIT et al.
Application No.: 11/572,633
PCT No.: PCT/IL05/00786
International Filing Date: 24 July 2005
Priority Date: 26 July 2004
Attorney Docket No.: 1054/20
For: HIGH-QUALITY-FACTOR TUNABLE MICRODISK

DECISION ON RESPONSE

This is a decision on applicant's "Petition to Correct International Application Number" treated as a petition under 37 CFR 1.182 filed in the United States Patent and Trademark Office on 05 November 2007.

On 25 January 2007, applicant filed a request for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee. The papers were assigned serial number 11/572,633. However the international application **PCT/IL05/00785** as indicated on the electronic acknowledgement receipt differs from the PCT application number **PCT/IL05/00786** on the application data sheet and on the declaration submitted. On 25 October 2007, a communication was mailed to applicant advising him to file a petition under 37 CFR 1.182 to correct the international application number.

Applicant's petition under 37 CFR 1.182 to correct the international application no. to PCT/IL05/00786 on the national stage papers filed on 25 January 2007 is GRANTED. The $400 petition fee will be charged to applicant's deposit account per his authorization.

This application is being returned to the National Stage Processing Branch of the Office Of PCT Operations for processing in accord with this decision. The USPTO records will identify the present application as a national stage of PCT/IL05/00786.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/572,638 | 09/03/2008 | Yuzhuo Zhang | BOSSP0100US | 1973 |

23908 7590 08/03/2009

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

| EXAMINER | |
|---|---|
| MARTEN, JERROD B | |
| **ART UNIT** | **PAPER NUMBER** |
| 1797 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/03/2009 | 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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United States Patent and Trademark Office
P.O. Box 1450
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RENNER OTTO BOISSELLE & SKLAR, LLP
1621 EUCLID AVENUE
NINETEENTH FLOOR
CLEVELAND OH 44115

Applicant: Zhang et al.
Appl. No.: 11/572,638
Filing Date: September 3, 2008
Title: PROCESS FOR DIRECT COAL LIQUEFACTION
Attorney Docket No.: BOSSP0100US
Pub. No.: US 2009/0152171 A1
Pub. Date: June 18, 2009

This is a decision on the request for republication of patent application publication under 37 CFR 1.221(a), filed on July 31, 2009, for the above-identified application.

The request under 37 CFR 1.221(a) is DISMISSED.

37 CFR 1.221(a) requires "a copy of the application in compliance with the Office 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.

The applicant did not supply a copy of the application in compliance with the Office electronic filing system, as required by 37 CFR 1.221(a) because **the Applicant submitted the papers as a "Document for an existing application", which are entered into the application file, and not as a "Pre-Grant Publication" submission**. The request for republication does not comply with the electronic filing system requirements, thus republication will not take place.

Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system, as a Pre-Grant publication submission and must include a copy of the application in compliance with the Office electronic filing system requirements. The applicant is directed to the following website for additional instructions on how to submit a Pre-Grant Publication submission via the electronic filing system:

http://www.uspto.gov/ebc/portal/efs/pgpub_quickstart.pdf

Any questions or requests 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

Telephone inquiries regarding this correspondence should be directed to The Office of Data Management at 571-272-4200.

Office of Data Management
United States Patent & Trademark Office

Adjustment date: 08/04/2009 KKING1
07/31/2009 INTEFSW 00007949 11572638
01 FC:1504 -300.00 DP

Refund Ref:
08/04/2009 0030072880

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Credit Card Refund Total: $300.00

Am Exp..: XXXXXXXXXX5002

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22 JAN 2008

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

In re Application of: CIOTO, Rubens, et al.
U.S. Application No.: 11/572,644
PCT No.: PCT/BR2004/000185
International Filing Date: 24 September 2004
Priority Date: 18 June 2004
Atty Docket No.: 288/9-2352
For: SYSTEM AND METHOD FOR AUTOMATED EXECUTION OF BOLTED JOINTS

DECISION ON PETITION

The petition for revival under 37 CFR 1.137(b) filed 25 January 2007 in the above-captioned application is hereby **GRANTED** as follows:

The present application became abandoned at midnight on 18 December 2006 based on applicants' failure to enter the U.S. national stage and file the U.S. basic national fee prior to the expiration of thirty months from the priority date.

The present petition was accompanied by the petition fee and the "required reply" in the form of the U.S. national stage entry papers and payment of the U.S. basic national fee. In addition, 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 the requirement of 37 CFR 1.137(b)(3). Based on the above, the requirements of 37 CFR 1.137(b) have been satisfied. The request to revive the application is therefore granted with respect to the United States.

This application is being referred to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision. It is noted that applicants have not yet filed an oath or declaration in compliance with 37 CFR 1.497.

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

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30 NOV 2007

JONES DAY
222 EAST 41ST STREET
NEW YORK, NY 10017-6702

| | | |
|---|---|---|
| In re Application of GOGOLEWSKI | : | |
| U.S. Application No.: 11/572,648 | : | |
| PCT Application No.: PCT/CH2004/000471 | : | |
| Int. Filing Date: 26 July 2004 | : | DECISION |
| Priority Date Claimed: none | : | |
| Attorney Docket No.: 8932-1304-999 | : | |
| For: BIOCOMPATIBLE, BIODEGRADABLE POLYURETHANE MATERIALS . . . | : | |

This is in response to applicant's "Rule 1.47(a) Petition to File Application by Other Than All Inventors" filed 13 November 2007, which is being treated under 37 CFR 1.47(b).

## BACKGROUND

On 26 July 2004, applicant filed international application PCT/CH2004/000471. A copy of the international application was communicated to the USPTO from the International Bureau on 02 February 2006. The thirty-month period for paying the basic national fee in the United States expired on 26 January 2007.

On 25 January 2007, 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 05 June 2007, 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 November 2007, applicant filed the present petition under 37 CFR 1.47(b).

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached

after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

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

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

The petition states that the sole inventor Sylwester Gogolewski refuses to sign the application papers. The petition adequately establishes that a bona fide attempt was made to present a copy of the application papers to Gogolewski for signature (see Exhibit C). However, the petition does not sufficiently illustrate Gogolewski's refusal to sign. In particular, although Gogolewski purportedly made an express written refusal to cooperate (see Exhibits B and D), the petition does not include an affidavit from the person to whom the refusal was actually made. Thus, it would not be reasonable to conclude at the present time that Gogolewski refuses to join in the application.

With regard to item (3) above, the petition states the last known address of the nonsigning inventor.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has not been provided. Applicant is advised that that when an assignee files an application under 37 CFR 1.47(b), ownership of the application must be established. See MPEP 324. Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from

the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

The petition states that Synthes U.S.A. ("Synthes") is the owner of the present application. Therefore, petitioner must establish a chain of title from the inventor Gogolewski to Synthes. The petition includes a copy of an employment agreement between Gogolewski and AO Research Institute ("AO"), whereby inventions made by the employee during his period of employment which are directly related to business operations or which could be exploited by the business become property of AO (see Exhibit F, Art.8). However, petitioner has not furnished an affidavit from a person with firsthand knowledge of Gogolewski making the present invention during his employment with and in direct relation to the business operations of AO. Moreover, petitioner has not sufficiently demonstrated a transfer of ownership from AO to Synthes. Petitioner must supply a copy of an assignment or other official document establishing a transfer of the present invention from AO to Synthes. Exhibits G, H, and I appear to be company press releases and are not adequate evidence.

With regard to item (6) above, the petition contains an adequate statement with regard to the preservation of rights of the parties and/or the prevention of irreparable harm.

Applicant is advised that the notification of a change of correspondence address filed 17 October 2007 cannot be processed because it is not signed by a person who may change the correspondence address. See MPEP 601.03. Although a copy of this particular decision is being forwarded to the address set forth in the petition, applicant is advised that the Office will not undertake dual correspondence.

## CONCLUSION

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

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

cc: SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

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NEW YORK, NY 10017-6702

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|---|---|---|
| In re Application of GOGOLEWSKI | : | |
| U.S. Application No.: 11/572,648 | : | |
| PCT Application No.: PCT/CH2004/000471 | : | |
| Int. Filing Date: 26 July 2004 | : | DECISION |
| Priority Date Claimed: none | : | |
| Attorney Docket No.: 8932-1304-999 | : | |
| For: BIOCOMPATIBLE, BIODEGRADABLE POLYURETHANE MATERIALS . . . | : | |

This is in response to applicant's " Renewed Petition Under 37 CFR 1.47(b)" filed 25 January 2008.

## BACKGROUND

On 26 July 2004, applicant filed international application PCT/CH2004/000471. A copy of the international application was communicated to the USPTO from the International Bureau on 02 February 2006. The thirty-month period for paying the basic national fee in the United States expired on 26 January 2007.

On 25 January 2007, 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 05 June 2007, 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 November 2007, applicant a present petition under 37 CFR 1.47(b).

On 30 November 2007, this Office mailed a decision dismissing the 13 November 2007 petition.

On 25 January 2008, applicant filed the present renewed petition under 37 CFR 1.47(b).

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Petitioner has previously satisfied items (1), (3), and (6) above.

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

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

The petition states that the sole inventor Sylwester Gogolewski refuses to sign the application papers. The petition adequately establishes that a bona fide attempt was made to present a copy of the application papers to Gogolewski for signature (see Exhibit C). The petition also sufficiently illustrates Gogolewski's refusal to sign. In particular, Gogolewski made an express written refusal to cooperate (see Exhibits B and D; see also the affidavit of Regina Brun, the person to whom the refusal was actually made). Thus, it can be concluded with reasonable certainty that Gogolewski refuses to join in the application.

With regard to item (4) above, an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has not been provided.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

The petition states that Synthes U.S.A. ("Synthes") is the owner of the present application. Therefore, petitioner must establish a chain of title from the inventor Gogolewski to Synthes. The petition includes a copy of an employment agreement between Gogolewski and AO Research Institute ("AO"), whereby inventions made by the employee during his period of employment which are directly related to business operations or which could be exploited by the business become property of AO (see Exhibit F, Art.8). However, petitioner has not furnished an affidavit from a person with firsthand knowledge of Gogolewski making the present invention during his employment with and in direct relation to the business operations of AO. In particular, it is not clear from the affidavit of Troy Svihl that Mr. Svihl personally observed the making the present invention by Gogolewski. Petitioner has sufficiently demonstrated a transfer of ownership from AO to Synthes (see recorded assignment).

## CONCLUSION

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

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

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

JONES DAY
222 EAST 41ST STREET
NEW YORK, NY 10017-6702

| | | |
|---|---|---|
| In re Application of GOGOLEWSKI | : | |
| U.S. Application No.: 11/572,648 | : | |
| PCT Application No.: PCT/CH2004/000471 | : | |
| Int. Filing Date: 26 July 2004 | : | DECISION |
| Priority Date Claimed: none | : | |
| Attorney Docket No.: 8932-1304-999 | : | |
| For: BIOCOMPATIBLE, BIODEGRADABLE POLYURETHANE MATERIALS . . . | : | |

This is in response to applicant's "Renewed Petition Under 37 CFR 1.47(b)" filed 07 April 2008.

## BACKGROUND

On 26 July 2004, applicant filed international application PCT/CH2004/000471. A copy of the international application was communicated to the USPTO from the International Bureau on 02 February 2006. The thirty-month period for paying the basic national fee in the United States expired on 26 January 2007.

On 25 January 2007, 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 05 June 2007, 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 November 2007, applicant a present petition under 37 CFR 1.47(b).

On 30 November 2007, this Office mailed a decision dismissing the 13 November 2007 petition.

On 25 January 2008, applicant filed a renewed petition under 37 CFR 1.47(b).

On 08 February 2008, this Office mailed a decision dismissing the 25 January 2008 renewed petition.

On 07 April 2008, applicant filed the present second renewed petition under 37 CFR 1.47(b).

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Petitioner has previously satisfied items (1), (2), (3), and (6) above.

With regard to item (4) above, the declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor is improper. Specifically, the declaration is not executed by a person who either: (1) has apparent authority to sign on behalf of the 37 CFR 1.47(b) applicant or (2) has stated that he is authorized to act on behalf of the 37 CFR 1.47(b) applicant. Patent counsel is not a title that confers apparent authority. See MPEP 324, Section V. (A)-(B).

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

The petition states that Synthes U.S.A. ("Synthes") is the owner of the present application. Therefore, petitioner must establish a chain of title from the inventor Gogolewski to Synthes. The petition includes a copy of an employment agreement between Gogolewski and AO Research Institute ("AO"), whereby inventions made by the employee during his period of employment which are directly related to business operations or which could be exploited by the business become property of AO (see Exhibit F, Art.8). Furthermore, petitioner has furnished affidavits from people with firsthand knowledge of Gogolewski making the present invention during his employment with and in direct relation to the business operations of AO (see 26 March 2008 affidavit of Regina Brun, ¶3, and 26 March 2008 affidavit of Christoph Noetzli, ¶3.) Moreover petitioner has sufficiently demonstrated a transfer of ownership from AO to Synthes (see recorded assignment). Thus, petitioner has adequately established that Synthes has sufficient proprietary interest in the present application.

## CONCLUSION

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

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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0 6 JUN 2008

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JONES DAY
222 EAST 41ST STREET
NEW YORK, NY 10017-6702

In re Application of GOGOLEWSKI :
U.S. Application No.: 11/572,648 :
PCT Application No.: PCT/CH2004/000471 :
Int. Filing Date: 26 July 2004 : DECISION
Priority Date Claimed: none :
Attorney Docket No.: 8932-1304-999 :
For: BIOCOMPATIBLE, BIODEGRADABLE :
POLYURETHANE MATERIALS . . . :

This is in response to applicant's "Renewed Petition Under 37 CFR 1.47(b)" filed 19 May 2008.

## BACKGROUND

On 26 July 2004, applicant filed international application PCT/CH2004/000471. A copy of the international application was communicated to the USPTO from the International Bureau on 02 February 2006. The thirty-month period for paying the basic national fee in the United States expired on 26 January 2007.

On 25 January 2007, 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 05 June 2007, 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 November 2007, applicant a present petition under 37 CFR 1.47(b).

On 30 November 2007, this Office mailed a decision dismissing the 13 November 2007 petition.

On 25 January 2008, applicant filed a renewed petition under 37 CFR 1.47(b).

On 08 February 2008, this Office mailed a decision dismissing the 25 January 2008 renewed petition.

On 07 April 2008, applicant filed a second renewed petition under 37 CFR 1.47(b).

On 11 April 2008, this Office mailed a decision dismissing the 07 April 2008 renewed petition.

On 19 May 2008, applicant filed the present third renewed petition under 37 CFR 1.47(b).

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

Petitioner has previously satisfied items (1), (2), (3), (5), and (6) above.

With regard to item (4) above, the renewed petition sufficiently establishes that the declaration filed 07 April 2008 is executed by a person who is authorized to act on behalf of the 37 CFR 1.47(b) applicant.

## CONCLUSION

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

This application has an international filing date of 26 July 2004 and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 07 April 2008.

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

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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ALEXANDRIA, VA 22313-1450
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06 JUN 2008

Sylwester Gogolewski
Laerchenring 10
Davos Platz, Switzerland
CH-7270

In re Application of GOGOLEWSKI
U.S. Application No.: 11/572,648
PCT Application No.: PCT/CH2004/000471
Int. Filing Date: 26 July 2004
Priority Date Claimed: none
For: BIOCOMPATIBLE, BIODEGRADABLE POLYURETHANE MATERIALS . . .

Dear Sylwester Gogolewski:

You are named as the inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(b) and 35 U.S.C. 118. Should a patent be granted, you will be designated as the inventor.

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

Bryan Lin

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

JONES DAY
222 EAST 41ST STREET
NEW YORK, NY 10017-6702
Attorney Docket No.: 8932-1304-999

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P.O. Box 1450
Alexandria, VA 22313-1450
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26 JUN 2007

Katherine M. Kowalchyk
Merchant & Gould
P.O. Box 2903
Minneapolis, MN 55402-0903

In re Application of :
KHAN, et al. :
Application No.: 11/572,667 :
PCT No.: PCT/US05/27660 : DECISION ON PETITION
Int. Filing Date: 03 August 2005 :
Priority Date: 03 August 2004 : UNDER 37 CFR 1.137(b)
Atty. Docket No.: 11613.0067USWO :
For: PREDICTION OF CLINICAL OUTCOME USING : GENE EXPRESSION PROFILING AND : ARTIFICIAL NEURAL NETWORKS FOR : PATIENTS WITH NEUROBLASTOMA :

The petition to revive under 37 CFR 1.137(b) filed 25 June 2007 in the above-captioned application is hereby **GRANTED** as follows:

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

A review of the application file reveals that applicant has now provided payment of the full, U.S. Basic National Fee. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being 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 the $130.00 surcharge for providing an executed oath or declaration later than thirty months from the priority date is required.

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

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2 8 APR 2008

GE HEALTHCARE INC.
IP DEPARTMENT
101 CARNEGIE CENTER
PRINCETON NJ 08540-5231

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| THANING, Mikkel et al. | : | |
| Application No.: 11/572,671 | : | |
| PCT No.: PCT/NO2005/000281 | : | |
| Int. Filing Date: 28 July 2005 | : | PETITION |
| Priority Date: 30 July 2004 | : | |
| Attorney's Docket No.: PN0442 | : | |
| For: METHOD OF PRODUCING ... ITS USE | : | UNDER 37 CFR 1.182 |

This decision is in response to the "PETITION UNDER CFR 1.182" filed on 08 April 2008, to accept entry of the above identified application into the national stage with the corrected PCT number of PCT/NO2005/00281. Petitioner has been charged the petition fee of $400.00 to the Deposit Account No.: 502-665.

## BACKGROUND

On 25 January 2007, applicant filed this national stage application using the EFS-Web electronic filing system. However, the incorrect PCT number was submitted at the time of filing.

On 08 April 2008, petitioner filed a petition under 37 CRF 1.182 stating that at the time of electronically filing the national stage application, the applicant identified aforementioned application as a national stage of PCT/NO2005/000282 rather than the correct international application number of PCT/NO2005/000281.

## DISCUSSION

Petitioner states that the PCT number was mistakenly entered as PCT/NO2005/000282 rather than the correct number PCT/NO2005/000281.

Although applicants entered the incorrect PCT serial number at the time of electronically filing the application, the correct PCT number PCT/NO2005/000281 was placed in the transmittal letter, and in the executed declaration. Accordingly, there is sufficient evidence that the correct international application PCT number is PCT/NO2005/000281.

Therefore, petition to accept the correct PCT number of PCT/NO2005/000281 for the instant application is granted, and will be reflected in the filing receipt.

## DECISION

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

07 JUL 2008

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GE HEALTHCARE, INC.
IP DEPARTMENT
101 CARNEGIE CENTER
PRINCETON NJ 08540-6231

In re Application of:
THANING, Mikkel, et al.
U.S. Application No.: 11/572,679
PCT No.: PCT/NO2005/000282
International Filing Date: 28 July 2005
Priority Date: 30 July 2004
Attorney's Docket No.: PN0443
For: METHOD OF TUMOUR IMAGING

DECISION

This decision is issued in response to the "Petition Under 37 CFR 1.182" filed 08 April 2008. Applicants have submitted the required petition fee.

## BACKGROUND

The procedural background for the present application was set forth in the Communication mailed herein on 31 March 2008. The Communication identified an inconsistency between the international application number entered during the electronic filing process (PCT/NO2005/000281) and the international application number referenced in the documents filed by applicants (PCT/NO2005/000282).

On 08 April 2008, applicants filed the "Petition Under 37 CFR 1.182" considered herein to correct the error in the international application number identified during the electronic filing of the present national stage application.

## DISCUSSION

In the present petition, applicants confirm that the identification of international application PCT/NO2005/000281 during the electronic filing process was the result of a mistake and that the correct international application herein is PCT/NO2005/000282. The petition notes that the correct international application number was indicated on the papers filed by applicants when initiating the present national stage application, including the Form PTO-1390 Transmittal Letter and the declaration. Applicants have also provided the required petition fee.

The present submission satisfies the requirements for a grantable petition to correct the inadvertent error in the international application number identified during the electronic filing

process. Accordingly, the materials filed herein on 25 January 2007 will be treated as having been directed to international application PCT/NO2005/000282.

It is noted that the declaration filed on 25 January 2007 is acceptable under 37 CFR 1.497 with respect to international application PCT/NO2005/000282.

## CONCLUSION

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

The materials filed herein on 25 January 2007 will be treated as the U.S. national stage of PCT/NO2005/000282.

The 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 25 January 2007.

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

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SNELL & WILMER L.L.P. (Panasonic)
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA, CA 92626

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Hiroyuki Morishita | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7606996 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/20/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/572,701 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/18/2008 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **99** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

01 FEB 2007

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Steven J. Hultquist
Intellectual Property/Technology Law
P.O. Box 14329
Research Triangle Park, NC 27709

In re Application of
ALONSO, et al.
Application No.: 11/572,707
PCT No.: PCT/ES05/00374
Int. Filing Date: 20 June 2005
Priority Date: 25 June 2004
Atty. Docket No.: 4258-129
For: SYNTHESIS OF POLYOXYGENATED NITROGEN SYSTEMS, COMPRISING REACTIONS BETWEEN ENAMINES OF 1,3-DIOXAN-5-ONES AND NITROOLEFINS

DECISION ON PETITION

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 25 January 2007 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 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. It is noted that applicant filed a second paper on 26 January 2007 purporting to provide payment of the petition fee by credit card. No such payment was included; however, a review of the transmittal letter filed on 25 January 2007 shows authorization to charge all necessary fees to deposit account 08-3284. Therefore, the $750.00 petition fee will be charged to the deposit account.

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.

02/01/2007 SBASHEIR 00000002 083284 11572707
01 FC:2453 750.00 DA

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

15 SEP 2008

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

| | | |
|---|---|---|
| In re Application of | : | |
| NUNO, Katsuhiko et al. | : | |
| Application No.: 11/572,750 | : | DECISION ON |
| PCT No.: PCT/JP2005/013989 | : | |
| Int. Filing Date: 25 July 2005 | : | PETITION |
| Priority Date: 26 July 2004 | : | |
| Attorney Docket No.: 300914US28PCT | : | UNDER 37 CFR 1.181 |
| For: LENS BARREL, CAMERA AND MOBILE INFORMATION TERMINAL | : | |

This decision is in response to applicant's Petition Under 37 CFR 1.181 to vacate the Notification of Missing Requirements, filed in the United States Patent and Trademark Office on 16 September 2008.

## BACKGROUND

On 26 January 2007, applicants filed a transmittal letter for entry into the national phase in the United States, accompanied by the basic national fee.

On 16 May 2008, the Office mailed Notification of Missing Requirements (PCT/DO/EO/905), indicating *inter alia* that the translation was defective and that a new translation of pages 89 and 90 and the surcharge for late submission of the translation were required.

On 16 July 2008, applicants filed this petition to vacate the Notification of Missing Requirements, accompanied by pages 89 and 90 of the description complete with the formerly missing words.

## DISCUSSION

Applicant correctly indicates that the application was both filed and published in English. The requirement for a new "translation" and the surcharge issued in error. The missing text is missing in the publication.

It does not appear that the Notification of Acceptance mailed 06 July 2007 was vacated.

## CONCLUSION

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

The Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 16 May 2008 is **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office of Patent Application Processing 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 26 January 2007.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

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Alexandria, VA 22313-1450
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11 SEP 2007

WARNER-LAMBERT COMPANY
2800 PLYMOUTH RD
ANN ARBOR MI 48105

| | | |
|---|---|---|
| In re Application of | : | |
| BARVIAN, Nicole Chantel et al. | : | |
| Application No.: 11/572,760 | : | DECISION |
| PCT No.: PCT/IB2005/002690 | : | |
| Int. Filing Date: 08 August 2005 | : | ON REQUEST UNDER |
| Priority Date: 18 August 2004 | : | |
| Attorney's Docket No.: PC32466 | : | 37 CFR 1.497(d) |
| For: ANDROGEN MODULATORS | : | |

This decision is in response to applicants' petition to correct the inventorship in the above captioned application, filed in the United States Patent and Trademark Office on 09 March 2007. It has been treated as a request under 37 CFR 1.497(d).

## BACKGROUND

On 08 August 2005, applicants filed international application PCT/IB2005/002690, which claimed a priority date of 18 August 2004. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 23 February 2006. The deadline for payment of the basic national fee in the United States was midnight on 18 February 2007.

On 26 January 2007, applicants filed a submission for entry into the national stage in the United States, accompanied by, *inter alia*, the U.S. Basic National Fee.

On 09 March 2007, applicants filed the instant request.

On 11 May 2007, applicants submitted a declaration of the inventors.

## DISCUSSION

Applicants file this request to add Lorna Helen Mitchell 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.

Item (2) has been satisfied. The processing fee set forth in §1.17(i) has been paid.

Item (1) has not been satisfied. Applicants have not provided a statement from the inventor being added that her omission occurred without deceptive intention on her part.

Item (3) has not been satisfied. Applicants indicate that the originally named inventors assigned their rights in this application, but this petition is not accompanied by the consent of the assignee.

The declaration of the inventors is composed of three pages. The first lists 4 inventors and indicates that one additional page lists additional inventors. The second page also lists 4 inventors without an indication of additional pages. The third page lists 1 inventor.

Inventors are required to execute an oath or declaration listing all inventors and their citizenships. If each inventor was presented with a complete copy of the declaration listing all of the inventors and their citizenships, a statement to such effect should be furnished. If the inventors were not presented with a complete copy of the declaration listing all of the inventors and their citizenships, then a new oath or declaration is required.

## 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)". Extensions of time are available.

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

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

2 3 SEP 2008

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PFIZER INC.
PATENT DEPARTMENT, MS8260-1611
GROTON CT 06340

| | | |
|---|---|---|
| In re Application of | : | |
| BARVIAN, Nicole Chantel et al. | : | |
| Application No.: 11/572,760 | : | DECISION |
| PCT No.: PCT/IB2005/002690 | : | |
| Int. Filing Date: 08 August 2005 | : | ON REQUEST UNDER |
| Priority Date: 18 August 2004 | : | |
| Attorney's Docket No.: PC32466A | : | 37 CFR 1.497(d) |
| For: ANDROGEN MODULATORS | : | |

This decision is in response to applicants' renewed request under 37 CFR 1.497(d), filed in the United States Patent and Trademark Office on 05 March 2008.

## BACKGROUND

On 11 September 2007, the Office mailed Decision On Request Under 37 CFR 1.497(d), refusing applicants' request and setting a two month period for reply.

On 05 March 2008, applicants filed this renewed request, accompanied by the fee for a four month extension of time.

## 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 intention on his or her part; (2) the processing fee set forth in §1.17(i); and (3) the written consent of the assignee, if an original named inventor has executed an assignment.

Items (1), (2) and (3) have been satisfied. Applicants provided a statement by Lorna Helen Mitchell, the processing fee and the written consent of the assignee in compliance with 37 CFR 3.73 has been furnished.

## CONCLUSION

For the above reasons, applicant's request under 37 CFR 1.497(d) is **GRANTED**.

This application is being referred to the National Phase Processing Branch of the Office of Patent Application Processing for further action consistent with this decision. The application has a 35 USC 371(c)(1), (c)(2) and (c)(4) date of 05 March 2008.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

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17 DEC 2007

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON VA 20191

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| FELLOUHE et al | : | |
| PCT No.: PCT/FR2005/001971 | : | |
| Application No.: 11/572,771 | : | |
| Int. Filing Date: 28 July 2005 | : | PAPERS FILED |
| Priority Date: 29 July 2004 | : | |
| Attorney's Docket No.: | : | |
| For: LAMINATED FABRIC PANELS AND METHOD | : | |
| OF ASSEMBLING SAME | : | UNDER 37 CFR 1.42 |

This is a decision on the declaration filed 27 November 2007, which has been treated as a request for status under 37 CFR 1.42.

## BACKGROUND

On 26 January 2007, 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). No executed declaration or oath was submitted at that time.

On 27 November 2007, applicants submitted an executed declaration, which is signed by Eddy FELLOUHE as legal representatives for the deceased joint inventor, Catherine FELLOUHE .

## DISCUSSION

A review of the application file reveals that the declaration does not comply with 37 C.F.R. §1.497(b)(2).

Because the inventor Catherine FELLOUHE is deceased and Eddy FELLOUHE has been appointed as legal representatives for the deceased inventor, 37 C.F.R. §1.497(b)(2) indicates that "[i]f the person making the oath or the declaration or any supplemental or oath or declaration is not the inventor (§§1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state (the inventors citizenship and so on). If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative." (see MPEP § 409.01)

In this instance, it is unclear if the information provided below the signature of Mr. FELLOUGHE is for the legal representative or for the deceased inventor. The citizenship, residence and mailing address of the legal representative and the deceased inventor needs to be provided as required under 37 C.F.R. §1.497(b)(2). Also, the Declaration must indicate that Mr. FELLOUGHE is the legal representative.

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

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29 APR 2008

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON VA 20191

| | | |
|---|---|---|
| In re Application of | : | DECISION ON RENEWED |
| FELLOUGHE et al | : | |
| PCT No.: PCT/FR2005/001971 | : | |
| Application No.: 11/572,771 | : | |
| Int. Filing Date: 28 July 2005 | : | PAPERS FILED |
| Priority Date: 29 July 2004 | : | |
| Attorney's Docket No.: | : | |
| For: LAMINATED FABRIC PANELS AND METHOD | : | |
| OF ASSEMBLING SAME | : | UNDER 37 CFR 1.42 |

This is a decision on the "SUBMISSION OF SUPPLEMENTAL... FILED ON NOVEMBER 27, 2007," filed on 14 February 2008, which is being treated as a request under 37 CFR 1.42.

## BACKGROUND

In a decision from this office dated 17 December 2007, the papers filed on 27 November 2007 were not accepted under 37 CFR 1.42.

On 14 February 2008, applicants submitted the renewed submission under 37 C.F.R. §1.42.

## DISCUSSION

Applicants have provided a supplemental executed declaration, which sets forth the citizenship and residence of both the legal representative, Eddy Fellouche, and of the deceased inventor Catherine Fellouche.

Accordingly, the requirements under 37 CFR 1.42 are satisfied and the declaration is acceptable at this time.

## CONCLUSION

The renewed submission filed under 37 CFR 1.42 is **ACCEPTED**.

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision. The 35 U.S.C.§ 371(c)(1), (c)(2), and (c)(4) date of this application as **14 February 2008**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3276
Fax: (571) 273-0459

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United States Patent and Trademark Office
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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

COPY MAILED
DEC 2 4 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Yatagai et al. | : | |
| Application No. 11/572,803 | : | DECISION ON PETITION |
| Filed: February 6, 2007 | : | TO WITHDRAW |
| Attorney Docket No. MITPA15.001APC | : | 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 11, 2008.

The request is **MOOT**.

A review of the file record indicates that the power of attorney to KNOBBE MARTENS OLSON & BEAR LLP has been revoked by the assignee of the patent application on July 27, 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 correspondence address of record until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-4914.

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

PTO/SB/83 (01-06)
Approved for use through 12/31/2008. OMB 0651-0035
U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR WITHDRAWAL AS ATTORNEY OR AGENT AND CHANGE OF CORRESPONDENCE ADDRESS

| | |
|---|---|
| Application Number | 11/572,803 |
| Filing Date | 02/06/2007 |
| First Named Inventor | Toyohiko YATAGAI |
| Art Unit | 2877 |
| Examiner Name | Unknown |
| Attorney Docket Number | MITPA15.001APC |

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

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

☐ all the attorneys/agents of record.

☐ the attorneys/agents (with registration numbers) listed on the attached paper(s), or

☒ the attorneys/agents associated with Customer Number 20,995

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

The reasons for this request are: The client has requested to transfer this file to the below Customer No. A Revocation and Power of Attorney will be subsequently submitted by the new attorneys.

## CORRESPONDENCE ADDRESS

1. ☐ The correspondence address is NOT affected by this withdrawal.
2. ☒ Change the correspondence address and direct all future correspondence to:

☒ The address associated with Customer Number: 76,993

*OR*

| | | | |
|---|---|---|---|
| ☐ Firm or Individual Name | | | |
| Address | | | |
| City | | State | Zip |
| Country | | | |
| Telephone | | Email | |

| | | | |
|---|---|---|---|
| Signature | Daniel Altman | | |
| Name | Daniel E. Altman | Registration No. | 34,115 |
| Date | March 11, 2008 | Telephone No. | 949-760-0404 |

*NOTE: Withdrawal is effective when approved rather than when received. Unless there are at least 30 days between approval of withdrawal and the expiration date of a time period for response or possible extension period, the request to withdraw is normally disapproved.*

This collection of information is required by 37 CFR 1.36. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

19 NOV 2007

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Oyen, Wiggs, Green & Mutala LLP
480 - The Station, 601 West Cordova Street
Vancouver, British Columbia V6B 1G1
CANADA

In re Application of :
WHITEHEAD, Lorne :
Application No.: 11/572,812 :
PCT No.: PCT/CA05/01111 : DECISION
Int. Filing Date: 15 July 205 :
Priority Date: 27 July 2004 :
Attorney Docket No.: B634 0083/GNM :
For: DIFFUSER FOR LIGHT FROM LIGHT SOURCE ARRAY AND DISPLAYS INCORPORATING SAME :

This decision is issued in response to applicant's "Petition (under 37 CFR 1.181)" filed in the United States Patent and Trademark Office (USPTO) on 09 November 2007, which is being treated as request to vacate the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed 24 October 2007. No petition fee is due.

On 26 January 2007, applicant timely filed a request to enter into the national stage under 35 U.S.C. 371 along with, among other things, the appropriate basic national filing fee; a copy of the international application; and a preliminary amendment. The international application furnished by the International Bureau included an executed Declaration of Inventorship under PCT Rules 4.17(iv) and 51bis.1(a)(iv).

On 24 October 2007, the United Stated Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 09 November 2007, applicant filed the present petition which included a copy of a Declaration of Inventorship under PCT Rules 4.17(iv) and 51bis.1(a)(iv) filed during the international phase.

A review of the application reveals that the Declaration of Inventorship under PCT Rules 4.17(iv) and 51bis.1(a)(iv) for the purposes of the designation of the United States of America has been forwarded by the International Bureau. The declaration of inventorship filed with international application under PCT Rule 4.17(iv) and 51bis.1(a)(iv) complies

with 37 CFR 1.497, therefore, the Notification of Missing Requirements (Form PCT/DO/EO/905) dated 24 October 2007 is **VACATED** and the petition under 37 CFR 1.181 is **GRANTED**.

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

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

19 MAR 2008

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SYNNESTVEDT LECHNER & WOODBRIDGE LLP
PO BOX 592
112 NASSAU STREET
PRINCETON NJ 08542-0592

In re Application of :
FLOM, Michael et al. :
U.S. Application No.: 11/572,820 :
PCT No.: PCT/US2005/027362. :
Int. Filing Date: 29 July 2005 :
Priority Date: 29 July 2004 :
Attorney Docket No.: 5718-102US : **DECISION**
For: SYSTEM AND METHOD FOR CREATING DISTRIBUTED APPLICATIONS UTILIZING PORTABLE DEVICES AND PHYSICAL LOCATION OF THE PORTABLE DEVICE :

This is a decision on Request for Refund, filed in the United States Patent and Trademark Office on 16 August 2007.

## BACKGROUND

On 29 January 2007, applicants filed papers for entry into the national stage of PCT/US2005/027362, which included the payment of other than small entity fees of $600 for a national stage application.

On 16 August 2007, applicants filed this request for the refund of $300.

## DISCUSSION

In the papers filed 16 August 2007, applicants requested a refund of the $300 paid in 29 January 2007. 37 CFR 1.28 (a) states:

> (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.

The refund request has a receipt date of 16 August 2007, long past 29 April 2007, the expiration of the three-month time period for requesting a refund.

## CONCLUSION

For the above reason, applicants' request for a refund pursuant to 37 CFR 1.28(a) is **DISMISSED** without prejudice.

Any request for reconsideration of this matter should be filed within **TWO (2) MONTHS** of the mail date of this decision.

Further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed, 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

Phone: (571) 272-3292
Fax: (571) 273-0459

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SYNNESTVEDT LECHNER & WOODBRIDGE LLP
PO BOX 592
112 NASSAU STREET
PRINCETON NJ 08542-0592

In re Application of :
FLOM, Michael et al. :
U.S. Application No.: 11/572,820 :
PCT No.: PCT/US2005/027362 :
Int. Filing Date: 29 July 2005 :
Priority Date: 29 July 2004 :
Attorney Docket No.: 5718-102US : **DECISION**
For: SYSTEM AND METHOD FOR CREATING DISTRIBUTED APPLICATIONS UTILIZING PORTABLE DEVICES AND PHYSICAL LOCATION OF THE PORTABLE DEVICE :

This is a decision on Request for Refund, filed in the United States Patent and Trademark Office on 02 April 2008.

## BACKGROUND

On 19 March 2008, the Office mailed Decision, dismissing applicant's request for a refund.

On 02 April 2008, applicant filed this renewed request for a refund of erroneously paid fees.

## DISCUSSION

On 29 January 2007, applicant filed large entity fees for entry into the national phase. However, the application data sheet accompanying the filing indicated that the applicant was entitled to small entity status. On 16 August 2007, applicant requested a refund of the overpayment of the large entity filing fee rather than the small, but did not clearly state that small entity status had been claimed at filing. Rather, applicant provided a verified statement of claiming small entity status. On 02 April 2008, applicant clearly stated that small entity status was asserted at filing with the application data sheet and requested a refund of the additional $300 paid. As status was properly claimed at filing, this request is being processed under 37 CFR 1.26, rather than 37 CFR 1.28.

Applicant has requested a refund of the surplus money paid, within two years of the payment. The $300 will be refunded.

## CONCLUSION

For the above reason, applicants' request for a refund pursuant to 37 CFR 1.26 is **GRANTED**.

This application is being referred to the National Phase Processing Branch of the Office of Patent Application Processing for further action consistent with this decision.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Phone: (571) 272-3292
Fax: (571) 273-0459

28 MAR 2008

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SYNNESTVEDT & LECHNER, LLP
1101 MARKET STREET
26TH FLOOR
PHILADELPHIA, PA 19107-2950

| | | |
|---|---|---|
| In re Application of MOODLEY | : | |
| U.S. Application No.: 11/572,838 | : | |
| PCT Application No.: PCT/EP2005/008310 | : | |
| Int. Filing Date: 01 August 2005 | : | |
| Priority Date Claimed: 30 July 2004 | : | DECISION |
| Attorney Docket No.: P30003-A USA | : | |
| For: IMPROVED PROCESS AND MACHINE FOR AUTOMATED MANUFACTURE OF GASTRO-RETENTIVE DEVICES | : | |

This is in response to applicant's "Petition Under 37 C.F.R. §1.182 to Correct Application 11/572,838 and Expunge Application 11/572,853 from PTO Database" filed 11 March 2008.

## BACKGROUND

On 01 August 2005, applicant filed international application PCT/EP2005/008310, which claimed priority of an earlier United States application filed 30 July 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 02 February 2006. The thirty-month period for paying the basic national fee in the United States expired on 30 January 2007.

On 29 January 2007, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US) via the EFS-Web electronic filing system of the USPTO. The basic national fee required by 35 U.S.C. 371(c)(1) has been provided.

On 11 March 2008, applicant filed the present petition under 37 CFR 1.182.

## DISCUSSION

The petition states that when filing the national stage papers, applicant incorrectly entered the international application number into the EFS-Web system. This submission was assigned U.S. Application Number 11/572,838. The petition further states that a second set of national

stage papers was filed using the correct international application number. This submission was assigned U.S. Application Number 11/572,853.

The end result of an international application is a single national stage application. Therefore, the submission of the second set of national stage papers was improper. Accordingly, the serialization of U.S. Application Number 11/572,853 will be vacated.

A review of the initial national stage submission reveals that the proper international application number was identified on, *inter alia*, the application data sheet. Applicant's explanation for the error is accepted.

## CONCLUSION

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

The serialization of U.S. Application Number 11/572,853 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 01 August 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 29 January 2007.

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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17 SEP 2008

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Alexandria, VA 22313-1450
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MICHAEL BEST & FRIEDRICH LLP
100 E WISCONSIN AVENUE
Suite 3300
MILWAUKEE WI 53202

In re Application of:
WEST, Simon, Michael, et al.
U.S. Application No.: 11/572,864
PCT No.: PCT/AU2005/001159
International Filing Date: 03 August 2005
Priority Date: 03 August 2004
Atty Docket No.: 024944-9016-00
For: CARRIER FOR ENTERAL ADMINISTRATION

DECISION ON PETITION

The petition for revival under 37 CFR 1.137(b) filed 21 August 2008 in the above-captioned application is hereby **GRANTED** as follows:

The present application became abandoned with respect to the United States at midnight on 03 February 2008 based on applicants' failure to file a timely and proper response to the Notification Of Missing Requirements (Form PCT/DO/EO/905) mailed 03 December 2007.

The present petition for revival was accompanied by payment of the small entity petition fee. The petition also included the "required reply" in the form of a proper response to the Notification Of Missing Requirements (Form PCT/DO/EO/905) mailed 03 December 2007, that is, an executed declaration in compliance with 37 CFR 1.497, and the authorization to charge Deposit Account No. 13-3080 the required $65 surcharge for filing the declaration later than thirty months after the priority date. In addition, 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 the requirement of 37 CFR 1.137(b)(3). Based on the above, the requirements of 37 CFR 1.137(b) have been satisfied. Accordingly, the request to revive the present national stage application is appropriately granted.

This application is being referred 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 21 August 2008.

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

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

| | | |
|---|---|---|
| In re Application of: MORI, Katsuhiko, et al. | : | |
| U.S. Application No.: 11/572,884 | : | |
| PCT No.: PCT/JP2005/014135 | : | DECISION |
| International Filing Date: 27 July 2005 | : | |
| Priority Date: 30 July 2004 | : | |
| Atty Docket No.: 00862.119220 | : | |
| For: IMAGE PROCESSING APPARATUS AND METHOD, IMAGE SENSING APPARATUS, AND PROGRAM | : | |

This communication is issued in response to the correspondence entitled "Application Given Two Application Numbers: Request For Clarification Re Application Number" filed 15 May 2007, treated herein as a petition under 37 CFR 1.181. No petition fee is required.

## BACKGROUND

On 27 July 2005, applicants filed international application PCT/JP2005/014135. The application claimed a priority date of 30 July 2004, and it designated the United States. On 02 February 2006, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for filing the basic national fee was thirty months from the priority date, i.e., 30 January 2007.

On 29 January 2007, applicants filed via the EFS-Web system materials requesting entry into the U.S. national stage for PCT/JP2005/014135, including, among other materials, payment of the U.S. basic national fee. The Electronic Acknowledgement Receipt generated with respect to this filing indicates that the submission was assigned U.S. application number 11/572,884.

On 31 January 2007, applicants filed via the EFS-Web system an Information Disclosure Sheet (IDS), accompanied by copies of eleven references. The Electronic Acknowledgement Receipt identifies the international application number for the submission as PCT/US03/14135 and indicates that the materials were assigned to U.S. application number 11/572,997.

On 15 May 2007, applicants filed the correspondence considered herein as a petition under 37 CFR 1.181, accompanied by copies of the IDS and references previously filed on 31 January 2007. The petition requests clarification as to the proper U.S. application number for use herein and consolidation of the two application files.

## DISCUSSION

A review of the application file confirms that U.S. application number 11/572,884 is the U.S. national stage of international application PCT/JP2005/014135.

As noted by applicants, the Electronic Acknowledgement Receipt for applicants' 31 January 2007 submission identifies a separate U.S. application number and international application number (as well as a different confirmation number). The information in the Electronic Acknowledgement Receipt is generated based on the information entered by applicant during the electronic filing procedure. Thus, it would appear that there was a data entry error made by applicant during the 31 January 2007 filing, and that this data entry error resulted in the submission being treated as the filing of a separate U.S. national stage application.

The present petition, and a review of the materials filed 31 January 2007, makes clear that applicants' 31 January 2007 filing was not intended as a separate U.S. national stage application. Accordingly, U.S. application number 11/572,997, which was established as a separate national stage application in response to such filing and contains only the IDS and related materials filed by applicants on 31 January 2007, will be discontinued.

The present petition states that the IDS and references included with the present correspondence are copies of the materials filed 31 January 2007. Accordingly, the present application file (11/572,884) now contains copies of the materials contained in discontinued application file 11/572,997. Consolidation of these application files is therefore unnecessary.

## CONCLUSION

Applicants' petition under 37 CFR 1.181 is **GRANTED** to the extent that U.S. application number 11/572,884 is confirmed to be the U.S. national stage of international application PCT/JP2005/014135, and U.S. application number 11/572,997, established in response to applicants' 31 January 2007 filing, will be discontinued.

All further correspondence with respect to the U.S. national stage of PCT/JP2005/014135 should be directed to U.S. application number 11/572,884.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 29 January 2007.

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

19 JUN 2008

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WOODLING, KROST AND RUST
9213 CHILLICOTHE ROAD
KIRTLAND OH 44094

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| In re Application of | : | |
| Probst et al. | : | |
| Application No.: 11/572,906 | : | DECISION |
| PCT No.: PCT/EP2004/008757 | : | |
| Int. Filing Date: 05 August 2004 | : | ON |
| Priority Date: 05 August 2004 | : | |
| Attorney Docket No.: 8391.CUST.NO.67886 | : | PETITION |
| For: Method For Inspecting Surfaces | : | |

This is in response to the petition under 37 CFR 1.47(b) filed on 18 April 2008.

## BACKGROUND

This international application was filed on 05 August 2004, claimed no earlier priority date, and designated the U.S. The International Bureau communicated a copy of the published international application to the USPTO on 09 February 2006. The 30 month time period for paying the basic national fee in the United States expired at midnight on 05 February 2007. Applicants filed *inter alia* the basic national fee on 29 January 2007.

On 18 October 2007, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration.

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known addresses of the inventors, (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.

Regarding requirement (1), the petition fee has been paid.

Regarding requirement (2), petitioner presents a "Declaration of Kenneth L. Mitchell" (and attachments) which indicates that both of the non-signing inventors "expressly and orally indicated that they would not execute the Declaration or Assignment..." during telephone conversations on 11 April 2008. However, it is not clear whether these alleged refusals occurred after the inventors were presented with complete copies of the application papers. Rather, the evidence presented shows only that copies of the application papers were sent to them on 14 April 2008, three days after the alleged refusal. Under the policy explained at MPEP 409.93(d), refusal to execute the declaration prior to presentation of a copy of the application papers, without an adequate showing that "the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers," is not sufficient.

Regarding requirement (3), the petition includes a statement the last known addresses of both of the non-signing inventors. Accordingly, requirement (3) has been satisfied.

Concerning requirement (4), the instant renewed petition is accompanied by a declaration document signed by Antoon De Proft in the capacity of CEO of ICOS VISION SYSTEMS N.V. However, the declaration is defective because it does not indicate the citizenship of either of the inventors.

Regarding requirement (5), petitioner's attention is respectfully directed to MPEP 409.03(f), which provides in part that

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that

(A) the invention has been assigned to the applicant, or
(B) the inventor has agreed in writing to assign the invention to the applicant, or
(C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324). An assignment of an application and any "reissue, division, or continuation of said application" does not itself establish an assignment of a continuation-in-part application. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956). An assignment to a 37 CFR 1.47(b) applicant for the sole purpose of obtaining a filing date for a 37 CFR 1.47(b) application is not considered an assignment within the meaning of 35 U.S.C. 118 and 37 CFR 1.47(b).

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by a statement of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter. A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant

should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

Petitioner presents a "Legal Memorandum of Uwe R. Borchert, European Patent Attorney," along with a "Declaration of Uwe R. Borchert." Atty. Borchert indicates that he is "a partner with [a] European Patent firm," though he does not explicitly state that he is familiar with German or Belgian property law *per se*, as opposed to practice before the EPO. Atty. Borchert indicates that in his opinion, a German or Belgian court would, "upon the fair payment of compensation to the inventors," reward ownership to ICOS, but he does not address the issue of whether such a court would award ownership to ICOS if this condition precedent were not satisfied (i.e., the issue of where ownership lies if compensation is not paid). It is also noted that Atty. Borchert has neither cited applicable legal authority (e.g., specific statutory or code section(s)) nor provided copies of same. Also, he has not addressed the issue of choice of law between German and Belgian law, nor German versus Belgian jurisdiction. As such, it would not be appropriate to conclude that requirement (5) has been satisfied at this time.

Regarding requirement (6), the petition includes an appropriate showing that according the application status under 37 CFR 1.47(b) is necessary to preserve the rights of the parties or to prevent irreparable damage.

## DECISION

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). Failure to timely file a proper response will result in **ABANDONMENT**.

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

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

United States Patent and Trademark Office

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| Int. Filing Date: 05 August 2004 | : | ON |
| Priority Date: 05 August 2004 | : | |
| Attorney Docket No.: 8391.CUST.NO.67886 | : | PETITION |
| For: Method For Inspecting Surfaces | : | |

This is in response to the petition under 37 CFR 1.47(a) filed on 19 November 2008, as well as the correspondence filed on 18 September 2008.

## DISCUSSION

On 19 June 2008, a Decision was mailed to applicants, dismissing without prejudice a petition under 37 CFR 1.47(b) filed on 18 April 2008. On 18 September 2008, applicants filed a declaration of inventorship signed by one of the joint inventors, Achim Schwarz. Following the policy described at MPEP 409.03(b)("Where 37 CFR 1.47(a) is available, application cannot be made under 37 CFR 1.47(b)"), the instant renewed petition is being treated 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.

Regarding **requirement (1)**, the $200.00 petition fee has been paid.

Regarding **requirement (2)**, petitioner presents evidence, including a "Declaration of Kenneth L. Mitchell" dated 19 November 2008, which tends to show that Mr. Probst has refused to execute the combined declaration and power of attorney after being presented with it and a complete copy of the application papers. However, the petition includes a statement (p. 7) that the "undersigned advised Mr. Probst that he was entitled to independent legal representation..." Similarly, the "Declaration of Kenneth L. Mitchell" dated 19 November 2008 indicates in part (in para. 13) that "both inventors were informed that they had a right to participate in the application and that they should obtain their own attorneys and that they could join in the application by filing a declaration." From these statements, it is not clear whether petitioner has reason to believe that Mr. Probst's alleged refusal arises from a refusal to appoint present counsel (by signing a combined Declaration and Power of Attorney), as opposed to a refusal to execute a Declaration which does not include a Power of Attorney. Petitioner should clarify whether Mr. Probst is allegedly refusing to execute the application, or if he is merely refusing to appoint certain counsel.

Regarding **requirement (3)**, the petition includes a statement the last known address of the non-signing inventor. Accordingly, requirement (3) has been satisfied.

Concerning **requirement (4)**, the declaration filed on 18 September 2008 was signed by Achim Schwarz on behalf of himself and non-signing joint inventor Christian Probst. This declaration satisfies requirement (4) of 37 CFR 1.47(a), and is suitable for purposes of compliance with 37 CFR 1.497(a) and (b).

## DECISION

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

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

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

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

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| Probst et al. | : | |
| Application No.: 11/572,906 | : | DECISION |
| PCT No.: PCT/EP2004/008757 | : | |
| Int. Filing Date: 05 August 2004 | : | ON |
| Priority Date: 05 August 2004 | : | |
| Attorney Docket No.: 8391 | : | PETITION |
| For: Method For Inspecting Surfaces | : | |

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 24 February 2009.

## DISCUSSION

On 02 December 2008, a Decision was mailed to applicants, dismissing without prejudice a petition under 37 CFR 1.47(a) filed on 19 November 2008. The petition was dismissed because

> Regarding requirement (2), petitioner presents evidence, including a "Declaration of Kenneth L. Mitchell" dated 19 November 2008, which tends to show that Mr. Probst has refused to execute the combined declaration and power of attorney after being presented with it and a complete copy of the application papers. However, the petition includes a statement (p. 7) that the "undersigned advised Mr. Probst that he was entitled to independent legal representation..." Similarly, the "Declaration of Kenneth L. Mitchell" dated 19 November 2008 indicates in part (in para. 13) that "both inventors were informed that they had a right to participate in the application and that they should obtain their own attorneys and that they could join in the application by filing a declaration." From these statements, it is not clear whether petitioner has reason to believe that Mr. Probst's alleged refusal arises from a refusal to appoint present counsel (by signing a combined Declaration and Power of Attorney), as opposed to a refusal to execute a Declaration which does not include a Power of Attorney. Petitioner should clarify whether Mr. Probst is allegedly refusing to execute the application, or if he is merely refusing to appoint certain counsel.

In response, counsel "clarifies that Mr. Probst is refusing to execute the application, regardless of whether or not counsel is appointed in the same document as the declaration." In support of this clarification, petitioner indicates that, on 02 February 2009, a declaration "without a POA" was sent to the inventors but that Mr. Probst failed to return the signed declaration. It is noted that the time period between the sending of the declaration "without a POA"on 02 February 2009 and the filing of this renewed petition on 24 February 2009 was less than a month; accordingly, a question arises as to whether sufficient time was allowed for the non-signing inventor to return a declaration. In a telephone conference on 21 April 2009, Atty. Mitchell confirmed that Mr. Probst still has not returned an executed declaration document. Based on the totality of the evidence now presented, it would be appropriate to conclude that requirement (2) has been satisfied.

## 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.

The application is being returned to the National Stage Processing Branch for processing as the U.S. National Stage of the above-identified international application. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **18 September 2008** (the date the declaration was filed).

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

2 2 APR 2009

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Mr. Christian Probst
Agricolastr. 107
80689 Munchen
GERMANY

In re Application of
Probst et al.
Application No.: 11/572,906
PCT No.: PCT/EP2004/008757
Int. Filing Date: 05 August 2004
Priority Date: 05 August 2004
Attorney Docket No.: 8391
For: Method For Inspecting Surfaces

Dear Mr. Probst:

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

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

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3283. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Requests for information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1(800) 972-6382 (outside the Washington D.C. area).

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

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

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9213 CHILLICOTHE ROAD
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# OFFICIAL GAZETTE NOTICE

37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of an application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of a joint inventor. The petition has been granted. A notice has been sent to the last known address of the non-signing inventor. The inventor whose signature is missing (Christian PROBST) may join in the application by promptly filing an appropriate oath or declaration complying with 37 CFR 1.63. The international application number is PCT/EP2004/008757 and was filed on August 5, 2004 in the names of Christian PROBST and Achim SCHWARZ for the invention entitled METHOD FOR INSPECTING SURFACES. The national stage application number is 11/572,906 and has a 35 U.S.C. 371(c)(1), (2) and (4) date of September 18, 2008.

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**NXP, B.V.**
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**M/S41-SJ**
**1109 MCKAY DRIVE**
**SAN JOSE CA 95131**

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OFFICE OF PETITIONS

In re Application of :
Andy C. NEGOI :
Application No. 11/572,916 : DECISION ON PETITION
Filed: January 29, 2007 :
Attorney Docket No. **GB040156US1** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 26, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, October 20, 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 January 21, 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 amendment, (2) the petition fee of $1620, and (3) a proper statement of unintentional delay. Accordingly, the reply to the non-final Office action of 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.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at (571) 272-2783.

This application is being referred to Technology Center AU 2821 for appropriate action on the concurrently filed amendment.

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

cc: **MARK A. WILSON**
**PMB: 348**
**2530 BERRYESSA ROAD**
**SAN JOSE CA 95132**

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31 MAR 2008

BROUSE MCDOWELL LPA
388 SOUTH MAIN STREET
SUITE 500
AKRON OH 44311

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| In re Application of | : | |
| RAM-LIEBIG et al. | : | |
| Application No.: 11/572,956 | : | DECISION |
| PCT No.: PCT/DE2005/001266 | : | |
| Int. Filing Date: 18 July 2005 | : | ON |
| Priority Date: 30 July 2004 | : | |
| Attorney Docket No.: 23086.44790 | : | PETITION |
| For: Tissue Graft Structure For The Reconstruction Of A Human Or Animal Organ | : | |

This is in response to the petition under 37 CFR 1.47(a) filed on 12 February 2008.

## BACKGROUND

This international application was filed on 18 July 2005, claimed an earlier priority date of 30 July 2004, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 09 February 2006. The 30 month time period for paying the basic national fee in the United States expired at midnight on 30 January 2007. Applicants filed *inter alia* the basic national fee on 30 January 2007.

On 12 October 2007, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

## DISCUSSION

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

Regarding **requirement (1)**, the $200.00 petition fee has been paid.

Regarding **requirement (2)**, petitioner seeks relief under 37 CFR 1.47(a) on the basis that joint inventor Manfred Wirth allegedly has refused to execute the application. Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address

> of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. The fact that an application may contain proprietary information does not relieve the 37 CFR 1.47 applicant of the responsibility to present the application papers to the inventor if the inventor is willing to receive the papers in order to sign the oath or declaration. It is noted that the inventor may obtain a complete copy of the application, unless the inventor has assigned his or her interest in the application, and the assignee has requested that the inventor not be permitted access. See MPEP § 106. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 USPQ 80 (Comm'r Pat. 1956).
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal. When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Petitioner has asserted that "Manfred Wirth has refused to sign the oath or declaration" without providing an adequate showing as described at MPEP 409.03(d).

Regarding **requirement (3)**, the petition provides the last known address of the non-signing inventor, Manfred Wirth. Accordingly, requirement (3) has been satisfied.

Regarding **requirement (4)**, inspection of the declaration of inventorship accompanying the instant petition reveals that it appears to have been compiled by aggregating sheets from multiple documents to arrive at a single declaration; this is suggested because pages 9 and 10 appear to be reduced photocopies whereas the remaining pages do not. Applicants' attention is drawn to MPEP 201.03, which explains in part that

> An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different

declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

In view of this policy, it would not be appropriate to accept the declaration.

## DECISION

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

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

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

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

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AKRON OH 44311

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| Application No.: 11/572,956 | : | DECISION |
| PCT No.: PCT/DE2005/001266 | : | |
| Int. Filing Date: 18 July 2005 | : | ON |
| Priority Date: 30 July 2004 | : | |
| Attorney Docket No.: 23086.44790 | : | PETITION |
| For: Tissue Graft Structure For The Reconstruction Of A Human Or Animal Organ | : | |

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 30 May 2008.

## DISCUSSION

In a Decision mailed on 31 March 2008, the petition under 37 CFR 1.47(a) filed on 12 February 2008 was dismissed, without prejudice, because

> Regarding **requirement (2)**, petitioner seeks relief under 37 CFR 1.47(a) on the basis that joint inventor Manfred Wirth allegedly has refused to execute the application... Petitioner has asserted that "Manfred Wirth has refused to sign the oath or declaration" without providing an adequate showing as described at MPEP 409.03(d).
>
> Regarding **requirement (4)**, inspection of the declaration of inventorship accompanying the instant petition reveals that it appears to have been compiled by aggregating sheets from multiple documents to arrive at a single declaration; this is suggested because pages 9 and 10 appear to be reduced photocopies whereas the remaining pages do not... In view of this policy [MPEP 201.03], it would not be appropriate to accept the declaration.

**In response**, concerning requirement (2), petitioner presents a copy of a letter dated 02 July 2007 from Kathrin Naue to Prof. Wirth, an email dated 31 July 2007 from Mandy Berbig (Prof. Wirth's assistant) to Ms. Naue acknowledging a letter dated 23 July 2007 and indicating that Prof. Wirth was "on holiday," and a letter dated 26 September 2007 from Frank Sender to Prof. Wirth, along with English translations of said correspondence. No copy of the letter dated 23 July 2007 referred to by Ms. Berbig has been provided. Nor have statements been provided by individual(s) having first-hand knowledge of the efforts undertaken to obtain Prof. Wirth's execution of the declaration (such as Ms. Naue or Mr. Sender). The letters from Ms. Naue and Mr. Sender refer to a copy of the declaration, but there is no mention of whether Mr. Wirth was presented with a complete copy of the application papers. It is also noted that the letters do not specifically reference the application in question by, e.g., application number or file reference number, but only by title. Since petitioner has not adequately shown that Prof. Wirth has refused to execute the application after being presented with an oath or declaration and a complete copy

of the application papers, nor that he could not be found or reached after diligent effort, it would not be appropriate to regard requirement (2) as having been satisfied at this time.

With regard to requirement (4), petitioner presents inter alia a copy of "the complete Declaration with Dr. Ram-Liebig's and Prof. Hakenberg's original signatures." This declaration is being accepted for purposes of compliance with 37 CFR 1.497(a) and (b), and in satisfaction of requirement (4) of 37 CFR 1.47(a).

## DECISION

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

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

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

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

cc: Emerson, Thomson & Bennett
777 West Market Street
Akron, OH 44303

2 4 JUN 2008

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

BROUSE MCDOWELL LPA
388 SOUTH MAIN STREET
SUITE 500
AKRON OH 44311

| | | |
|---|---|---|
| In re Application of | : | |
| RAM-LIEBIG et al. | : | |
| Application No.: 11/572,956 | : | |
| PCT No.: PCT/DE2005/001266 | : | |
| Int. Filing Date: 18 July 2005 | : | DECISION |
| Priority Date: 30 July 2004 | : | |
| Attorney Docket No.: 23086.44790 | : | |
| For: Tissue Graft Structure For The Reconstruction Of A Human Or Animal Organ | : | |

This is in response to the request for withdrawal filed on 12 May 2008.

## DISCUSSION

Counsel requests withdrawal from the representation on the basis that "the client terminated its relationship with Brouse McDowell and requested its files be transferred to Emerson, Thomson & Bennett."

> A registered patent attorney or patent agent who has been given a power of attorney pursuant to § 1.32(b) may withdraw as attorney or agent of record upon application to and approval by the Director. The applicant or patent owner will be notified of the withdrawal of the registered patent attorney or patent agent. Where power of attorney is given to the patent practitioners associated with a Customer Number, a request to delete all of the patent practitioners associated with the Customer Number may not be granted if an applicant has given power of attorney to the patent practitioners associated with the Customer Number in an application that has an Office action to which a reply is due, but insufficient time remains for the applicant to file a reply. See § 41.5 of this title for withdrawal during proceedings before the Board of Patent Appeals and Interferences.

While 37 CFR 10.40 provides in part that

> (b) *Mandatory withdrawal.* A practitioner representing a client before the Office shall withdraw from employment if:
>
> (4) The practitioner is discharged by the client.

The statement that the client has discharged Brouse McDowell is corroborated by the letter from Atty. Alexander Carksohn dated 26 March 2008. However, the request for permission to withdraw has not been properly signed because the S-signature appearing thereon is not in a proper format.

## DECISION

The request 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 may be obtained under 37 CFR 1.136(a)

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

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

2 3 SEP 2008

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www.uspto.gov

BROUSE MCDOWELL LPA
388 SOUTH MAIN STREET
SUITE 500
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| | | |
|---|---|---|
| In re Application of | : | |
| RAM-LIEBIG et al. | : | |
| Application No.: 11/572,956 | : | DECISION |
| PCT No.: PCT/DE2005/001266 | : | |
| Int. Filing Date: 18 July 2005 | : | ON |
| Priority Date: 30 July 2004 | : | |
| Attorney Docket No.: 23086.44790 | : | PETITION |
| For: Tissue Graft Structure For The Reconstruction Of A Human Or Animal Organ | : | |

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 25 August 2008.

## DISCUSSION

In a Decision mailed on 24 June 2008, the renewed petition under 37 CFR 1.47(a) filed on 30 May 2008 was dismissed, without prejudice, because

> concerning requirement (2), petitioner presents a copy of a letter dated 02 July 2007 from Kathrin Naue to Prof. Wirth, an email dated 31 July 2007 from Mandy Berbig (Prof. Wirth's assistant) to Ms. Naue acknowledging a letter dated 23 July 2007 and indicating that Prof. Wirth was "on holiday," and a letter dated 26 September 2007 from Frank Sender to Prof. Wirth, along with English translations of said correspondence. No copy of the letter dated 23 July 2007 referred to by Ms. Berbig has been provided. Nor have statements been provided by individual(s) having first-hand knowledge of the efforts undertaken to obtain Prof. Wirth's execution of the declaration (such as Ms. Naue or Mr. Sender). The letters from Ms. Naue and Mr. Sender refer to a copy of the declaration, but there is no mention of whether Mr. Wirth was presented with a complete copy of the application papers. It is also noted that the letters do not specifically reference the application in question by, e.g., application number or file reference number, but only by title. Since petitioner has not adequately shown that Prof. Wirth has refused to execute the application after being presented with an oath or declaration and a complete copy of the application papers, nor that he could not be found or reached after diligent effort, it would not be appropriate to regard requirement (2) as having been satisfied at this time.

In response, applicants have filed evidence which establishes with reasonable certainty that Prof. Wirth was presented with a copy of the application papers and a declaration for his execution. Petitioner has also adequately demonstrated that, within the meaning of 37 CFR 1.47(a), Prof. Wirth has refused to execute the application (by way of the telephonic refusal described in the Affidavit of Frank Sender). Therefore, requirement (2) now is deemed to have been satisfied.

## 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.

The application is being returned to the National Stage Processing Branch for processing as the U.S. National Stage of the above-identified international application. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **30 May 2008**.

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

cc: Emerson, Thomson & Bennett
777 West Market Street
Akron, OH 44303

23 SEP 2008

United States Patent and Trademark Office

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

Manfred Wirth
Ludwig Richter Str. 11
01326 Dresden
GERMANY

| | | |
|---|---|---|
| In re Application of | : | |
| RAM-LIEBIG et al. | : | |
| Application No.: 11/572,956 | : | DECISION |
| PCT No.: PCT/DE2005/001266 | : | |
| Int. Filing Date: 18 July 2005 | : | ON |
| Priority Date: 30 July 2004 | : | |
| Attorney Docket No.: 23086.44790 | : | PETITION |
| For: Tissue Graft Structure For The Reconstruction Of A Human Or Animal Organ | : | |

Dear Prof. Wirth:

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

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

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3283. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Requests for information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1(800) 972-6382 (outside the Washington D.C. area).

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

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

cc: Emerson, Thomson & Bennett
777 West Market Street
Akron, OH 44303

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## OFFICIAL GAZETTE NOTICE

37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of an application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of a joint inventor. The petition has been granted. A notice has been sent to the last known address of the non-signing inventor. The inventor whose signature is missing (Manfred WIRTH) may join in the application by promptly filing an appropriate oath or declaration complying with 37 CFR 1.63. The international application number is PCT/DE2005/001266 and was filed on July 18, 2005 in the names of Gouya RAM-LIEBIG, Oliver HAKENBERG and Manfred WIRTH for the invention entitled TISSUE GRAFT STRUCTURE FOR THE RECONSTRUCTION OF A HUMAN OR ANIMAL ORGAN.. The national stage application number is 11/572,956 and has a 35 U.S.C. 371(c)(1), (2) and (4) date of May 30, 2008.

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PATENT DEPARTMENT
TAYLOR, PORTER, BROOKS &
PHILLIPS, L.L.P
P.O. BOX 2471
BATON ROUGE LA 70821-2471

MAILED

JUL 13 2010

OFFICE OF PETITIONS

In re Application :
Little :
Application No. 11/573,020 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: January 31, 2007 :
Dkt. No.: Little 02L3 US :

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT under 37 C.F.R. § 1.705(b)," filed January 29, 2010. Applicants submit that the correct patent term adjustment to be indicated on the patent is 422 days plus an additional number of days pursuant to 37 CFR 1.702(b), not zero days as calculated by the Office as of the mailing of the initial determination of patent term extension. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and, on the basis that the adjustment pursuant to 37 CFR 1.703(a)(1) delay was improperly calculated.

37 CFR 1.702(b)

Insofar as the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See, § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

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).

37 CFR 1.703(a)(1)

Applicant herein asserts that the application is entitled to an adjustment of 422 days pursuant to 37 CFR 1.703(a)(1) in connection with the mailing of the non-final Office action on May 27, 2009.

A review of the record reveals that, as asserted, the application is entitled to an adjustment of 422 days pursuant to 37 CFR 1.702(a)(1). The adjustment commenced April 1, 2008 and ended May 27, 2009. See, 37 CFR 1.703(a)(1).

In view thereof, the request for correction of the reduction of is GRANTED TO THE EXTENT INDICATED HEREIN.

CONCLUSION

Accordingly, as of the time of allowance, the application is entitled to an overall patent term adjustment of 422 days.

Receipt is hereby acknowledged of the required patent term adjustment application fee of $200.00. See, 37 CFR 1.18(e).

---

[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.

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) 272-3205.

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Adjusted PAIR Calculation

| PTE Calculations for Application: 11/573020 | | | |
|---|---|---|---|
| Application Filing Date: | 01/31/2007 | PTO Delay (PTO): | 0 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 0 |
| Post-Issue Petitions: | 0 | Total PTE (days): | 422 |
| PTO Delay Adjustment: | 422 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 41 | 07/07/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 422 | | |
| 33 | 11/03/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 32 | 11/02/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 31 | 11/02/2009 | ISSUE REVISION COMPLETED | | | |
| 30 | 11/02/2009 | DOCUMENT VERIFICATION | | | |
| 29 | 10/26/2009 | NOTICE OF ALLOWABILITY | | | |
| 26 | 08/25/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 25 | 08/26/2009 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 24 | 09/11/2009 | DATE FORWARDED TO EXAMINER | | | |
| 23 | 08/26/2009 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 22 | 08/25/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 21 | 08/25/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 20 | 05/27/2009 | MAIL NON-FINAL REJECTION | | | |
| 19 | 05/26/2009 | NON-FINAL REJECTION | | | |
| 18 | 01/31/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 17 | 01/31/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 14 | 04/28/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 13 | 03/13/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 12 | 01/08/2009 | PG-PUB ISSUE NOTIFICATION | | | |
| 11 | 11/21/2008 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 10 | 09/18/2008 | REQUEST FOR FOREIGN PRIORITY (PRIORITY | | | |

| | | | | | |
|---|---|---|---|---|---|
| | | PAPERS MAY BE INCLUDED) | | | |
| 9 | 01/31/2007 | REFERENCE CAPTURE ON IDS | | | |
| 8 | 01/31/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 7 | 10/08/2008 | APPLICATION DISPATCHED FROM OIPE | | | |
| 6 | 01/31/2007 | 371 COMPLETION DATE | | | |
| 5 | 09/26/2008 | SENT TO CLASSIFICATION CONTRACTOR | | | |
| 4 | 09/29/2008 | FILING RECEIPT | | | |
| 3 | 09/29/2008 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 2 | 06/03/2008 | CLEARED BY OIPE CSR | | | |
| 1 | 01/31/2007 | 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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29 FEB 2008

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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON VA 20191

In re Application of: GOHDE, Wolfgang
U.S. Application No.: 11/573,024
Int'l Application No: PCT/DE2004/000394
Int'l Filing Date: 01 March 2004
Priority Date: None
Atty Docket No.: P31328
For: DEVICE FOR MEASURING LIGHT EMITTED BY MICROSCOPICALLY SMALL PARTICLES OR BIOLOGICAL CELLS

DECISION ON PETITION
(37 CFR 1.137(b))

This decision is issued in response to applicant's petition for revival under 37 CFR 1.137(b) filed 31 January 2007. Applicant has paid the required petition fee.

## BACKGROUND

On 01 March 2004, applicant filed international application PCT/DE2004/000394. The application did not claim an earlier priority date, and it designated the United States. On 15 September 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for payment of the U.S. basic national fee was thirty months from the international filing date, 01 September 2006.

Applicant did not request entry in the U.S. national stage and submit the basic national fee on or before 01 September 2006. Accordingly, the international application became abandoned with respect to the United States at midnight on 01 September 2006.

On 31 January 2007, applicant filed the petition for revival under 37 CFR 1.137(b) considered herein accompanied by, among other materials, payment of the basic national fee.

## 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).[1]

With respect to item (1), the "required reply" here is a request for entry into the U.S. national stage under 35 U.S.C. 371 and payment of the basic national fee. The present petition was accompanied by such materials. Item (1) above is therefore satisfied.

With respect to item (2), applicant has paid the required petition fee. Item (2) is therefore satisfied.

With respect to item (3), the petition includes a statement that "the entire delay in filing the required reply, i.e., completing entry into the U.S. National Phase for the above-captioned International application, from the due date for the filing until the filing of this grantable petition, was unintentional," accompanied by an explanatory statement regarding the delay executed by counsel and a supporting statement executed by the sole applicant. However, the statements provided raise a question as to whether the abandonment of the international application was unintentional. Specifically, the statements indicate that applicant's German counsel was aware of the deadline for entry into the U.S. national stage and that such counsel forwarded to the applicant a letter informing him of the pending deadline, as well as subsequent reminder letters. Failing to receive a response to these letters from the applicant, applicant's German counsel apparently made the decision not to file the required U.S. national stage materials. The statements provided indicate that the applicant did not timely receive the letters from his German counsel informing him of the pending U.S. deadline; however, the knowledge and deliberate actions of an applicant's attorney may be imputed to the applicant himself. See New York University v. Autodesk, Inc., 2007 U.S. Dist. LEXIS 50832 (S.D.N.Y., Jul. 13, 2007) (an applicant is bound by its attorney's actions and "is considered to have notice of all facts, 'notice of which can be charged upon the attorney.'"); Lawman Armor Corp. v. David A Simon, 2005 U.S. Dist. LEXIS 10843 (E.D. Mich., March 29, 2005) (action of attorney binding on applicant even though attorney was unable to contact applicant despite multiple mailings). Accordingly, on the present record, which implies that the application became abandoned as a result of the deliberate act of applicant's attorney, it cannot be confirmed that the entire delay in filing the required reply from the due date for such reply until the filing of the present petition was unintentional. Item (3) above is therefore not satisfied.

## 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 statement and supporting materials required to support the conclusion that the "entire delay in filing the

[1] Item (4) does not apply to the present application.

required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional," as discussed above.

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.

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

26 JUN 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON VA 20191

In re Application of: GOHDE, Wolfgang
U.S. Application No.: 11/573,024
Int'l Application No: PCT/DE2004/000394
Int'l Filing Date: 01 March 2004
Priority Date: None
Atty Docket No.: P31328
For: DEVICE FOR MEASURING LIGHT EMITTED BY MICROSCOPICALLY SMALL PARTICLES OR BIOLOGICAL CELLS

DECISION ON RENEWED PETITION
(37 CFR 1.137(b))

In a decision mailed by this Office on 29 February 2008, applicant's 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 current record did not make clear that the entire delay in filing the U.S. national stage application and the petition for revival was unintentional.

On 29 April 2008, applicants filed the "Renewed Petition Under 37 CFR 1.137(b)" considered herein. The renewed petition includes supplemental statements from the applicant and from his German attorneys regarding the delay in filing the U.S. national stage herein. These materials, in combination with the previous submission, provide an acceptable showing that the entire delay in filing the U.S. national stage from the due date for the U.S. national stage until the filing of the petition under 37 CFR 1.137(b) was unintentional. Applicant has therefore satisfied the final requirement of a grantable petition for revival under 37 CFR 1.137(b).

The 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. It is noted that applicant has not submitted a translation into English of the international application.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

14 MAR 2007

PAUL J WHITE, SENIOR COUNSEL
NATIONAL RENEWABLE ENERGY LABORATORY (NREL)
1617 COLE BOULEVARD
GOLDEN, CO 80401-3393

| | | |
|---|---|---|
| In re Application of SEIBERT | : | |
| U.S. Application No.: 11/573,035 | : | |
| PCT Application No.: PCT/US2006/007153 | : | |
| Int. Filing Date: 28 February 2006 | : | |
| Priority Date Claimed: 28 February 2005 | : | DECISION |
| Attorney Docket No.: NREL 04-19 | : | |
| For: PROCESS AND GENES FOR EXPRESSION AND OVER-EXPRESSION OF ACTIVE [FeFe] HYDROGENASES | : | |

This is in response to applicant's "Rule 91.1 (b) Rectification", filed 12 February 2007, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

## BACKGROUND

On 28 February 2006, applicant filed international application PCT/US2006/007153, which claimed priority of an earlier United States application filed 28 February 2005. The thirty-month period for paying the basic national fee in the United States expires on 28 August 2007.

On 31 January 2007, 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 12 February 2007, applicant filed the present petition under 37 CFR 1.181.

## DISCUSSION

The petition states that applicant mistakenly listed "PCT/UD06/07153" as the international application number instead of "PCT/US06/07153" when filing the national stage papers. Applicant's explanation for the error is accepted.

## CONCLUSION

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

The present application is a U.S. national stage application based on international application PCT/US06/07153.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ABELMAN, FRAYNE & SCHWAB
666 THIRD AVENUE, 10TH FLOOR
NEW YORK, NY 10017

**COPY MAILED**

DEC 17 2009

**OFFICE OF PETITIONS**

In re Application of :
Andrey Shmakov, et. al. :
Application No. 11/573,037 : ON PETITION
Filed: January 31, 2007 :
Attorney Docket No. 207,976 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 16, 2009, to revive the above-identified application.

The application became abandoned for failure to file a reply to the non-final Office action mailed on September 4, 2008. A Notice of Abandonment was mailed on May 6, 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 amendment; (2) the petition fee of $810; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 3691 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

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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05 DEC 2007

FREESCALE SEMICONDUCTOR, INC.
LAW DEPARTMENT
7700 WEST PARMER LANE MD:TX32/PL02
AUSTIN, TX 78729

In re Application of ZECRI et al :
U.S. Application No.: 11/573,078 :
PCT Application No.: PCT/EP2005/053819 :
Int. Filing Date: 03 August 2005 : DECISION
Priority Date Claimed: 03 August 2004 :
Attorney Docket No.: SC12968ET :
For: A SEMICONDUCTOR SWITCH ARRANGEMENT AND AN ELECTRONIC DEVICE :

This is in response to applicant's "Petition Under 37 CFR 1.47" filed 17 October 2007.

## BACKGROUND

On 03 August 2005, applicant filed international application PCT/EP2005/053819, which claimed priority of an earlier European Patent Office application filed 03 August 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 09 February 2006. The thirty-month period for paying the basic national fee in the United States expired on 03 February 2007.

On 01 February 2007, 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 July 2007, 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 17 October 2007, 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. However, the declaration is improper with regard to inventor Michel Zecri because it contains non-initialed and non-dated alterations. See 37 CFR 1.52(c).

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 Luca Bertolini 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 Bertolini for signature (see affidavit of Isabelle Barbe-Medioni, ¶¶6-7). However, petitioner has not sufficiently demonstrated that Bertolini refuses to sign. In particular, in the electronic mail message dated 10 October 2005, Bertolini's statement that he does not intend to sign absent an explanation of that obligates him to do so falls short of an express refusal. It is noted that Bertolini made a purported express oral refusal to sign in a voicemail message to Ms. Barbe-Medioni. However, the date of the refusal is not specified in Ms. Barbe-Medioni's affidavit. Thus, it would not be reasonable to conclude at the present time that Bertolini 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 Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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07 MAR 2008

FREESCALE SEMICONDUCTOR, INC.
LAW DEPARTMENT
7700 WEST PARMER LANE MD:TX32/PL02
AUSTIN, TX 78729

| | | |
|---|---|---|
| In re Application of ZECRI et al | : | |
| U.S. Application No.: 11/573,078 | : | |
| PCT Application No.: PCT/EP2005/053819 | : | |
| Int. Filing Date: 03 August 2005 | : | DECISION |
| Priority Date Claimed: 03 August 2004 | : | |
| Attorney Docket No.: SC12968ET | : | |
| For: A SEMICONDUCTOR SWITCH ARRANGEMENT AND AN ELECTRONIC DEVICE | : | |

This is in response to applicant's "Renewed Petition Under 37 CFR 1.47(a)" filed 05 March 2008.

## BACKGROUND

On 03 August 2005, applicant filed international application PCT/EP2005/053819, which claimed priority of an earlier European Patent Office application filed 03 August 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 09 February 2006. The thirty-month period for paying the basic national fee in the United States expired on 03 February 2007.

On 01 February 2007, 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 July 2007, 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 17 October 2007, applicant filed a petition under 37 CFR 1.47(a).

On 05 December 2007, this Office mailed a decision dismissing the 17 October 2007 petition.

On 05 March 2008, 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 (3) and (4) above.

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

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 Luca Bertolini 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 Bertolini for signature (see affidavit of Isabelle Barbe-Medioni, ¶¶6-7). Furthermore, petitioner has sufficiently demonstrated that Bertolini refuses to sign. In particular, Bertolini made a purported express oral refusal to sign in a voicemail message to Ms. Barbe-Medioni (see Barbe-Medioni's supplemental affidavit, ¶8). Therefore, it can be concluded with reasonable certainty that Bertolini refuses to join in the application.

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 03 August 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 05 March 2008.

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

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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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**KNOBBE MARTENS OLSON & BEAR LLP**
**2040 MAIN STREET**
**FOURTEENTH FLOOR**
**IRVINE CA 92614**

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FEB 16 2010

In re Application of :
BOLAND, Brian T. :
Application No. 11/573,088 : DECISION ON PETITION
Filed: February 01, 2007 : TO WITHDRAW
Attorney Docket No. **DUMME72.003APC** : 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 08, 2009.

The request is not approved because a revocation of power of attorney has been previously filed.

A review of the file record indicates that the power of attorney to KNOBBE MARTENS OLSON & BEAR LLP has been revoked by the assignee of the patent application on December 02, 2009. 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 Tredelle Jackson at 571-272-2783.

/Tredelle D. Jackson/
Tredelle D. Jackson
Petitions Examiner
Office of Petitions

cc: **WILEY REIN LLP**
**1776 K. STREET N.W.**
**WASHINGTON, DC 20006**

27 MAY 2008

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO IL 60606

| | | |
|---|---|---|
| In re Application of | : | DECISION |
| MARTI CLAUZEL et al. | : | |
| Application No.: 11/573,089 | : | |
| PCT No.: PCT/EP2005/053778 | : | |
| Int. Filing Date: 02 August 2005 | : | |
| Priority Date: 02 August 2004 | : | |
| Attorney Docket No.: 04-617-Y | : | |
| For: COMPOUNDS FOR INHIBITING | : | |
| COPPER-CONTAINING AMINE OXIDASES | : | |
| AND USES THEREOF | : | |

This decision is in response to applicants' petition under 37 CFR 1.497(d) filed 09 May 2008.

## BACKGROUND

On 02 August 2005, applicant filed international application PCT/EP2005/053778, which designated the United States and claimed a priority date of 02 August 2004. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 09 February 2006. The thirty-month period for paying the basic national fee in the United States expired at midnight on 02 February 2007.

On 01 February 2007, applicants filed a transmittal letter for entry in to the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 07 June 2007, 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) was required.

On 05 December 2007, applicants filed a submission including a declaration of inventors.

On 12 February 2008, a Notification was mailed indicating that the declaration filed 05 December 2007 did not list the inventorship set forth in the international application and thus

was not sufficient. The Notification indicated that the inventors for the international application are Luc Marti Clauzel, Silvia Garcia Vicente, Francesc Yraola Font, and Miriam Royo Exposito.

On 06 March 2008, applicants submitted a declaration of inventors listing Luc Marti Clauzel, Silvia Garcia Vicente, Francesc Yraola Font, and Miriam Royo Exposito as the inventors and signed by them.

On 09 May 2008, applicants submitted the instant petition under 37 CFR 1.497(d) requesting that two inventors be added. The petition was accompanied by a statement from Fernando Albericio Palomera and Antonio Zorzano Olarte, a consent of assignee statement from Genmedica Therapeutics SL, a statement under 3.73(b), and a declaration of inventors.

## DISCUSSION

37 CFR 1.497(d), provides:

> (d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92*bis* subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:
>
> (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
>
> (2) The processing fee set forth in Sec. 1.17(i); and
>
> (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see Sec. 3.73(b) of this chapter); and
>
> (4) Any new oath or declaration required by paragraph (f) of this section.

Items (1)-(3) have been satisfied. Item (4) is not required.

Although a declaration of inventors was filed on 09 May 2008, the declaration of inventors filed 05 December 2007 is in compliance with 37 CFR 1.497(a)-(b).

## CONCLUSION

The request under 37 CFR 1.497(d) is **GRANTED** 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 in accordance with

this decision including processing the application in the name of Luc Marti Clauzel, Silvia Garcia Vicente, Francesc Yraola Font, Miriam Royo Exposito, Fernando Albericio Palomera, and Antonio Zorzano Olarte as inventors.

/Daniel Stemmer/

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

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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON VA 20191

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SEP 17 2007

**OFFICE OF PETITIONS**

In re Application of
Okafuji, et al.
Application No. 11/573,094
Filed: not determined yet, undergoing pre-exam processing
Attorney Docket No. P31609

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed April 9, 2007, to change the name of inventor "Miwa Miyazaki" to –Miwa Kawano--.

The petition is **DISMISSED**.

Any reconsideration petition should be filed within two months of the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a).

In order the change an inventor's name, the Office requires a $400.00 petition fee accompanied by EITHER a declaration signed with both names with an explanation of how the name change was effected (marriage, divorce, etc.) OR a certified copy of a court order for the name change.

Petitioner has provided a declaration explaining how the name changed signed with only one name – Mina Kawano.

In view of the above, the petition under § 1.182 cannot be granted at this time to change the inventor's name.

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

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

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

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

Any questions concerning this matter may be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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1950 ROLAND CLARKE PLACE
RESTON VA 20191

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JAN 23 2008

OFFICE OF PETITIONS

In re Application of :
Okafuji, et al. :
Application No. 11/573,094 : DECISION ON PETITION
Filed: not determined yet, undergoing pre-exam processing :
Attorney Docket No. P31609

This is a decision on the petition under 37 CFR 1.182, filed November 5, 2007, to change the name of inventor "Miwa Miyazaki" to –Miwa Kawano--.

The petition is **GRANTED**.

Office records have been updated to reflect the inventor's change of name.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3230.

This application is being returned to the Office of Patent Application Processing (OPAP). OPAP will mail a Filing Receipt which reflects the inventor's change of name in due course.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

27 FEB 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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ALBIHNS STOCKHOLM AB
BOX 5581, LINNEGATAN 2
SE-114 85 STOCKHOLM SWEDEN

In re Application of
ROOS, Sture
Application No.: 11/573,102
PCT No.: PCT/IB05/52562
Int. Filing Date: 29 July 2005
Priority Date: 02 August 2004
Attorney Docket No.: 071392-202008
For: DRIVE SYSTEM AND METHOD FOR AN AUTOMATED SWITCH MATRIX

DECISION
REGARDING
SUBMISSION UNDER 37 CFR 1.42

This decision is issued in response to the declaration filed 11 November 2008 which is being treated as a Submission under 37 CFR 1.42. No petition fee is required.

## BACKGROUND

On 29 July 2005, applicant filed international application PCT/IB05/52562 which claimed a priority date of 02 August 2004 and which designated the United States. On 09 February 2006, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB"). The deadline for payment of the basic national fee was 02 February 2007 (thirty months from the priority date).

On 02 February 2007, 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; a copy of the international application; and a preliminary amendment.

On 28 August 2008, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b). The notification set a TWO (2) MONTH period for response.

On 11 November 2008, applicant submitted a declaration executed by Johan Oberg, on behalf of deceased inventor, Sture Roos.

## DISCUSSION

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

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

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

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

The declaration filed 11 November 2008 was executed by Johan Oberg as "legal representative" to the deceased inventor, Sture Ross. The declaration provides the residence, post office address, and country of citizenship for the deceased inventor and the legal representative. 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.

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

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

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21 DEC 2007

HAMMER & HANF, PC
3125 SPRINGBANK LANE
SUITE G
CHARLOTTE NC 28226

| | | |
|---|---|---|
| In re Application of | : | |
| HOPPES, et al. | : | |
| Application No.: 11/573,107 | : | |
| PCT No.: PCT/EP05/08488 | : | DECISION ON PETITION |
| Int. Filing Date: 05 August 2005 | : | |
| Priority Date: 13 August 2004 | : | UNDER 37 CFR 1.137(b) |
| Atty. Docket No.: 2011.18 | : | |
| For: LONG-LIFE MEMBRANE ELECTRODE ASSEMBLIES | : | |

The petition to revive under 37 CFR 1.137(b) filed 20 December 2007 in the above-captioned application is hereby **GRANTED** as follows:

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

A review of the application file reveals that applicant has now provided a statement regarding payment of the full, U.S. Basic National Fee after the expiration of thirty months from the earliest claimed priority date. 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 05 August 2005 under 35 U.S.C. 363 and will be given a date of **24 May 2007** under 35 U.S.C. 371(c)(1), (c)(2) and (c)(4).

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

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

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COMMISSIONER FOR PATENTS
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P.O. BOX 1450
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CROCKETT & CROCKETT, P.C.
26020 ACERO
SUITE 200
MISSION VIEJO CA 92691

**MAILED**

MAY 20 2009

OFFICE OF PETITIONS

Applicant: Ho
Appl. No.: 11/573,126
International Filing Date: August 3, 2005
Title: METHOD FOR TRANSMITTING A DIGITAL SIGNAL, METHOD FOR RECEIVING A DIGITAL SIGNAL, TRANSMITTER AND RECEIVER
Attorney Docket No.: 212/988U
Pub. No.: US 2008/0260070 A1
Pub. Date: October 23, 2008

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on December 23, 2008, for the above-identified application

The request is dismissed.

Applicant requests that the application be republished because the patent application publication contains material errors, wherein the amendments filed on February 2, 2007 in the national stage entry of the PCT were not entered and published with the publication.

37 CFR 1.221 (b) is applicable "only when the Office makes **a material mistake** which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. [1]

The error noted by requestor with respect to the amendment is not an Office error. The patent application publication does not include a mistake regarding the failure to include the preliminary amendment, which amended the claims because patent application publications are not required to include preliminary amendments. See 37 CFR 1.215(a). [2]

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[1]Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).
[2]Changes to Support Implementation of the United States Patent and Trademark Office 21st Century Strategic Plan; Final Rule, 69 FR 56482 (Sept. 21, 2004).

Applicant did not file a substitute specification, which incorporated the amendment. Applicant did not file a copy of the application in compliance with the Office electronic filing systems requirements. See 37 CFR 1.215 and MPEP 1121.

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 December 23, 2008, 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.

Applicants are advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application in compliance with the Office 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.

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

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

Any request for republication under 37 CFR 1.221(a) must be submitted via the EFS system as a "Pre-Grant Publication" and any 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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

INTELLECTUAL PROPERTY LAW
GROUP LLP
12 SOUTH FIRST STREET
SUITE 1205
SAN JOSE CA 95113

**MAILED**

APR 26 2010

**OFFICE OF PETITIONS**

In re Application of

Antonio Amengual Pericase

Application No. 11/573,157

Filed: September 17, 2007

Attorney Docket No.
**HENSON.HIERROS.PT3**

DECISION ON PETITION

This is a decision on the petition under 37 CFR §1.137(b), February 26, 2010, to revive the above-identified application.

The petition is **granted**.

This application became abandoned for failure to timely file corrected drawings as required by the Notice of Allowability (the "Notice") mailed October 6, 2009. The Notice set forth a three (3) month statutory period for reply. No response was received within the allowable period. Accordingly, this application became abandoned on January 7, 2010. A Notice of Abandonment was mailed on January 25, 2010.

Corrected drawings were received on February 26, 2010.

The application is being forwarded to the Office of Data Management for further processing.

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

K. A. McLaughlin

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

07 JUN 2007

CONNOLLY BOVE LODGE & HUTZ LLP
1875 EYE STREET, N.W.
SUITE 1100
WASHINGTON DC 20036

In re Application of ERNST
Application No.: 11/573,173
PCT No.: PCT/IB04/02565
Int. Filing: 02 July 2004
Priority Date: None
Attorney Docket No.: 68150.000003
For: GALANIN RECEPTORS AND BRAIN INJURY

DECISION ON

PETITION TO REVIVE

UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 2 February 2007 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 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 basic national fee of $150 has now 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, including issuance of a Notification of Missing Requirements 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, is required.

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

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

25 JUL 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CONNOLLY BOVE LODGE & HUTZ LLP
1875 EYE STREET, N.W.
SUITE 1100
WASHINGTON DC 20036

| | | |
|---|---|---|
| In re Application of | : | |
| ERNST (Deceased) | : | DECISION ON |
| Application No.: 11/573,173 | : | |
| PCT No.: PCT/IB04/02565 | : | REQUEST |
| Int. Filing Date: 02 July 2004 | : | |
| Priority Date: None | : | UNDER 37 CFR 1.42 |
| Attorney Docket no.: 20679-00228-US1 | : | |
| For: HARDNESS TESTER WITH INDENTER | : | |
| OF HARD METAL OR COMPOUND AND | : | |
| OSCILLATING CROWN FOR TESTING... | : | |

This is a decision on applicant's request under 37 CFR 1.42 along with an executed declaration filed in the United States Patent and Trademark Office (USPTO) on 20 September 2007.

## BACKGROUND

On 02 February 2007, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee. On 13 September 2007, 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 20 September 2007, applicant filed an executed declaration identifying Erik Ernst as the legal representative of deceased inventor Alfred Ernst.

## DISCUSSION

The declaration must state the relationship and the country of citizenship for both the deceased inventor and the legal representative, and the residency and mailing address for the legal representative, to meet the requirements for compliance with 37 CFR 1.497(a) and (b).

The declaration submitted with the petition identifies Erik Ernst as the legal representative of deceased inventor Alfred Ernst and states the relationship, country of citizenship, residency and mailing address for the legal representative. The declaration meets the requirements for compliance with 37 CFR 1.497(a) and (b). Accordingly, it is appropriate, at this time, to accord the application status under 37 CFR 1.42.

## CONCLUSION

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

The declaration by the legal representative for deceased inventor Alfred Ernst submitted on 20 September 2007 is accepted as a proper declaration under 37 CFR 1.497(a) and (b).

The application will be forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is 20 September 2007.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

UNITED STATES PATENT AND TRADEMARK OFFICE

17 NOV 2009

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

SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, WILLIS TOWER
CHICAGO IL 60606-1080

| | | |
|---|---|---|
| In re Application of | : | |
| NANIKASHVILI, et al. | : | DECISION ON PETITION |
| Serial No.: 11/573,197 | : | |
| PCT No.: PCT/IL2007/000079 | : | UNDER 37 CFR 1.47(a) |
| Int. Filing Date: 22 January 2007 | : | |
| Priority Date: 23 January 2006 | : | |
| Atty Docket No.: 40007139-0008-002 | : | |
| For: COMPACT MONITOR AND A METHOD FOR MONITORING A USER | : | |

This decision is in response to applicant's petition under 37 C.F.R. § 1.47 filed 15 October 2009 in the United States Patent and Trademark Office (USPTO) to accept the application without the signature of co-inventor Reuven Nanikashvili.

## BACKGROUND

On 22 January 2007, applicant filed international application PCT/IL2007/000079 which claimed priority to an earlier application filed 23 January 2006. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 26 July 2007. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 23 July 2008.

On 02 February 2007, 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).

On 16 March 2009, 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 15 October 2009, applicant filed the present petition under 37 CFR 1.47(a) accompanied by payment of a five-month extension of time fee of $1175.00.

## 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.

Regarding item 4, applicant has not included an oath or declaration signed by co-inventor Moshe Raines on his own behalf and on behalf of the non-signing inventor.

In light of the above, it is not possible to grant applicant's petition at this time.

## CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

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

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail 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.

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 USPTO will mail all future correspondence solely to the address of record.

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: 571-272-3294

cc:

Pearl Cohen Zedek Latzer, LLP
1500 Broadway
12th Floor
New York, NY 10036

UNITED STATES PATENT AND TRADEMARK OFFICE

23 FEB 2010

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

Oren Reches
Pearl Cohen Zedek Latzer, LLP
1500 Broadway, 12th Floor
New York, NY 10036

| | | |
|---|---|---|
| In re Application of | : | |
| NANIKASHVILI, et al. | : | |
| U.S. Application No.: 11/573,197 | : | DECISION ON RENEWED |
| PCT No.: PCT/IL2007/000079 | : | |
| Int. Filing Date: 22 January 2007 | : | PETITION UNDER |
| Priority Date: 23 January 2006 | : | |
| Attorney Docket No.: 40007139-0008-002 | : | 37 CFR 1.47(a) |
| For: COMPACT MONITOR AND A METHOD FOR MONITORING A USER | : | |

This decision is in response to the applicant's "Renewed Petition Under 37 CFR 1.47 (a)" filed 02 February 2010 in the United States Patent and Trademark Office (UPSTO) to accept the application without the signature of co-inventor Reuven Nanikashvili.

## BACKGROUND

On 17 November 2009, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(a). Applicant was afforded two months to file any request for reconsideration and advised that this time period could be extended pursuant to 37 CFR 1.136(a).

On 02 February 2010, applicant filed the present renewed petition accompanied by a petition for a one-month extension of time. Applicant's response is thus considered timely filed.

## DISCUSSION

As detailed in the decision mailed 17 November 2009, 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) above.

Applicant has presently provided a combined declaration and power of attorney signed by co-inventor Moshe Raines on his own behalf and for co-inventor Reuven Nanikashvili. Thus, applicant has satisfied the remaining item and it is proper to grant applicant's renewed petition at this time.

## CONCLUSION

For the reasons discussed above, applicant's renewed petition under 37 CFR 1.47(a) is **GRANTED**.

The application has an international filing date of 22 January 2007 under 35 U.S.C. 363, and will be given a date of **02 February 2010** 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.

Counsel is advised that a courtesy copy of this decision is being mailed to the address listed on the renewed petition. However, an official change of correspondence has yet to be filed. The correspondence address has been changed to that which appears on the executed declaration and power of attorney.

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

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

cc:

Reches Patents
211 North Union Street, Suite 100
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

23 FEB 2010

Mr. Reuven Nanikashvili
51/57 Atzmaut Street
Ashdod 77452
ISRAEL

In re Application of
NANIKASHVILI, et al.
U.S. Application No.: 11/573,197
PCT No.: PCT/IL2007/000079
Int. Filing Date: 22 January 2007
Priority Date: 23 January 2006
Attorney Docket No.: 40007139-0008-002
For: COMPACT MONITOR AND A METHOD FOR MONITORING A USER

Dear Mr. Nanikashvili:

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

Counsel of record:
Oren Reches
Pearl Cohen Zedek Latzer, LLP
1500 Broadway, 12th Floor
New York, NY 10036
United States of America

25 OCT 2007

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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BERENBAUM, WEINSHIENK & EASON, P.C
370 17TH STREET
SUITE 4800
DENVER CO 80202

| | | |
|---|---|---|
| In re Application of | : | |
| LOPEZ et al. | : | |
| Application No.: 11/573,199 | : | DECISION |
| PCT No.: PCT/ES2005/070108 | : | |
| Int. Filing Date: 26 July 2005 | : | |
| Priority Date: 03 August 2004 | : | |
| Attorney Docket No.: 14455.871US01 | : | |
| For: A TOOL AND A METHOD FOR POLISHING OPTICAL SURFACES | : | |

This is a decision on applicants' request for refund filed on 21 September 2007 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 26 July 2005, applicants filed international application PCT/ES2005/070108, which designated the United States and claimed a priority date of 03 August 2004. A copy of the international application was communicated from the International Bureau to the USPTO on 16 February 2006. The thirty-month period for paying the basic national fee in the United States expired at midnight on 05 February 2007 (03 February 2007 being a Saturday).

On 02 February 2007, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration of inventors.

On 20 August 2007, 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 English translation of the claims as originally filed, the processing fee under 37 CFR 1.492(i) for providing the translation later than thirty months from the priority date, an oath or declaration of inventors, 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 were required. The NOTIFICATION indicated that the spelling of the second inventor's name on the declaration (Agustin Savall Freixenet) does not correspond with the spelling on the published application (Agusti Savall

Freixenet).

On 20 September 2007, applicants filed a submission including an English translation of the claims as originally filed, the processing fee under 37 CFR 1.492(i), the surcharge under 37 CFR 1.492(h), and an explanation of the difference in the spelling of the name of the second inventor.

On 21 September 2007, applicants filed a request for refund of the surcharge under 37 CFR 1.492(h).

## DISCUSSION

The submission filed 20 September 2007 concerning the name of the inventor Freixenet identified above explains that the spelling of the inventor's name in the declaration is an accurate translation. This explanation of the difference in spelling between the international application and the declaration of inventors is accepted and noted for the record.

Accordingly, the declaration filed 02 February 2007 is in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) is not required. The surcharge has been credited to Deposit Account 022093.

## CONCLUSION

The request for refund filed 21 September 2007 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.

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

Adjustment Date: 10/25/2007 SBASHEIR
09/21/2007 INTEFSW 00003053 022093 11573199
01 FC:1618 130.00 CR

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Myers, Bigel, Sibley & Sajovec
P.O. Box 37428
Raleigh, NC 27627

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APR 23 2008

OFFICE OF PETITIONS

In re Application of :
Parag V. Karmarkar :
Application No. 11/573,226 : DECISION ON PETITION
Filed: August 6, 2007 : TO WITHDRAW
Attorney Docket No. 9450-2 : 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 19, 2008.

The request is **NOT APPROVED**.

A review of the file record indicates that Bryant R. Gold and Laura Haburay Bishop 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 properly notified by the applicant.

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

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Bryant R. Gold
Laura Bishop
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110

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OFFICE OF PETITIONS

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

In re Application of :
Legrand :
Application No. 11/573,232 : ON APPLICATION FOR
Filed: February 5, 2007 : PATENT TERM ADJUSTMENT
Atty Docket No. 33889-US-PCT :

This is in response to the PETITION REGARDING PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b), filed December 3, 2009. Applicant requests that the initial determination of patent term adjustment be corrected from one hundred and nine (109) days to one hundred fourteen (114) days.

The application for patent term adjustment is **DISMISSED**.

On September 18, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 109 days. The instant application for patent term adjustment was timely filed[1].

Applicant disputes the period of adjustment of 109 days for Office delay in mailing 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 fulfilled the requirements of 35 U.S.C. 371 in an international application. Applicant contends the period of reduction should be 114 days. Applicant asserts that all requirements of 35 U.S.C. 371(c) were met on February 5, 2007. Therefore, applicant argues that February 5, 2007 should be the date from which the 14 month period is calculated.

[1] PALM records indicate that the Issue Fee was received on December 3, 2009.

The Office calculated the 14 month period from February 10, 2007, which is the completion date.

Applicant is informed that the date of completion of all 35 U.S.C. 371 requirements is relevant for purposes of patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)(II) and 37 CFR 1.702(a)(1) when the Office has failed to mail a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than 14 months after the date on which the requirements under 35 U.S.C. 371 were fulfilled. This date is the latest of:

(A) the date of submission of the basic national fee;
(B) the date of submission or communication of the copy of the international application;
(C) the date of submission of the translation of the international application if the international application is not in the English language;
(D) the date of submission of an oath or declaration of the inventor in compliance with 35 U.S.C. 371(c)4)
(E) the earlier of 30 months from the priority date or the date of request for early processing under 35 U.S.C. 371(f) if requested prior to 30 months from the priority date;
(F) if a request for early processing has not been requested prior to 30 months from the priority date, the date of submission of any translation of the annexes to the international preliminary examination report if the translation of the annexes are filed within the time period set in a Notification of Missing Requirements requiring either an English translation of the international application or an oath or declaration; and
(G) the date of submission of any surcharge for submitting the oath or declaration later than 30 months form the priority date.

As early processing was not requested in this application, the date of completion is 30 months from the priority date. See (E) above. The priority date was August 10, 2004. The date of completion is February 10, 2007. In short, the fourteen month completion date cannot be before the commencement date.

Entry of the period of reduction of 109 days (from April 11, 2007, which is the date after 14 months after the date of completion, to July 28, 2008, the date a restriction requirement was mailed) is warranted.

In view thereof, the determination of patent term adjustment at the time of the mailing of the notice of allowance remains 109 days.

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).

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

Telephone inquiries specific to this decision should be directed to Shirene Willis Brantley, Senior Petitions Attorney, at (571) 272-3230.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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AUG 13 2009

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

In re Application of :
HATANAKA, KOJI, et al. :
Application No. 11/573,238 :
Filed: February 05, 2007 :
Attorney Docket No. 00862.108237. :

DECISION ON REQUEST TO PARTICIPATE IN PATENT PROSECUTION HIGHWAY PROGRAM AND PETITION TO MAKE SPECIAL UNDER 37 CFR 1.102(d)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed June 24, 2009 to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

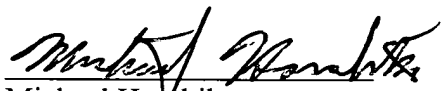
(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
(3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
(4) Examination of the U.S. application has not begun;
(5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
(6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Michael Horabik at 571-272-3068.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.



Michael Horabik
Quality Assurance Specialist
Technology Center 2600
Communications

16 OCT 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Alston & Bird LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000

In re Application of :
MUHLENMEISTER et al. :
Application No.: 11/573,252 : DECISION ON PETITION
PCT No.: PCT/EP05/08245 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 29 July 2005 :
Priority Date: 31 July 2004 :
Attorney Docket No.: 038827/323278 :
For: METHOD AND DEVICE FOR CONTROLLING THE QUALITY DURING THE PRODUCTION OF AN EXTRUDED POLYMER PRODUCT :

The petition to revive under 37 CFR 1.137(b) filed 05 February 2007 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
Fax: (571) 273-0459

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**SHELDON MAK ROSE & ANDERSON PC**
**100 CORSON STREET; THIRD FLOOR**
**PASADENA, CA 91103-3842**

**MAILED**

MAR 29 2010

**OFFICE OF PETITIONS**

In re Application of :
**Harvey L. DEUTSCH**, et *al.* :
Application No. 11/573,262 : DECISION ON PETITION TO
Filed: February 5, 2007 : WITHDRAW FROM RECORD
Attorney Docket No. **16476-1US** :

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 20, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others.

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

All future communications from the Office will be directed to the assignee of the entire interest at the address below until otherwise properly notified by the applicant.

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

/Monica A. Graves/
Petitions Examiner, Office of Petitions

cc: **THE CATHETER EXCHANGE, INC.**
**16633 VENTURA BOULEVARD, SUITE 735**
**ENCINO, CA 91436**

United States Patent and Trademark Office

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR 1-C-11
PLANO TX 75024

26 NOV 2007

In re Application of
Vikberg et al.
Application No.: 11/573266
PCT No.: PCT/EP04/08634
Int. Filing Date: 02 August 2004
Earlier Priority Date: N/A
Attorney Docket No.: P19187-US1
For: Location Dependent Handling Of Mobile Subscribers

DECISION

The petition to revive under 37 CFR 1.137(b) filed on 05 February 2007 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 for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of the basic national fee, and has paid the petition 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 forwarded to the United States Designated/Elected Office for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h)(since the declaration filed on 05 February 2007 was not signed).

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

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HYUN JONG PARK
PARK & ASSOCIATES IP LAW, LLC
265 BIC DRIVE
SUITE 106
MILFORD, CT 06461

MAILED

MAR 25 2010

OFFICE OF PETITIONS

In re Application of :
Bo-Young Lee, et. al. :
Application No. 11/573,268 : ON PETITION
Filed: February 5, 2007 :
Attorney Docket No. 2088-044 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 30, 2009, to revive the above-identified application.

The application became abandoned for failure to file a reply to the non-final Office action mailed May 29, 2009. A Notice of Abandonment was mailed on December 23, 2009.

The Revocation and New Power of Attorney filed March 8, 2010 has been accepted and made of record. However, 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 petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $810; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 3742 for review of the amendment submitted 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

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/573,268 | 02/05/2007 | Bo-Young Lee | 2088-044 |

**CONFIRMATION NO. 8903**

**POA ACCEPTANCE LETTER**

66837
HYUN JONG PARK
Park & Associates IP Law LLC
265 Bic Drive
Suite 106
Milford, CT 06461

*OC000000040684491*

Date Mailed: 03/18/2010

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/08/2010.

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.

/amsmith/

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

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18 JUN 2007

ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR 1-C-11
PLANO, TX 75024

In re Application of
GEVORGIAN et al.
Application No.: 11/573,312
PCT No.: PCT/SE04/01099
Int. Filing Date: 06 July 2004
Priority Date: None
Attorney Docket No.: P19309-US1
For: A TUNEABLE RESONATOR

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 06 February 2007 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
Fax: (571) 273-0459

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16 JUL 2007

JOHN ALEXANDER GALBREATH
2516 CHESTNUT WOODS CT
REISTERSTOWN MD 21136

| | |
|---|---|
| In re Application of<br>SHAANAN et al.<br>Application No.: 11/573,313<br>PCT No.: PCT/IL05/01252<br>Int. Filing Date: 24 November 2005<br>Priority Date: 06 January 2005<br>Attorney Docket No.: I020607<br>For: ERROR DETECTION AND CORRECTION FOR INFRARED PULSE POSITION MODULATION SYSTEM | DECISION ON<br><br>DECLARATION |

This is a decision on applicants' declaration, filed on 06 February 2007 in the United States Patent and Trademark Office (USPTO).

On 06 February 2007, prior to the expiration of thirty month period, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, *inter alia*, the basic national fee along with a declaration identifying two inventors.

A review of the published international application PCT/IL05/01252 reveals that Tamir Shaanan was identified as the sole inventor. However, a review of the International Bureau (IB) documents reveals that on 11 April 2007, the IB issued a Notification of the Recording of A Change (Form PCT/IB/306) adding Lev Freilicher as an applicant/inventor for the United States under PCT Rule 92*bis*.1.

Since there is this indication that Lev Freilicher was accepted by the International Bureau under PCT Rule 92*bis* as a co-inventor, it is proper to accept the declaration identifying him as a co-inventor. The declaration executed by Lev Freilicher as a joint inventor of Tamir Shaanan in the above referenced application is acceptable and in compliance with 37 CFR 1.497(a) and (b).

The application will be forwarded to the United States Designated/Elected Office for further processing.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

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STITES & HARBISON PLLC
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA, VA 22314

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Mark Graham | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7603917 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/20/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/573,322 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/30/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **72** 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

SALIWANCHIK LLOYD & SALIWANCHIK
A PROFESSIONAL ASSOCIATION
PO Box 142950
GAINESVILLE FL 32614

In re Application of
David C. Miller et al.
Application No. 11/573,330
Filed: September 26, 2007
Attorney Docket No. BHI-105XT

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed October 5, 2009.

The request is **NOT APPROVED**.

The request cannot be approved because the address is neither the first named inventor nor the assignee of record.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71* or, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

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

Telephone inquiries concerning this decision should be directed to JoAnne Burke at 571-272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

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OFFICE OF PETITIONS

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A PROFESSIONAL ASSOCIATION
PO Box 142950
GAINESVILLE FL 32614

In re Application of
David C. Miller et al.
Application No. 11/573,330
Filed: September 26, 2007
Attorney Docket No. BHI-105XT

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 CFR § 1.36(b), filed January 26, 2010.

The request is **NOT APPROVED**.

The request cannot be approved because petitioner still has not provided a proper change of correspondence address and the requested change in the correspondence address is improper.

As stated in the previous decision mailed on November 18, 2009, the Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71,* or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> ***An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.***

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the 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).

Therefore, as there is currently no Statement under 37 CFR 3.73(b) with the current assignee information of record in the instant application, the Office cannot change the correspondence address to the address on the Request to Withdraw at this present time.

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

Telephone inquires concerning this decision should be directed to JoAnne Burke at 571-272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
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SALIWANCHIK LLOYD & SALIWANCHIK
A PROFESSIONAL ASSOCIATION
PO Box 142950
GAINESVILLE FL 32614

MAILED

JUN 0 3 2010

OFFICE OF PETITIONS

In re Application of
David C. Miller et al.
Application No. 11/573,330
Filed: September 26, 2007
Attorney Docket No. BHI-105XT

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 CFR § 1.36(b), filed April 13, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office 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. Saliwanchik on behalf of all attorneys of record who are associated with Customer Number 23557.

All attorneys/agents associated with Customer Number 23557 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the assignee "Beeman Holdings, Inc." at the address list listed in the request.

There is no outstanding Office action mailed that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4584.

/JoAnne Burke/
JoAnne Burke
Petitions Examiner
Office of Petitions

cc: BEEMAN HOLDINGS, INC.
1734 APEX ROAD
SARASOTA, FL 34240

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11 JUN 2007

VOLPE AND KOENIG, P.C.
UNITED PLAZA, SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA PA 19103

In re Application of
ADEL et al.
Application No.: 11/573,382
PCT No.: PCT/EP05/04345
Int. Filing Date: 22 April 2005
Priority Date: 25 May 2004
Attorney Docket No.: INA-PT195 (4415-18-US)
For: WHEEL-AND-DISC DRIVE

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 07 February 2007 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
Fax: (571) 273-0459

22 MAY 2007

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COMMISSIONER FOR PATENTS
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Michael N. Mercanti
LUCAS & MERCANTI, LLP
475 Park Avenue South
New York, New York 10016

| | |
|---|---|
| In re Application of | : |
| Hermans | : DECISION ON |
| US Application No.: 11/573,390 | : |
| PCT Application No.: PCT/NL05/000574 | : PETITION UNDER |
| Int. Filing Date: 05 August 2005 | : |
| Priority Date: 05 August 2004 | : 37 CFR 1.137 (b) |
| Attorney's File Reference: 310.1054 | : |
| For: NEISSERIA GONORRHOEAE DETETION: USING THE 5' UNTRANSLATED REGION OF THE OPA GENE | |

Applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)," filed in the United States Patent and Trademark Office (USPTO) on 07 February 2007 is **GRANTED**.

## BACKGROUND

On 05 August 2005, applicant filed international application PCT/NL05/000574. The international application claims a priority date of 05 August 2004 and designates the United States. The deadline for payment of the basic national fee in the United States National Stage was thirty months from the priority date, that is 05 February 2007. The application became abandoned as of midnight on 05 February 2007 for failure to pay the basic national fee.

On 07 February 2007, applicant filed the instant petition for revival accompanied by, *inter alia,* the requisite basic national fee as required by 35 U.S.C. 371(c)(1), a copy of the international application as required by 35 U.S.C. 371(c)(2) (including a Transmittal Letter), PCT application, and a petition fee of $1500.

## DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper reply, (2) the petition fee required by law, (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995). A payment of the basic national fee constitutes a proper reply for entry into the national stage. A proper reply requires payment of the basic

national fee and submission of a copy of the international application, if such a copy has not already been communicated by the International Bureau.

The submission of the national fee and the copy of the international application satisfies 37 CFR 1.137(b)(1). The payment of the petition fee satisfies the requirement under 37 CFR 1.137(b)(2). Applicant's statement in the petition that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3). A terminal disclaimer is not required because the application was filed after 08 June 1995, which satisfies the requirements of 37 CFR 1.137 (b)(4). Therefore, the requirements for a grantable petition under 37 CFR 1.137(b) have been satisfied.

## CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is **GRANTED** as to the National Stage in the United States of America.

Applicant has satisfied the filing requirements under 35 U.S.C. 371.

The application has an international filing date of 05 August 2005 under 35 U.S.C. 363 and a date of 07 February 2007 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.

Newton Edwards
PCT Legal Administration Detailee
Office of PCT Legal Administration
Telephone: 571-272-6094
Facsimile: 571-272-0459

Leonard Smith
Supervisory PCT Legal Examiner
Office of PCT Legal Administration

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PRICE HENEVELD COOPER DEWITT & LITTON, LLP
695 KENMOOR, S.E.
P.O. BOX 2567
GRAND RAPIDS, MI 49501

In re Application of :
Joseph Dendel :
Application No. 11/573,402 : ON PETITION
Filed: February 8, 2007 :
Attorney Docket No. PRI17 P-301

This is a decision on the petition, filed January 7, 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 December 3, 2009 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 3725 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).

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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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JAN 12 2010

In re Application of :
Joseph Dendel :
Application No. 11/573,402 : ON PETITION
Filed: February 8, 2007 :
Attorney Docket No. PRI17 P-301

This is a decision on the petition, filed January 7, 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 December 3, 2009 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 3725 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).

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LEYDIG VOIT & MAYER, LTD
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6731

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Enhui Liu | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7647406 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/12/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/573,428 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 03/15/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **358** 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**
**SUITE 500**
**3000 K STREET NW**
**WASHINGTON, DC 20007**

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OFFICE OF PETITIONS

In re Application of :
**HART,** Terance W. et al. :
Application No. 11/573,451 : DECISION ON PETITION
Filed: February 09, 2007 : TO WITHDRAW
Attorney Docket No. **093286-0144** : 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 15, 2009.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to Foley and Lardner LLP has been revoked by the assignee of the patent application on November 20, 2009. 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: **FANELLI STRAIN & HAAG PLLC**
**1455 PENNSYLVANIA AVE., N.W.**
**SUITE 400**
**WASHINGTON DC 20004**

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14 OCT 2009

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79526
DEMONT & BREYER, LLC
100 Commons Way, Ste. 250
Holmdel, NJ 07733

In re Application of :
BIERTÜMPFEL *et al* :
U.S. Application No.: 11/573,475 :
PCT No.: PCT/EP2005/008507 : **DECISION ON**
Int. Filing Date: 05 August 2005 : **PETITION UNDER**
Priority Date: 10 August 2004 : **37 CFR 1.137(b)**
Docket No.: 9771-029US :
For: METHOD AND APPARATUS FOR :
PRODUCING HYBRID LENSES :

Applicants' petition to revive under 37 CFR 1.137(b) filed on 04 September 2009 is hereby **DISMISSED** without prejudice for the following reason:

The proper response to the Form PCT/DO/EO/905 mailed 19 May 2008 is a declaration in compliance with 37 CFR 1.497(a) and (b) and a $130.00 surcharge fee.

Applicants submitted an executed declaration with the subject petition. However, applicants failed to provide the $130.00 surcharge fee. Moreover, the declaration executed by co-inventor, Bernd Wölfing contains noninitialed changes with regard to his name and is not accepted.

Any changes made in ink must be initialed and dated by the applicant prior to execution of the declaration. The Office will not consider whether noninitialed and/or nondated 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). A new declaration by Mr. Wölfing is required.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a declaration in compliance with 37 CFR 1.497(a) and (b) and a $130.00 surcharge fee must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to timely respond may be considered as an intentional delay.

Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web, by facsimile to (571) 273-0459, or if mailed addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box

1450, Alexandria, Virginia 22313-1450.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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21 JAN 2010

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Holmdel, NJ 07733

In re Application of
BIERTÜMPFEL *et al*
U.S. Application No.: 11/573,475
PCT No.: PCT/EP2005/008507
Int. Filing Date: 05 August 2005
Priority Date: 10 August 2004
Docket No.: 9771-029US
For: METHOD AND APPARATUS FOR PRODUCING HYBRID LENSES

**DECISION ON RENEWED PETITION UNDER 37 CFR 1.137(b)**

Applicants' response filed on 30 November 2009 is treated as a renewed petition to revive under 37 CFR 1.137(b) and is hereby **GRANTED** as follows:

A new declaration executed by co-inventor, Bernd WÖLFING was provided. The declaration is in compliance with 37 CFR 1.497(a) and (b). The $130.00 surcharge fee was also paid. This response satisfies all requirements of 37 CFR 1.137(b).

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 05 August 2005, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 30 November 2009.

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

04 SEP 2009

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45776
DR. REDDY'S LABORATORIES, INC.
200 Somerset Corporate Blvd.
Seventh Floor
Bridgewater, NJ 08807-2862

In re Application of
MEHTA *et al*
U.S. Application No.: 11/573,505
PCT No.: PCT/US2005/028009
Int. Filing Date: 08 August 2005
Priority Date: 09 August 2004
Docket No.: GEN 3.3-021
For: STABILIZED DESLORATADINE COMPOSITION

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

Applicants' petition to revive under 37 CFR 1.137(b) filed on 15 July 2009 is hereby **GRANTED** as follows:

The appropriate fees and the petition fee have been paid. Applicants made 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.

This application is being forwarded to the United States Designated/Elected Office for further processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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19 OCT 2009

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ADAMS INTELLECTUAL PROPERTY LAW
Suite 2350 Charlotte Plaza
201 South College Street
CHARLOTTE NC 28244

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| CURTIS et al | : | |
| Application No.: 11/573,511 | : | |
| PCT No.: PCT/US2005/28947 | : | |
| Int. Filing Date: 12 August 2005 | : | PAPERS FILED |
| Priority Date: 12 August 2004 | : | |
| Attorney's Docket No.: 2974/7US | : | |
| For: SOLENOID VALVE AND METHOD | : | |
| OF ASSEMBLY THEREOF | : | UNDER 37 CFR 1.42 |

This is a decision on the declaration filed 11 September 2009, which has been treated as a request for status under 37 CFR 1.42.

## BACKGROUND

On 09 February 2007, applicants filed 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 28 May 2009, 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." The Notice stated that the above 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 inventors be submitted, applicants submitted on 28 July 2009 an executed declaration.

On 31 August 2009, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) indicating that the oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it: the Oath submitted to USPTO on July 28, 2009 is defective..."

On 11 September 2009, applicants filed another executed declaration, which included 3 separate declarations and one composite declaration in which Linnea M. Hargraves is signing as the executor of the Estate of the deceased co-inventor Donald E. Hargraves.

## DISCUSSION

A review of the application file reveals that the declaration does not comply with 37 C.F.R. §1.63 since both the mailing address of the legal representative and deceased inventor is required.

Because the inventor Donald E. Hargraves is deceased and Linnea M. Hargraves has been appointed as the legal representative for the deceased inventor, 37 C.F.R. §1.497(b)(2) indicates that "[i]f the person making the oath or the declaration or any supplemental or oath or declaration is not the inventor (§§1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state (the inventors citizenship and so on). If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative." (see MPEP § 409.01)

In this instance, it appears applicants have only listed the legal representative's citizenship, residence and mailing address but the citizenship, residence and mailing address of the deceased inventor has not been provided in the declaration as required under 37 C.F.R. §1.63.

Consequently, applicants have not satisfied the requirements under 37 CFR 1.42.

The Notification of Acceptance (Form PCT/DO/EO/903) mailed on 11 September 2009 was in error because applicants filed a defective executed declaration.

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **not accepted**.

The Notification of Acceptance (Form PCT/DO/EO/903) mailed on 11 September 2009 is **VACATED** with the mailing of this decision.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

05 FEB 2010

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FULBRIGHT & JAWORSKI L.L.P.
600 CONGRESS AVE.
SUITE 2400
AUSTIN, TX 78701

| | | |
|---|---|---|
| In re Application of GAUTHIER et al | : | |
| U.S. Application No.: 11/573,518 | : | |
| PCT Application No.: PCT/EP2005/008653 | : | |
| Int. Filing Date: 09 August 2005 | : | DECISION |
| Priority Date Claimed: 11 August 2004 | : | |
| Attorney Docket No.: UGEN:014US | : | |
| For: USE OF PAX4 IN PANCREATIC CELL PROLIFERATION | : | |

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 11 September 2009.

## BACKGROUND

On 09 August 2005, applicant filed international application PCT/EP2005/008653, which claimed priority of an earlier United States application filed 11 August 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 16 February 2006. The thirty-month period for paying the basic national fee in the United States expired on 12 February 2007.

On 09 February 2007, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 02 September 2008, the DO/EO/US mailed a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (Form PCT/DO/EO/922), which indicated that a sequence listing in computer readable form must be submitted.

On 23 December 2008, applicant filed a response which did not include a sequence listing in computer readable form.

On 13 May 2008, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916).

On 16 June 2009, international application PCT/EP2005/008653 became abandoned as to the United States for failure to timely respond to the Notification of Defective Response.

On 11 September 2009, 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.

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 09 August 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 09 February 2007.

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

10 DEC 2008

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THOMPSON COBURN, LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS MO 63101

| | |
|---|---|
| In re Application of BACCHUS et al. | : |
| Application No.: 11/573,533 | : |
| PCT No.: PCT/AU05/01213 | : DECISION ON |
| Int. Filing: 12 August 2005 | : |
| Priority Date: 13 August 2004 | : PETITION |
| Attorney Docket No.: 66225-65532 | : |
| For: METHOD AND APPARATUS FOR FORMING AND FILLING FLEXIBLE PACKAGING | :UNDER 37 CFR 1.47(a) |
| | : |

This is a decision on applicant's Petition Under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office on 06 October 2008.

## BACKGROUND

On 04 August 2008, 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 06 October 2008, applicant filed a response to the 905 along with a petition under 37 CFR 1.47(a) and 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 signature of inventors Richard James Aislabie, Hugh Leslie Hall and Chris Robert Hall, alleging that the inventors refuse to sign the application.

## DISCUSSION

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

Applicant has satisfied Item (1) with the requisite $200 petition fee, charged to applicant's deposit account per his authorization.

With respect to Item (2), copies of the correspondence sent to the respective nonsigning inventors were attached to the petition. The correspondence letter indicated that a complete copy of the application papers including the declaration were enclosed. A Delivery Confirmation-Advice Receipt was provided for inventors Chris Hall and Hugh Hall, an indication that the papers were delivered to them. However, only a "Registered Post-Customer Receipt" for Richard Aislabie was also attached to the petition, which did not indicate that Mr. Aislabie received the papers. Thus, it is not clear that a copy of the application papers, including a declaration, was

delivered to the nonsigning inventor Aislabie. In addition, Petitioner did not provide a first hand statement of facts regarding the non-signing inventors refusal, which is required. *See* MPEP 409.03(d). Item (2) is not yet satisfied.

With regard to Item (3), counsel of record indicates in the petition that the last known address of inventors Richard Aislabie, Chris Hall and Hugh Hall were provided via the correspondence addressed to each inventor and submitted with the petition. If this is incorrect, Petitioner should notify the Office immediately with the correct last known address for each inventor. Item (3) is satisfied.

With regard to Item (4) above, the 37 CFR 1.47(a) applicant submitted a declaration signed by two of the five co-inventors. However, the declaration does not identify inventor Hugh Hall and provide his residence, citizenship and mailing address, as required pursuant to 37 CFR 1.497(a) and (b). Moreover, while the declaration is a three page declaration, the signature pages are marked as Page "1 of 2" and "2 of 2". The declaration appears to be incomplete and is unacceptable as it is improperly executed. A new declaration is required, which identifies the residence, address and citizenship of all of the inventors listed on the published international application, and which is executed by the joint inventors to meet the requirements of 37 CFR 1.497(a) and (b) and 1.47(a)..

Items (2) and (4) above are not satisfied. Thus, Petitioner has not satisfied the requirements of 37 CFR 1.47(a). Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

## CONCLUSION

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

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

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

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3286
Facsimile: (571) 272-0459

9 JUL 2009

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|---|---|
| In re Application of BACCHUS et al. | : |
| Application No.: 11/573,533 | : |
| PCT No.: PCT/AU05/01213 | : DECISION ON |
| Int. Filing: 12 August 2005 | : |
| Priority Date: 13 August 2004 | : PETITION |
| Attorney Docket No.: 66225-65532 | : |
| For: METHOD AND APPARATUS FOR FORMING AND FILLING FLEXIBLE PACKAGING | :UNDER 37 CFR 1.47(a) |

This is a decision on applicant's Renewed Petition Under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office on 06 April 2009. Petitioner's request for a two month extension of time is granted.

## BACKGROUND

On 04 August 2008, 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 06 October 2008, applicant filed a response to the 905 along with a petition under 37 CFR 1.47(a) and 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 signature of inventors Richard James Aislabie, Hugh Leslie Hall and Chris Robert Hall, alleging that the inventors refuse to sign the application.

On 10 December 2008, a decision dismissing the petition was mailed to applicant indicating that a first hand statement of facts regarding the non-signing inventors refusal and a new declaration was required.

## DISCUSSION

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

Applicant previously satisfied Items (1) and (3).

With respect to Item (2), copies of the correspondence sent to the respective nonsigning inventors were attached to the petition. The 16 September 2008 correspondence letter indicated that a complete copy of the application papers including the declaration were enclosed. A

Delivery Confirmation-Advice Receipt was provided for inventors Chris Hall and Hugh Hall, an indication that the papers were delivered to them. A "Registered Post-Customer Receipt" for Richard Aislabie was also attached to the petition. A letter from Australian solicitor Frank Carroll indicated that all three inventors received the application papers. No other response to the correspondence was received. Thus, from this evidence, it can be concluded that these inventors refuse to sign the application papers. Item (2) is satisfied.

With regard to Item (4) above, the 37 CFR 1.47(a) applicant submitted a newly executed declaration signed by two of the five co-inventors, which identifies the residence, address and citizenship of all of the inventors listed on the published international application, and which is executed by the joint inventors to meet the requirements of 37 CFR 1.497(a) and (b) and 1.47(a).

Items (2) and (4) above are now satisfied. Thus, 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

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

The U.S. Designated/Elected Office has accepted the application as a 37 CFR 1.47(a) application using the declarations filed 06 April 2009. The application has an international filing date of 12 August 2005 under 35 U.S.C. 363, and a date of 06 April 2009 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 respective last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3286
Facsimile: (571) 272-0459

9 JUL 2009

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RICHARD AISLABIE
10 HOLMEAD ROAD
EIGHT MILE PLAINS
QUEENSLAND AUSTRALIA 4113

In re Application of BACCHUS et al.
Application No.: 11/573,533
PCT No.: PCT/AU05/01213
Int. Filing: 12 August 2005
Priority Date: 13 August 2004
Attorney Docket No.: 66225-65532
For: METHOD AND APPARATUS FOR FORMING AND FILLING FLEXIBLE PACKAGING

Dear Mr. Aislabie:

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

THOMPSON COBURN, LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS MO 63101

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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CHRIS ROBERT HALL
2/6 BLUEBIRD COURT
GREENBANK
QUEENSLAND, AUSTRALIA 4124

In re Application of BACCHUS et al.
Application No.: 11/573,533
PCT No.: PCT/AU05/01213
Int. Filing: 12 August 2005
Priority Date: 13 August 2004
Attorney Docket No.: 66225-65532
For: METHOD AND APPARATUS FOR FORMING AND FILLING FLEXIBLE PACKAGING

Dear Mr. Hall:

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

THOMPSON COBURN, LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS MO 63101

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HUGH LESLIE HALL
31 FARNE STREET
SUNNYBANK HILLS
QUEENSLAND, AUSTRALIA 4109

In re Application of BACCHUS et al.
Application No.: 11/573,533
PCT No.: PCT/AU05/01213
Int. Filing: 12 August 2005
Priority Date: 13 August 2004
Attorney Docket No.: 66225-65532
For: METHOD AND APPARATUS FOR FORMING AND FILLING FLEXIBLE PACKAGING

Dear Mr. Hall:

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

THOMPSON COBURN, LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS MO 63101

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Church Street Station
New York NY 10008-0770

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| In re Application of | : | |
| Ohsawa, Kenji et al | : | DECISION ON REQUEST TO |
| Application No. 11/573,534 | : | PARTICIPATE IN PATENT |
| Filed: Feb. 9, 2007 | : | PROSECUTION HIGHWAY |
| Attorney Docket No. 09864/0206236-US0 | : | PROGRAM AND PETITION |
| For: HEAT PIPE AND METHOD FOR MANUFACTURING SAME | : | 37 CFR 1.102(d) |

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the renewed petition under 37 CFR 1.102(d), filed Mar. 7, 2008, to make the above-identified application special.

The request and petition are **dismissed**.

A grantable request to participate in the PPH pilot program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
(3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
(4) Examination of the U.S. application has not begun;
(5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
(6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH program and petition met all conditions except Items #2, 5 and 6 above. The request to participate in the PPH pilot program and petition fail to include:
1. A copy of the Japanese language allowed claims,

2. A copy of the Office action issued by the JPO indicating all claims are allowable, and
3. A copy of the IDS listing five documents cited by the JPO examiner. It is noted that the JPO examiner has cited five patent publications or documents, namely, Japanese Unexamined Patent Application Publication No. H11-31768; Japanese Unexamined Patent Application Publication No. 2004-353902; Japanese Unexamined Patent Application Publication No. H11-287578; Japanese Unexamined Patent Application Publication No. S57-28991 and Japanese Unexamined Patent Application Publication No. H11-201671. In the IDS filed on Oct. 15, 2007, there were only two listed. A copy of the missing patent publications or documents and a new IDS Form 1499 are required.

Applicant is given a time period of **ONE MONTH or THIRTY DAYS**, whichever is longer, from the mailing date of this decision to correct the deficiencies. **NO EXTENSION OF TIME UNDER 37 CFR 1.136 IS PERMITTED.** If the deficiencies are not corrected with the time period given, the application will await action in its regular turn.

Response must be filed via EFS-Web. Telephone inquiries concerning this decision should be directed to Henry C. Yuen, at 571-272-4856.

Henry C. Yuen
Special Programs Examiner
Technology Center 3700
Tel: 571-272-4856

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P.O. Box 1450
Alexandria, VA 22313-1450
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P.O. BOX 770
Church Street Station
New York NY 10008-0770

4/22/08

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| In re Application of | : | |
| OHSAWA, KENJI et al | : | DECISION ON REQUEST TO |
| Application No. 11/573,534 | : | PARTICIPATE IN PATENT |
| Filed: Feb. 9, 2007 | : | PROSECUTION HIGHWAY |
| Attorney Docket No. 09864/0206236-US0 | : | PROGRAM AND PETITION |
| For: HEAT PIPE AND METHOD FOR MANUFACTURING SAME | : | 37 CFR 1.102(d) |

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the renewed petition under 37 CFR 1.102(d), filed Apr. 8, 2008, to make the above-identified application special.

The request and petition are **granted**.

A grantable request to participate in the PPH program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
(3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
(4) Examination of the U.S. application has not begun;
(5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
(6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH program and petition comply with the above requirements. Receipt of a copy of the Japanese language allowed claims is acknowledged. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen, at 571-272-4856. All other inquiries concerning the examination or status of the application should be directed to Frantz Jules, SPE of Art Unit 3744, 571-272-6681.

The application is being forwarded to Examiner, Allan Flanigan, for action on the merits commensurate with this decision.

Henry C. Yuen, Special Programs Examiner
Technology Center 3700 – Mechanical Engineering,
Manufacturing and Products
571-272-4856

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11 APR 2008

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SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

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| In re Application of KLIMOV et al | : | |
| U.S. Application No.: 11/573,548 | : | |
| PCT Application No.: PCT/RU2005/000210 | : | |
| Int. Filing Date: 20 April 2005 | : | DECISION |
| Priority Date Claimed: 12 August 2004 | : | |
| Attorney Docket No.: 24816-12602 | : | |
| For: DEVICE FOR BIOMETRICALLY CONTROLLING A FACE SURFACE | : | |

This is in response to applicant's "Petition for Filing on Behalf of Unavailable and/or Nonsigning Inventors Under 37 C.F.R. § 1.47(a)" filed 28 January 2008.

## BACKGROUND

On 20 April 2005, applicant filed international application PCT/RU2005/000210, which claimed priority of an earlier Russian Federation application filed 12 August 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 23 March 2006. The thirty-month period for paying the basic national fee in the United States expired on 12 February 2007.

On 09 February 2007, 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 28 January 2008, 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 inventors. However, the declaration is improper because it fails to list the name of the third inventor as required by 37 CFR 1.497(a)(3).

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

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.
>
> * * *
>
> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Andrey Klimov cannot be found and that joint inventor Artem Yukhin refuses to sign.

With regard to inventor Klimov, applicant attempted to contact Klimov at his residential mailing address, at his business mailing address, at his electronic mail address, and by searching Internet directories (see affidavit of Dohyun Ahn, ¶¶ 2, 3, 5, 6, 9, 11, and 12.) Because all of these attempts to locate Klimov were unsuccessful, it is reasonable to conclude that Klimov cannot be found after diligent effort.

With regard to inventor Yukhin, applicant has adequately demonstrated that a bona fide attempt was made to present a copy of the application papers to Yukhin for signature. In particular, the application papers were sent to Yukhin via FedEx and/or electronic mail on several occasions (see affidavit of Dohyun Ahn, ¶¶ 2, 3, 6, 7, and 15.) Furthermore, applicant has sufficiently demonstrated Yukhin's refusal to sign. In particular, Yukhin's failure to respond to the repeated communications is deemed a constructive refusal to cooperate. Thus, it can be concluded with reasonable certainty that Yukhin 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 addresses of the nonsigning inventors.

## 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 Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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| In re Application of KLIMOV et al | : | |
| U.S. Application No.: 11/573,548 | : | |
| PCT Application No.: PCT/RU2005/000210 | : | |
| Int. Filing Date: 20 April 2005 | : | DECISION |
| Priority Date Claimed: 12 August 2004 | : | |
| Attorney Docket No.: 24816-12602 | : | |
| For: DEVICE FOR BIOMETRICALLY CONTROLLING A FACE SURFACE | : | |

This is in response to applicant's "Renewed Petition for Filing on Behalf of Unavailable and/or Nonsigning Inventors Under 37 C.F.R. § 1.47(a)" filed 21 April 2008.

## BACKGROUND

On 20 April 2005, applicant filed international application PCT/RU2005/000210, which claimed priority of an earlier Russian Federation application filed 12 August 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 23 March 2006. The thirty-month period for paying the basic national fee in the United States expired on 12 February 2007.

On 09 February 2007, 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 28 January 2008, applicant filed a petition under 37 CFR 1.47(a).

On 11 April 2008, this Office mailed a decision dismissing the 28 January 2008 petition.

On 21 April 2008, 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 (2), (3), and (4) above.

With regard to item (1) above, applicant has submitted a substitute copy of the declaration signed by the available inventor on his/her own behalf and on behalf of the nonsigning inventors. Further review of the declaration reveals that the surname of the second inventor is indicated as "Suhovey", while the surname of the second inventor is listed as "Sukhovei" in the published international application.

MPEP 1893.01(e) states in relevant part,

> Where there has been no change of inventorship but the name of an inventor indicated in the international application during the international phase has changed such that the inventor's name is different from the corresponding name indicated in an oath or declaration submitted under 37 CFR 1.497, for example, on account of marriage, then a petition under 37 CFR 1.182 will be required to accept the oath or declaration with the changed name. See MPEP § 605.04(c). However, where the discrepancy between the name of the inventor indicated in the international application during the international phase and the name of the inventor as it appears in the oath or declaration submitted under 37 CFR 1.497 is the result of a typographical or transliteration error, then a petition under 37 CFR 1.182 will not be required. In such case, the Office should simply be notified of the error.

Applicant must specify whether the inventor's name has changed or whether the discrepancy between the name of the inventor indicated in the international application and the name of the inventor as it appears in the declaration is the result of a typographical or transliteration error. If the inventor's name has changed, a petition under 37 CFR 1.182 with the requisite $400.00 petition fee is required. Such petition must be accompanied by a statement signed by the inventor setting forth both names and the procedure whereby the change of name was effected or a copy of the court order. See MPEP 605.04(c).

## CONCLUSION

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

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

available under 37 CFR 1.136(a). 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 Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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| In re Application of KLIMOV et al | : | |
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| Int. Filing Date: 20 April 2005 | : | DECISION |
| Priority Date Claimed: 12 August 2004 | : | |
| Attorney Docket No.: 24816-12602 | : | |
| For: DEVICE FOR BIOMETRICALLY CONTROLLING A FACE SURFACE | : | |

This is in response to applicant's "Renewed Petition for Filing on Behalf of Unavailable and/or Nonsigning Inventors Under 37 C.F.R. § 1.47(a)" filed 16 May 2008.

## BACKGROUND

On 20 April 2005, applicant filed international application PCT/RU2005/000210, which claimed priority of an earlier Russian Federation application filed 12 August 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 23 March 2006. The thirty-month period for paying the basic national fee in the United States expired on 12 February 2007.

On 09 February 2007, 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 28 January 2008, applicant filed a petition under 37 CFR 1.47(a).

On 11 April 2008, this Office mailed a decision dismissing the 28 January 2008 petition.

On 21 April 2008, applicant filed a renewed petition under 37 CFR 1.47(a).

On 23 April 2008, this Office mailed a decision dismissing the 21 April 2008 petition.

On 16 May 2008, applicant filed the present second 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 (2), (3), and (4) above.

With regard to item (1) above, applicant has furnished a declaration signed by the available inventor on his/her own behalf and on behalf of the nonsigning inventors. Further review of the declaration reveals that the surname of the second inventor is indicated as "Suhovey", while the surname of the second inventor is listed as "Sukhovei" in the published international application.

MPEP 1893.01(e) states in relevant part,

> Where there has been no change of inventorship but the name of an inventor indicated in the international application during the international phase has changed such that the inventor's name is different from the corresponding name indicated in an oath or declaration submitted under 37 CFR 1.497, for example, on account of marriage, then a petition under 37 CFR 1.182 will be required to accept the oath or declaration with the changed name. See MPEP § 605.04(c). However, where the discrepancy between the name of the inventor indicated in the international application during the international phase and the name of the inventor as it appears in the oath or declaration submitted under 37 CFR 1.497 is the result of a typographical or transliteration error, then a petition under 37 CFR 1.182 will not be required. In such case, the Office should simply be notified of the error.

The present renewed petition states that the discrepancy between the name of the inventor indicated in the international application and the name of the inventor as it appears in the declaration is the result of a typographical or transliteration error and that the name indicated in the declaration is correct.

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 20 April 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 21 April 2008.

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

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

18 JUN 2008

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

Artem Leonidovich Yukhin
Taganskaya Street 30/2, Apartment 27
Moscow 109004
Russia

In re Application of KLIMOV et al
U.S. Application No.: 11/573,548
PCT Application No.: PCT/RU2005/000210
Int. Filing Date: 20 April 2005
Priority Date Claimed: 12 August 2004
For: DEVICE FOR BIOMETRICALLY CONTROLLING A FACE SURFACE

Dear Artem Leonidovich Yukhin:

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

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

Bryan Lin
PCT Legal Examiner
PCT Legal Office
Telephone: 571-272-3303
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FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041
Attorney Docket No.: 24816-12602

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Andrey Vladimirovish Klimov
Zatonnaya Street 4, Apartment 113
Moscow, 115407
Russia

In re Application of KLIMOV et al
U.S. Application No.: 11/573,548
PCT Application No.: PCT/RU2005/000210
Int. Filing Date: 20 April 2005
Priority Date Claimed: 12 August 2004
For: DEVICE FOR BIOMETRICALLY CONTROLLING A FACE SURFACE

Dear Andrey Vladimirovish Klimov:

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

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

Bryan Lin

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

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041
Attorney Docket No.: 24816-12602

19 NOV 2007

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FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

In re Application of :
KLIMOV, Andrey Vladimirovich et al. :
Application No.: 11/573,550 : DECISION
PCT No.: PCT/RU2005/000160 :
Int. Filing Date: 01 April 2005 : ON PETITION UNDER
Priority Date: 12 August 2004 :
Docket No.: 24816-12603 : 37 CFR 1.47(a)
For: DEVICE FOR CONTACTLESSLY :
CONTROLLING THE SURFACE :
PROFILE OF OBJECTS :

This is a decision on applicants' Petition Under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 31 August 2007.

## BACKGROUND

On 01 April 2005, applicants filed international application no. PCT/RU2005/000160, claiming a priority date of 12 August 2004. A copy of the international application was transmitted to the Office by the International Bureau on 23 March 2006. The deadline for payment of the basic national fee in the United States was 12 February 2007

On 09 February 2007, applicants filed a transmittal letter for entry into the national phase in the United States, accompanied by the basic national fee.

On 04 April 2007, 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 31 August 2007, applicants filed a petition under 37 CFR 1.47(a) accompanied by a declaration of the inventors and 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 after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Item (1) has been met. The petition fee of $200 has been paid.

Item (2) has not been satisfied. The petition must supply proof that applicant refused to sign after being presented with the application papers (specification, including claims, drawings, and oath or declaration). MPEP §409.03(d). It is not clear that either Mr. Klimov or Mr. Yukhin were ever presented with a complete copy of the application papers. The packages to Mr. Yukhin were returned as undeliverable and the packages to Mr. Klimov were delivered to a receptionist at a commercial address. The address provided for an inventor and the address served is supposed to be the last known residential address. If this petition is based on applicants' inability to locate the inventors, applicants must demonstrate a diligent effort to locate. This should include copies of internet searches and a first hand statement of facts supporting a diligent effort to locate.

Item (3) has not been satisfied. The petition lists the last known addresses of non-signing inventor Andrey Vladimirovich Klimov as Zatonnaya Street 4, Apartment 113; Moscow, Russia 115407 and the address of Artem Leonidovich Yukhin as 555 Bryant Street #343; Palo Alto, CA 94301-1704. However, from the statements in the petition, the address listed for Mr. Yukhin is not a residential address. See MPEP 409.03(e) and 609.03.

Item (4) has not been satisfied. It is clear from the emails of Mr. Sergey Vladimirovich Suhovey that he did not feel comfortable executing an English language declaration. He executed the declaration only after presentation with a Russian translation of the English document. As such, Mr. Suhovey's declaration is the English language document with the Russian translation. The complete copy of the declaration as executed by Mr. Suhovey must be returned to the Office. Further, under 37 CFR 1.69, a statement that the Russian is an accurate translation of the English must be provided if the Russian provided was other than a USPTO form. If applicant is not in possession of the complete declaration, as executed by the inventor, then the inventor needs to re-execute the declaration and the complete copy must then be returned to the Office. Additionally, some of the required declaration language has been cut off in the copy that applicants furnished to the Office. A complete copy of the declaration executed by the inventor with all of its text is required or a new declaration of the inventor is required. If the foreign language is not a USPTO form, a translation statement must accompany the submission.

## 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 under 37 CFR 1.136(a) are available. 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 may be filed via EFS-Web or if mailed, 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

17 MAR 2008

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801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

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|---|---|
| In re Application of | |
| KLIMOV, Andrey Vladimirovich et al. | |
| Application No.: 11/573,550 | DECISION |
| PCT No.: PCT/RU2005/000160 | |
| Int. Filing Date: 01 April 2005 | ON PETITION UNDER |
| Priority Date: 12 August 2004 | |
| Docket No.: 24816-12603 | 37 CFR 1.47(a) |
| For: DEVICE FOR CONTACTLESSLY CONTROLLING THE SURFACE PROFILE OF OBJECTS | |

This is a decision on applicants' Petition Under 37 CFR 1.47(b), filed in the United States Patent and Trademark Office (USPTO) on 15 January 2008.

## BACKGROUND

On 19 November 2007, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicant's petition without prejudice.

On 15 January 2008, applicant filed this renewed petition, but this time 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 nonsigning applicant.

Item (1) was previously satisfied.

Item (2) has been satisfied as to Mr. Yukhin and Mr. Klimov. While reviewing the 379 page document that applicant provided in support of this petition, a copy of the declaration executed by Mr. Suhovey, without missing text, was located. Applicant has provided a Russian translation and a statement that the Russian is an accurate translation of the English, however, applicant does not state that the translation furnished is the one furnished to Mr. Suhovey when he executed the declaration on 29 August 2007. The certificate is substantially later than his

signing of the declaration. The translation furnished to Mr. Suhovey for the execution of the declaration and a statement that it is an accurate translation are required. If the translation furnished is the one in the file, then a statement to that effect is sufficient.

Item (3) has been satisfied. The petition lists the last known addresses of non-signing inventor Andrey Vladimirovich Klimov as Zatonnaya Street 4, Apartment 113; Moscow, Russia 115407 and the address of Artem Leonidovich Yukhin as Taganskaya Street 30/2, Apartment 27; Moscow, Russia 109004.

Item (4) has not been satisfied as a copy of the translation furnished to Mr. Suhovey is still outstanding and a 37 CFR 1.69 statement is required if one for the translation has not yet been furnished.

## 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 under 37 CFR 1.136(a) are available. 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 may be filed via EFS-Web or if mailed, 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

0 3 JUN 2008

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801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

| | |
|---|---|
| In re Application of | |
| KLIMOV, Andrey Vladimirovich et al. | |
| Application No.: 11/573,550 | DECISION |
| PCT No.: PCT/RU2005/000160 | |
| Int. Filing Date: 01 April 2005 | ON PETITION UNDER |
| Priority Date: 12 August 2004 | |
| Docket No.: 24816-12603 | 37 CFR 1.47(a) |
| For: DEVICE FOR CONTACTLESSLY CONTROLLING THE SURFACE PROFILE OF OBJECTS | |

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 28 March 2008.

## BACKGROUND

On 17 March 2008, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicant's petition without prejudice.

On 28 March 2008, applicant filed this renewed petition.

## DISCUSSION

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

Item (1), (2) and (3) were previously satisfied. The last known address of non-signing inventor Andrey Vladimirovich Klimov is Zatonnaya Street 4, Apartment 113; Moscow, Russia 115407 and the address of Artem Leonidovich Yukhin is Taganskaya Street 30/2, Apartment 27; Moscow, Russia 109004.

Item (4) has now been satisfied.

## CONCLUSION

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

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the 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 **15 January 2008**.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

0 3 JUN 2008

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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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Andrey Vladimirovich Klimov
Zatonnaya Street 4, Apartment 113
Moscow 115407
Russia

In re Application of
KLIMOV, Andrey Vladimirovich et al.
Application No.: 11/573,550
PCT No.: PCT/RU2005/000160
Int. Filing Date: 01 April 2005
Priority Date: 12 August 2004
Docket No.: 24816-12603
For: DEVICE FOR CONTACTLESSLY CONTROLLING THE SURFACE PROFILE OF OBJECTS

Dear Mr. Klimov:

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

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

03 JUN 2008

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Artem Leonidovich Yukhin
Taganskaya Street 30/2, Apartment 27
Moscow 109004
Russia

In re Application of
KLIMOV, Andrey Vladimirovich et al.
Application No.: 11/573,550
PCT No.: PCT/RU2005/000160
Int. Filing Date: 01 April 2005
Priority Date: 12 August 2004
Docket No.: 24816-12603
For: DEVICE FOR CONTACTLESSLY CONTROLLING THE SURFACE PROFILE OF OBJECTS

Dear Mr. Yukhin:

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

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

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Date Mailed: December 22, 2008

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW CA 94041

Applicant: Klimov et al.
Appl. No.: 11/573,550
Filing Date: January 15, 2008
Title: DEVICE FOR CONTACTLESSLY CONTROLLING THE SURFACE PROFILE OF OBJECTS
Attorney Docket No.: 24816-12603
Pub. No.: US 2008/0266409 A1
Pub. Date: October 30, 2008

This is a decision on the request for republication of patent application publication under 37 CFR 1.221(a), filed on December 18, 2008, for the above-identified application.

The request under 37 CFR 1.221(a) is DISMISSED.

37 CFR 1.221(a) requires "a copy of the application in compliance with the Office 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.

The applicant did not supply a copy of the application in compliance with the Office electronic filing system, as required by 37 CFR 1.221(a) because **the Applicant submitted the papers as a "Document for an existing application", which are entered into the application file, and not as a "Pre-Grant Publication" submission**. The request for republication does not comply with the electronic filing system requirements, thus republication will not take place.

Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system, **as a Pre-Grant publication submission.** The applicant is directed to the following website for additional instructions on how to submit a Pre-Grant Publication submission via the electronic filing system:

http://www.uspto.gov/ebc/portal/efs/pgpub_quickstart.pdf

Any questions or requests 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

Telephone inquiries regarding this correspondence should be directed to The Office of Data Management at 571-272-4200.

Tammy J. Koontz
Program & Management Analyst
Office of Data Management

Adjustment date: 12/23/2008 KKING1
12/19/2008 INTEFSW 00006655 192555 11573550
01 FC:1504 300.00 CR

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26 NOV 2007

BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD MI 48075

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| In re Application of | : | |
| Balogh | : | |
| Application No.: 11/573,566 | : | |
| PCT No.: PCT/HU05/00057 | : | |
| Int. Filing Date: 25 May 2005 | : | DECISION |
| Earlier Priority Date: 26 May 2004 | : | |
| Attorney Docket No.: SBGK0106PUSA | : | |
| For: Method And Apparatus For Generating 3D Images | : | |

The petition to revive under 37 CFR 1.137(b) filed on 12 February 2007 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 for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of the basic national fee, and has paid the petition 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 forwarded to the Office of Patent Application Processing for further processing. The date of this application under 35 U.S.C. 371(c)(1), (2) and (4) is **12 February 2007**.

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

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12 SEP 2007

ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR 1-C-11
PLANO TX 75024

In re Application of :
SVENSSON et al. :
Application No.: 11/573,604 : DECISION ON PETITION
PCT No.: PCT/SE04/01130 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 13 July 2004 :
Priority Date: None :
Attorney Docket No.: P19417-US1 :
For: A LOW PROFILE ANTENNA

The petition to revive under 37 CFR 1.137(b) filed 12 February 2007 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
Fax: (571) 273-0459

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Paper No.

SENNIGER POWERS LLP (SGM)
100 NORTH BROADWAY
17TH FLOOR
ST. LOUIS MO 63102

MAILED

JUL 01 2010

OFFICE OF PETITIONS

In re Application of :
Potyen et al. : DECISION ON APPLICATION
Application No. 11/573,608 : FOR
Filed: March 20, 2008 : PATENT TERM ADJUSTMENT
Docket No. ALD 1033.2 :
Title: STABILIZED BORANE- :
TETRAHYDROFURAN COMPLEX :

This is a decision on the "REQEUST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR § 1.705," filed February 2, 2010. Applicants request that the patent term adjustment indicated on the initial determination of patent term adjustment be corrected from zero (0) days to two hundred and twenty-nine (229) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **two hundred and twenty-nine (229)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On January 4, 2010, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants were advised that the patent term adjustment to date is 0 days. On February 2, 2010, Applicants timely[1] filed the present application for patent term adjustment. Applicants dispute the Office's failure to accord an adjustment of 229 days pursuant to 37 CFR 1.703(a)(1).

[1] Office records show that the Issue Fee payment was received on February 2, 2010.

Applicants state that any patent issuing from the application is not subject to a terminal disclaimer.[2]

37 CFR 1.703(a)(1) states that the term of an original patent shall be adjusted by the failure of the Office to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. 371 in an international application.

The application history has been reviewed and it has been determined that Applicants are correct in stating that 229 days of Office delay should have been accorded. Pursuant to the Notice of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495 that was mailed on July 30, 2008, this application fulfilled the requirements of 35 U.S.C. 371 in an international application on March 20, 2008. The Office mailed a first-action allowance 229 days later on January 4, 2010, resulting in 229 days of examination delay.

The adjustment of 0 days has been removed, and an adjustment of 229 days has been entered.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is two hundred and twenty-nine (229) days (229 days of Office delay minus 0 days of Applicant delay).

Submission of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

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.

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[2] Petition, page 2.

Telephone inquiries regarding this matter should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of updated PAIR screen

Day : Wednesday

# PALM INTRANET

Date: 6/30/2010
Time: 08:31:51

| PTA Calculations for Application: 11/573608 | | | |
|---|---|---|---|
| Application Filing Date: | 03/20/2008 | PTO Delay (PTO): | 0 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 0 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 229 |
| PTO Delay Adjustment: | 229 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 40 | 06/30/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 229 | | |
| 29 | 01/04/2010 | MAIL NOTICE OF ALLOWANCE | | | |
| 28 | 12/29/2009 | ISSUE REVISION COMPLETED | | | |
| 27 | 12/29/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 26 | 12/29/2009 | DOCUMENT VERIFICATION | | | |
| 25 | 12/29/2009 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 24 | 12/29/2009 | NOTICE OF ALLOWABILITY | | | |
| 18 | 11/07/2008 | EMAIL NOTIFICATION | | | |
| 17 | 11/06/2008 | PG-PUB ISSUE NOTIFICATION | | | |
| 16 | 10/16/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 15 | 10/08/2008 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 14 | 03/20/2008 | PRELIMINARY AMENDMENT | | | |
| 13 | 05/09/2008 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | | |
| 11 | 08/18/2008 | APPLICATION DISPATCHED FROM OIPE | | | |
| 10 | 07/30/2008 | EMAIL NOTIFICATION | | | |
| 9 | 07/30/2008 | EMAIL NOTIFICATION | | | |
| 8 | 03/20/2008 | 371 COMPLETION DATE | | | |
| 7 | 07/29/2008 | SENT TO CLASSIFICATION CONTRACTOR | | | |
| 6 | 07/30/2008 | FILING RECEIPT | | | |
| 5 | 07/30/2008 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 4 | 07/25/2008 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 3 | 03/20/2008 | CLEARED BY OIPE CSR | | | |
| 2 | 03/20/2008 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |

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## EXPLANATION OF PTA CALCULATION

## EXPLANATION OF PTE CALCULATION

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Date Mailed : 12-28-2009

Patent No.: 7,608,789 B2
Patent Issued : October 27, 2009
Inventor( s) Hans Kureger
Application No.: 11/573,610

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 1.322or 1.323.

The alleged errors in col. 8, line 41 & 48 is printed in accordance with the record.

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

However, further consideration will be given upon receipt of a request for reconsideration directed to Decisions & Certificates of Correction Branch.

A certificate of correction will issue to correct the remaining error noted in your request.

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

Lindsie Cahill
Fish & Richardson
P.O. Box 1022
Minneapolis, MN 55440-1022

ej

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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 NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/573,635 | 02/12/2007 | Takeshi Niitani | 20241/0206270-US0 | 3806 |

7278 7590 07/17/2009

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

| EXAMINER | |
|---|---|
| HU, HENRY S | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1796 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 07/17/2009 | 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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wk

Mailed: JUL 17 2009

In re application of :
Niitani et al. : DECISION ON
Serial No. 11/573,635 : PETITION
Filed: 02/12/2007 :
For: Multibranched Polymer And Method For Producing The Same

This is a decision on a PETITION filed March 30, 2009, 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 1700 for consideration.

**DECISION**

Petitioner requests that the information disclosure statement submitted on February 12, 2007 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 images will be removed from the Official file.

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

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

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DIRECTORS OFFICE
DEC 11 2007
TECHNOLOGY CENTER 2800

**Fitzpatrick, Cella, Harpter & Scinto**
**30 Rockefeller Plaza**
**New York, NY 10112**

| | | |
|---|---|---|
| **In re Application of** | : | **DECISION ON REQUEST TO** |
| **Tsuyoshi MUTO** | : | **PARTICIPATE IN PATENT** |
| **Application No. 11573655** | : | **PROSECUTION HIGHWAY** |
| **Filed: February 13, 2007** | : | **PILOT PROGRAM AND PETITION** |
| **Attorney Docket No. 03500.519365** | : | **TO MAKE SPECIAL UNDER** |
| **For: IMAGE FORMING DEVICE, CONTROL METHOD OF IMAGE FORMING DEVICE, PROGRAM FOR ACHIEVING CONTROL METHOD, AND STORAGE METHOD FOR STORING PROGRAM** | : | **37 CFR 1.102(d)** |

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) pilot program and the petition under 37 CFR 1.102(d), filed October 17, 2007, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH pilot program and petition to make special require:

(1) The U.S. application to validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO, or a national stage application under PCT which validly claims priority under 35 U.S.C. 119(a)/365(b) to one or more applications filed in the JPO;
(2) A copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof, and a statement that the English translation is accurate;
(3) All the claims in the U.S. application to sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
(4) Examination of the U.S. application has not begun;
(5) A copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof, and a statement that the English translation is accurate;
(6) An IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
(7) The required petition fee under 37 CFR 1.17(h).

Please note, regarding item (2), on page five of the English Translation of the Allowed Claims in JP Application Number 2004-299074, Claim 19, line 1, there is a comment in the right margin in

a box which states "Deleted: A". This has been interpreted as an extraneous comment that is not part of the translated claims.

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Christine Oda at 571-272-1602.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://www.uspto.gov/ebc/index.html.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

/C. Oda/
Christine Oda
TQAS
Technology Center 2800 - Semiconductors,
Electrical & Optical Systems & Components

30 APR 2007

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Richard P. Ferrara
FISH & RICHARDSON, P.C.
P.O. BOX 1022
Minneapolis MN 55440-1022

| | | |
|---|---|---|
| In re Application of: | : | |
| SAFFORD, Timothy E. | | |
| Application No.: 11/573,700 | : | DECISION |
| PCT Application No.: PCT/US05/14061 | : | |
| Int. Filing Date: 25 April 2005 | : | UNDER |
| Priority Date: 23 April 2004 | : | |
| Atty Docket No.: 16785-008US1 | : | |
| For: LIGHTING FIXTURE ADAPTER | : | 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 C.F.R 1.137(b) " filed 14 February 2007, which has been treated as a petition under 37 C.F.R. 1.137(b).

## BACKGROUND

On 25 April 2005, applicant filed international application PCT/US2005/014061, which designated the U.S. and claimed priority date of 23 April 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 23 October 2006. Accordingly, PCT/ US2005/014061 became abandoned as to the United States of America at midnight of 23 October 2006 for failure to timely pay the Basic National Fee.

On 14 February 2007, applicant filed a submission for entry into the national stage in the United States, which was accompanied by, *inter alia*, the U.S. Basic National Fee, an English translation and a petition under 37 CFR 1.137(b).

## DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required).

Regarding item (1), applicant has provided the required reply.

Regarding item (2), applicant has provided the required petition fee.

Regarding 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 noted above, petition to revive under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application.

Bena Miller
Detailee PCT Legal Examiner
Office of PCT Legal Administration

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

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OFFICE OF PETITIONS

SALIWANCHIK LLOYD & SALIWANCHIK
A PROFESSIONAL ASSOCIATION
PO Box 142950
GAINESVILLE FL 32614

In re Application of
Timothy E. Safford et al.
Application No. 11/573,700
Filed: January 31, 2008
Attorney Docket No. 16785-008US1

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed October 5, 2009.

The request is **NOT APPROVED**.

The request cannot be approved because the address is neither the first named inventor nor the assignee of record.

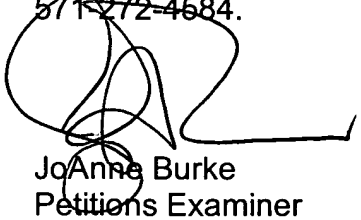
The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71* or, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

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

Telephone inquiries concerning this decision should be directed to JoAnne Burke at 571-272-4584.



JoAnne Burke
Petitions Examiner
Office of Petitions

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OFFICE OF PETITIONS

SALIWANCHIK LLOYD & SALIWANCHIK
A PROFESSIONAL ASSOCIATION
PO Box 142950
GAINESVILLE FL 32614

In re Application of
Timothy E. Safford et al.
Application No. 11/573,700
Filed: January 31, 2008
Attorney Docket No. 16785-008US1

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 CFR § 1.36(b), filed January 26, 2010.

The request is **NOT APPROVED**.

The request cannot be approved because petitioner still has not provided a proper change of correspondence address and the requested change in the correspondence address is improper.

As stated in the previous decision mailed on November 18, 2009, the Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71,* or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> ***An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.***

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the 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).

Therefore, as there is currently no Statement under 37 CFR 3.73(b) with the current assignee information of record in the instant application, the Office cannot change the correspondence address to the address on the Request to Withdraw at this present time.

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

Telephone inquires concerning this decision should be directed to JoAnne Burke at 571-272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

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A PROFESSIONAL ASSOCIATION
PO Box 142950
GAINESVILLE FL 32614

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JUN 0 3 2010

OFFICE OF PETITIONS

In re Application of
Timothy E. Safford et al.
Application No. 11/573,700
Filed: January 31, 2008
Attorney Docket No. 16785-008US1

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 CFR § 1.36(b), filed April 13, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office 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. Saliwanchik on behalf of all attorneys of record who are associated with Customer Number 23557.

All attorneys/agents associated with Customer Number 23557 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the assignee "Beeman Holdings, Inc." at the address list listed in the request.

There is an outstanding Office action mailed February 24, 2010, that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4584.

/JoAnne Burke/
JoAnne Burke
Petitions Examiner
Office of Petitions

cc: BEEMAN HOLDINGS, INC.
1734 APEX ROAD
SARASOTA, FL 34240

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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18 MAY 2007

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

In re Application of :
BEEMAN et al. :
Application No.: 11/573,702 : DECISION ON PETITION
PCT No.: PCT/US05/21600 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 17 June 2005 :
Priority Date: 18 June 2004 :
Attorney Docket No.: 16785-009US1 :
For: LIGHTED ARTWORK HOLDER

The petition to revive under 37 CFR 1.137(b) filed 14 February 2007 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "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

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

United States Patent and Trademark Office

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26 NOV 2007

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

| | | |
|---|---|---|
| In re Application of | : | |
| Uccello | : | |
| Application No.: 11/573,706 | : | |
| PCT No.: PCT/US05/24964 | : | |
| Int. Filing Date: 14 July 2005 | : | DECISION |
| Earlier Priority Date: 15 July 2004 | : | |
| Attorney Docket No.: 15894-004US1 | : | |
| For: Beadless Signage System And Method | : | |

The petition to revive under 37 CFR 1.137(b) filed on 14 February 2007 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 for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of the basic national fee, and has paid the petition 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 forwarded to the Office of Patent Application Processing for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

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

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KLARQUIST SPARKMAN, LLP
121 S.W. SALMON STREET
SUITE #1600
PORTLAND, OR 97204-2988

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Shari M. Ling | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7662573 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/573,711 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/14/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **276** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 5/19/10 **Paper No.:** —

**TO SPE OF** : ART UNIT 1634

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 11/573711 Patent No.: 7662573B2

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**

Virginia Tolbert
**Certificates of Correction Branch**
571-272-0460

**Thank You For Your Assistance**

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

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

**Comments:** _____

/Dave Nguyen/
SPE AU 1634

6/17/2010

UNITED STATES PATENT AND TRADEMARK OFFICE

09 MAR 2009

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Tessera/FotoNation
Patent Legal Dept.
3025 Orchard Parkway
San Jose CA 95134

In re Application of :
CORCORAN et al. :
Application No.: 11/573,713 :
PCT No.: PCT/EP06/08229 :
Int. Filing Date: 21 August 2006 : DECISION
Priority Date: 14 February 2006 :
Attorney Docket No.: FN-119US :
For: FOREGROUND/BACKGROUND :
SEGMENTATION IN DIGITAL IMAGES :

This is a decision on applicant's response to Notification of Missing Requirements filed 03 November 2008 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 14 February 2007, applicant filed a transmittal letter requesting entry into the United States National stage under 35 U.S.C. 371 along with the basic national fee. Applicant also filed two executed declarations.

On 16 September 2008, the United States Designated/Elected Office mailed a Notification of Missing Requirements (PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b).

On 03 November 2008, applicant filed the instant response.

## DISCUSSION

At the outset, it is noted that the Notification of Missing Requirements indicates that the declarations are unacceptable as submitted because the declarations identify inventors who were not named as applicant/inventors in the published international application.

A review of the published international application PCT/EP06/08229 reveals that Peter Corcoran, Adrian Capata, Eran Steinberg and Petronel Bigioi are named applicant/inventors. The declaration submitted on 14 February 2007 identified Mihai Cluc, Adrian Xamfir, Adrian Capata, Peter Corcoran and Eran Steinberg as the joint inventors. Applicant did not provide a Notification of the Recording of A Change (Form PCT/IB/306) issued by the International Bureau adding Mihai Cluc and Adrian Xamfir and deleting Petronel Bigioi as applicant/inventors under PCT Rule 92*bis*. In lieu of the Form 306, applicant must file a petition under 37 CFR 1.497(d).

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in 37 CFR §1.17(i); and (3) if an assignment has been

executed by any of the original named inventors, the written consent of the assignee(s) (See 37 CFR 3.73(b)).

The declaration executed by Mihai Cluc and Adrian Xamfir in the above referenced application is unacceptable and is not in compliance with 37 CFR 1.497(a) and (b) at this time.

Applicant must file a declaration in compliance with 37 CFR 1.497(a) and (b) identifying the inventors as listed in the international application. To meet this requirement, applicant may submit the Notification of the Recording of A Change (Form PCT/IB/306) issued by the International Bureau adding Mihai Cluc and Adrian Xamfir and deleting Petronel Bigioi as applicant/inventors under PCT Rule 92*bis*. Or Applicant may file a petition under 37 CFR 1.497(d) to add Mihai Cluc and Adrian Xamfir and deleting Petronel Bigioi as inventors in the above-captioned application.

## CONCLUSION

The declaration executed by Mihai Cluc and Adrian Xamfir in the above referenced application is unacceptable and is not in compliance with 37 CFR 1.497(a) and (b) at this time.

Applicant must file a declaration in compliance with 37 CFR 1.497(a) and (b). To meet this requirement, applicant may submit the Notification of the Recording of A Change (Form PCT/IB/306) issued by the International Bureau adding Mihai Cluc and Adrian Xamfir and deleting Petronel Bigioi as applicant/inventors under PCT Rule 92*bis*.

In the alternative, applicant may file a petition under 37 CFR 1.497(d) to add Mihai Cluc and Adrian Xamfir and deleting Petronel Bigioi as inventors in the above-captioned application.

Any reconsideration must be filed within ONE (1) MONTH from the mail date of this decision or in the time remaining, as set forth in the FORM PCT/DO/EO/905.

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 PCT Legal Office.

Cynthia M. Kratz
Attorney-Advisor
Office of PCT Legal Administration
Tel.: (571) 272-3286
Fax: (571) 273-0459

9 JUN 2009

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Patent Legal Dept.
3025 Orchard Parkway
San Jose CA 95134

In re Application of :
CORCORAN et al. :
Application No.: 11/573,713 :
PCT No.: PCT/EP06/08229 :
Int. Filing Date: 21 August 2006 : DECISION
Priority Date: 14 February 2006 :
Attorney Docket No.: FN-119US :
For: FOREGROUND/BACKGROUND :
SEGMENTATION IN DIGITAL IMAGES :

This is a decision on applicant's Response to Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Elected Office (DO/EO/US) filed 09 March 2009 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 14 February 2007, applicant filed a transmittal letter requesting entry into the United States National stage under 35 U.S.C. 371 along with the basic national fee. Applicant also filed two executed declarations.

On 16 September 2008, the United States Designated/Elected Office mailed a Notification of Missing Requirements (PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b).

On 03 November 2008, applicant filed a response with explanation.

On 09 March 2009, a decision was mailed to applicant indicating, *inter alia*, that a petition under 37 CFR 1.497(d) was required to add or delete inventors.

On 09 April 2009, applicant filed the instant petition under 37 CFR 1.497(d).

## DISCUSSION

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added or being deleted as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s) (See 37 CFR 3.73(b)).

Petitioner provided the statements of Mihai Ciuc and Adrian Zamfir to be added as inventors to the above referenced application and the statement of Petronel Bigioi, the inventor to be deleted, in support of the correction of inventorship under 37 CFR 1.497(d). Applicant also filed executed declarations. A review of the application file reveals that the petition fee of $130

was charged to applicant's deposit account per his authorization. Applicant also submitted the written consent of the assignee to add Mihai Ciuc and Adrian Zamfir and to delete Petronel Bigioi as inventors.

With regard to applicant's petition, applicant satisfied the requirements of 37 CFR 1.497(d) and met all of the requirements to add Mihai Ciuc and Adrian Zamfir and to delete Petronel Bigioi as inventors in the above-identified international application.

The declarations filed on 09 April 2009 meet the requirements of 37 CFR 1.497(a) and (b) as the declaration identifies the application, all the inventors and provides their respective citizenship, residency and mailing address.

## CONCLUSION

Applicant's petition under 37 CFR 1.497(d) to add Mihai Ciuc and Adrian Zamfir and to delete Petronel Bigioi as inventors 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 09 April 2009.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

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

MAILED

MAY 21 2009

OFFICE OF PETITIONS

In re Application of :
Christopher Allan Parr et al :
Application No. 11/573,732 : DECISION DISMISSING PETITION
Filed: February 15, 2007 : UNDER 37 CFR 1.313(a)
Attorney Docket No. PB61014USW :

This is a decision on the petition filed May 20, 2009, which is being treated as a petition under 37 CFR 1.313(a), requesting withdrawal of the above-identified application from issue.

The petition is **dismissed** as moot for the reasons stated below.

A review of the file record discloses that a Notice of Allowance and Fee(s) Due was mailed on March 5, 2009, with the issue fee being due on or before June 5, 2009. The issue fee in this case has not been paid.

The filing of a petition under 37 CFR 1.313(a) is unnecessary, since the mere filing of an RCE and submission will effectively withdraw an application from issue prior to payment of the issue fee. In view thereof, the petition to withdraw from issue is dismissed as involving a moot issue. *Note* MPEP §§ 706.07(h)(IX) and 1308.

Inquiries concerning this decision may be directed to Irvin Dingle at (571) 272-3210.

The matter is being referred to Technology Center AU 1624 for appropriate processing of the RCE filed May 20, 2009, and for consideration of the concurrently filed Information Disclosure Statement.

/Irvin Dingle/
Irvin Dingle
Petitions Examiner
Office of Petitions

07 APR 2008

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Alexandria, VA 22313-1450
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Andrea Q. Ryan
Sanofi-Aventis U.S. LLC
1041 Route 202-206
Mail Code: D303A
Bridgewater, NJ 08807

In re Application of :
VOLLERT et al. :
Application No.: 11/573,762 : DECISION ON REQUEST
PCT No.: PCT/EP05/08660 :
Int. Filing Date: 10 August 2005 :
Priority Date: 19 August 2004 :
Attorney Docket No.: DEAV2004/0052 US PCT :
For: PROCESS FOR IDENTIFICATION OF COMPOUNDS FOR MODULATING THE ACTIVITY OF SODIUM/CALCIUM EXCHANGE TRANSPORTER

This decision is issued in response to applicant's Petition to Correct Inventorship under 37 CFR 1.497(d) filed 16 January 2008.

## BACKGROUND

On 10 August 2005, applicant filed international application PCT/EP05/08660 which claimed a priority date of 19 August 2004. The published international application identified four applicant/inventors for the United States: Henning Vollert; Sven Geibel; Bela Kelety; and Wolfgang Doerner. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 19 February 2007.

On 15 February 2007, 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; a copy of the international application; a preliminary amendment; and an application data sheet.

On 18 July 2007, the United Stated Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. Furthermore, the Notification stated that a sequence listing in computer readable form had not been submitted as required by 37 CFR 1.821-1.825. The notification set a two-month time limit in which to respond.

On 16 January 2008, applicant filed a request under 37 CFR 1.497(d).

## DISCUSSION

The present submission seeks to correct the inventorship so as to add inventor Andreas Haase; Natalie Watzke; and Kerstin Diekert to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), 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; 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.

Applicant has satisfied items (1); (2); and (4).

In regards to item(3) above, applicant has provided a Statement under 37 CFR 3.73(b) which sufficiently identifies the above identified application, however, a review of the "Consent of Assignee to Change in Inventorship in a Patent Application under 37 CFR 1.497(d)(3)" filed on 16 January 2008 reveals that the consent to add Andreas Haase; Natalie Watzke; and Kerstin Diekert is defective. The consent of assignee does not list the name or title of the individual signing on behalf of Sanofi-Aventis Deutschland Gmbh. Therefore, applicant is requested to file an additional written consent of the assignee that provides the name and title of the individual acting on behalf of the assignee.

## CONCLUSION

Applicant's request to add inventor Andreas Haase; Natalie Watzke; and Kerstin Diekert under 37 CFR 1.497(d) is **DISMISSED** without prejudice. The inventors of record remain the inventors named on the international application.

Applicant must file a proper response to this decision within **TWO (2) MONTHS** from the mail date indicated above. A proper response must include a written consent of assignee in compliance with 37 CFR 3.73(b).

Failure to file a timely and proper response will result in abandonment of the application. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, 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.

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

0 9 MAY 2008

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Andrea Q. Ryan
Sanofi-Aventis U.S. LLC
1041 Route 202-206
Mail Code: D303A
Bridgewater, NJ 08807

In re Application of :
VOLLERT et al. :
Application No.: 11/573,762 :
PCT No.: PCT/EP05/08660 :
Int. Filing Date: 10 August 2005 : DECISION ON REQUEST
Priority Date: 19 August 2004 :
Attorney Docket No.: DEAV2004/0052 US PCT :
For: PROCESS FOR IDENTIFICATION OF COMPOUNDS FOR MODULATING THE ACTIVITY OF SODIUM/CALCIUM EXCHANGE TRANSPORTER

In a decision mailed by this Office on 07 April 2008, applicants' request to correct inventorship was dismissed without prejudice for failure to satisfy all the requirements of 37 CFR 1.497(d). Specifically, applicants had not provided the required consent of the assignee to the requested change in inventorship.

On 30 April 2008, applicants filed the renewed request under 37 CFR 1.497(d) considered herein. The submission included the consent of the assignee to the requested correct of inventorship, in the form required under 37 CFR 1.497(d)(3) and 3.73(b).

Applicants' request to correct inventorship under 37 CFR 1.497(d) is **GRANTED**. The inventorship herein is corrected to add Andreas Haase; Natalie Watzke; and Kerstin Diekert as additional inventors of record.

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.

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

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OCCHIUTI ROHLICEK & TSAO, LLP
10 FAWCETT STREET
CAMBRIDGE MA 02138

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OFFICE OF PETITIONS

Applicant: Dahyabhai
Appl. No.: 11/573,763
International Filing Date: August 10, 2005
Title: SAFER CAR
Attorney Docket No.: 46101-002US1
Pub. No.: US 2008/0054654 A1
Pub. Date: March 6, 2008

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on May 6, 2008, for the above-identified application.

The request is DISMISSED as moot.

Since the application has been abandoned, the request is deemed moot.

Inquiries relating to this matter may be directed to Michael Cygan, Legal Advisor, at (571) 272-7700, or the undersigned at (571) 272-7709.

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

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14 MAR 2007

BROOKS KUSHMAN P.C.
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD MI 48075

In re Application of:
CARMEL, Sharon
U.S. Application No.: 11/573,794
PCT No.: PCT/IL2005/000889
International Filing Date: 16 August 2005
Priority Date: 16 August 2004
Atty Docket No.: REIN0102PUSA
For: A SYSTEM AND METHOD FOR THE SYNCHRONIZATION OF DATA ACROSS MULTIPLE COMPUTING DEVICES

DECISION ON REFUND REQUEST

This decision is issued in response to the "Request For Refund Under 37 CFR 1.28(a)" filed 08 March 2007. No petition fee is required.

## BACKGROUND

On 16 August 2005, applicant filed international application PCT/IL2005/000889. The international application claimed a priority date of 16 August 2004, and it designated the United States. On 23 February 2006, the International Bureau (IB) communicated a copy of the international application to the United States Patent And Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 16 February 2007.

On 16 February 2007, applicant filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of $1,840 in large entity fees. The materials filed 16 February 2007 did not include an assertion of small entity status.

On 08 March 2007, applicant filed the request for refund considered herein.

## DISCUSSION

Pursuant to 37 CFR 1.28(a), a refund of a portion of large entity fees timely paid in full prior to establishing small entity status "may be obtained if an assertion [of small entity status] under 37 CFR 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."

In the present application, applicant' 16 February 2007 submission included payment of $1,840 in total fees: $300 basic national fee, $100 search fee, $200 examination fee, $1,200 for claims in excess of twenty, and $40 for recordation of an assignment. Except for the $40 recordation fee, these fees are all large entity fees that are reduced by half for small entities.

In the present refund request, applicant states that "a copy of the statement claiming small entity status in this application" is attached; based thereon, applicant requests a refund of $600 from the purported $1200 fee payment of 16 February 2007.[1] However, a statement claiming small entity status was not submitted with the present refund request, nor does the refund request itself include an adequate statement asserting small entity status for the applicant. Applicant has therefore failed to satisfy the requirement of 37 CFR 1.28(a) that the refund request include an assertion of small entity status under 37 CFR 1.27(c). Accordingly, a refund of excess fees based on applicant's purported small entity status is not appropriate on the current record.

## CONCLUSION

Applicant's refund request is **DISMISSED** without prejudice.

Any request for reconsideration must satisfy the requirements of 37 CFR 1.28, that is, it must include a proper assertion of small entity status under 37 CFR 1.27(c) and a request for a refund of the excess fees paid.

Pursuant to 37 CFR 1.28(a), the deadline for submitting an acceptable request for refund based on small entity status is three months from the date on which the large entity fees were paid. Thus, in the present application, the deadline for submitting an acceptable request for refund under 37 CFR 1.28 is 16 May 2007.

As noted in 37 CFR 1.28(a), **this deadline is not extendable under 37 CFR 1.136.**

Please direct further correspondence with respect to this petition 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

[1] It is not clear why applicant is not requesting a refund of $900, that is, one half of the total of $1,800 in reducible large entity fees paid herein on 16 February 2007.

28 MAR 2007

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1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD MI 48075

In re Application of
CARMEL, Sharon
U.S. Application No.: 11/573,794
PCT No.: PCT/IL05/00889
Int. Filing Date: 16 August 2005
Priority Date: 16 August 2004
Attorney Docket No.: REIN0102PUSA
For: A SYSTEM AND METHOD FOR THE SYNCHRONIZATION OF DATA ACROSS MULTIPLE COMPUTING DEVICES

DECISION ON PETITION

This decision is issued in response to applicant's (renewed) "Request for Refund under 37 CFR 1.28(a)" filed on 19 March 2007.

## BACKGROUND

On 16 August 2005, applicant filed international application PCT/IL05/00889 which claimed a priority date of 16 August 2004, and it designated the United States. On 23 February 2006, the International Bureau (IB) communicated a copy of the international applicaiton to the United States Patent and Trademark Office. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 16 February 2007.

On 16 February 2007, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of $1,840 in the large entity fees. The materials filed 16 February 2007 did not include an assertion of small entity status.

On 08 March 2007, applicant filed "Request for Refund under 37 CFR 1.28(a)" which was dismissed without prejudice in a decision dated 19 March 2007.

On 19 March 2007, applicant filed the present request for refund considered herein.

## DISCUSSION

Pursuant to 37 CFR 1.28(a), a refund of a portion of large entity fees timely paid in full prior to establishing small entity status "may be obtained if an assertion [of small entity status] 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."

In the present application, applicant's 16 February 2007 submission included payment of $1,840 in total fees; $300 basic national fee, $100 search fee, $200 examination fee, $1200 for claims in excess of twenty, and $40 for recordation of an assignment. Except for the $40 recordation fee, these fees are all large entity fees that are reduced by half for small entities.

In the present refund request, applicant states that "the above-identified application was inadvertently filed as a large entity on February 16, 2007. Application claims small entity status as defined by 37 CFR 1.27." Therefore, the 19 March 2007 request for a refund of a portion of the fees paid upon filing the present application based upon the subsequent establishment of small entity status was made within three-months of the payment of the large entity fees. Accordingly, petitioner is entitled to a refund of a portion of the large entity fees paid upon filing the present application.

## CONCLUSION

The request for refund under 37 CFR 1.28(a) is **GRANTED**.

Deposit Account no. 50-2660 will be refunded 900.00.

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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| 03 FC:2633 | 100.00 | DA |
| 04 FC:2615 | 600.00 | DA |

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BAKER DONELSON BEARMAN CALDWELL & BERKOWITZ, PC
555 11TH STREET, NW
6TH FLOOR
WASHINGTON, DC 20004

| | | |
|---|---|---|
| In re Application of | : | |
| LARSON, Tony et al. | : | |
| Application No.: 11/573,860 | : | |
| PCT No.: PCT/GB2005/003193 | : | |
| Int. Filing Date: 15 August 2005 | : | DECISION |
| Priority Date: 19 August 2004 | : | |
| Docket No.: 2905493.1000 | : | |
| For: ASSAY FOR OILS | : | |

This decision is in response to applicants' submission of "Response to Notification of Missing Requirements," filed in the above-captioned application on 24 August 2007.

## BACKGROUND

On 15 August 2005, applicants filed international application PCT/GB2005/003193, claiming a priority date of 19 August 2004. A copy of the international application was transmitted to the Office by the International Bureau on 23 February 2006. The deadline for entry into the national phase in the United States was 19 August 2007.

On 16 February 2007, applicants submitted a transmittal letter for entry into that national phase in the United States accompanied by the basic national fee.

On 14 June 2007, applicants submitted a declaration of the inventors.

On 13 July 2007, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that the first named inventor on the declaration did not match the first named inventor on the international application.

On 24 August 2007, applicants filed this response to the notification.

## DISCUSSION

The declaration does not comply with 37 CFR 1.497(a)-(b). The first named inventor is listed as "Anthony Lawson" in the international application, but on the declaration, he is listed as "Tony Larson". Applicant has stated that this is a typographical error. However, while "Lawson" to "Larson" may be regarded as a typographical error, "Anthony" to "Tony" is regarded as a name change. An explanation of the discrepancy and a petition under 37 CFR 1.182 to correct the discrepancy, as set out in MPEP 605.04(c), is required.

## CONCLUSION

Applicants are required to submit a proper response 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 the abandonment of the application.

Any further correspondence with respect to this matter may be filed electronically or if mailed, 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

12 SEP 2008

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WASHINGTON, DC 20004

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| In re Application of | : | |
| LARSON, Tony et al. | : | |
| Application No.: 11/573,860 | : | |
| PCT No.: PCT/GB2005/003193 | : | |
| Int. Filing Date: 15 August 2005 | : | DECISION |
| Priority Date: 19 August 2004 | : | |
| Docket No.: 2905493.1000 | : | |
| For: ASSAY FOR OILS | : | |

This decision is in response to applicants' Petition Under 37 CFR 1.182, filed in the above-captioned application on 11 July 2008.

## BACKGROUND

On 12 March 2008, the Office mailed Decision, indicating that applicants' declaration of the inventors did not comply with 37 CFR 1.497(a)-(b).

On 11 July 2008, applicants filed this petition under 37 CFR 1.182 to correct the inventor's name.

## DISCUSSION

The first named inventor is listed as "Anthony Lawson" in the international application, but on the declaration, he is listed as "Tony Larson". Applicants have now furnished a statement from the attorney who prepared the international application explaining that he was told the inventor's name was "Tony" but that he had assumed that "Tony" was short for "Anthony" and listed the inventor as "Anthony Lawson". He further indicates that the papers were not presented to the inventor during the international phase for him to recognize the error. This is an adequate explanation of the discrepancy. The balance of the $400 petition fee will be charged to deposit account no. 11-0553, as authorized.

## CONCLUSION

For the reasons discussed above, applicants' petition under 37 CFR 1.182 is **GRANTED**.

This application is being forwarded to the National Phase Processing Branch of the Office of Patent Application Processing for further action consistent with this decision. The application has a 35 USC 371 (c)(1), (c)(2) and (c)(4) date of 14 June 2007.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

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10 MAR 2008

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FOURTEENTH FLOOR
IRVINE CA 92614

| | |
|---|---|
| In re Application of MILLAR et al. | |
| Application No.: 11/573,873 | DECISION ON PETITION |
| PCT No.: PCT/AU05/01840 | |
| Int. Filing: 05 December 2005 | UNDER 37 CFR 1.47(a) |
| Priority Date: 03 December 2004 | |
| Attorney Docket No.: ALAR31.001APC | |
| For: METHODS FOR SIMPLIFYING MICROBIAL NUCLEIC ACIDS... | |

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 15 January 2008, to accept the application without the signature of joint inventor, Dr. George Miklos. Petitioner requests a four month extension of time, which is granted.

## BACKGROUND

On 16 February 2007, 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 18 July 2007, 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 15 January 2008, applicant filed the petition along with declaration, executed by the joint inventors on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor Dr. George Miklos, alleging that Dr. Miklos refuses to sign the application.

## DISCUSSION

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

own behalf and on behalf of the non-signing joint inventor(s).

Applicant has satisfied items (1) through (4) above with the requisite petition fee, factual proof that the nonsigning inventor refuses to sign the declaration, the last known address of the non-signing inventor and a declaration executed by the joint inventor, submitted on 15 January 2008.

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

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

The U.S. Designated/Elected Office has accepted the application as a 37 CFR 1.47(a) application using the declaration filed 15 January 2008. The application has an international filing date of 05 December 2005 under 35 U.S.C. 363, and a date of 15 January 2008 under 35 U.S.C. 371(c). The 25 October 2004 Notification of Acceptance remains in effect.

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 respective last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

Cynthia M. Kratz

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

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

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KAPLAN GILMAN & PERGAMENT LLP
1480 ROUTE 9 NORTH
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| In re Application of | : | |
| Clancy et al. | : | |
| Application No. 11/573,889 | : | DECISION ON PETITION |
| Filed: August 28, 2007 | : | |
| Attorney Docket No. 818-005 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 18, 2009, to revive the above-identified application.

The petition is **DISMISSED**.

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

The application became abandoned for failure to file a proper and timely reply within the meaning of 37 CFR 1.113 to the final Office action of January 8, 2009. Accordingly, the application became abandoned on April 9, 2009.

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

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).

The Examiner has responded to the Amendment After Final with an Advisory Action (copy enclosed).

Further, 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.

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 Joan Olszewski at (571) 272-7751.

Joan Olszewski
Petitions Examiner
Office of Petitions

Enclosure: Examiner's Advisory

| **Advisory Action Before the Filing of an Appeal Brief** | **Application No.** 11/573,889 | **Applicant(s)** CLANCY ET AL. | |
|---|---|---|---|
| | **Examiner** Rodney P. Swartz, Ph.D. | **Art Unit** 1645 | |

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 18 August 2009 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): see attached Detailed Action.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Rodney P. Swartz, Ph.D./
Primary Examiner, Art Unit 1645

## DETAILED ACTION

1. Applicants' Response to Office Action, received 18 August 2009, is acknowledged. Claims 1, 21 and 41 have been amended.

2. Claims 1-5, 12-16, 18-29 and 32-51 are pending and under consideration.

### Objections/Rejections Withdrawn

3. The objection to Figures 1 and 2 are withdrawn in light of the replacement figures.

4. The rejection of claims 1-5, 12-16 and 18-20 under 35 U.S.C. 112, first paragraph, scope of enablement for cross protection between two disparate species, is maintained for the reasons put forth in the original rejection.

Applicants argue that the amendment of claim 1 obviates the rejection.

The examiner has considered applicants' argument in light of the amendment of claim 1 and finds it persuasive for claim 1 and dependent claims therefrom.

### Rejections Maintained

5. The rejection of claims 21-29 and 32-51 under 35 U.S.C. 112, second paragraph, as being indefinite for "formulating" is maintained.

Applicants argue that the amendment of claims 21 and 41 obviate the rejection.

The examiner has considered applicants' argument, in light of the claims amendments, but does not find it persuasive.

The amended claims recite that the formulating step "comprises" mixing the isolate or isolates with one or more pharmaceutically acceptable excipients suitable for oral administration.

The use of the open language, "comprises", does not restrict the scope of the procedure to that method step explicitly stated, i.e., mixing, but permits any nondefined procedure to also

be performed in the "formulating step". Thus, it remains unclear what steps the term "formulating" encompasses.

6. The rejection of claims 21-29 and 32-51 under 35 U.S.C. 112, first paragraph, scope of enablement for cross protection between two disparate species, is maintained for the reasons put forth in the original rejection.

Applicants argue that the amendment of claim 1 obviates the rejection.

The examiner has considered applicants' argument in light of the amendment of claim 1 and finds it persuasive for claim 1 and dependent claims therefrom, but does not find it persuasive for claims 21 and 41 and dependent claims therefrom.

Claim 21 remains drawn to a method for providing an oral killed vaccine against abnormal microbial colonization of a mucosal surface by evaluating and selecting "an" isolate for formulation as a vaccine. The scope of this claim remains to be drawn to a single isolate being utilized as an oral killed vaccine against any/all abnormal microbial colonization of a mucosal surface.

Claim 41 remains drawn to a method for providing an oral killed vaccine against abnormal microbial colonization of a mucosal surface by evaluating isolates for interleukin induction of expression in antigen responsive cells, and selecting "an" isolate for formulation as a vaccine. The scope of this claim remains to be drawn to a single isolate being utilized as an oral killed vaccine against any/all abnormal microbial colonization of a mucosal surface.

**Conclusion**

7. Claims 21-29 and 32-51 remain finally rejected.

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571)

272-0865. The examiner can normally be reached on Monday through Wednesday from 9:00 AM to 7:30 PM EST. Thursday is the examiner's work at home day.

If attempts to reach the Examiner by telephone are unsuccessful, please contact the Examiner's Supervisor, Robert B. Mondesi (571)272-0956.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rodney P. Swartz, Ph.D./

Primary Examiner, Art Unit 1645

September 24, 2009

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KAPLAN GILMAN & PERGAMENT LLP
1480 ROUTE 9 NORTH
WOODBRIDGE NJ 07095

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OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Clancy et al. | : | |
| Application No. 11/573,889 | : | DECISION ON PETITION |
| Filed: August 28, 2007 | : | |
| Attorney Docket No. 818-005 | : | |

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed November 3, 2009, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to properly and timely reply to the final Office action mailed January 8, 2009. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on April 9, 2009. A Notice of Abandonment was mailed November 3, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $405.00 and the submission required by 37 CFR 1.114; (2) the petition fee of $810.00 (previously paid August 18, 2009); and (3) a proper statement of unintentional delay.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

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

This matter is being referred to Technology Center 1645 for processing of the Request for Continued Examination under 37 CFR 1.114 filed on November 3, 2009.

Joan Olszewski

Joan Olszewski
Petitions Examiner
Office of Petitions

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18 MAY 2007

Professional Patent Solutions
P.O. Box 654
Herzeliya Pituach 46105 ISRAEL

In re Application of :
HOFMAN et al. :
Application No.: 11/573,902 : DECISION ON PETITION
PCT No.: PCT/IL05/00711 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 05 July 2005 :
Priority Date: 08 July 2004 :
Attorney Docket No.: 7137-US :
For: CHARACTER RECOGNITION SYSTEM AND METHOD

The petition to revive under 37 CFR 1.137(b) filed 20 February 2007 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "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
Fax: (571) 273-0459

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WATERS INVESTMENTS LIMITED
C/O WATERS CORPORATION
34 MAPLE STREET - LG
MILFORD MA 01757

In re Application of :
Wittmer et al. :
Application No.: 11/573,906 :
PCT No.: PCT/US2005/030604 :
Int. Filing Date: 24 August 2005 : DECISION
Priority Date: 24 August 2004 :
Attorney Docket No.: W-415-02 :
For: Devices And Methods For Preventing Ice Build-Up And :
Articles Of Manufacture That Are Resistant To Ice Build-Up :

This is a decision on the "Request, Under 37 CFR § 1.48(a)(1),..." filed on 11 June 2008.

## DISCUSSION

This international application was filed on 24 August 2005 and claimed a priority date of 24 August 2004. The United States was designated. Consequently, the thirty month period for payment of the basic national fee in the United States expired as of midnight on 24 February 2007. On 19 February 2007, applicants filed *inter alia* the basic national fee.

On 09 April 2008, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(h).

On 16 April 2008, applicants filed a response, including a declaration and the surcharge under 37 CFR 1.492(h).

On 15 May 2008, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to applicants, again requiring an oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) and stating that the declaration is not compliant because it names Peter Kirby, whose name did not appear on the published international application.

## DISCUSSION

As noted in the Notification of Defective Response, the declaration of the inventors filed on 16 April 2008 names an inventor (Peter Kirby) who was not nominated in the published international application. In view of the different inventive entity nominated by the declaration as opposed to the published international application, the declaration filed on 16 April 2008 was not accepted, leading to the mailing of the Notification of Defective Response on 15 May 2008.

To cure this defect, counsel seeks relief under 37 CFR 1.48(a)(herein treated as a request under 37 CFR 1.497(d)), requesting "correction of the inventorship, deleting Peter Kirby as an inventor." Petitioner is advised that the inventive entity of record in this application remains that which was named in the international phase. Since the inventive entity was never effectively changed to include Mr. Kirby, no submission seeking to delete him is necessary or appropriate. Instead, the reply required by the Notification of Missing Requirements and the Notification of Defective Response was an oath or declaration compliant with 37 CFR 1.497(a) and (b), naming the correct inventive entity (as named in the international phase). In this regard, Mr. Kirby does not appear from the record to have been named as an

inventor during the international phase. Since Mr. Kirby has not been named or added as an inventor, the request to delete him as an inventor is MOOT.

It is noted that the ADS filed on 19 February 2007 identifies the wrong international application number (PCT/US2005/03064). Also, further inspection of the declaration reveals that it names "Kareh, Joseph" in place of "KAREH, Joshep" nominated in the published international application; no explanation of this discrepancy has been provided. In addition, applicant is advised that the declaration identifies this application as a "continuation of PCT/US05/030604," rather than as the national stage.

## DECISION

The petition is **DISMISSED AS MOOT**, without prejudice.

The declaration is **NOT ACCEPTED**, without prejudice.

A proper response (i.e., an oath or declaration compliant with 37 CFR 1.497(a) and (b)) must be filed within the remainder of the period for response set by the Notification of Missing Requirements mailed on 09 April 2008, as extended under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT** of this international application with respect to the national phase in the United States.

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

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

2 6 JAN 2009

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C/O WATERS CORPORATION
34 MAPLE STREET - LG
MILFORD MA 01757

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|---|---|---|
| In re Application of | : | |
| Wittmer et al. | : | |
| Application No.: 11/573,906 | : | |
| PCT No.: PCT/US2005/030604 | : | |
| Int. Filing Date: 24 August 2005 | : | DECISION |
| Priority Date: 24 August 2004 | : | |
| Attorney Docket No.: W-415-02 | : | |
| For: Devices And Methods For Preventing Ice Build-Up And Articles Of Manufacture That Are Resistant To Ice Build-Up | : | |

This is in response to the "Further Response..." filed on 10 October 2008.

## DISCUSSION

In a Decision mailed on 04 September 2008, the "Request, Under 37 CFR § 1.48(a)(1)..." filed on 11 June 2008 was dismissed as moot (without prejudice), and the declaration then of record was not accepted, without prejudice. The Decision noted that

> ... further inspection of the declaration reveals that it names "Kareh, Joseph" in place of "KAREH, Joshep" nominated in the published international application; no explanation of this discrepancy has been provided. In addition, applicant is advised that the declaration identifies this application as a "continuation of PCT/US05/030604," rather than as the national stage.

In response, applicants have filed a newly executed declaration which nominates the same inventive entity as the published international application. Counsel clarifies that the name "Joseph Kareh" as it appears on the declaration is correct, and that the different spelling appearing on the published international application represents an error which "arose through no fault of Applicants, and occurred entirely during the publication process." Review of the Request (Form PCT/RO/101) reveals that the name appears as "Joseph" thereon. Accordingly, it would be appropriate to accept the declaration filed on 10 October 2008 for purposes of compliance with 37 CFR 1.497(a) and (b).

The ADS filed on 10 October 2008 is acknowledged.

## DECISION

The declaration is **ACCEPTED**, as noted above.

This application is being forwarded to the Office of Patent Application Processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **10 October 2008**.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

25 JUN 2009

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BIRMINGHAM MI 48009

| | |
|---|---|
| In re Application of FOSCHINI et al. | |
| Application No.: 11/573,943 | |
| PCT No.: PCT/US04/33922 | : DECISION ON |
| Int. Filing: 14 October 2004 | |
| Priority Date: None | : PETITION |
| Attorney Docket No.: 000.05586US;60469182PUS1 | |
| For: ELEVATOR MOTION PROFILE CONTROL FOR LIMITING POWER CONSUMPTION | :UNDER 37 CFR 1.47(a) |

This is a decision on applicant's Petition Under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office on 14 April 2009. Applicant's request for a four month extension of time is granted.

## BACKGROUND

On 10 October 2008, 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 14 April 2009, applicant filed a response to the 905 along with a petition under 37 CFR 1.47(a) and 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 signature of inventor Leonida Lorquando, alleging that the inventor refuses to sign the application.

## DISCUSSION

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

Applicant has satisfied Item (1) with the payment of the requisite $200 petition fee.

With respect to Item (2), Petitioner indicates that the nonsigning inventor has refused to sign the application papers because several email communications were sent to him to obtain his signature and despite these efforts the inventor has not signed the declaration. The email correspondence sent to the respective nonsigning inventor was attached to the petition. It is not clear that a copy of the application papers, including a declaration, was delivered to the nonsigning inventor. In addition, Petitioner did not provide a first hand statement of facts regarding the non-signing inventors refusal, which is required. *See* MPEP 409.03(d). Item (2) is

not yet satisfied.

With regard to Item (3), the last known address of the nonsigning inventor was submitted with the petition. Item (3) is satisfied.

With regard to Item (4) above, the 37 CFR 1.47(a) applicant submitted a multi-page declaration signed by the co-inventors. The signature pages are marked as Page "1 of 3", "Page 2 of 3" and "Page 3 of 3". The declaration also contains two unnumbered supplemental pages. The declaration is not properly executed. It appears that either the attorney pieced together separate complete declarations into one composite declaration or the inventors were presented with an incomplete declaration. While it is acceptable for applicants to execute separate copies of the declaration, the entire declaration, as executed by the inventor, must be submitted. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." *See* MPEP 201.03. What is required is one declaration where all inventors have signed or separate complete declarations. The requirements of 37 CFR 1.497 (a) and (b) have not yet been met and the declaration is unacceptable as filed.

Items (2) and (4) above are not satisfied. Thus, Petitioner has not satisfied the requirements of 37 CFR 1.47(a). Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

## CONCLUSION

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

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

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

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3286
Facsimile: (571) 272-0459

22 OCT 2009

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BIRMINGHAM MI 48009

| | |
|---|---|
| In re Application of FOSCHINI et al. | : |
| Application No.: 11/573,943 | : |
| PCT No.: PCT/US04/33922 | : DECISION ON |
| Int. Filing: 14 October 2004 | : |
| Priority Date: None | : PETITION |
| Attorney Docket No.: 000.05586US;60469182PUS1 | : |
| For: ELEVATOR MOTION PROFILE CONTROL FOR LIMITING POWER CONSUMPTION | :UNDER 37 CFR 1.47(a) : |

This is a decision on applicant's renewed Petition Under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office on 17 September 2009. Applicant's request for a one month extension of time is granted.

## BACKGROUND

On 10 October 2008, 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 14 April 2009, applicant filed a response to the 905 along with a petition under 37 CFR 1.47(a) and a declaration, executed by the joint inventors on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor Leonida Lorquando, alleging that the inventor refuses to sign the application.

On 25 June 2009, a decision was mailed indicating that some requirements of 37 CFR 1.47(a) had not yet been satisfied.

On 17 September 2009, applicant filed a declaration, executed by the previously non-signing inventor.

## DISCUSSION

Petitioner has now presented the declaration signed by inventor Leonida Lorquando. A review of the declaration reveals that the declaration identifies all the inventors named in the international application and is executed by the previously non-signing inventor. The declaration also states the residency, citizenship and mailing address of each inventor.

The petition under 37 CFR 1.47(a) is considered moot as a declaration executed by the previously unavailable inventor has now been submitted. The declaration executed by inventor Lorquando is acceptable under 37 CFR 1.497(a) and (b).

However, applicant did not respond to the portion of the decision which stated that applicant had submitted an unacceptable multi-page declaration signed by the co-inventors. There are two unnumbered identical supplemental signature pages, which are executed by different inventors (Bonfiglioli and Thebeau). It appears that either the attorney pieced together separate complete declarations into one composite declaration or the inventors were presented with an incomplete declaration. The declaration is not properly executed. While it is acceptable for applicants to execute separate copies of the declaration, the entire declaration, as executed by the inventor, must be submitted. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." *See* MPEP 201.03. What is required is one declaration where all inventors have signed or separate complete declarations. The requirements of 37 CFR 1.497 (a) and (b) have not yet been met and the declaration submitted on 14 April 2009 is unacceptable as filed.

## CONCLUSION

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

The declaration, executed by the previously non-signing inventor and submitted 17 September 2009, is in compliance with 37 CFR 1.497(a) and (b) and is acceptable. However, the declaration as submitted on 14 April 2009 is unacceptable at this time.

Applicant must file a response within TWO (2) MONTHS from the mail date of this decision. No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

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

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

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

31 DEC 2009

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CARLSON GASKEY & OLDS
400 W MAPLE STE 350
BIRMINGHAM MI 48009

In re Application of FOSCHINI et al.
Application No.: 11/573,943
PCT No.: PCT/US04/33922
Int. Filing: 14 October 2004
Priority Date: None
Attorney Docket No.: 000.05586US;60469182PUS1
For: ELEVATOR MOTION PROFILE CONTROL FOR LIMITING POWER CONSUMPTION

: DECISION ON
: DECLARATION

This is a decision on applicant's declaration filed in the United States Patent and Trademark Office on 28 October 2009.

The procedural history of this application was set forth in the decision mailed on 22 October 2009 and is incorporated by reference.

Petitioner has now presented declarations signed by all the inventors.. A review of the declarations reveal that the declarations identify all the inventors named in the international application. The declarations also state the residency, citizenship and mailing address of each inventor. The requirements of 37 CFR 1.497 (a) and (b) have been met and the declarations submitted on 28 October 2009 are acceptable as filed.

The application will be forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is 28 October 2009.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

10 SEP 2009

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

John Kilyk, Jr.
LEYDIG VOIT & MAYER, LTD
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6731

| | | |
|---|---|---|
| In re Application of: | : | |
| WAKAO, Hiroshi et al. | : | DECISION |
| US Application No.: 11/573,995 | : | |
| PCT Application No.: PCT/JP2005/014474 | : | |
| Int. Filing Date: 01 August 2005 | : | UNDER |
| Priority Date: 18 August 2004 | : | |
| Atty Docket No.: 701192 | : | |
| For: METHOD OF CONSTRUCTING CLONE MAMMAL | : | 37 CFR § 1.47(a) |
| | : | |

This is in response to applicants' "PETITION AND STATEMENT TO WAIVE REQUIREMENTS UNDER 37 C.F.R. §1.183" received on 11 May 2009, which has been treated as a petition under 37 C.F.R. §1.47(a).

## BACKGROUND

On 01 August 2005, applicants filed international application PCT/JP2005/014474.

On 20 February 2007, applicant filed a submission for entry into the national stage in the United States, which was accompanied by, inter alia, a preliminary amendment to the specification. The papers were assigned U.S. application number 11/573,995.

On 10 October 2008, 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 11 May 2009, applicants filed the present petition under 37 CFR 1.47(a) requesting acceptance of the application without an inventor's signature.

## 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 inventor refuses to execute the application 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 other joint inventors on behalf of and as agent for the non-signing inventor.

With regard to item (1) above, the requisite petition fee will be charged to Deposit Account No. 12-1216.

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 Mr. Hiroshi Wakao refused to sign the application paper. An affidavit was provided by Toshikuni Tsujigami, which indicated that he mailed the paper to Mr. Wakao for signature on 26 February 2007. Mr. Tsujigami followed up the request by an email. Mr. Wakao responded on 22 November 2008 by email requesting a research sample from Riken before signing the papers. Mr. Tsujigami explained to Mr. Wakao that providing the sample is a

different issue and the declaration needs to be signed. Mr. Wakao did not respond to further inquiries. Item (2) has been satisfied.

With regard to item (3) above, the petition contains a copy of the nonsigning inventor's last known address.

With regard to item (4) above, a copy of the oath or declaration executed by the applicants on behalf of and as agents for the nonsigning inventor has been provided but defective. The international application listed Akihiko Koseki as one of the applicants, which does not match with the name Haruhiko Koseki listed on the declaration.

Based on the above, applicants have not satisfied the requirements for a grantable petition under 37 CFR 1.47(a).

## 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. Failure to timely file a proper response will result in abandonment of the application. Extensions of time under 37 CFR 1.136 are available. 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.

Shian Luong
PCT Special Programs Examiner
Office of PCT Legal Administration
Telephone: (571) 272-4557

Leonard Smith
Supervisory PCT Legal Examiner
Office of PCT Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

0 3 DEC 2009

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LEYDIG VOIT & MAYER, LTD
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6731

| | | |
|---|---|---|
| In re Application of: | : | |
| WAKAO, Hiroshi et al. | : | DECISION |
| US Application No.: 11/573,995 | : | |
| PCT Application No.: PCT/JP2005/014474 | : | |
| Int. Filing Date: 01 August 2005 | : | UNDER |
| Priority Date: 18 August 2004 | : | |
| Atty Docket No.: 701192 | : | |
| For: METHOD OF CONSTRUCTING CLONE MAMMAL | : | 37 CFR § 1.47(a) |
| | : | |

This is in response to applicants' "RENEWED PETITION UNDER 37 C.F.R. §1.47(a)" received on 28 October 2009.

## BACKGROUND

On 01 August 2005, applicants filed international application PCT/JP2005/014474.

On 20 February 2007, applicant filed a submission for entry into the national stage in the United States, which was accompanied by, inter alia, a preliminary amendment to the specification. The papers were assigned U.S. application number 11/573,995.

On 10 October 2008, 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 11 May 2009, applicants filed the petition under 37 CFR 1.47(a) requesting acceptance of the application without an inventor's signature. The decision was dismissed based on a defective declaration.

On 28 October 2009, applicants filed the renewed petition.

## DISCUSSION

Applicants have met items (1) - (3) of the 37 CFR 1.47(a) requirements.

For item (4), applicants provided a statement regarding the discrepancy of the name of the second inventor between the published international application and the declaration submitted in the national stage.

Section 1893.01 (e) of the Manual Of Patent Examining Procedure ("MPEP") states the following:

> Where ... the name of an inventor indicated in the international application during the international phase has changed such that the inventor's name is different from the corresponding name indicated in an oath or declaration submitted under 37 CFR 1.497, for example, on account of marriage, then a petition under 37 CFR 1.182 will be required to accept the oath or declaration with the changed name. See MPEP § 605.04(c). ). However, where the discrepancy between the name of the inventor indicated in the international application during the international phase and the name of the inventor as it appears in the oath or declaration submitted under 37 CFR 1.497 is the result of a typographical or transliteration error, then a petition under 37 CFR 1.182 will not be required. In such case, the Office should simply be notified of the error.

The renewed petition indicates that the first name of the second inventor was incorrectly listed on the international application as "Akihiko" due to a transliteration error. The correct name of this inventor is "Haruhiko" as listed in the declaration on 11 May 2009. Applicants request that the name of the record for this inventor be corrected to "Haruhiko" so as to permit acceptance of the previously filed declaration.

Based on the above, applicants have satisfied the requirements for a grantable petition under 37 CFR 1.47(a).

## CONCLUSION

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

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

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

This application is being referred to the National Stage Processing (DO/EO/US) for further processing in accordance with this decision. The 35 USC 371 (c)(1), (c)(2), (c)(4) date is 11 May 2009.

Shian Luong
PCT Special Programs Examiner
Office of PCT Legal Administration
Telephone: (571) 272-4557

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

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P.O. Box 1450
Alexandria, VA 22313-1450
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Mr. Hiroshi Wakao
c/o Preventive Medicine – Environmental Biology Department
National University Corporation Hokkaido University
Kita 15-jo, Nishi 7-chome
Kita-ku
Sapporo-shi
Hokkaido 060-8638
Japan

In re Application of:
WAKAO, Hiroshi et al.
US Application No.: 11/573,995
PCT Application No.: PCT/JP2005/014474
Int. Filing Date: 01 August 2005
Priority Date: 18 August 2004
Atty Docket No.: 701192
For: METHOD OF CONSTRUCTING CLONE MAMMAL

Dear Mr. Wakao,

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.

Shian Luong
PCT Special Programs Examiner
Office of PCT Legal Administration
Telephone: (571) 272-4557

Boris Milef
PCT Legal Examiner
Office of PCT Legal Administration

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ELI LILLY & COMPANY
PATENT DIVISION
P.O. BOX 6288
INDIANAPOLIS IN 46206-6288

MAILED

MAR 23 2010

OFFICE OF PETITIONS

In re Application of :
Finley et al. :
Application No. 11/574,044 : ON APPLICATION FOR
Filed: February 21, 2007 : PATENT TERM ADJUSTMENT
Attorney Docket No. X16743 :
Title: Histamine H3 Receptor :
Agents, Preparation and :
Therapeutic Uses :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705)" filed October 1, 2009. This petition is properly treated under 37 CFR §1.705(b). Applicants submit that the correct patent term adjustment to be indicated on the patent is 310 days, not zero days as calculated by the Office as of the mailing of the initial determination of patent term adjustment.

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

On July 2, 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 zero days. Applicants dispute the calculation.

The Office has considered applicants' argument and finds it persuasive that an adjustment is required. 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. In other words, the period of Office delay reduced by the period of applicant delay.

Applicants contend a 310 day adjustment is required for failure by the Office to mail at least one of the notifications under 35 U.S.C. 132 not later than fourteen months after the date on which the application fulfilled the requirements under 35 U.S.C. 371 on February 21, 2007, pursuant to 37 CFR §1.702(a)(1).

However, review of the record shows that the requirements of 35 U.S.C. 371 were fulfilled on February 23, 2007. Thus, the mailing of the restriction requirement on February 25, 2009, is 14 months and 308 days after fulfillment. As such a 308-day of adjustment pursuant to 37 CFR §1.702(a)(1) is required.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is 308 days.

As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

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

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[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant, at (571) 272-3215.

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED PALM Screen

| PTE Calculations for Application: 11/574044 | | | |
|---|---|---|---|
| Application Filing Date: | 02/21/2007 | PTO Delay (PTO): | 0 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 0 |
| Post-Issue Petitions: | 0 | Total PTE (days): | 308 |
| PTO Delay Adjustment: | 308 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 48 | 03/20/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 308 | | |
| 38 | 07/02/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 37 | 06/30/2009 | DOCUMENT VERIFICATION | | | |
| 36 | 06/30/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 35 | 06/30/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 34 | 06/08/2009 | NOTICE OF ALLOWABILITY | | | |
| 30 | 06/08/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 29 | 06/08/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 28 | 05/02/2009 | DATE FORWARDED TO EXAMINER | | | |
| 27 | 04/27/2009 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 26 | 04/27/2009 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 25 | 02/25/2009 | ELECTRONIC REVIEW | | | |
| 24 | 02/25/2009 | EMAIL NOTIFICATION | | | |
| 23 | 02/25/2009 | MAIL RESTRICTION REQUIREMENT | | | |
| 22 | 02/20/2009 | EMAIL NOTIFICATION | | | |
| 21 | 02/19/2009 | PG-PUB ISSUE NOTIFICATION | | | |
| 20 | 02/17/2009 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 19 | 02/13/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 18 | 02/05/2009 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 17 | 06/08/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 16 | 06/08/2007 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | | |

| | | | | | |
|---|---|---|---|---|---|
| 15 | 06/08/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 14 | 02/21/2007 | PRELIMINARY AMENDMENT | | | |
| 13 | 11/17/2008 | APPLICATION DISPATCHED FROM OIPE | | | |
| 12 | 10/29/2008 | EMAIL NOTIFICATION | | | |
| 11 | 10/29/2008 | EMAIL NOTIFICATION | | | |
| 10 | 02/23/2007 | 371 COMPLETION DATE | | | |
| 9 | 10/28/2008 | SENT TO CLASSIFICATION CONTRACTOR | | | |
| 8 | 10/29/2008 | FILING RECEIPT | | | |
| 7 | 10/29/2008 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 6 | 06/08/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 5 | 06/08/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 4 | 03/15/2007 | CASE CLASSIFIED BY OIPE | | | |
| 3 | 02/27/2007 | CLEARED BY OIPE CSR | | | |
| 2 | 02/27/2007 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 02/21/2007 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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

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| | | |
|---|---|---|
| In re Application of | : | |
| Berge BRUNO, et al | : | |
| Application No. 11/574,101 | : | DECISION ON PETITION |
| Filed: February 22, 2007 | : | TO WITHDRAW |
| Attorney Docket No. 042098-0121 | : | 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 27, 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 Rouget F. Henschel on behalf of all the attorney/agents of record associated with Customer No. 22428.

All attorneys/agents of record associated with Customer No. 22428 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 the undersigned at 571-272-6735.

Diane Goodwyn
Petitions Examiner
Office of Petitions

cc: BERGE BRUNO
3, PLACE DES CELESTINS
69002 LYON
FRANCE

cc: MR. JOHNATHAN P. OSHA
OSHA & LIANG LLP
ONE HOUSTON CENTER,
1221 MCKINNEY STREET, SUITE 2800,
HOUSTON, TX 77010

22 DEC 2008

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www.uspto.gov

22850
OBLON, SPIVAK, McCLELLAND & MAIER, P.C.
1940 Duke Street
Alexandria, VA 22314

In re Application of :
YOU, Han Sun *et al* :
U.S. Application No.: 11/574,105 :
PCT No.: PCT/KR2005/002770 :
Int. Filing Date: 23 August 2005 : **DECISION**
Priority Date: 23 August 2004 :
Attorney Docket No.: 303985US6PCT :
For: BOTTOM COUPLING STRUCTURE :
FOR CONTAINERS :

This decision is in response to the request to withdraw as attorneys of record and change of correspondence address filed 13 August 2008, which is hereby **GRANTED** as follows:

As set forth in 37 CFR 1.36, a registered attorney or agent may withdraw, upon application to and approval by the Commissioner, so long as sufficient time remains for applicant to respond to any pending action. In the present case, the request to withdraw is signed by Marvin J. Spivak, on behalf of the attorneys associated with customer number 22850.

There is currently no action required on this application within the next 30 days, so the requirement of "at least 30 days between *approval* of withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a)," is satisfied.

For the reasons above, the request to withdraw as agents of record is **GRANTED** as to the attorneys associated with customer number 22850.

All future communication will be directed to the address of the applicant, Han Sun You.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Hidetaka Furusho | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7592901 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/574,131 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/22/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **360** 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.

10 DEC 2007

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3580 Wilshire Blvd.
17th Floor
CHICAGO IL 60606

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|---|---|---|
| In re Application of | : | |
| KWEON, GYEONG-IL | : | DECISION |
| Application No.: 11/574,132 | : | |
| PCT No.: PCT/KR05/03446 | : | |
| In. Filing Date: 14 October 2005 | : | |
| Priority Date: 14 October 2004 | : | |
| Atty. Docket No.: 2088-048 | : | |
| For: RECTILINEAR MIRROR AND IMAGING SYSTEM HAVING THE SAME | : | |

This decision is issued in response to applicant's "2nd Refund Request" filed 18 October 2007 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 22 February 2007, within the thirty month deadline, applicant filed a transmittal letter requesting national stage entry for international application No. PCT/KR05/03446 along with the basic national fee.

On 08 August 2007, applicant filed a request for refund for $125 charged to deposit account no. 50-3566 under 37 CFR 1.492(j). In a communication dated 01 October 2007, applicant's request was dismissed.

On 18 October 2007, applicant filed the instant request.

## DISCUSSION

Applicant acknowledges that on 22 February 2007, the specification and drawings as electronically filed totaled 108 pages. Applicant contends that the application size fee for electronically filed applications is calculated at a rate of 75% and that he is entitled to reduced fees for electronically filing his application.

37 CFR 1.52(f) states that "the paper size equivalent of the specification and drawings of an application submitted via the Office electronic filing system will be

considered to be seventy-five percent of the number of sheets of paper present in the specification and drawings...as required by §1.16(s)." Section 1.16(s) indicates that "application size fee for any application under 35 U.S.C. 111." Further, Manual of Patent Examining Procedure § 1893.01(c) states "[f]ees under 37 CFR 1.16 relate to national applications under 35 U.S.C. 111(a), and not to international applications entering the national stage under 35 U.S.C. 371. National stage fees are specifically provided for in 37 CFR 1.492." The instant application does not qualify for a reduced fees for electronic filing because the reduced fee is applicable only to applications filed under 35 U.S.C. 111. The instant application is filed under 35 U.S.C. 371 and is not eligible for the reduced fee.

## CONCLUSION

Applicant's request for refund is **DISMISSED** without prejudice.

Based on the above, the appropriate fee for electronically submitting a specification and drawings containing more than 100 pages is $125.

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

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**GREENBLUM & BERNSTEIN, P.L.C.**
**1950 ROLAND CLARKE PLACE**
**RESTON, VA 20191**

**MAILED**

FEB 12 2009

**OFFICE OF PETITIONS**

In re Application of
Ikushima **KAZUMASA**
Application No. 11/574,183
Filed: February 23, 2007
Attorney Docket No. **P31729**

DECISION GRANTING PETITION
UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed February 11, 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 February 5, 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]

There is no indication that the person signing the petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. However, the signature of Mr. William S. Boshnick appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts in accordance with 37 CFR 1.34(a).

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 2856 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

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

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0 2 JAN 2008

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

| | |
|---|---|
| In re Application of ABE et al. | : |
| Application No.: 11/574,193 | : DECISION ON |
| PCT No.: PCT/JP05/15398 | : |
| Int. Filing: 25 August 2005 | : PETITION |
| Priority Date: 25 August 2004 | : |
| Attorney Docket No.:303645US0PCT | :UNDER 37 CFR 1.47(a) |
| For: PROCESSING APPARATUS, METHOD OF PROCESSING AND PROCESS FOR PRODUCING DETOXIFIED MATTER | : |

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 09 November 2007, to accept the application without the signature of joint inventor TSUYOSHI ABE.

## BACKGROUND

On 23 February 2007, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 10 September 2007, 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 09 November 2007, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor TSUYOSHI ABE alleging that the non-signing inventor refused to sign the application.

## DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(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).

Petitioner satisfied Item (1) with the payment of the $200 petition fee.

With respect to Item (2) above, Petitioner provided a statement of first-hand knowledge from Junichi Omori, patent attorney. Mr. Omori states that on 09 July 2007, he sent a letter to the non-signing inventor, including a copy of the entire patent application and declaration to his last known address. This correspondence was delivered to Mr. Abe on 10 July 2007 ( a copy of the mailing receipt and English translation were provided). The inventor has not responded to this correspondence. The action taken by petitioner is sufficient to demonstrate that a *bona fide* attempt was made to present a copy of the application papers for U.S. application 11/574,193 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and that TSUYOSHI ABE, by his conduct, refuses to sign the application papers. Item (2) is satisfied.

Item (3) is satisfied with the submission of last known address of the non-signing inventor.

With regard to Item (4), the declaration submitted on 09 November 2007 appears to be in both the Japanese and English languages. As stated in 37 CFR 1.69(b), unless the text of any oath or declaration in a language other than English is in the form provided by the Patent and Trademark Office..., it must be accompanied by an English translation together with a statement that the translation is accurate. The executed declaration is accompanied by a statement of counsel that the translation is accurate.

The requirements of 37 CFR 1.497 (a) and (b) have been met and the declaration is acceptable as filed. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a).

## CONCLUSION

The petition under 37 CFR §1.47(a) is **GRANTED**.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 11 November 2007. The application has an international filing date of 25 August 2005 under 35 U.S.C. 363, and a date of 11 November 2007 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.

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

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

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**P.O. BOX 1022**
**MINNEAPOLIS MN 55440-1022**

MAILED

AUG 14 2009

OFFICE OF PETITIONS

In re Application of
Pedrono, Claude
Application No. 11/574,198
Filed: July 24, 2007
Attorney Docket No. 08641-045US1 / 22226US ESS

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 18, 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 will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40 (c).

The request was signed by Marc M. Wefers on behalf of all practitioners of record. Marc M. Wefers and all practitioners of record have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The correspondence address remains unchanged.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Liana Walsh
Petitions Examiner
Office of Petitions

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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 :
Wolfgang DILLMANN, et al :
Application No. 11/574,232 : DECISION ON PETITION
Filed: January 30, 2008 : TO WITHDRAW
Attorney Docket No. 220002067300 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 22, 2009.

The request is **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 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 correspondence address for future communications from the Office has been provided.

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.

/Diane C. Goodwyn/
Diane C. Goodwyn
Petitions Examiner
Office of Petitions

2 1 MAR 2008

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

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|---|---|
| In re Application of | |
| ZHANG, Yifeng | |
| Application No.: 11/574,240 | DECISION |
| PCT No.: PCT/IB2005/052807 | |
| Int. Filing Date: 26 August 2005 | ON PETITION UNDER |
| Priority Date: 27 August 2004 | |
| Docket No.: US040346US2 | 37 CFR 1.137(b) |
| For: METHODS AND APPARATUSES FOR INTRASYSTEM AND INTERSYSTEM SLIDING INTERMEDIATE FREQUENCY TRANSCEPTION | |

Applicant's Petition Under 37 CFR 1.137(b), filed in the above-captioned application on 18 January 2008 is **GRANTED**.

Applicant indicates that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, as required by 37 CFR 1.137(b)(3). The appropriate reply and petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

Applicant supplied a declaration of inventorship in compliance with 37 CFR 1.497(a)-(b), during the international phase. The fee for late filing of the search fee, examination fee or oath or declaration has been furnished.

This application is being forwarded to the National Stage Processing Branch of the Office of Patent Application Processing for continued processing in accordance with this decision. This application has a 35 USC 371(c)(1), (c)(2) and (c)(4) date of 18 January 2008.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

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SAN JOSE CA 95131

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| In re Application of | : | |
| SCHAFFLER | : | |
| Serial No.: 11/574,243 | : | DECISION ON |
| PCT App. No.: PCT/IB05/52709 | : | |
| Int'l Filing Date: 17 August 2005 | : | PETITION UNDER |
| Priority Date: 31 August 2004 | : | |
| Attorney Docket No.: AT04 0057 US | : | 37 CFR 1.137(b) |
| For: METHOD OF MANUFACTURING AN RFID ANTENNA | : | |

The petition to revive under 37 CFR 1.137(b) filed 10 July 2009 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 the application went abandoned for failure to reply to the Notification of Missing Requirements within the time period set forth in the notice. A declaration, in compliance with 37 CFR 1.497(a) and (b), was provided on 10 July 2009 and is acceptable. The required petition fee of $1620 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 **10 July 2009.**

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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1940 DUKE STREET
ALEXANDRIA, VA 22314

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Andreas Wolfert | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7659430 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/09/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/574,263 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/26/2007 | : 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.

13 FEB 2009

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COHEN & POKOTILOW, LTD.
11TH FLOOR, SEVEN PENN CENTER
1635 MARKET STREET
PHILADELPHIA PA 19103-2212

In re Application of:
SRINATH, Sumithra, et al.
U.S. Application No.: 11/574,354
PCT Application No.: PCT/IN2004/000265
International Filing Date: 27 August 2004
Priority Date: None
Attorney's Docket No.: A1181/20007
For: PROCESS FOR THE PRODUCTION OF AMORPHOUS ATORVASTAIN CALCIUM

DECISION ON PETITION
(37 CFR 1.182)

This decision is issued in response to the "Request For Data Correction" filed 21 October 2008, treated herein as a petition under 37 CFR 1.182 to correct applicants' error in identifying the international application number to which the present U.S. national stage application was directed. Deposit Account No. 03-0075 will be charged the required $400 petition fee.

## BACKGROUND

On 27 August 2004, applicants filed international application PCT/IN2004/000265. The international application did not claim an earlier priority date, and it designated the United States. On 02 March 2006, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the international filing date, i.e., 27 February 2007.

On 27 February 2007, applicants filed papers to initiate a U.S. national stage application using the EFS-Web electronic filing system. This submission included an Application Data Sheet (ADS), a PCT Rule 4.17(iv) declaration, and payment of the basic national fee.

The ADS filed by applicants on 27 February 2007 identified the international application number as PCT/IN2004/000265. However, during the electronic filing process, applicants identified the international application number as PCT/IN05/000265. Based on the information provided by applicants during the electronic filing process, the present application was initially established as the U.S. national stage of PCT/IN05/000265, and the IB documents for such international application were placed in the present application file.

On 21 October 2008, applicants filed the "Request For Data Correction" treated herein as a petition under 37 CFR 1.182. The petition indicates that the present application was intended as the U.S. national stage of PCT/IN2004/000264, and it seeks to correct the reference herein to incorrect international application number PCT/IN2005/000265.

## DISCUSSION

As set forth above, the data entered by applicants during the electronic filing process incorrectly identified the international application to which the present national stage filing was directed. Under such circumstances, a grantable petition under 37 CFR 1.182 is required to correct applicants' error and thereby permit the materials filed 27 February 2007 to be treated as having been directed to international application PCT/IN2004/000264, as necessary to avoid abandonment of this international application with respect to the United States. Accordingly, applicants' 21 October 2008 correspondence has been treated as the required petition under 37 CFR 1.182.

In the present petition, applicants confirm that the identification of international application PCT/IN2005/000265 during the electronic filing process was the result of an inadvertent error and that the correct international application herein is PCT/IN2004/000265. Applicants note that the correct international application number was contained in the materials filed 04 September 2008 (specifically, in the ADS). Finally, applicants' petition included the authorization to charge Deposit Account No. 03-0075 for required fees. Pursuant to this authorization, the Deposit Account will be charged the petition fee required with respect to a petition under 37 CFR 1.182.

The present submission satisfies the requirements for a grantable petition to correct the inadvertent error in the international application number identified during the electronic filing process. Accordingly, the materials filed herein on 27 February 2007 will be treated as having been directed to international application PCT/IN2004/000265.

The IB documents relating to international application PCT/IN2005/000265 that were placed in the present application file by the United States Designated/Elected Office (DO/EO/US) will be removed from the active application file.

## CONCLUSION

Applicants' petition under 37 CFR 1.182 is **GRANTED**.

Deposit Account No. 03-0075 will be charged the required $400 petition fee.

The materials filed herein on 27 February 2007 will be treated as the U.S. national stage of PCT/IN2004/000265. Such materials were filed prior to the expiration of thirty months from the priority date of such application.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision.

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

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03 AUG 2007

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Goldens Bridge, N.Y. 10526

| | | |
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| In re Application of | : | DECISION ON |
| BRAIMAN et al | : | |
| Application No.: 11/574,381 | : | |
| PCT No.: PCT/IL2005/000629 | : | PETITION UNDER |
| Int. Filing Date: 15 June 2005 | : | |
| Priority Date: 17 June 2004 | : | 37 CFR 1.137(b) |
| Attorney's Docket No.: 940/6//1 | : | |
| For: Tracking System Using Fixed Optical Radiators | : | |

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 27 February 2007.

## BACKGROUND

On 15 June 2005, this international application was filed, claiming an earliest priority date of 17 June 2004. The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 17 December 2006.

On 27 February 2007, applicants filed the instant petition under 37 CFR 1.137(b) and Transmittal letter for entry into the national stage in the United States, which was accompanied by, basic national fee, and an executed declaration.

## DISCUSSION

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

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

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

**DECISION**

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

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **27 February 2007.**

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

UNITED STATES PATENT AND TRADEMARK OFFICE

2 4 APR 2008

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

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| In re Application of<br>CHOI (Deceased)<br>Application No.: 11/574,393<br>PCT No.: PCT/KR05/02924<br>Int. Filing Date: 03 September 2005<br>Priority Date: 03 September 2004<br>Attorney Docket no.: Q99791<br>For: PYRROLO[3,2-c] PYRIDINE DERIVATIVES AND PROCESSES FOR THE PREPARATION THEREOF | DECISION ON<br><br>REQUEST<br><br>UNDER 37 CFR 1.42 |

This is a decision on applicant's submission filed in the United States Patent and Trademark Office (USPTO) on 19 November 2007 and treated as a request under 37 CFR 1.42.

## BACKGROUND

On 27 February 2007, applicant filed a transmittal letter requesting entry into the U.S. national stage for international application PCT/KR05/02924.

On 19 September 2007, a Notification of Missing Requirements was mailed to applicant indicating an oath or declaration, in compliance 37 CFR 1.497(a) & (b), is required.

On 19 November 2007, applicant filed a "Response to Notification of Missing Requirements" under 37 CFR 1.42.

## DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

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

The legal representative of a deceased inventor must make the application for patent "on the same terms and conditions applicable to the inventor." 35 U.S.C. 117. To this end, 37 CFR

1.497(b)(2) states, in pertinent part,:

"If the person making the oath or declaration or any supplemental declaration is not the inventor (§§1.42, 1.43 or §1.47), the oath or declaration shall state the relationship of the person to the inventor...and the citizenship, residence and mailing address of the legal representative". (Emphasis added.)

37 CFR 1.497(b)(2) requires the declaration to *state the relationship* of the person(s) (under 37 CFR 1.42) making the declaration for a deceased inventor and *state the citizenship, residency and mailing address of the heir(s)/legal representative as well as that of the deceased inventor.*

A review of the declaration submitted on 19 November 2007 reveals that the declaration is in the Korean and English language. The declaration was not in the form provided by the USPTO (i.e. Form PTO/SB/103). However, as stated in 37 CFR 1.69(b), a statement that the translation is accurate was found in declaration. See also MPEP 602.06.

Moreover, the declaration does not provide an English translation of the citizenship, residency and last known mailing address for the deceased inventor CHOI and is unacceptable.

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **DISMISSED WITHOUT PREJUDICE.**

Applicant is required to correct the above-noted defects including the furnishing of a oath/declaration in compliance with 37 CFR 1.42 and 1.497 within **TWO (2) MONTHS** from the mail date of this Decision.

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

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

2 8 AUG 2008

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| In re Application of<br>CHOI (Deceased)<br>Application No.: 11/574,393<br>PCT No.: PCT/KR05/02924<br>Int. Filing Date: 03 September 2005<br>Priority Date: 03 September 2004<br>Attorney Docket no.: Q99791<br>For: PYRROLO[3,2-c] PYRIDINE DERIVATIVES AND PROCESSES FOR THE PREPARATION THEREOF | : | DECISION ON<br><br>REQUEST<br><br>UNDER 37 CFR 1.42 |

This is a decision on applicant's submission filed in the United States Patent and Trademark Office (USPTO) on 19 November 2007 and treated as a request under 37 CFR 1.42.

## BACKGROUND

On 27 February 2007, applicant filed a transmittal letter requesting entry into the U.S. national stage for international application PCT/KR05/02924.

On 19 September 2007, a Notification of Missing Requirements was mailed to applicant indicating an oath or declaration, in compliance 37 CFR 1.497(a) & (b), is required.

On 19 November 2007, applicant filed a "Response to Notification of Missing Requirements" under 37 CFR 1.42.

On 24 April 2008, a decision was mailed to applicant indicating that the declaration did not provide an English translation of the citizenship, residency and last known mailing address for the deceased inventor CHOI and was unacceptable.

On 13 June 2008, an executed declaration was submitted in response to the 24 April 2008 decision.

## DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

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

The legal representative of a deceased inventor must make the application for patent "on the same terms and conditions applicable to the inventor." 35 U.S.C. 117. To this end, 37 CFR 1.497(b)(2) states, in pertinent part,:

"If the person making the oath or declaration or any supplemental declaration is not the inventor (§§1.42, 1.43 or §1.47), the oath or declaration shall state the relationship of the person to the inventor...and the citizenship, residence and mailing address of the legal representative". (Emphasis added.)

37 CFR 1.497(b)(2) requires the declaration to *state the relationship* of the person(s) (under 37 CFR 1.42) making the declaration for a deceased inventor and *state the citizenship, residency and mailing address of the heir(s)/legal representative as well as that of the deceased inventor.*

A review of the declaration submitted on 13 June 2008 reveals that the declaration is in the Korean and English language. Although the declaration was not in the form provided by the USPTO (i.e. Form PTO/SB/103), as stated in 37 CFR 1.69(b), a statement that the translation is accurate was found in declaration. (See MPEP 602.06). The declaration states the relationship of the person(s) (under 37 CFR 1.42) making the declaration for a deceased inventor and states the citizenship, residency and mailing address of the heir(s)/legal representative as well as that of the deceased inventor. The declaration now provides an English translation of the citizenship, residency and last known mailing address for the deceased inventor CHOI and is acceptable.

## CONCLUSION

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

The application will be forwarded to the United States Designated /Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is 13 June 2008.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

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Alexandria, VA 22313-1450
www.uspto.gov

NICOLAS E. SECKEL
Patent Attorney
1250 Connecticut Avenue, NW Suite 700
WASHINGTON DC 20036

10/8/09

*In re* Application of:
LEVASSEUR, GUILLAUME et al
Serial No.: 11/574,403
Filed: Feb. 27, 2007
Docket: MSDI-187/PC1104.00
Title: METHOD OF INHIBITING THE AUTOMATIC STOP CONTROL SYSTEM OF THE HEAT ENGINE OF A VEHICLE IN CONGESTED TRAFFIC

DECISION ON PETITION

This is a decision on the petition filed on September 16, 2009 seeking withdrawal of the finality of the Office action mailed July 16, 2009 and issued a new non-final Office action This petition is being considered pursuant to 37 CFR §1.181. No fee is required.

The petition is granted.

It is noted that the record shows that the applicant has not amended any claims in the amendment filed on March 12, 2009. Therefore, at least the new rejection of claim 1 based on obviousness-type double patenting on the newly cited copending application, SN 11/574,399 was not necessitated by the amendment filed on March 12, 2009. As such, the finality of the Office actions issued on July 16, 2009 is premature and thus the finality of the action is hereby withdrawn. The Office action mailed on July 16, 2009 will be designated as non-final Office action. The period to respond to the Office action of July 16, 2009 remains unchanged. Since the finality is being withdrawn, an amendment responding to the Office action will be treated as a 37 CFR § 1.111 amendment.

In the petition, petitioner also argues that the examiner has not commented on the terminal disclaimer filed on April 25, 2009. This is not true because Paragraphs 1 and 2 of page 2 of the Office action, the examiner stated that "1.The terminal disclaimer filed on 4/25/2009 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 2/27/2007 has been reviewed and is NOT accepted. 2. The terminal disclaimer does not comply with 37 CFR 1.321 (b) and/or (c) because: The application/patent being disclaimed has been improperly identified since the number used to identify the 11574402 being disclaimed is incorrect. The correct number is 11574404.

In view of the confusion in the Office action as to the status of the disclaimer filed on April 25, 2009, the request for a new Office action is granted. The finality of the last Office action mailed July 16, 2009 is also withdrawn. The requested withdrawal of finality of the last Office action is granted.

The application is being forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3747 for preparation of a new Office action.

The mere filing of a petition will not stay any period for reply that may by running against the application, nor act as a stay of other proceedings as stated in 37CFR § 1.181(f.) Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION GRANTED.

Robert Olszewski, Director
Technology Center 3700

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P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

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JUL 17 2009

OFFICE OF PETITIONS

Applicants: Jimenez et al.
Application No.: 11/574,428
Intenational Filing Date: August 30, 2005
Title: METHODS AND COMPOSITIONS TO INHIBIT P2X7 RECEPTOR EXPRESSION
Attorney Docket No.: 22355-002US1 F/USP290262
Pub. No.: 2009/0005330 A1
Pub. Date: January 1, 2009

This is a decision on the request for corrected of patent application publication under 37 CFR 1.221(b), received on February 24, 2009, for the above-identified application.

Applicant requests that the application be republished because the patent application republication contains material errors, wherein paragraph [0025] has text with an inconsistent font, claim 12 includes an error introduced by the preliminary amendment, claim 34 is incomplete and claims 35-38 were omitted.

The request is granted-in-part.

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 or revised patent application publication other than as provided in paragraph (a) of this section must be filed within two months from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. [1]

The request is granted with respect to claims 34-38.

The error noted by requestor with respect to the font used in the publication is not an error that will be correct by corrected publication. The font used in the publication is determined by the publisher and not an error in the publication.

The errors noted by requestor with respect to claims 12 is not an Office errors The patent application publication correctly reflects claims 12 as amended.

[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).

Applicant is reminded of his duty to conduct a reasonable inquiry before filing a paper before the Office. See MPEP 410.

It would greatly benefit the Office if **applicant did not provide copies of papers**, which were previously submitted and/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.

A "request for republication of an application previously published" filed under 37 CFR 1.221(a) "must include a copy of the application compliance with the Office's electronic filing system [EFS] requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i)." Applicant's petition does not comply with the EFS requirements. The republication will not take place and the publication fee set forth in § 1.18(d) has not been charged. The processing fee will be retained.

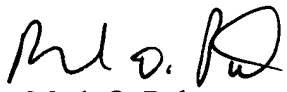
A guide for filing a request for a Pre-Grant Publication, such as a request for republication, may be found on the link below:

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

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

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



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

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**Darby & Darby P.C.**
**P.O. Box 770**
**Church Street Station**
**New York, NY 10008-0770**

**COPY MAILED**

**NOV 06 2008**

| | | |
|---|---|---|
| In re Application of | : | |
| Sigrid Heuer | : | |
| Application No. 11/574,443 | : | DECISION ON PETITION |
| Filed: February 28, 2007 | : | TO WITHDRAW |
| Attorney Docket No. 20864/0205122-US0 | : | 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 October 2, 2008.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Erik R. Swanson on behalf of all attorneys/agents associated with customer number 07278. All attorneys/agents associated with customer number 07278 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The correspondence address has been changed and is copied below.

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

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Sigrid Heuer
Corneliusstrasse 22
Frankfurt/Main, Germany 60325

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/574,443 | 02/28/2007 | Sigrid Heuer | 20864/0205122-US0 |

**CONFIRMATION NO. 4674**

**POWER OF ATTORNEY NOTICE**

7278
DARBY & DARBY P.C.
P.O. BOX 770
Church Street Station
New York, NY 10008-0770

Date Mailed: 11/06/2008

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/02/2008.

- 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.

/kainabinet/

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

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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In re Application of :
Lawrence E. Tannas, Jr. :

Application No. 11574504 :DECISION ON PETITION TO MAKE SPECIAL
:UNDER 37 CFR 1.102(c)(1)
Filed: :

Attorney Docket No. TNS-010

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1) ,filed 17-JUN-2008 to make the above-identified application special based on applicant's age as set forth in MPEP § 708.02, Section IV.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1), MPEP § 708.02, Section IV: Applicant's Age must include a statement by applicant or a registered practitioner having evidence that applicant is at least 65 years of age. No fee is required.

Accordingly, the above-identified application has been accorded “special” status and will be taken up for action by the examiner upon the completion of all pre-examination processing.

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

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

PTO/SB/130 (03-08)
Approved for use through 05/31/2008. OMB 0651- 0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number

# PETITION TO MAKE SPECIAL BASED ON AGE FOR ADVANCEMENT OF EXAMINATION UNDER 37 CFR 1.102(c)(1)

## Application Information

| | | | | | |
|---|---|---|---|---|---|
| Application Number | 11574504 | Confirmation Number | 5546 | Filing Date | 2007-02-28 |
| Attorney Docket Number (optional) | TNS-010 | Art Unit | 2871 | Examiner | not yet assigned |
| First Named Inventor | Lawrence E. Tannas, Jr. | | | | |
| Title of Invention | APPARATUS AND METHODS FOR RESIZING ELECTRONIC DISPLAYS | | | | |

**Attention: Office of Petitions**

An application may be made special for advancement of examination upon filing of a petition showing that the applicant is 65 years of age, or more. No fee is required with such a petition. See 37 CFR 1.102(c)(1) and MPEP 708.02 (IV).

APPLICANT HEREBY PETITIONS TO MAKE SPECIAL FOR ADVANCEMENT OF EXAMINATION IN THIS APPLICATION UNDER 37 CFR 1.102(c)(1) and MPEP 708.02 (IV) ON THE BASIS OF THE APPLICANT'S AGE.

A grantable petition requires one of the following items:
(1) Statement by one named inventor in the application that he/she is 65 years of age, or more; or
(2) Certification by a registered attorney/agent having evidence such as a birth certificate, passport, driver's license, etc. showing one named inventor in the application is 65 years of age, or more.

**Name of Inventor who is 65 years of age, or older**

| Given Name | Middle Name | Family Name | Suffix |
|---|---|---|---|
| Lawrence | E. | Tannas | Jr. |

A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18.
Please see 37 CFR 1.4(d) for the format of the signature.

Select (1) or (2) :

○ (1) I am an inventor in this application and I am 65 years of age, or more.

◉ (2) I am an attorney or agent registered to practice before the Patent and Trademark Office, and I certify that I am in possession of evidence, and will retain such in the application file record, showing that the inventor listed above is 65 years of age, or more.

| | | | |
|---|---|---|---|
| Signature | /william a. english/ | Date (YYYY-MM-DD) | 2008-06-17 |
| Name | William A. English | Registration Number | 42515 |

PTO/SB/130 (03-08)
Approved for use through 05/31/2008. OMB 0651- 0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Fr eedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about indivi duals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

14 NOV 2008

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P.O. BOX 770
CHURCH STREET STATION
NEW YORK, NEW YORK 10008-0770

In re Application of:
WITELSON, Brian, et al.
U.S. Application No.: 11/574,524
PCT No.: PCT/US2005/031362
International Filing Date: 02 September 2005
Priority Date: 03 September 2004
Atty's Docket No.: 20084/1201040-US1
For: ELECTRODE FOR USE IN A DEIONIZATION APPARATUS AND METHOD OF MAKING SAME

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This decision is issued in response to applicants' "Petition Under 37 CFR 1.47(a)" filed 30 September 2008. Applicants have paid the required petition fee.

## BACKGROUND

On 02 September 2005, applicants filed international application PCT/US2005/031362. The international application claimed a priority date of 03 September 2004, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 03 March 2007.

On 01 March 2007, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the small entity basic national fee.

On 01 August 2008, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497, the surcharge for filing the oath or declaration later than thirty months after the priority date, and additional fees were required.

On 30 September 2008, applicants filed a response to the Notification Of Missing Requirements. The response included payment of the required fees and surcharge, a partially executed declaration, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of co-inventor James R. FAJT, whom applicants assert has refused to execute the application or cannot be located after diligent effort.

## DISCUSSION

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

Applicants here have provided the required petition fee, and the petition states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

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

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

Here, applicants have filed declarations executed by two of the three inventors of record in the international application, and the declarations contain an unsigned signature block for the non-signing inventor James R. FAJT. These declarations can be accepted as having been executed by the signing inventors on their own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute 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 MPEP also states the following:

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

Here, as evidence of the inventor's refusal to execute the declaration, applicants have provided a statement from Flynn Barrison setting forth the efforts made to obtain the signature of the non-signing inventor, with supporting documents. Mr. Barrison states that, in response to a mailing that included a copy of the complete application, inventor FAJT provided a signed declaration containing unacceptable handwritten notations and that, in response to a subsequent mailing, the inventor provided a second signed declaration again containing an unacceptable handwritten annotation (this time in the inventor's address). The statement indicates that another request for signature, accompanied by a corrected copy of the declaration and the application papers, was mailed to the inventor on 13 February 2008, and that no response to this mailing has been received, and that an additional request for signature was sent to the inventor on 07 April 2008, to which no response has been received. However, applicants have not included in the petition any of the responsive correspondence received from the inventor, as necessary to

confirm the receipt of the signature requests by the inventor. In addition, the 13 February 2008 and 07 April 2008 mailings to inventor FAJT were signed by Paul Fields, not Mr. Barrison. In that the inventor's failure to respond to these final mailings would serve as the basis for a finding that this inventor has refused to execute the application, a statement from Mr. Fields providing firsthand confirmation of these mailings is required before it can be concluded that inventor FAJT has refused to execute the application. Until such supplemental materials are filed, item (4) is not satisfied.

## CONCLUSION

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

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy item (4) of a grantable petition, as discussed above and in the MPEP. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

18 MAR 2009

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

DARBY & DARBY P.C.
P.O. BOX 770
CHURCH STREET STATION
NEW YORK, NEW YORK 10008-0770

In re Application of:
ELSON, Brian, et al.
U.S. Application No.: 11/574,524
PCT No.: PCT/US2005/031362
International Filing Date: 02 September 2005
Priority Date: 03 September 2004
Atty's Docket No.: 20084/1201040-US1
For: ELECTRODE FOR USE IN A DEIONIZATION APPARATUS AND METHOD OF MAKING SAME

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

This decision is issued in response to applicants' "Renewed Petition Under 37 CFR 1.47(a)" filed 13 January 2009. No additional petition fee is required.

## BACKGROUND

The procedural background for the present application was set forth in the decision mailed on 14 November 2008. The decision dismissed without prejudice applicant's original petition under 37 CFR 1.47(a) for failure to satisfy all requirements of a grantable petition. Specifically, applicants had not provided an acceptable showing that the non-signing inventor refused to execute the application or cannot be located after diligent effort.

On 13 January 2009, applicants filed the renewed petition considered herein.

## DISCUSSION

The renewed petition includes supplemental materials describing the efforts made to obtain the signature of non-signing inventor James R. FAJT, including a statement from Paul Fields, with accompanying exhibits.

The renewed petition includes evidence of Mr. FAJT's unacceptable response to earlier signature requests, as discussed in the original petition. In addition, Mr. Fields confirms the mailing of the final request for signature to Mr. FAJT on 13 February 2008 (which was signed by Mr. Fields), and a subsequent reminder on 07 April 2008, and provides evidence of delivery of such mailings to the inventor's address. Finally, Mr. Fields indicates that no response to this request has been received. These materials, in combination with those previously submitted, provide an acceptable showing the James R. FAJT has refused to execute the application.

Based on the above, applicants have now satisfied the final requirement of a grantable petition under 37 CFR 1.47(a).

## CONCLUSION

The renewed petition under 37 CFR 1.47(a) is **GRANTED**. The application is accepted without the signature of non-signing inventor James R. FAJT.

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 petition.

The application is being referred 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 September 2008.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

18 MAR 2009

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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James R. FAJT
604 Benchmark Drive
College Station, Texas 77845

In re Application of: ELSON, Brian, et al.
U.S. Application No.: 11/574,524
PCT No.: PCT/US2005/031362
International Filing Date: 02 September 2005
Priority Date: 03 September 2004
Atty's Docket No.: 20084/1201040-US1
For: ELECTRODE FOR USE IN A DEIONIZATION APPARATUS AND METHOD OF MAKING SAME

Dear Mr. FAJT:

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:
DARBY & DARBY P.C.
P.O. BOX 770
CHURCH STREET STATION
NEW YORK, NEW YORK 10008-0770

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Alexandria, VA 22313-1450
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20 AUG 2007

Robert C. Faber
Ostrolenk, Faber, Gerb & Soffen, LLP
1180 Avenue of the Americas
New York, New York 10036-8402

In re Application of :
COLLIARD et al. :
Application No.: 11/574,572 : DECISION ON PETITION
PCT No.: PCT/FR05/01923 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 25 July 2005 :
Priority Date: 23 July 2004 :
Attorney Docket No.: P/24-192V2995 :
For: ELECTROCHEMICAL :
COMPENSATION OSCILLATOR FOR
THE BIOLOGICAL PROTECTION OF
LIVING ORGANISMS

The petition to revive under 37 CFR 1.137(b) filed 01 March 2007 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
Fax: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

16 OCT 2008

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

30008
GUDRUN E. HUCKETT DRAUDT
Schubertstr. 15A
Wuppertal, 42289
Germany

In re Application of :
JENSEN *et al* :
U.S. Application No.: 11/574,585 :
PCT No.: PCT/DE2005/001445 :
Int. Filing Date: 16 August 2005 : **DECISION**
Priority Date: 02 September 2004 :
Attorney's Docket No.: 1814 :
For: TOOL SUPPORT FOR TOOLS ON MACHINE TOOLS :

This is a decision on the papers filed 30 July 2008 which are treated under 37 CFR 1.497(d).

## BACKGROUND

On 12 September 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee were required. Applicants were given two months to respond with extensions of time available.

On 01 October 2007, applicants filed a declaration executed by two joint inventors.

On 01 May 2008, a communication was mailed noting that the declaration filed 01 October 2007 was not in compliance with 37 CFR 1.497(a) and (b) as the international application listed only one inventor and the declaration recorded two inventors.

On 14 July 2008, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916) for the reason noted above.

On 30 July 2008, applicants filed the subject petition to add an inventor.

## DISCUSSION

Applicants request that Klaus Maier be added 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 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(l); and
>
> (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

Applicants filed a statement by Mr. Maier who requests to be added as an inventor in the above-captioned application. The statement declares that the omission "occurred without deceptive intention." The processing fee of $130.00 has been paid.

Applicants also submitted a statement signed by Werner Tschiggfrei as Business Manager of the assignee WTO Werkzeug-Einrichtungen GmbH agreeing to the change in ownership in the above-captioned application. A statement under 37 CFR 3.73(b) signed by Mr. Tschiggfrei attesting that he is authorized to act on behalf of the assignee was also provided. This statement is sufficient to meet the requirements of section 324 of the MPEP. WTO Werkzeug-Einrichtungen GmbH is the assignee of the above-captioned application. The reel and frame number of the assignment was also 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**.

Klaus Maier has been added as an inventor in the subject application.

The declaration filed 01 October 2007 is now in compliance with 37 CFR 1.497(a) and (b).

**11/574,585**

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 16 August 2005 under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 01 October 2007.

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

31 OCT 2008

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P.O. BOX 1450
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Paul D. Bianco
FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO, P.L.
21355 East Dixie Highway
Suite 115
Miami, FL 33180

In re Application of :
KRUSE :
Application No.:11/574,599 : DECISION ON
PCT Application No.: PCT/EP05/08836 :
Int. Filing Date: 13 August 2005 : PETITION
Priority Date: 07 September 2004 :
Attorney Docket No.: 7400-X07-186 : UNDER 37 CFR §1.181(a)
For: Fluid Reservoir For A Paint Spray Gun :

This decision is in response to applicant's "PETITION UNDER 37 CFR §1.181(a) TO WITHDRAW THE HOLDING OF ABANDONMENT" filed 02 July 2008 requesting relief based on non-receipt of the "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)".

## BACKGROUND

On 13 August 2005, applicant filed international application PCT/EP05/08836, which claimed priority to an earlier German application filed 07 September 2004. The thirty month national stage deadline expired on 07 March 2007. On 02 March 2007, 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).

On 17 September 2007, 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 of the inventors must be filed.

On 18 June 2008, a Notification of Abandonment (PCT/DO/EO/909) was mailed to applicant, indicating that the application had become abandoned for failure to timely reply to the Notification of Missing Requirements (PCT/DO/EO/905) mailed on 17 September, 2007.

On 02 July 2008, applicant filed the instant petition to under 37 CFR 1.181 to withdraw the holding of abandonment.

## DISCUSSION

MPEP 711.03(c), Section I. A., "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action" states in relevant part,

> The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.
>
> Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.
>
> A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The petition states that the Notification of Missing Requirements was never received. Petitioner has provided a statement from the practitioner that the correspondence was not received. Furthermore, the petition contains a statement that a search of the practitioner's file records revealed that the correspondence was not received and a statement describing the docketing system of the practitioner's firm and establishing that the system is sufficiently reliable. Additionally, the renewed petition includes a copy of the master docket record for the practitioner's firm, listing all replies docketed for the due date for reply to the Notification of Missing Requirements. Such docket record indicates that no response was due on 17 November 2007 for the present application.

## CONCLUSION

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

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 18 June 2008 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 13 August 2005, and a date under 35 U.S.C. (c)(1), (c)(2), and (c)(4) of 02 July 2008.

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

Helen L. Pezzuto
Detailee
PCT Legal Administration
Telephone: (571) 272-6094
Fax: (571) 273-0459

Bryan Lin
PCT Legal Examiner
PCT Legal Administration

01 APR 2008

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Alexandria, VA 22313-1450
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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON VA 20191

In re Application of :
Ruppert et al. :
Application No.: 11/574,616 :
PCT No.: PCT/EP2004/009847 :
Int. Filing Date: 03 September 2004 : DECISION
Priority Date: N/A :
Attorney Docket No.: P31777 :
For: Multicolor Cosmetics :

This is in response to the submission under 37 CFR 1.497(d) filed on 05 November 2007.

## BACKGROUND

This international application was filed on 03 September 2004, claimed no earlier priority date, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 03 March 2007. Applicant filed *inter alia* the basic national fee on 02 March 2007.

On 16 July 2007, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an English translation, an oath or declaration compliant with 37 CFR 1.497(a) and (b), a processing fee under 37 CFR 1.492(i) and a surcharge under 37 CFR 1.492(h).

On 07 August 2007, applicants filed a response.

On 04 October 2007, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to applicants, indicating that the declaration was defective because it listed an inventor not named in the published international application.

## DISCUSSION

A declaration filed under 37 CFR 1.497 (d) must be by the actual inventor or inventors as required under 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47. The 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 the error in inventorship occurred without deceptive intention on his or her part, (2) the processing fee set forth in 37 CFR 1.17; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (*See* 37 CFR 3.73(b)). *See* Section 201.03 of the Manual of Patent Examining Procedure (M.P.E.P.).

Regarding requirement (1), applicants have provided an appropriate statement by Michaela KOHUT, who is sought to be added as an inventor.

Regarding requirement (2), the required processing fee was paid on 05 November 2007.

Regarding requirement (3), applicants have furnished appropriate evidence of the consent of the assignee, Beiersdorf AG, to the change in inventorship.

Inspection of the dual language declaration filed on 07 August 2007 (and on 05 November 2007) reveals that it does not appear to have been made on a form provided by the USPTO, and that it does not appear to include a statement that the translation is accurate. Attention is drawn to 37 CFR 1.69(b), which provides that

> Unless the text of any oath or declaration in a language other than English is in a form provided by the Patent and Trademark Office or in accordance with PCT Rule 4.17(iv), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.

In the absence of such a statement, it would not be appropriate to accept the declaration at this time.

## CONCLUSION

The declaration 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. No additional processing fee is required.

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

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

23 JUN 2008

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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON VA 20191

In re Application of :
Ruppert et al. :
Application No.: 11/574,616 :
PCT No.: PCT/EP2004/009847 :
Int. Filing Date: 03 September 2004 : DECISION
Priority Date: N/A :
Attorney Docket No.: P31777.P05 :
For: Multicolor Cosmetics :

This is in response to the correspondence filed on 30 May 2008.

## DISCUSSION

In a Decision mailed on 01 April 2008, in response to the submission under 37 CFR 1.497(d) filed on 05 November 2007, the declaration was not accepted, without prejudice, because

> Inspection of the dual language declaration filed on 07 August 2007 (and on 05 November 2007) reveals that it does not appear to have been made on a form provided by the USPTO, and that it does not appear to include a statement that the translation is accurate. Attention is drawn to 37 CFR 1.69(b), which provides that
>
> *Unless the text of any oath or declaration in a language other than English is in a form provided by the Patent and Trademark Office or in accordance with PCT Rule 4.17(iv), it must be accompanied by an English translation together with a statement that the translation is accurate, except that in the case of an oath or declaration filed under § 1.63, the translation may be filed in the Office no later than two months from the date applicant is notified to file the translation.*
>
> In the absence of such a statement, it would not be appropriate to accept the declaration at this time.

**In response**, petitioner has provided a "Statement Regarding Translation," signed by Heribert Muensterer, stating that "I am well acquainted with both the German and English languages, and that the English language part of the attached executed Declaration and Power of Attorney for U.S. Patent Application No. 11/574,616 is an accurate translation, to the best of my knowledge and ability, of the German language part of said Declaration and Power of Attorney." In view of this statement, the requirements of 37 CFR 1.69(b) have been satisfied. Accordingly, as all of the requirements of 37 CFR 1.497(d) were previously satisfied, it would now be appropriate to accept the declaration.

## DECISION

The declaration is **ACCEPTED** under 37 CFR 1.497(d)..

This application is being forwarded to the Office of Patent Application Processing for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **07 August 2007**.

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

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WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON VA 20190

| | | |
|---|---|---|
| In re Application of | : | |
| JACOBY et al. | : | |
| Application No.: 11/574,619 | : | |
| PCT No.: PCT/US2005/022744 | : | |
| Int. Filing Date: 24 June 2005 | : | DECISION |
| Priority Date: 03 September 2004 | : | |
| Attorney Docket No.: 01640486AA | : | |
| For: DETECTING SOFTWARE ATTACKS BY MONITORING ELECTRIC POWER CONSUMPTION PATTERNS | : | |

This decision is in response to applicantss' "COMMUNICATION TO ADD INVENTOR IN NON-PROVISIONAL APPLICATION UNDER 37 CFR 1.48(a)", which has properly been treated as a petition under 37 CFR 1.497(d), filed 02 March 2007 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 24 June 2005, applicants filed international application PCT/US2005/022744 which designated the U.S. and claimed a priority date of 03 September 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 16 March 2006. The thirty-month period for paying the basic national fee in the United States expired at midnight on 05 March 2007 (03 March 2007 being a Saturday).

On 02 March 2007, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee, an assertion of small entity status, a declaration of inventors, and the instant petition under 37 CFR 1.497(d).

## DISCUSSION

Petition Under 37 CFR 1.497(d)

37 CFR 1.497(d), provides:

> (d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92$^{bis}$ subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this

> section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:
>
> (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
>
> (2) The processing fee set forth in Sec. 1.17(i); and
>
> (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see Sec. 3.73(b) of this chapter); and
>
> (4) Any new oath or declaration required by paragraph (f) of this section.

Items (1) and (3) have been satisfied. Item (4) is not required.

As to item (2), the processing fee of $130 has been charged to Deposit Account 50-2041.

Declaration of Inventors

The declaration of inventors filed 02 March 2007 is not sufficient. The declaration contains non-initialed alterations. 37 CFR 1.52(c). "The Office will not consider whether noninitialed and or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration." MPEP § 605.04(a). Item I. Additionally, the declaration is an improper composite declaration, consisting of one of Page 1, one of Page 2, two of Page 3, and one of Page 4. Each inventor must be presented with a complete declaration which lists all of the inventors, and the signature of each inventor must appear on at least one complete declaration. Multiple complete declarations may be submitted, but it is not permissible to combine pages of separate documents.

## CONCLUSION

The request under 37 CFR 1.497(d) is **GRANTED** for the reasons set forth above.

Applicants are required to file a proper declaration within TWO (2) MONTHS from the date of mailing of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper reply will result in abandonment of the application.

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

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

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

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MAY 11 2009

**OFFICE OF PETITIONS**

In re Application of :
**Henry E. YOUNG, et al.** :
Application No. 11/574,622 : DECISION ON PETITION TO
Filed: October 28, 2008 : WITHDRAW FROM RECORD
Attorney Docket No. **101353.0002US** :

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 4, 2009.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to **RUTAN & TUCKER, LLP** has been revoked by the assignee of the patent application on April 3, 2009. 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: **FISH & ASSOCIATES, PC**
**ROBERT D. FISH**
**2603 MAIN STREET, SUITE 1000**
**IRVINE, CA 92614-6232**

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GIFFORD, KRASS, SPRINKLE,ANDERSON & CITKOWSKI, P.C
PO BOX 7021
TROY, MI 48007-7021

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Hartmut S. Engel | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7635207 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/574,663 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 03/02/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **109** 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.

0 8 MAR 2007

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NAVAL RESEARCH LABORATORY
ASSOCIATE COUNSEL (PATENTS)
CODE 1008.2
4555 OVERLOOK AVENUE, S.W.
WASHINGTON DC 20375-5320

In re Application of:
BLUM, Amy Szuchmacher, et al.
U.S. Application No.: 11/574,676
PCT No.: PCT/US2005/026914
International Filing Date: 01 August 2005
Priority Date: 30 July 2004
Atty Docket No.: 96174-US2
For: PROTEIN SCAFFOLDS AND VIRAL PARTICLES FOR DETECTING ANALYTES

DECISION ON PETITION

The petition for revival under 37 CFR 1.137(b) filed 05 March 2007 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" satisfies the requirements of 37 CFR 1.137(b)(3).

Applicant has now submitted the basic national fee, and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

It is noted the 05 March 2007 submission included an executed declaration in compliance with 37 CFR 1.497 and payment of the surcharge required for filing the declaration later than thirty months after the priority date.

This application is being referred 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 05 March 2007.

03/08/2007 SBASHEIR 00000002 500281 11574676
Sale Ref: 00000002 DA#: 500281 11574676
01 FC:1453 1500.00 DA

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

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MAY 19 2010

OFFICE OF PETITIONS

LEASON ELLIS LLP
81 MAIN STREET
SUITE 503
WHITE PLAINS, NY 10601

In re Application of :
Terutsugu Oyama :
Application No.: 11/574,689 : ON PETITION
Filed: May 7, 2007 :
Attorney Docket No.: 20441/0206361-US0 :

This is a decision on the petition, filed May 18, 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 May 13, 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 2834 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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24 JUL 2007

Knobbe, Martens, Olson & Bear, LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

In re Application of
DUBY, Sean R.
Application No.: 11/574,722
PCT No.: PCT/US05/06947
Int. Filing Date: 04 March 2005
Priority Date: 09 March 2004
Attorney Docket No.: 1991.78033
For: FILTER PLATE ASSEMBLY FOR FILTER

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 05 March 2007 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
Fax: (571) 273-0459

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**Barnes & Thornburg, LLP**
**P.O. Box 2786**
**Chicago, IL 60690-2786**

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JUN 0 3 2008

OFFICE OF PETITIONS

In re Application of :
Roy Rozek et al. :
Application No. 11/574,807 : DECISION ON PETITION
Filed: March 6, 2007 : TO WITHDRAW
Attorney Docket No. 926512-105228 : 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 April 18, 2008.

The request is **APPROVED**.

A review of the file record indicates that Thomas J. Donovan of the firm Barnes & Thornburg, LLP: (1) does not have power of attorney in this patent application; and (2) has been employed or otherwise engaged in the proceedings in this patent application. In view of the present decision, all the attorneys associated with customer number 23644 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) an intervening assignee of the entire interest under 37 C.F.R. 3.71. Accordingly, all correspondence will be mailed to the first named inventor, since no assignee has properly intervened in this application. A courtesy copy of this decision will be mailed to the address noted on the request to withdraw. If this firm desires to receive future correspondence regarding this application, the proper power of attorney documents must be submitted.

Applicant is reminded that there is no attorney of record 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: Harry Lynn
911 Bayberry Lane
Kohler, WI 53044

cc: Welsh & Katz, Ltd.
120 S Riverside Plaza
22nd Floor
Chicago, IL 60606

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/574,807 | 03/06/2007 | Roy Rozek | 926512-105228 |

**CONFIRMATION NO. 9718**

23644
BARNES & THORNBURG LLP
P.O. BOX 2786
CHICAGO, IL 60690-2786

**POWER OF ATTORNEY NOTICE**

*OC000000030263333*

Date Mailed: 06/03/2008

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 04/18/2008.

- 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.

/kainabinet/

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

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POWELL GOLDSTEIN LLP
ONE ATLANTIC CENTER FOURTEENTH FLOOR
1201 WEST PEACHTREE STREET NW
ATLANTA GA 30309-3488

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APR 16 2008

In re Application of :
**LOPES**, et al. :
Application No. 11/574,845 : DECISION ON PETITION
Filed: March 7, 2007 : TO WITHDRAW
Attorney Docket No. **149559.00300** : 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 24, 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 Charles Warner on behalf of all attorneys of record. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

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

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **CLAUDIO C. LOPES**
**AV DOM HELDER CAMARO**
**3119 CASA 19, APT 201 DEL CASTILHO**
**RIO DE JANEIRO, BRASIL**

cc: **LARENCE P. COLTON**
**SMITH GAMBRELL & RUSSELL**
**1230 PEACHTREE STREET, NW**
**PROMENADE II, SUITE 3100**
**ATLANTA, GA 30309**

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**100 CORSON STREET**
**THIRD FLOOR**
**PASADENA CA 91103-3842**

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| | | |
|---|---|---|
| In re Application of | : | |
| Harvey L. Deutsch | : | DECISION ON PETITION |
| Application No. 11/574,865 | : | TO WITHDRAW |
| Filed: March 7, 2007 | : | FROM RECORD |
| Attorney Docket No. 16475-1US | : | |

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed July 29, 2009.

The request is **NOT APPROVED**.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71,* or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

Therefore, as there is currently no Statement under 37 CFR 3.73(b) currently of record in the instant application, the Office cannot change the correspondence address to the address on the Request to Withdraw.

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

Currently, there is no Office action that requires a reply.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Joan Olszewski
Petitions Examiner
Office of Petitions

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| | | |
|---|---|---|
| In re Application of | : | |
| Harvey L. Deutsch | : | DECISION ON PETITION |
| Application No. 11/574,865 | : | TO WITHDRAW |
| Filed: March 7, 2007 | : | FROM RECORD |
| Attorney Docket No. 16475-1US | : | |

This is a decision on the renewed request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed September 24, 2009.

The request is **NOT APPROVED**.

The Request for Withdrawal as Attorney or Agent and Change of Correspondence Address submitted on July 29, 2009 and renewed September 24, 2009 is hereby not accepted. Petitioner has not complied with current USPTO requirements, as set forth in 37 CFR 10.40 concerning Request for Withdrawal as Attorney and Change of Correspondence Address. Specifically, pursuant to 37 CFR 10.40, the Office will require the practitioner(s) to certify that he, she or they have:

(1) given reasonable notice to the client, prior to the expiration of the reply period, that the practitioner(s) intends to withdraw from employment;

(2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and

(3) notified the client of any replies that may be due and the time frame within which the client must respond.

Currently, the petition filed July 29, 2009 does not comply with item (1) of the above certifications.

Further, the Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71,* or, if no assignee of the entire interest has properly been

made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

The renewed petition does 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.

Petitioner has not submitted the correct Reel Number on the Statement under 37 CFR 3.73(b). Accordingly, the Office cannot change the correspondence address to the address on the Request to Withdraw. All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Currently, there is an Office action mailed October 7, 2009 that requires a reply.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Joan Olszewski
Petitions Examiner
Office of Petitions

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|---|---|---|
| In re Application of | : | |
| Harvey L. Deutsch | : | DECISION ON PETITION |
| Application No. 11/574,865 | : | TO WITHDRAW |
| Filed: March 7, 2007 | : | FROM RECORD |
| Attorney Docket No. 16475-1US | : | |

This is a decision on the second renewed request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed November 19, 2009.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40 (c).

The request was signed by David A. Farah on behalf of all attorneys of record who are associated with Customer No. 23676.

All attorneys/agents associated with Customer Number 23676 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the assignee at the address indicated below.

Currently, there is an outstanding Office action mailed October 7, 2009 that requires a reply.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: The Catheter Exchange, Inc.
16633 Ventura Boulevard, Suite 735
Encino CA 91436

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27 FEB 2008

McLELAND PATENT LAW OFFICE, PLLC
11320 RANDOM HILLS ROAD
SUITE 250
FAIRFAX, VA 22030

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| DEMAIS et al | : | |
| PCT No.: PCT/FR05/00145 | : | |
| Application No.: 11/574,871 | : | |
| Int. Filing Date: 21 January 2005 | : | PETITION UNDER |
| Priority Date: 09 January 2004 | : | |
| Attorney's Docket No.: MLA-001 | : | |
| For: Intercalated Clays | : | 37 CFR 1.47(a) |

This is in response to the "PETITION UNDER CFR 1.47(a) FOR ACCEPTANCE OF APPLICATION WITHOUT SIGNATURE OF JOINT INVENTOR" filed on 11 February 2008. The $200.00 petition fee has been paid by credit card.

## BACKGROUND

On 21 January 2005, applicants filed international application PCT/FR05/0145, which claimed priority of an earlier application filed 09 January 2004.

On 07 March 2007, 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 10 August 2007, 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 (2) months from the date of mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 11 February 2008, petitioner filed the present petition accompanied, inter alia, an executed Declaration without the signature of inventor, Dominique BRAULT.

## 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(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) - (4) of 37 CFR 1.47(a).

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

Regarding item (2), in this case, Catherine POTTIER has sufficiently demonstrated by her declaration that a complete copy of the application papers were mailed to the non-signing inventor, Mr. Dominique BRAULT, on September 4, 2007 by registered mail and that Mr. Brault refuses to sign the required papers.

In addition, petitioner has provided documentary evidence to support this assertion as evidenced by postal receipt copies, and the cover letter letters addressed to Mr. BRAULT instructing him what to do.

Consequently, the current record supports the premise that Dominique BRAULT conduct constitutes refusal.

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

Dominique BRAULT
7, rue du Trieux
22740 LEZARDRIEUX
FRANCE

Regarding requirement 4, petitioner has provided an executed declaration signed by Herve DEMAIS, Jocelyne BRENDLE, Herve LEDEIT, Anca LAZA, and Lue LURTON on their behalf and on the behalf of the nonsigning joint inventor Dominique BRAULT.

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

## CONCLUSION

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

The Application Division and the International Division are authorized to accept the application as a 37 CFR 1.47(a) application and to mail a filing receipt. The application will be given a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of **11 February 2008.**

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

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

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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2018 POWERS FERRY ROAD
SUITE 800
ATLANTA GA 30339

MAILED

FEB 27 2009

OFFICE OF PETITIONS

Applicant: Shillington
Appl. No.: 11/574,920
International Filing Date: September 16, 2005
Title: CENTRALISED ONLINE ORDERING AND FULFILMENT METHOD AND SYSTEM
Attorney Docket: 5S11.1-010
Pub. No.: US 2008/0065506 A1
Pub. Date: March 13, 2008

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on June 23, 2008, for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication contains the material error of not including a preliminary amendment.

37 CFR 1.221 (b) is applicable "only when the Office makes a material mistake which is apparent from Office records.... Any request for a corrected publication or revised patent application publication other than provided as provided in paragraph (a) of this section must be filed within **two months** from the date of the patent application publication. This period is not extendable." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. [1]

The request for corrected publication, received on June 23, 2008, more than two months from the March 13, 2008 publication date, and therefore was not timely filed under 37 CFR 1.221(b).

The error noted by requestor with respect to failure to include the preliminary amendment in the publication is not an Office error. See 37 CFR 1.215(a). Applicant's attention is further directed to MPEP 1130(B), which clearly states "failure to include an amendment is not an Office error . .

[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] request for corrected publication under 37 CFR 1.221(b) may result in a patent term adjustment reduction where the Office made only non-material errors."

Applicant did not file a substitute specification including the amendment. Applicant did not file a copy of the application in compliance with the Office electronic filing systems requirements.

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 June 23, 2008, 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.

A "request for republication of an application previously published" filed under 37 CFR 1.221(a) "must include a copy of the application compliance with the Office's electronic filing system [EFS] requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i)." Applicant's petition does not comply with the EFS requirements. The republication will not take place and the publication fee set forth in § 1.18(d) has not been charged. The processing fee will be retained.

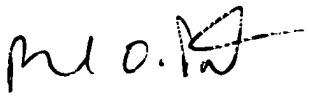
Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system, as a "Pre-Grant Publication" and questions or request for reconsideration of the decision, should be addressed as follows:

By mail to: Mail Stop PGPUB
Commissioner for Patents
P.O. Box 1450
Alexandria, Va. 22313-1450

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

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

Inquiries relating to this matter may be directed to Michael Cygan at (571) 272-7700, or to the undersigned at (571) 272-7709.



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

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01 NOV 2007

26211
FISH & RICHARDSON
P.O. Box 1022
Minneapolis, MN 55440-1022

In re Application of:
SHNIBERG *et al*
U.S. Application No.: 11/574,945
PCT No.: PCT/US2005/027736
Int. Filing Date: 05 August 2005
Priority Date: 05 August 2004
Attorney Docket No.: 18025-002US1
For: MANAGING RISK ASSOCIATED WITH OWNERSHIP OF SHARES IN A COMPANY

**DECISION**

This decision is in response to applicants' petition to revive under 37 CFR 1.137(b) filed with the national stage papers on 08 March 2007 which is hereby **GRANTED** as follows:

The basic national fee and 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. All requirements of 37 CFR 1.137(b) are satisfied.

An executed declaration and a surcharge fee were not provided.

This application is being forwarded to the Office of Patent Application Processing for the mailing of a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a $65.00 surcharge fee pursuant to 37 CFR 1.492(h) are required.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

UNITED STATES PATENT AND TRADEMARK OFFICE

11 SEP 2007

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

THE JANSSON FIRM
9501 N. CAPITAL OF TX HWY #202
AUSTIN TX 78759

In re Application of: RAIMBAULT, Pierre
U.S. Application No.: 11/574,961
Int'l Application No: PCT/FR2004/002902
Int'l Filing Date: 10 November 2004
Priority Date: 13 November 2003
Atty Docket No.: 103.003
For: METHOD FOR IDENTIFYING AN ELECTROINC LABEL, ELECTRONIC LABEL, AND BASE STATION FOR IMPLEMENTING SAID METHOD

DECISION ON PETITION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 08 March 2007 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" satisfies the requirement of 37 CFR 1.137(b)(3). Applicant has now submitted the small entity basic national fee, and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the United States of America.

It is noted that, on 23 May 2007, applicant submitted a translation into English of the international application and the processing fee for filing this English translation later than thirty months after the priority date.

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, including the mailing of a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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DENNISON ASSOCIATES
133 RICHMOND STREET WEST
SUITE 301
TORONTO ON M5H 2L7 CA CANADA

MAILED

JUN 14 2010

OFFICE OF PETITIONS

In re Application of :
Christopher Morris :
Application No. 11/574,965 : ON PETITION
Filed: March 8, 2007 :
Attorney Docket No. JJ-12 805-1US :

This is a decision on the petition, filed May 5, 2010 under 37 CFR 1.137(b) to revive the above-identified application.

The petition is **DISMISSED.**

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "**Renewed Petition under 37 CFR 1.137(b)**." This is **not** 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 February 5, 2009, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on May 6, 2009.

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

The petition does not satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (2) the $810 petition fee was not received. Accordingly, this petition can not be treated until the petition fee is received.

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.

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

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

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

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

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

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Christopher Morris
24 Waterloo Court
Brampton, Ontario L6Y 3M5
Canada

UNITED STATES PATENT AND TRADEMARK OFFICE

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**BARNES & THORNBURG LLP**
**P.O. BOX 2786**
**CHICAGO, IL 60690-2786**

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MAY 27 2008

In re Application of :

**SOLBERG JR.**, Charles H. et al. :
Application No. 11/574,966 : DECISION ON PETITION
Filed: September 24, 2007 : TO WITHDRAW
Attorney Docket No. **926518-105230** : 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 15, 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 reasons set forth in the request, (file responsibility was transferred to the attorneys/agents associated with customer number 24628), 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 Michelle R. Eason at 571-272- 4231.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **WELSH & KATZ, LTD**
**120 S RIVERSIDE PLAZA**
**22ND FLOOR**
**CHICAGO, IL 60606**

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Husch Blackwell Sanders, LLP
Husch Blackwell Sanders LLP Welsh & Katz
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

Mail Date: 04/22/2010

| | | |
|---|---|---|
| **Applicant** | : Charles H. Solberg JR. | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7674307 | : RECALCULATION of PATENT |
| **Issue Date** | : 03/09/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/574,966 | : OF WYETH |
| **Filed** | : 09/24/2007 | : |
| | | : |

The Patentee's Request for Recalculation is **DISMISSED.**

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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DIW May-10

ROBERT L. STEARNS
DICKINSON WRIGHT, PLLC
38525 WOODWARD AVENUE, SUITE 2000
BLOOMFIELD HILLS MI 48304-5092

MAILED

MAY 25 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Linz et al. | : | |
| Application Number: 11/575010 | : | ON PETITION |
| Filing Date: 12/31/2007 | : | |
| Attorney Docket Number: 35745-001 | : | |

This is a decision in response to the petition under 37 CFR 1.137(b)[1] filed on March 5, 2010, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on January 7, 2010, for failure to timely file corrected drawings in response to the Notice of Allowability mailed on October 6, 2009, which set a three (3)-month statutory period for reply. Notice of Abandonment was mailed on January 25, 2010.

Receipt of the corrected drawings filed on March 5, 2010, is acknowledged.

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

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

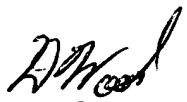
(2) the petition fee as set forth in 37 CFR 1.17(m);

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

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

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

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



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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**TUCKER ELLIS & WEST LLP**
**1150 HUNTINGTON BUILDING**
**925 EUCLID AVENUE**
**CLEVELAND OH 44115-1414**

MAILED

MAY 03 2010

OFFICE OF PETITIONS

In re Application of :
Erwin Brunnhofer et al :
Application No. 11/575,020 : DECISION GRANTING PETITION
Filed: March 9, 2007 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 010356/000013 :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed April 30, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on January 5, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 3635 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.*

UNITED STATES PATENT AND TRADEMARK OFFICE

22 JUL 2008

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

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

| | | |
|---|---|---|
| In re Application of | : | |
| BAUMBERG et al. | : | |
| Application No.: 11/575,043 | : | DECISION ON SUBMISSION |
| PCT No.: PCT/GB05/03454 | : | |
| Int. Filing Date: 07 September 2005 | : | |
| Priority Date: 10 September 2004 | : | |
| Attorney Docket No.: DYOUP0333US | : | |
| For: RAMAN SPECTROSCOPY | : | |

This application is before the PCT Legal Office for consideration of applicant's "Reply to Notification of Defective Response Dated May 2, 2008" filed in the United States Patent and Trademark Office on 02 June 2008.

## BACKGROUND

On 09 March 2007, applicant filed a transmittal letter concerning a filing under 35 U.S.C. 371 accompanied by the basic national fee.

On 29 October 2007, 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 31 October 2007, applicant filed executed declarations in response to the Notification of Missing Requirements.

On 02 May 2008, a Notification of Defective Response was mailed to applicant indicating that the declaration of the inventors was not in compliance with 37 CFR 1.497(a) and (b) because "the fifth inventor's first name is different than on the published international application."

On 02 June 2008, applicant filed the instant response to the Notification of Defective Response.

## DISCUSSION

A review of the application file reveals that the given name of the fifth inventor as listed on the published international application is "Yoshi Sugawara". The declaration, filed on 31 October 2007, identified the fifth inventor as "Yoshi Sugawara"; however, the declaration was altered. The alteration identified and was executed as "Yoshihiro Sugawara".

The Notification of Defective Response indicated that the declaration was not in

compliance with 37 CFR 1.497(a) and (b) because "the fifth inventor's first name is different than on the published international application." The declaration executed by Mr. Sugawara is not in compliance with 37 CFR 1.497(a) and (b) as the declaration does not name the inventive entity as identified in the published international application. Applicant argues that the inventor's name is "Yoshihiro Sugawara" and that an abbreviated form of the name is used on the published international application. The change in the first name of the fifth inventor is neither a typographical or transliteration error, which can corrected by a statement explaining the error.

The proper reply to the Notification of Defective Response was either the filing of a declaration which identified and was executed by"Yoshi Sugawara", the named inventor in the published international application or in the alternative, the filing of a petition under 37 CFR 1.182 correcting the fifth inventor's name to "Yoshihiro Sugawara". *See* MPEP §§1893.01(e) and 605.04(c).

On 14 May 2008, applicant filed a request in the International Bureau under PCT Rule 92*bis* to change the first full name of the inventor Sugawara. This filing appears to be beyond the thirty month period prescribed by the rule. Applicant did not produce a Notification of the Recording of a Change (Form PCT/IB/306), indicating that the name change was accepted by the International Bureau.

Applicant's response to Notification of Defective Response is unacceptable and does not satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States. The application is abandoned.

It is noted that inventor Philip N. Bartlett corrected the spelling of his first name from Phillip (as it appeared on the published international application) to Philip. Where the discrepancy between the name of the inventor indicated in the international application during the international phase and the name of the inventor as it appears in the oath or declaration submitted under 37 CFR 1.497 is the result of a typographical or transliteration error, then a petition under 37 CFR 1.182 is not required. In such case, the Office should be notified of the error. *See* MPEP 1893.03(e), 201.03 and 605.04(g).

## CONCLUSION

For the reasons set forth above, applicant's response to the Notification of Defective Response is unacceptable. The application is **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.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

UNITED STATES PATENT AND TRADEMARK OFFICE

06 JAN 2009

Commissioner for Patents
United States Patent and Trademark Office
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RENNER OTTO BOISSELLE & SKLAR, LLP
1621 EUCLID AVENUE
NINETEENTH FLOOR
CLEVELAND OH 44115

In re Application of
BAUMBERG et al.
Application No.: 11/575,043
PCT No.: PCT/GB05/03454
Int. Filing Date: 07 September 2005
Priority Date: 10 September 2004
Attorney Docket No.: DYOUP0333US
For: RAMAN SPECTROSCOPY

DECISION ON SUBMISSION

This application is before the PCT Legal Office for consideration of applicant's "Request for Withdrawal of Abandonment" filed in the United States Patent and Trademark Office (USPTO) on 29 October 2008. This is also responsive to applicant's "Request for Reconsideration of Decision on Submission Dated July 22, 2008 and Withdrawal of Abandonment" filed on 05 August 2008 in the USPTO.

## BACKGROUND

On 29 October 2007, 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 31 October 2007, applicant filed executed declarations in response to the Notification of Missing Requirements.

On 02 May 2008, a Notification of Defective Response was mailed to applicant indicating that the declaration of the inventors was not in compliance with 37 CFR 1.497(a) and (b) because "the fifth inventor's first name is different than on the published international application."

On 02 June 2008, applicant filed a response to the Notification of Defective Response. On 22 July 2008, a decision was mailed indicating that the response to Notification of Defective Response was unacceptable and did not satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States. The application was abandoned. On 10 October 2008, a Notification of Abandonment was mailed to applicant.

On 05 August 2008, applicant filed the instant request. On 29 October 2008, applicant filed a request for withdrawal of abandonment.

## DISCUSSION

Petitioner argues that the declaration identifies the inventor, fulfilling the requirements of 37 CFR 1.497(a) and (b). Applicant is reminded that the applicant provided the names of the applicant/inventors for the international application on the Request when filing the international application along with the description, claims and drawings on 07 September 2005, the international filing date. The international application was published on 16 March 2006, which identified "Yoshi" as the first name of the inventor Sugawara. Inventor Sugawara should have been aware of his name as published in the international application. Applicant had the opportunity to correct his first name pursuant to PCT Rule 92bis [1] within the time period set forth in the rule or by 10 March 2007. Petitioner acknowledges that the first name of the inventor Sugawara is incorrect, thus, a petition under 37 CFR 1.182 is necessary to correct the inventor's name as it was not corrected during the international stage of the application pursuant to PCT Rule 92bis within the thirty (30) month deadline.

The 02 May 2008 Notification of Defective Response notified applicant that the declaration was not in compliance with 37 CFR 1.497(a) and (b) because "the fifth inventor's first name is different than on the published international application." The declaration executed by Mr. Sugawara is not in compliance with 37 CFR 1.497(a) and (b) as the declaration does not name the inventive entity as identified in the published international application. Applicant argues that the inventor's name is "Yoshihiro Sugawara" and that an abbreviated form of the name is used on the published international application. The change in the first name of the fifth inventor is neither a typographical or transliteration error, which can corrected by a statement explaining the error.

Petitioner was advised in the decision dated 22 July 2008 that the declaration did not identify the fifth inventor *as named* in the published international application and in addition, that the declaration as altered by Mr. Sugawawa made the declaration unacceptable. As previously stated in that decision, the proper reply to the Notification of Defective Response was either the filing of a declaration which identified and was executed by"Yoshi Sugawara", the named inventor in the published international application or in the alternative, the filing of a petition under 37 CFR 1.182 correcting the fifth inventor's name to "Yoshihiro Sugawara". *See* MPEP §§1893.01(e) and 605.04(c).

Applicant's response to Notification of Defective Response is unacceptable and does not satisfy the requirements of 35 U.S.C. 371 (c)(4) for entrance into the national stage in the United States. The application remains abandoned.

## CONCLUSION

For the reasons set forth above, applicant's request for reconsideration is dismissed. The application remains **ABANDONED**. The proper reply is a petition under 37 CFR 1.182 to correct the inventor Sugawara's first name.

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,

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[1] On 14 May 2008, applicant filed a request in the International Bureau under PCT Rule 92*bis* to change the first full name of the inventor Sugawara, which was beyond the thirty month period prescribed by the rule. No indication that a Notification of the Recording of a Change (Form PCT/IB/306), indicating that the name change was accepted by the International Bureau, has been provided.

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

8 JUN 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

8 JUN 2009

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

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

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| In re Application of | : | |
| BAUMBERG et al. | : | |
| Application No.: 11/575,043 | : | DECISION on PETITION |
| PCT No.: PCT/GB05/03454 | : | |
| Int. Filing Date: 07 September 2005 | : | UNDER |
| Priority Date: 10 September 2004 | : | |
| Attorney Docket No.: DYOUP0333US | : | 37 CFR 1.181(a), 1.182 & 1.137(b) |
| For: RAMAN SPECTROSCOPY | : | |

This is a decision on applicant's Petition For Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b), Petition to the Director under 37 CFR 1.181(a) and Petition under 37 CFR 1.182 filed in the United States Patent and Trademark Office (USPTO) on 06 March 2009 and supplemental petition filed on 24 April 2009. In effect, applicant requests reconsideration of the decision dated 06 January 2009 and requests withdrawal of holding of abandonment of the application.

## BACKGROUND

The procedural history was set forth in the decision mailed on 06 January 2009 and is incorporated herein by reference.

As previously stated in the 22 July 2008 decision[1], the proper reply to the Notification of Defective Response was either the filing of a declaration which identified and was executed by"Yoshi Sugawara", the named inventor in the published international application or in the alternative, the filing of a petition under 37 CFR 1.182 correcting the fifth inventor's name to "*Yoshihiro* Sugawara".

The application became abandoned for failure to file a proper reply to the 02 May 2008 Notification of Defective Response.

## DISCUSSION

Petitioner asks for reconsideration of the decision mailed on 6 January 2009 and argues that the declaration identifies the inventor, fulfilling the requirements of 37 CFR 1.497(a) and (b). Applicant is reminded that the applicant provided the names of the applicant/inventors for the international application on the Request when filing the international application along with the description, claims and drawings on 07 September 2005, the international filing date. The

[1] *See also* MPEP §§1893.01(e) and 605.04(c).

international application was published on 16 March 2006, which identified "Yoshi" as the first name of the inventor Sugawara. Inventor Sugawara should have been aware of his name as published in the international application and had the opportunity to correct his first name pursuant to PCT Rule 92*bis* [2] within the time period set forth in the rule or by 10 March 2007. Petitioner acknowledged that the first name of the inventor Sugawara is incorrect and was advised that a petition under 37 CFR 1.182 was necessary to correct the inventor's name as it was not corrected during the international stage of the application pursuant to PCT Rule 92*bis* within the thirty (30) month deadline.

The 02 May 2008 Notification of Defective Response notified applicant that the declaration was not in compliance with 37 CFR 1.497(a) and (b) because "the fifth inventor's first name is different than on the published international application." The declaration executed by Mr. Sugawara was not in compliance with 37 CFR 1.497(a) and (b) as the declaration did not name the inventive entity as identified in the published international application. Applicant argues that the inventor is the same inventor and that an abbreviated form of the name is used on the published international application. However, since the in the first name of the fifth inventor is neither a typographical or transliteration error, which can corrected by a statement explaining the error, a petition under 37 CFR 1.182 was required.

In addition, Petitioner was advised in the decision dated 22 July 2008 that not only did the declaration not identify the fifth inventor *as named* in the published international application but that the declaration was altered by Mr. Sugawawa, making it unacceptable.

Petitioner offers copies of the declarations filed under PCT Rule 4.17 in substitution for the declaration filed on 31 October 2007. However, these declarations do not meet the requirements of 37 CFR 1.497(a) and (b) since they do not identify the application to which they are directed and do not identify all the inventors. It is evident that the declarations were not filed with the Request form as many of the declarations are dated after the filing date of the international application, including Mr. Sugawara's declaration. Moreover, the box at the bottom of each sheet entitled "This declaration is continued on the following sheet, "Continuation of Box No. VIII(iv)." is not checked. All of the inventors were not properly identified. Thus, these declarations are not acceptable and not in compliance with 37 CFR 1.497(a) and (b) because they do not identify the application to which they are directed and they do not apprise the executing applicant/inventor of all inventors of the application.

Finally, Petitioner is reminded that "[e]xcept 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." MPEP Section 605.04(b). Petitioner's arguments have been reconsidered and are not found convincing. The petition under 37 CFR 1.181(a) is dismissed.

Petition under 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 06 March 2009 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).

---

[2] On 14 May 2008, applicant filed a request in the International Bureau under PCT Rule 92*bis* to change the first full name of the inventor Sugawara, which was beyond the thirty month period prescribed by the rule. No indication that a Notification of the Recording of a Change (Form PCT/IB/306), indicating that the name change was accepted by the International Bureau, has been provided.

A review of the application file reveals that the declaration, in compliance with 37 CFR 1.497(a) and (b) has been provided. Per Petitioner's authorization to charge his deposit account, the required petition fee of $1610 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.

Petition under 37 CFR 1.182

On 31 October 2007, Applicant filed an executed declaration of the joint inventors. The published international application identified the fifth inventor as **Yoshi** Sugawara. However, the declaration was corrected to identify the inventor as **Yoshihiro** Sugawara and was executed as such. On 06 March 2009, the instant petition under 37 CFR 1.182 was submitted to correct the fifth named inventor's first name. The petition requests that inventor's name be corrected to **Yoshihiro** Sugawara. The petition under 37 CFR 1.182 to change the inventor's name from **Yoshi** Sugawara to **Yoshihiro** Sugawara is **GRANTED**. The declaration submitted on 06 March 2009 and executed by Mr. Sugawara is in compliance with 37 CFR 1.497(a) and (b) and is acceptable.

## CONCLUSION

For the reasons stated above, the petition under 37 CFR 1.181(a) for reconsideration of the 06 January 2009 decision is **DISMISSED**. The petition to revive under 37 CFR 1.137(b) is **GRANTED**.

The petition under 37 CFR 1.182 to change the inventor's name from Yoshi Sugawara to **Yoshihiro Sugawara** is **GRANTED**.

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 06 March 2009.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/575,044 | 11/27/2007 | Shigeru Hagiwara | 1220.1005 | 2750 |

7590 06/21/2010

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

| EXAMINER | |
|---|---|
| KREUTZER, COLIN WRIGHT | |
| ART UNIT | PAPER NUMBER |
| 2882 | |
| MAIL DATE | DELIVERY MODE |
| 06/21/2010 | 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.

Nimi Farmer

Patent Publication Branch
Office of Data Management

UNITED STATES PATENT and TRADEMARK OFFICE

05 MAR 2009

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John L. Haack
MERCHANT & GOULD
P.O. Box 2903
Minneapolis, MN 55402-0903

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| In re Application of | : | DECISION ON |
| BRADLEY et al | : | |
| Application No.: 10/575,061 | : | |
| PCT No.: PCT/GB2004/004313 | : | |
| Int. Filing Date: 11 October 2004 | : | PETITION UNDER |
| Priority Date: 09 October 2003 | : | |
| Attorney Docket No.: 15271.0012USWO | : | |
| For: MEASUREMENT OF MELTING POINTS OF SAMPLES | : | 37 CFR 1.182 |

This is in response to applicants' submission "Renewed Petition Under 37 CFR 1.181" filed on 19 November 2008, which is being treated as a petition under 37 CFR 1.182. Applicants have now filed a corrected composite executed Declaration that has the second listed inventor as Jean-Francois THABURET.

## BACKGROUND

In a decision from this Office on 27 May 2008, it stated that the executed declaration was an improper composite executed declaration.

On 19 November 2008, applicants submitted the current petition, which included a new executed Declaration with the second named inventor listed correctly as Jean-Francois THABURET.

## DISCUSSION

Applicants' response is accepted as a sufficient response to the Notification of Missing Requirements (FORM PCT/DO/EO/905) mailed on 30 November 2006. Applicants have submitted a properly executed composite declaration.

## DECISION

The petition under 37 CFR 1.182 is **GRANTED** that the correct name of the second joint inventor is Jean-Francois THABURET and a properly submitted composite declaration has been filed.

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision that is, for issuance of a Notification of Acceptance of Application (Form PCT/DO/EO/903) identifying the 35 U.S.C. §371(c)(1), (c)(2,) and (c)(4) date as **19 November 2008**.

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

20 JUN 2008

United States Patent and Trademark Office

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VERENIUM C/O MOFO S.D.
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

| | | |
|---|---|---|
| In re Application of | : | |
| Lam et al. | : | |
| Application No.: 11/575,066 | : | |
| PCT No.: PCT/US2005/032351 | : | |
| Int. Filing Date: 09 September 2005 | : | DECISION |
| Priority Date: 10 September 2004 | : | |
| Attorney Docket No.: 564462004203 | : | |
| For: Compositions And Methods For Making And Modifying Oils | : | |

This is in response to the "Petition For Revival..." filed on 23 April 2008, which is being treated under 37 CFR 1.181 and 1.137(b).

## BACKGROUND

This international application was filed on 09 September 2005, designated the United States, and claimed an earliest priority date of 10 September 2004. Accordingly, the 30 month time period for paying the basic national fee in the United States will expire at midnight on 10 March 2007. On 09 March 2007, applicants filed *inter alia* the basic national fee.

On 03 August 2007, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring additional claims fees, an oath or declaration compliant with 37 CFR 1.497(a) and (b), a surcharge under 37 CFR 1.492(h), and enumerated requirements related to the sequence listing.

On 09 November 2007, applicants filed a response.

On 19 February 2008, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to applicants, indicating that the requirements regarding the sequence listing had not been satisfied.

On 10 March 2008, applicants filed a further response.

On 10 April 2008, 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 and properly reply to the Notification of Missing Requirements .

## DISCUSSION

*Petition Under 37 CFR 1.181*

Petitioner requests withdrawal of the holding of abandonment because the response filed on 10 March 2008 "was a bona fide substantial response." Petitioner's attention is drawn to the text of the Notification of Missing Requirements, which states in part that "failure to properly respond will result in abandonment." The response filed on 09 November 2007, while a *bona*

*fide* response, did not fully satisfy the requirements of the Notification of Missing Requirements. However, applicants were given an additional opportunity to perfect their response, by the Notification of Defective Response mailed on 19 February 2008. The Notification of Defective Response did not extend the period for response to the Notification of Missing Requirements, but instead provided a time limit in which to perfect the response. The response filed on 10 March 2008 did not fully satisfy the requirements set in the Notification of Missing Requirements. Therefore, though the 10 March 2008 response may have been *bona fide*, the application was properly held abandoned with respect to the national stage in the United States because the response was not timely perfected. Accordingly, it would not be appropriate to withdraw the holding of abandonment on the basis of the present record.

*Petition Under 37 CFR 1.137(b)*

Petitioner alternatively petitions for relief pursuant to 37 CFR 1.137(b). The petition to revive under 37 CFR 1.137(b) is hereby **GRANTED** as follows:

Petitioner states that "Applicants respectfully request the USPTO accept this Petition to Revive as unintentionally abandoned U.S. Serial No.: 11/576,066, under 37 CFR § 1.137(b)." 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 under 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement is not correct. Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of an acceptable CRF of the sequence listing. The petition fee is being charged to counsel's Deposit Account 03-1952, as authorized by the petition. 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.

## CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED**, without prejudice.

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

This application is being returned to the Office of Patent Application Processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **09 November 2007** (the date the declaration compliant with 37 CFR 1.497(a) and (b) was filed).

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

*fide* response, did not fully satisfy the requirements of the Notification of Missing Requirements. However, applicants were given an additional opportunity to perfect their response, by the Notification of Defective Response mailed on 19 February 2008. The Notification of Defective Response did not extend the period for response to the Notification of Missing Requirements, but instead provided a time limit in which to perfect the response. The response filed on 10 March 2008 did not fully satisfy the requirements set in the Notification of Missing Requirements. Therefore, though the 10 March 2008 response may have been *bona fide*, the application was properly held abandoned with respect to the national stage in the United States because the response was not timely perfected. Accordingly, it would not be appropriate to withdraw the holding of abandonment on the basis of the present record.

*Petition Under 37 CFR 1.137(b)*

Petitioner alternatively petitions for relief pursuant to 37 CFR 1.137(b). The petition to revive under 37 CFR 1.137(b) is hereby **GRANTED** as follows:

Petitioner states that "Applicants respectfully request the USPTO accept this Petition to Revive as unintentionally abandoned U.S. Serial No.: 11/576,066, under 37 CFR § 1.137(b)." 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 under 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement is not correct. Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of an acceptable CRF of the sequence listing. The petition fee is being charged to counsel's Deposit Account 03-1952, as authorized by the petition. 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.

## CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED**, without prejudice.

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

This application is being returned to the Office of Patent Application Processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **09 November 2007** (the date the declaration compliant with 37 CFR 1.497(a) and (b) was filed).

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

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17 DEC 2007

Joseph R. Robinson
DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257

In re Application of :
Hiroyuki Nishide et al :
Application No.: 11/575,091 :
PCT No.: PCT/JP2005/020320 :
Int. Filing Date: 04 November 2005 : DECISION
Priority Date: 08 November 2004 :
Attorney Docket No.: 09864/0206372-US0 :
For: MEMORY ELEMENT AND MEHTOD FOR MANUFACTURING SAME :

This decision is in response to applicants' "PETITION UNDER 37 CFR 1.497(d)," which is being treated as a petition under 37 CFR 1.181, filed on 28 November 2007 indicating that the executed declaration filed on contains the correct spelling of the fifth inventors' name Shigemoto ABE.

The published PCT application and the ADS contained an error since Shigemoto ABE was misspelled as Shigemoto ANBE.

## BACKGROUND

On 12 March 2007, applicants filed in the United States Patent and Trademark Office (PTO) a Transmittal Letter (Form PTO-1390) accompanied by, *inter alia*, the basic national fee. Applicant, however, did not satisfy the requirement set forth by 35 U.S.C. 371(c)(4) because no executed oath or declaration was filed at that time.

On 28 August 2007, 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" was required. The notification indicated that a new oath or declaration must be submitted within two (2) months from the date of mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 28 November 2007, applicants submitted the current petition, which included a new executed Declaration, with the fifth named inventor listed as Shigemoto ABE, which is his correct spelling rather than as Shigemoto ANBE.

## DISCUSSION

The correct name of the fifth joint-inventor is "Shigemoto ABE" as filed in the executed declaration on 28 November 2007, and not as it appeared in the publication of the international application. Shigemoto ABE has stated that his name was incorrectly spelled in the international application but now has been corrected. Accordingly, the correct name, Shigemoto ABE, now appears in the declaration as filed on 28 November 2997 to the USPTO.

## DECISION

For the reasons above, the petition under 37 CFR 1.181 is **GRANTED** that the correct spelling of the fifth joint inventor is Shigemoto ABE.

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

18 DEC 2007

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27526
BLACKWELL SANDERS LLP
4801 Main Street
Suite 1000
KANSAS CITY, MO 64112

In re Application of
CASHMAN *et al*
U.S. Application No.: 11/575,115
PCT No.: PCT/US2003/002073
Int. Filing Date: 23 January 2003
Priority Date: 23 January 2002
Attorney Docket No.: 56510.10001
For: METHOD FOR POSITIVELY IDENTIFYING LIVESTOCK AND USE THEREOF IN LEGAL INSTRUMENTS RELATING THERETO

**DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(a) and, 37 CFR 1.137(b)**

This decision is in response applicants' petition to revive under 37 CFR 1.137(a), or in the alternative, 37 CFR 1.137(b) filed on 12 March 2007.

## BACKGROUND

On 23 January 2003, applicants filed PCT/US2003/002073 claiming priority to a U.S. provisional application filed 23 January 2002. As such, the thirty-month period to enter the national stage in the United States expired on 23 July 2004.

On 12 March 2007, applicants filed papers to enter the national stage of PCT/US2003/002073 which were accompanied by, *inter alia*, the subject petition, a copy of a complaint filed with the Supreme Court of Pennsylvania, a letter to the Office of Enrollment and Discipline (OED) of the USPTO, a petition fee of $250.00 and authorization to charge any additional fee to Deposit Account No. 11-0160.

## DISCUSSION

Applicants request that the subject application be revived pursuant to 37 CFR 1.137(a), or in the alternative, 37 CFR 1.137(b).

A petition to revive an abandoned application pursuant to 37 CFR 1.137(a) must be accompanied by: (1) the required reply; (2) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; (3) any terminal disclaimer required pursuant to 37 CFR 1.137(c); and (4)

the petition fee.

Applicants filed an appropriate response by filing the above-captioned national stage application. The Basic National fee has been charge to Deposit Account No. 11-0160 as authorized. A terminal disclaimer is not required. The $250.00 petition fee has been paid. As such, items (1), (3) & (4) of 37 CFR 1.137(a) are complete

Regarding item (2), the allegation that applicants were misled by their former counsel may be enough to warrant granting a petition based upon the unavoidable standard of 37 CFR 1.137(a). However, applicants must provide copies of all documentary evidence in this matter including any correspondence with Mr. Husick. Applicants must also show that Mr. Husick was paid to work on the subject application.

Moreover, a review of applicants' letter to the OED at the USPTO dated 22 February 2007 indicates that applicants were unaware that Mr. Husick filed a PCT application on 23 January 2003 claiming priority to U.S. provisional application U.S. No. 60/652,131. The subject petition and entry into the national stage was not filed until 12 March 2007, which is over four years from the expiration of the provisional application. A statement of facts by must be provided describing any action's taken by Mr. Husick with regard to the subject application. Applicants must also explain their actions during this period.

For these reasons, item (2) of 37 CFR 1.137(a) is not yet satisfied.

## CONCLUSION

Applicants' petition for revival pursuant to 37 CFR 1.137(a) is **DISMISSED** without prejudice.

The above-captioned application remains **ABANDONED**.

Applicants' petition to revive under 37 CFR 1.137(b) will not be considered at this time, so as to provide a chance to respond to this decision. Any renewed petition must be filed within **TWO (2) MONTHS** from the mail date of this decision.

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

**11/575,115**

Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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P.O. Box 1450
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BLACKWELL SANDERS LLP
4801 Main Street
Suite 1000
Kansas City, MO 64112

In re Application of
CASHMAN *et al*
U.S. Application No.: 11/575,115
PCT No.: PCT/US2003/002073
Int. Filing Date: 23 January 2003
Priority Date: 23 January 2002
Attorney Docket No.: 56510.10001
For: METHOD FOR POSITIVELY IDENTIFYING LIVESTOCK AND USE THEREOF

**DECISION**

This decision is in response applicants' renewed petition under 37 CFR 1.137(a), or in the alternative petition under 37 CFR 1.137(b) filed on 18 February 2008.

## BACKGROUND

On 18 December 2007, a decision dismissing applicants' petition under 37 CFR 1.137(a) was mailed. Applicants were given two months to respond. Applicants petition, in the alternative under 37 CFR 1.137(b) was not considered to provide applicants a chance to respond to the decision.

On 18 February 2008, applicants filed a renewed petition under 37 CFR 1.137(a), or in the alternative petition under 37 CFR 1.137(b) which was accompanied by, *inter alia*, along with (1) an engagement letter; (2) an email listing fees paid to Mr. Husick, (3) a timeline; and (4) exhibits A - DD.

## DISCUSSION

### Petition to Revive an Unavoidably Abandoned Application Under 37 CFR 1.137(a)

In the prior petition, item (2) of 37 CFR 1.137(a) requiring a showing that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unavoidable was not satisfied. Applicants were requested to provide copies of all documentary evidence in the matter, including evidence that Mr. Husick was paid to work in the subject application. A statement of facts was also requested describing any action taken by Mr. Husick and applicants with regard to the

subject application.

In the renewed petition, applicants provided a copy of the engagement letter with Mr. Husick, an email listing all fees paid to Mr. Husick, a timeline of events in the subject application from 23 January 2002 until 20 September 2002 and documentary evidence denoted as exhibits A - DD.

After carefully reviewing the evidence provided, item (2) of 37 CFR 1.137(a) is still not satisfied. There is no direct evidence that Mr. Husick intentionally misled applicants with regard to the subject application. Mr. Husick provided notice that an international application was filed as early as 30 January 2003 (exhibit E) and confirmed with a letter on 09 April 2003 (exhibit L). Mr. Husick also states that the date of national stage commencement is 23 July 2004 in the 09 April 2003 letter (exhibit L) and again with a letter dated 20 November 2003 (exhibit W). Moreover, exhibit AA is vague on what patents are being discussed and does not discuss national stage timelines.

As such, the requirement in item (2) of 37 CFR 1.137(a) that applicants show that the entire delay in entering the national stage was unavoidable has not been met.

For the reason listed above, applicants' petition for revival pursuant to 37 CFR 1.137(a) is **DISMISSED** without prejudice.

**Petition to Revive an Unintentionally Abandoned Application Under 37 CFR 1.137(b)**

Applicants' petition to revive under 37 CFR 1.137(b) filed in the alternative is hereby **GRANTED** as follows:

The required petition fee for a small entity of $770.00 has been charged to Deposit Account No. 11-0160 as authorized. 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.

This application is being forwarded to the National Brach 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

0 4 MAR 2009

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Alexandria, VA 22313-1450
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Sterne, Kessler, Goldstein & Fox P.L.L.C.
1100 New York Avenue, N.W.
Washington, D.C. 20005

In re Application of
JACKSON et al.
Application No.: 11/575,120
PCT No.: PCT/AU05/01383
Int. Filing Date: 12 September 2005
Priority Date: 09 October 2004
Atty. Docket No.: 2349.0020000/MAC
For: TRUNCATED LHRH FORMULATIONS

DECISION

This decision is issued in response to applicant's "Petition under 37 CFR 1.181 to Correct the Electronic File Wrapper Records for PTO Error" filed 22 December 2008 which is being treated as a Request for Corrected Notice of Acceptance and Official Filing Receipt. No petition fee is due.

## BACKGROUND

On 12 March 2007, applicant filed a Transmittal Letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. 371. Filed with the Transmittal Letter were, *among others*, the requisite basic national fee; a copy of the international application; and an application data sheet.

On 07 January 2008, applicant filed an executed declaration of inventorship.

On 31 July 2008, applicant filed "Petition under 37 CFR 1.181 to Correct the Electronic File Wrapper Records for PTO Error."

On 12 January 2009, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification of Acceptance of Application under 35 U.S.C. 371 AND 37 CFR 1.495" (Form PCT/DO/EO/903) which set forth the date of receipt of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) requirements as 07 January 2008 and a 35 U.S.C. 371 completion date as 07 January 2008. Also on 12 January 2009, a filing receipt was issued that identified the 35 U.S.C. 371(c) date as 07 January 2008.

## DISCUSSION

Applicant requests a corrected filing date (or 371(c) date) from 07 January 2008 to 03 January 2008. The actual filing date of the present application is the international filing date, i.e., 12 September 2005. (See 35 U.S.C. 363) The date in the filing date portion on the filing receipt of a national stage application is the date upon which the requirements set forth in 35 U.S.C. 371(c) for entry into the national stage were completed. (See MPEP §1895.01)

Applicant states in the present request that "the correct date of which the inventors' declaration was received was January 3, 2008, as evidence by Applicants' USPTO date stamped return receipt postcard." The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. (See MPEP 503.) Here, applicants have provided a copy of their date-stamped filing receipt. The receipt itemizes, *among others*, a declaration of inventorship. The receipt is stamped "OIPE JAN 03 2008" across its face and is sufficient to indicate that the declaration of inventorship was in fact received in the Office on 03 January 2008, not 07 January 2008. Thus, the application met the requirements of 35 U.S.C. 371(c) and thus entered the national stage in the United States on 03 January 2008. Therefore, applicant's request to correct the Filing Receipt and Notice of Acceptance is granted.

## CONCLUSION

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

The Notification of Acceptance (Form PCT/DO/EO/903) and filing receipt mailed 12 January 2009 are hereby **VACATED**.

The National Stage Processing Branch of the International Division will be instructed to issue a corrected Notification Of Acceptance (Form PCT/DO/EO/903) identifying the 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date as 03 January 2008 and a date of completion of all 35 U.S.C. 371 requirements as 03 January 2008. Additionally, a corrected Official Filing Receipt will be issued.

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

2 6 AUG 2008

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New York NY 10008-0770

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| In re Application of | : | |
| Loeffler et al. | : | |
| Application No.: 11/575,156 | : | DECISION |
| PCT No.: PCT/US2005/033063 | : | |
| Int. Filing Date: 14 September 2005 | : | ON |
| Priority Date: 14 September 2004 | : | |
| Attorney Docket No.: 04107/1200821-US1 | : | PETITION |
| For: Isolated Reductive Dehalogenase Genes | : | |

This is in response to the petition under 37 CFR 1.47(a) filed on 27 May 2008.

## BACKGROUND

This international application was filed on 14 September 2005, claimed an earlier priority date of 14 September 2004, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 14 March 2007. Applicants filed *inter alia* the basic national fee on 13 March 2007.

On 29 October 2007, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of, *inter alia*, an oath or declaration compliant with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

## DISCUSSION

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

Regarding **requirement (1)**, petitioner has paid the $200.00 petition fee.

Regarding **requirement (2)**, counsel provides a "Declaration Under 37 CFR 1.47(a) Regarding Non-Signing Inventor" which describes certain efforts undertaken to ascertain the whereabouts of Dr. Ivy Thompson/Thomson. The "Declaration" is made by Gary M. Myles, but the extent to which he has first-hand knowledge of the facts recounted is unclear. Rather, it appears that a paralegal, Ms. Kelly, may have engaged in the searches and correspondence described, but her first-hand statement has not been provided. Petitioner provides documentation of efforts undertaken to locate Dr. "Thomson," while the published international application nominates a Dr. "Thompson," as do the emails to John Schultz. As such, it is not clear whether the correct name was used in the efforts taken to locate the inventor (e.g., internet-based searches might not be expected to return optimal results if the wrong spelling were to be used).

Therefore, it would not be appropriate to deem requirement (2) to have been satisfied at this time.

Regarding **requirement (3)**, the petition includes a statement of the last known address of the non-signing inventor.

Regarding **requirement (4)**, inspection of the declaration of inventorship filed on 27 May 2008 reveals that it nominates "Ivy Thomson" in place of "THOMPSON, Ivy" who was named in the published international application. Petitioner has not provided an adequate explanation of this discrepancy. See MPEP 605.04(b) and 605.04(c). Therefore, this declaration does not satisfy requirement (4).

## DECISION

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

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

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

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

10 NOV 2008

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Church Street Station
New York NY 10008-0770

In re Application of
Loeffler et al.
Application No.: 11/575,156
PCT No.: PCT/US2005/033063
Int. Filing Date: 14 September 2005
Priority Date: 14 September 2004
Attorney Docket No.: 04107/1200821-US1
For: Isolated Reductive Dehalogenase Genes

DECISION ON PETITION

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 27 October 2008.

## DISCUSSION

In a Decision mailed on 26 August 2008, the petition under 37 CFR 1.47(a) filed on 27 May 2008 was dismissed, without prejudice, because

> Regarding requirement (2), counsel provides a "Declaration Under 37 CFR 1.47(a) Regarding Non-Signing Inventor" which describes certain efforts undertaken to ascertain the whereabouts of Dr. Ivy Thompson/Thomson. The "Declaration" is made by Gary M. Myles, but the extent to which he has first-hand knowledge of the facts recounted is unclear. Rather, it appears that a paralegal, Ms. Kelly, may have engaged in the searches and correspondence described, but her first-hand statement has not been provided. Petitioner provides documentation of efforts undertaken to locate Dr. "Thomson," while the published international application nominates a Dr. "Thompson," as do the emails to John Schultz. As such, it is not clear whether the correct name was used in the efforts taken to locate the inventor (e.g., internet-based searches might not be expected to return optimal results if the wrong spelling were to be used). Therefore, it would not be appropriate to deem requirement (2) to have been satisfied at this time.
>
> Regarding requirement (4), inspection of the declaration of inventorship filed on 27 May 2008 reveals that it nominates "Ivy Thomson" in place of "THOMPSON, Ivy" who was named in the published international application. Petitioner has not provided an adequate explanation of this discrepancy. See MPEP 605.04(b) and 605.04(c). Therefore, this declaration does not satisfy requirement (4).

**In response**, regarding requirement (2), petitioner has presented a "Declaration of Tiffany Kelly" in which Ms. Kelly describes her efforts to send correspondence to Dr. Thomson. She indicates that a certified letter was mailed to Dr. Thomson in Auburn, Alabama on 05 March 2008, but was returned as undeliverable. It is unclear whether the fate of this letter is the only direct evidence that Dr. Thomson's last known physical address (as opposed to email address)

may no longer be valid, or whether petitioner has further reason to doubt the validity of the Auburn address.

Ms. Kelly states that "several searches were done to locate address information for Ms. Ivy Thomson. Copies are attached in Exhibits 4-6." Review of Exhibits 4-6 reveals that several possible alternative addresses were returned by the searches (for instance, the address in Atlanta shown by the Alabama Voter Registrations search), but the record does not clearly indicate whether petitioner attempted to contact Dr. Thomson at those possible alternative addresses. Thus, based on the evidence currently of record, it would not be appropriate to conclude that Dr. Thomson "could not be found or reached after diligent effort."

Regarding requirement (4), petitioner indicates that the inventor's name was misspelled during the international phase, and that the "correct spelling of the inventor's name is Ivy Thomson." Based on this indication that the discrepancy represents a mere spelling error, it would be appropriate to accept the spelling of the inventor's name as "Thomson."

## DECISION

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

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

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

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

27 JUL 2009

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New York NY 10008-0770

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| In re Application of | : | |
| Loeffler et al. | : | |
| Application No.: 11/575,156 | : | DECISION |
| PCT No.: PCT/US2005/033063 | : | |
| Int. Filing Date: 14 September 2005 | : | ON |
| Priority Date: 14 September 2004 | : | |
| Attorney Docket No.: 21595/1200821-US1 | : | PETITION |
| For: Isolated Reductive Dehalogenase Genes | : | |

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 09 February 2009.

## DISCUSSION

In a Decision mailed on 10 November 2008, the petition under 37 CFR 1.47(a) filed on 27 October 2008 was dismissed, without prejudice, because requirement (2) had not been satisfied.

**In response**, petitioner has provided a declaration document executed by Ivy Thomson (the discrepancy between "Thomson" and "Thompson" was excused as a mere typographical error in the Decision mailed on 10 November 2008). This declaration, taken in combination with the declaration filed on 27 May 2008, satisfies 37 CFR 1.497(a) and (b). As such, the petition under 37 CFR 1.47(a) is MOOT.

## DECISION

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

This application is being forwarded to the Office of Patent Application Processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **09 February 2009**.

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

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

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Kathrin Harre | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7625954 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/01/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/575,165 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 03/13/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **199** 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. |
|---|---|---|---|---|
| 11/575,168 | 03/13/2007 | Koichi Nose | U2054.0166 | 4555 |

32172 7590 03/12/2010

DICKSTEIN SHAPIRO LLP
1633 Broadway
NEW YORK, NY 10019

| EXAMINER | |
|---|---|
| NGUYEN, HAI L | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2816 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/12/2010 | 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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DICKSTEIN SHAPIRO LLP
1177 AVENUE OF THE AMERICAS (6TH AVENUE)
NEW YORK, NY 10036-2714

In re Application of:
Nose et al.
Serial No.: 11/575,168
Filed: March 3, 2007
Title: Clock Generating Circuit and Clock Generating Method
Attorney Docket No.: U2054.0166

DECISION *SUA SPONTE* WITHDRAWING HOLDING OF ABANDONMENT

This is a decision, *sua sponte*, withdrawing the holding of abandonment of the above-identified application.

The application was held abandoned for failure to timely file a response to the Office action mailed on February 26, 2009. A Notice of Abandonment was mailed on January 15, 2010.

A review of the prosecution record indicates that an after final amendment was filed on May 21, 2009 followed by a request for a pre-brief appeal conference filed on June 26, 2009 with a decision to proceed to the board of appeals on August 27, 2009. Applicant's maximum time period for response, including an extension of time of five months, expired on February 27, 2010. The record indicates that a Request for Continued Prosecution along with an appropriate petition for extension of time and requisite fees were timely filed on February 24, 2010. The application was abandoned prematurely.

For the above stated reason, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status.

The application file is being forwarded to the examiner for consideration of the response.

Inquiries related to this decision should be directed to Lincoln Donovan, Supervisory Patent Examiner, at (571) 272-1988.

John Cabeca, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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14 APR 2008

PAUL D. BIANCO
FLEIT KAIN GIBBONS GUTMAN BONGINI &
BIANCO P.L.
21355 EAST DIXIE HIGHWAY, SUITE 115
MIAMI, FLORIDA 33180

| | | |
|---|---|---|
| In re Application of | : | |
| Ran Kohen | : | DECISION ON |
| Application No.: 11/575,231 | : | |
| PCT No.: PCT/US2005/32661 | : | |
| Int. Filing Date: 14 September 2005 | : | PETITION UNDER |
| Priority Date: 14 September 2004 | : | |
| Attorney Docket No.: 7014-A07-007 | : | |
| For: STRUCTURE FOR MOUNTING CHANDELIER ARMS | : | 37 CFR 1.181 |

This decision is in response to applicants' "executed declaration" filed on 27 September 2007 with the correct name of the sole inventor as Ron ROLAND. This is being treated as a petition under 37 CFR 1.181.

## BACKGROUND

On 14 September 2005, applicants filed international application No. PCT/US2005/32661, which claims a priority date of 14 September 2004.

On 14 March 2007, applicant filed in the United States Patent and Trademark Office (PTO) a Transmittal Letter (Form PTO-1390) accompanied by, *inter alia*, the basic national fee. However, not executed declaration was filed at such time.

On 27 July 2007, 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" was required. The notification indicated that a new oath or declaration must be submitted within two (2) months from the date of mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 27 September 2007, applicant filed an executed declaration. In the declaration section, the name Ran RONALD appears; this name did not appeared in the international application which is Ran KOHEN.

## DISCUSSION

It is unclear from the submission whether the corrected name is due to a name change since applicant has provided no explanation. Therefore, the declaration of the inventors is not acceptable at this time, in that the name of the named inventor, Ran RONALD, does not correspond to that set forth in the international application, Ran KOHEN.

MPEP § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include (1) the appropriate petition fee and (2) an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Applicant must provide items (1) and (2) for consideration. Alternatively, applicants may provide a showing that the name change was effected in accordance with PCT Rule 92Bis prior to the filing of the present national stage application.

Also, in the case where there is no change name of the individual but an incorrect name was given, a petition under **37 CFR 1.182** should be filed requesting correction of applicant's name

If, however, the name change is due to a typographical error then applicant needs to state and explain it by filing a petition under 37 CFR 1.181. If filed under 37 CFR 1.181 the reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181."

For the reasons above, the application may not enter into national stage processing at this time.

## CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED**, without prejudice.

A proper response to the Notice must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file the proper response will result in ABANDONMENT.

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

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

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06 JUN 2008

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BIANCO P.L.
21355 EAST DIXIE HIGHWAY, SUITE 115
MIAMI, FLORIDA 33180

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|---|---|---|
| In re Application of | : | |
| Ran Roland KOHEN | : | |
| Application No.: 11/575,231 | : | |
| PCT No.: PCT/US2005/32661 | : | |
| Int. Filing Date: 14 September 2005 | : | DECISION |
| Priority Date: 14 September 2004 | : | |
| Attorney Docket No.: 7014-A07-007 | : | |
| For: STRUCTURE FOR MOUNTING CHANDELIE ARMS | : | |

This decision is in response to applicant's "Renewed Petition Under 37 CFR 1.181," filed on 13 May 2008 indicating that the current executed declaration contains the correct spelling of the inventor's name Ran Roland KOHEN.

## BACKGROUND

In a decision from this Office on 14 April 2008, the decision indicated that the application could not enter into national stage at that time since the name Ran RONALD appeared in the declaration which did not appear in the international publication, which was Ran KOHEN.

On 13 May 2008, applicant submitted the current petition, which included a new executed Declaration, which includes the correct name of the inventor as Ran Roland KOHEN.

## DISCUSSION

The correct name of the inventor is "Ran Roland KOHEN" as filed in the executed declaration on 13 May 2008. Petitioner has stated that applicant filed an executed declaration with the name of Ran ROLAND instead of the correct name of Ran Roland KOHEN, which was due to a typographical error in that applicant's last name was inadvertently left off the declaration.

Accordingly, the correct name, Ran Roland KOHEN, now appears in the declaration as filed on 13 May 2008 to the USPTO.

## DECISION

For the reasons above, the petition under 37 CFR 1.181 is **GRANTED** that the correct spelling of the inventor is Ran Roland KOHEN.

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 **13 May 2008.**

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

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In re Application of :
Thomas William Beck et al. :
Application No. 11/575,234 : DECISION ON PETITION
Filed: March 14, 2007 :
Attorney Docket No. **2004P87079WOUS** :

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

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 13, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 14, 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 amendment, (2) the petition fee of $1,620, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584.

This application is being referred to Technology Center AU 1797 for appropriate action by the Examiner in the normal course of business.

/JoAnne Burke/
JoAnne Burke
Petitions Examiner
Office of Petitions

22 JAN 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

Ladas & Parry LLP
224 South Michigan Avenue
Suite 1600
Chicago, IL 60604

In re Application of :
KIM et al. :
U.S. Application No.: 11/575,242 :
PCT No.: PCT/KR05/03073 :
Int. Filing Date: 15 September 2005 : DECISION ON PETITION
Priority Date: 15 September 2004 : UNDER 37 CFR 1.47(a)
Attorney Docket No.: CU-5592 WWP :
For: DIGITAL TELEVISION :
TRANSMISSION AND RECEIVING
APPARATUS AND METHOD USING 1/4
RATE CODED ROBUST DATA

This decision is issued in response to applicants' "Petition In Support Of Joint Inventors Filing On Behalf Of Nonsigning Unavailable Inventor Under 37 CFR 1.47" filed 29 October 2008. Deposit Account No 12-0400 will be charged the required $200 petition fee.

## BACKGROUND

On 15 September 2005, applicants filed international application PCT/KR05/03073. The international application claimed a priority date of 15 September 2004, and it designated the United States. On 23 March 2006, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 15 March 2007.

On 14 March 2007, 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 September 2008, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497 and payment of the surcharge for filing the declaration later than thirty months after the priority date were required.

On 29 October 2008, applicants filed a response to the Notification Of Missing

Requirements. The response included payment of the required surcharge, a partially executed declaration, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of inventor Seung-Won KIM, whom applicants assert cannot be found or reached after diligent effort.

## DISCUSSION

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

Applicants here have authorized a charge to Deposit Account No. 12-0400 for required fees, pursuant to which applicants will be charged the required $200 petition fee, and the petition states the last known address of the nonsigning inventor. Items (1) and (2) are therefore satisfied.

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

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

Here, applicants have filed a declaration executed by five of the six inventors of record, and the declaration includes an unsigned signature block for the nonsigning inventor, Seung-Won KIM. This declaration may be accepted as having been executed by the signing inventors on their own behalf and on behalf of the nonsigning inventor. Item (3) of a grantable petition is therefore satisfied.

Regarding item (4), petitioner asserts that Seung-Won KIM cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. [...]
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet

> searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, applicants have provided a statement from the Shinsung International Patent & Law Firm, with accompanying exhibits, discussing efforts made to contact the nonsigning inventor. The Statement of Facts asserts that a signature request, accompanied by a English specification, drawings, and declaration, were mailed to the last known address of the nonsigning inventor by Shinsung International Patent & Law Firm, and that this mailing was returned to the sender. Additionally, the statement asserts that a search of telephone directory revealed 193 corresponding individuals by the name Seung-Won KIM, and that each individual was telephoned. None of the individuals were the nonsigning inventor. However, the Statement of Facts fails to identify the person or persons attempting to contact the missing inventor. Applicants must provide a firsthand statement of facts from the person(s) who have contacted, or attempted to contact, the nonsigning inventor confirming these communications and the details thereof.

Before it can be concluded that the nonsigning inventor cannot be located after diligent effort, applicants must provide firsthand evidence, with supporting materials, describing the efforts made to locate a current address for the inventor and contact him at such address. Such efforts should include, but not be limited to, an internet search for the inventor.

Based on the above, applicants have failed to provide an acceptable showing that the nonsigning inventor has refused to execute the application or cannot be located after diligent effort. Item (4) of a grantable petition is therefore not satisfied on the present record.

## CONCLUSION

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

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy item (4) of a grantable petition, as discussed above and in the MPEP. No additional petition fee is required. Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

18 MAR 2009

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Ladas & Parry LLP
224 South Michigan Avenue
Suite 1600
Chicago, IL 60604

In re Application of :
KIM et al. :
U.S. Application No.: 11/575,242 :
PCT No.: PCT/KR05/03073 :
Int. Filing Date: 15 September 2005 : DECISION ON PETITION
Priority Date: 15 September 2004 : UNDER 37 CFR 1.47(a)
Attorney Docket No.: CU-5592 WWP :
For: DIGITAL TELEVISION :
TRANSMISSION AND RECEIVING
APPARATUS AND METHOD USING 1/4
RATE CODED ROBUST DATA

This decision is issued in response to applicants' "Renewed Petition under 37 CFR 1.47(a) & Submission of Declaration/Power of Attorney" filed 12 March 2009. In a decision dated 22 January 2009, applicants' petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor, Seung-Won KIM, was dismissed without prejudice.

The petition for status under 37 CFR 1.47(a) is moot since the declaration filed 13 March 2009 with the present petition was executed by the named inventor, the previous non-signing inventor, Seung-Won KIM. The declaration filed 13 March 2009 is acceptable under 37 CFR 1.497.

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

The application has an international filing date of 15 September 2005 under 35 U.S.C. 363 and a date of 12 March 2009 under 35 U.S.C. 371(c)(1),(c)(2) and (c)(4).

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.

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

23 FEB 2009

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30743
WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C.
11491 Sunset Hills Road
Suite 340
Reston, VA 20190

In re Application of :
BUCK *et al* :
U.S. Application No.: 11/575,245 :
PCT No.: PCT/US2005/031657 :
Int. Filing Date: 07 September 2005 : **DECISION ON**
Priority Date: 07 September 2004 : **PETITION UNDER**
Docket No.: 02940367AA : **37 CFR 1.137(b)**
For: CRYPTOSPORIDIUM HOMINIS :
GENES AND GENE PRODUCTS FOR :
CHEMOTHERAPEUTIC, :
IMMUNOPROPHYLACTIC AND :
DIAGNOSTIC APPLICATIONS :

Applicants' petition to revive under 37 CFR 1.137(b) filed on 14 March 2007 with the national stage papers is hereby **GRANTED** as follows:

The proper fees and the petition fee for a small entity were submitted. Applicants provided 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.

This application is being forwarded to the United States Designated/Elected Office for further processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

UNITED STATES PATENT AND TRADEMARK OFFICE

28 MAY 2009

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CONNOLLY BOVE LODGE & HUTZ LLP
1875 EYE STREET, N.W.
SUITE 1100
WASHINGTON, DC 20006

| | | |
|---|---|---|
| In re Application of STEINAR et al | : | |
| U.S. Application No.: 11/575,248 | : | |
| PCT Application No.: PCT/IB2005/003156 | : | |
| Int. Filing Date: 02 September 2005 | : | |
| Priority Date Claimed: 14 September 2004 | : | DECISION |
| Attorney Docket No.: 20459-00403-US1 | : | |
| For: METHOD OF MANUFACTURING WEAR LININGS FOR CASTING LADLES AND TUNDISHES | : | |

This is in response to applicant's correspondence filed 09 March 2009, which is being treated as a petition under 37 CFR 1.497(d).

## BACKGROUND

On 02 September 2005, applicant filed international application PCT/IB2005/003156, which claimed priority of an earlier Sweden application filed 14 September 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 23 March 2006. The thirty-month period for paying the basic national fee in the United States expired on 14 March 2007.

On 14 March 2007, 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 12 September 2008, 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 12 November 2008, applicant filed an executed declaration.

On 22 December 2008, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which identified a discrepancy with regard to the inventorship listed on the declaration.

On 09 March 2009, applicant filed the present petition under 37 CFR 1.497(d).

## DISCUSSION

The petition states that Anton Sekkingstad and Odd Westeras should be added as inventors.

37 CFR 1.497(d) states,

> If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:
>
> (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
>
> (2) The processing fee set forth in § 1.17(i); and
>
> (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and
>
> (4) Any new oath or declaration required by paragraph (f) of this section.

With regard to item (1) above, the requisite statements have been provided.

With regard to item (2) above, the requisite processing fee will be charged to Deposit Account No. 22-0185 as authorized in the petition.

With regard to item (3) above, the purported written consent of the assignee cannot be accepted. In particular, the assignee North Cape Minerals AS has not established the right to take action in compliance with 37 CFR 3.73(b). The assignee must present documentary evidence of a chain of title from the inventors to the assignee or specify by reel and frame where such information is recorded in the Office. Furthermore, the statement of consent either (1) is not signed by a person with apparent authority to sign on behalf of the assignee or (2) does not set forth that the person signing is authorized to act on behalf of the assignee. See MPEP 324, Section V.

MPEP 201.03, Section II D, states in relevant part,

> The individual signing on behalf of the assignee giving its consent to the requested inventorship correction, should specifically state that he or she has the authority to act on behalf of the assignee. In the absence of such a statement, the consent will be accepted if it is signed by an appropriate official of the assignee

> (e.g., president, vice president, secretary, treasurer, or derivative thereof) if the official's title has been made of record. A general statement of authority to act for the assignee, or on the specific matter of consent, or the appropriate title of the party signing on behalf of the assignee should be made of record in the consent. However, if it appears in another paper of record, e.g., small entity assertion, it is also acceptable.

In the present case, the individual, Steinar Slagnes, signing on behalf of North Cape Minerals AS giving its consent to the correction of inventorship, has not stated that he has authority to act on behalf of the assignee. Steinar Slagnes does not have a title that confers apparent authority, such as chief executive officer, president, manager, director, vice-president, secretary, or treasurer.

With regard to item (4) above, a new declaration under 37 CFR 1.497(f) is not required.

Applicant is advised that the declaration filed 12 November 2008 names the first inventor as "Steinar Slagnes" whereas the international application and application data sheet names the first inventor as "Slagnes Steinar". Applicant is required to explain the discrepancy in response to this decision.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)". 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 Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

0 3 MAR 2010

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CONNOLLY BOVE LODGE & HUTZ LLP
1875 EYE STREET, N.W.
SUITE 1100
WASHINGTON, DC 20006

In re Application of SLAGNES et al :
U.S. Application No.: 11/575,248 :
PCT Application No.: PCT/IB2005/003156 :
Int. Filing Date: 02 September 2005 :
Priority Date Claimed: 14 September 2004 : DECISION
Attorney Docket No.: 20459-00403-US1 :
For: METHOD OF MANUFACTURING WEAR LININGS FOR CASTING LADLES AND TUNDISHES :

This is in response to applicant's correspondence filed 23 October 2009 and 08 January 2010, which is being treated as a renewed petition under 37 CFR 1.497(d).

## BACKGROUND

On 02 September 2005, applicant filed international application PCT/IB2005/003156, which claimed priority of an earlier Sweden application filed 14 September 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 23 March 2006. The thirty-month period for paying the basic national fee in the United States expired on 14 March 2007.

On 14 March 2007, 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 12 September 2008, 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 12 November 2008, applicant filed an executed declaration.

On 22 December 2008, the DO/EO/US mailed a Notification of Defective Response (Form PCT/DO/EO/916), which identified a discrepancy with regard to the inventorship listed on the declaration.

On 09 March 2009, applicant filed a petition under 37 CFR 1.497(d).

On 28 May 2009, this Office mailed a decision dismissing the 09 March 2009 petition.

On 23 October 2009, applicant filed a renewed petition under 37 CFR 1.497(d).

On 16 December 2009, this Office mailed a communication which stated that the 23 October 2009 was not fully responsive to the 28 May 2009 decision.

On 08 January 2010, applicant filed a supplement to the 23 October 2009 renewed petition.

## DISCUSSION

The petition states that Anton Sekkingstad and Odd Westeras should be added as inventors.

37 CFR 1.497(d) states,

> If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:
>
> (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
>
> (2) The processing fee set forth in § 1.17(i); and
>
> (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and
>
> (4) Any new oath or declaration required by paragraph (f) of this section.

With regard to item (1) above, the requisite statements have been provided.

With regard to item (2) above, the requisite processing fee has been provided.

With regard to item (3) above, proper written consent of the assignee has been provided.

With regard to item (4) above, a new declaration under 37 CFR 1.497(f) is not required.

The declaration filed 12 November 2008 names the first inventor as "Steinar Slagnes" whereas the international application and application data sheet names the first inventor as "Slagnes Steinar". The present renewed petition states that the discrepancy is the result of an error in the international publication and that the declaration contains the correct name. Applicant's explanation is accepted.

## CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.497(d) is GRANTED.

The application has an International Filing Date under 35 U.S.C. 363 of 02 September 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 12 November 2008.

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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KOHN & ASSOCIATES, PLLC
30500 NORTHWESTERN HWY
STE 410
FARMINGTON HILLS, MI 48334

COPY MAILED

JAN 22 2008

OFFICE OF PETITIONS

In re Application of :
Oded Erez :
Application No. 11/575,251 : DECISION ON PETITION
Filed: March 14, 2007 : TO MAKE SPECIAL UNDER
Attorney Docket No. 0146.00004 : 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed December 21, 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 declaration statement signed by applicant. Accordingly, the above-identified application has been accorded "special" status.

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

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 Office of Patent Application Processing for processing. This application will be accorded "special" once pre-examination processing is complete.

April M. Wise
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

30 NOV 2007

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

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

In re Application of:
PAMMER, Oskar, et al.
U.S. Application No.: 11/575,274
PCT No.: PCT/EP2005/007528
International Filing Date: 12 July 2005
Priority Date: 02 August 2004
Atty Dkt No.: P/3240-120 V3132
For: FEEDING DEVICE FOR A BELT-TYPE SINTERING MACHINE

DECISION ON PETITION

The petition for revival under 37 CFR 1.137(b) filed 14 March 2007 in the above-captioned application is hereby **GRANTED** as follows:

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

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 is granted as to the national stage in the United States of America.

It is noted that applicant's 14 March 2007 submission to initiate the present national stage application included an English translation of the international application; Deposit Account No. 15-0700 will be charged the $130 processing fee for filing the English translation later than thirty months after the priority date. It is also noted that, on 13 June 2007, applicants submitted an executed declaration in compliance with 37 CFR 1.497, accompanied by the surcharge for filing the declaration later than thirty months after the priority date.

This application is being referred 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 13 June 2007.

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

United States Patent and Trademark Office

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Alexandria, VA 22313-1450
www.uspto.gov

26 NOV 2007

IPLA P.A.
3580 WILSHIRE BLVD.
17TH FLOOR
LOS ANGELES CA 90010

In re Application of :
SAMYONG :
Application No. 11/575,296 :
PCT No.: PCT/KR05/02658 :
Int. Filing Date: 16 August 2005 : COMMUNICATION
Priority Date: 13 April 2005 :
Att. Docket No.: 2081-01 :
For: Producing Method For :
Non Woven Silk Fabric :

This is in response to the correspondence filed on 14 March 2007.

## BACKGROUND

This international application was filed on 16 August 2005, claimed an earliest priority date of 13 April 2005, and designated the U.S. The International Bureau communicated a copy of the published international application to the USPTO on 19 October 2006. The 30 month time period for paying the basic national fee in the United States expired at midnight 13 October 2007. Applicants filed, *inter alia*, the basic national fee on 14 March 2007.

## DISCUSSION

Inspection of the declaration filed on 14 March 2007 reveals that it nominates Samgyong LEE in place of "SAMYONG, Lee" who is nominated in the published international application. MPEP 605.04(b) states in part that

> *Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 37 CFR 1.182 together with an appropriate petition fee.*

Since the change described above represents more than a mere typographic error or phonetic misspelling of applicant's name, a petition (and fee) under 37 CFR 1.182 is required. *See also* MPEP MPEP § 201.03(b).

Counsel "declares that the inventor's first name and last name in the International Application are mistakenly reversed. Correct name of the inventor is LEE, SAMYONG where Lee is the inventor's surname." However, this does not fully describe the discrepancy present in the declaration, where the name "Samgyong" is used. Moreover, applicant has not provided a formal petition (and fee) for acceptance of the declaration. In particular, petitioner has not established that Samgyong Lee and Lee Samyong refer to the same inventor, and has not shown the manner in which the discrepancy arose (such as providing appropriate statements made on the basis of first-hand knowledge by the inventor(s) and/or the individual(s) responsible for the

discrepancy). Therefore, it would not be appropriate to accept the declaration filed on 14 March 2007 on the basis of the present record.

## CONCLUSION

The declaration is **NOT ACCEPTED**, without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this Communication to file a response, extendable under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT**.

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

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

1 4 OCT 2008

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LOS ANGELES CA 90010

In re Application of :
Lee :
Application No. 11/575,296 :
PCT No.: PCT/KR05/02658 :
Int. Filing Date: 16 August 2005 : DECISION
Priority Date: 13 April 2005 :
Att. Docket No.: 2081-01 :
For: Producing Method For :
Non Woven Silk Fabric :

This is in response to the petition filed on 29 August 2008.

## DISCUSSION

*Petition Under 37 CFR 1.137(b)*

This international application became abandoned with respect to the national stage in the United States for failure to timely reply to the Communication mailed on 26 November 2007. The petition to revive under 37 CFR 1.137(b) is hereby **GRANTED** as follows:

Petitioner 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." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of an acceptable response to the Communication mailed on 26 November 2007, and has paid the petition 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.

*Acceptance of Declaration*

In the Communication mailed on 26 November 2007, the declaration filed on 14 March 2007 was not accepted, without prejudice, because it nominated Samgyong LEE in place of "SAMYONG, Lee" who was named in the published international application. That is, the order of the names was inverted, and "Samgyong" was used in place of "Samyong." In response, petitioner has provided a newly executed declaration naming Samyong Lee, as well as a statement ("Inventor's Declaration") by Mr. Lee indicating that the inversion of the name order was the result of "an inadvertent typo." Under the totality of the particular circumstances presented in this case, it would be appropriate to accept the inventor's statement that the name discrepancy arose from a mere typographic error. Therefore, the declaration filed on 29 August 2008, which presents the inventor's name as Samyong Lee, is being accepted for purposes of compliance with 37 CFR 1.497(a) and (b). Petitioner's Deposit Account no. 50-3566 is being

charged in the amount of $65.00 for the surcharge under 37 CFR 1.492(h), as authorized by the petition.

## DECISION

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

The declaration is **ACCEPTED**.

This application is being forwarded to the Office of Patent Application Processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **29 August 2008**.

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

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15 AUG 2007

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

| | | |
|---|---|---|
| In re Application of | : | |
| CHAN, Waiman | : | |
| Application No.: 11/575,320 | : | DECISION |
| PCT No.: PCT/CN2005/000435 | : | |
| Int. Filing Date: 01 April 2005 | : | ON PETITION UNDER |
| Priority Date: 02 April 2004 | : | |
| Docket No.: 5283-00003 | : | 37 CFR 1.137(b) |
| For: CHROMIUM PLATING | : | |

Applicants' Petition to Revive Under 37 CFR §1.137(b), filed in the above-captioned application on 15 March 2007 is **GRANTED**.

Applicants indicate that the delay in filing was unintentional. This is construed to mean that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, as required by 37 CFR 1.137(b)(3). If this is not a correct interpretation, applicant 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. The fee for late filing of the search fee, examination fee or oath or declaration has been paid.

This application is being referred 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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29 NOV 2007

Fitch, Even, Tabin & Flannery
120 S. LaSalle Street
Suite 1600
Chicago, IL 60603-3406

In re Application of :
ASANO et al. :
Application No.: 11/575,362 : DECISION ON REQUEST
PCT No.: PCT/US05/12823 :
Int. Filing Date: 14 April 2005 :
Priority Date: 17 September 2004 :
Attorney Docket No.: 1410-67770 :
For: COMPOSITIONS HAVING BODY FAT REDUCING FUNCTION AND FOOD AND DRINK CONTAINING THE SAME

This decision is issued in response to the declaration filed 17 September 2007 which is being treated as a Petition to Correct Inventorship under 37 CFR 1.497(d). The $130 petition fee has been charged to Deposit Account no. 06-1135.

## BACKGROUND

On 14 April 2005, applicant filed international application PCT/US05/12823 which claimed a priority date of 17 September 2004. The published international application identified two applicant/inventors for the United States: Ichiro Asano and Shigeyoshi Fujii. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 17 March 2007.

On 15 March 2007, 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; a copy of the international application; and a preliminary amendment.

On 18 June 2007, the United Stated Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 17 September 2007, applicant filed the present request under 37 CFR 1.497(d).

## DISCUSSION

The present submission seeks to correct the inventorship so as to add inventors Katsuhito Mutoh; Izumi Takao; Kazuto Ozaki; Kenichi Nakamuro; and Toshiyuki Matsushima to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), 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; and
> >
> > (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees (see § 3.73(b) of this chapter).
> >
> > (4) any new oath or declaration required by paragraph (f) of this subsection.

With respect to the addition of Katsuhito Mutoh; Izumi Takao; Kazuto Ozaki; Kenichi Nakamuro; and Toshiyuki Matsushima to the application, applicant's 17 September 2007 submission satisfies requirements (1), (2), and (4).

Item (3) has not been satisfied. Applicant has not provided the assignee's consent to the addition of Katsuhito Mutoh; Izumi Takao; Kazuto Ozaki; Kenichi Nakamuro; and Toshiyuki Matsushima as inventors 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), inventors Katsuhito Mutoh; Izumi Takao; Kazuto Ozaki; Kenichi Nakamuro; and Toshiyuki Matsushima cannot be added to the application on the present record.

## CONCLUSION

Applicant's request to add inventors Katsuhito Mutoh; Izumi Takao; Kazuto Ozaki; Kenichi Nakamuro; and Toshiyuki Matsushima under 37 CFR 1.497(d) is **DISMISSED** without prejudice. The inventors of record remain the inventors named on the international application.

Applicant must file a proper response to this decision within **TWO (2) MONTHS** from the mail date indicated above. A proper response must include a written consent of assignee in compliance with 37 CFR 3.73(b). Failure to file a timely and proper response will result in abandonment of the application. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, 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.

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

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Alexandria, VA 22313-1450
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25 MAR 2008

Fitch, Even, Tabin & Flannery
120 S. LaSalle Street
Suite 1600
Chicago, IL 60603-3406

In re Application of
ASANO et al.
Application No.: 11/575,362
PCT No.: PCT/US05/12823
Int. Filing Date: 14 April 2005
Priority Date: 17 September 2004
Attorney Docket No.: 1410-67770
For: COMPOSITIONS HAVING BODY FAT REDUCING FUNCTION AND FOOD AND DRINK CONTAINING THE SAME

DECISION ON REQUEST

This decision is issued in response to applicant's "Request for Reconsideration of Petition to Correct Inventorship under 37 CFR 1.497(d)" filed 28 January 2008.

## BACKGROUND

On 14 April 2005, applicant filed international application PCT/US05/12823 which claimed a priority date of 17 September 2004. The published international application identified two applicant/inventors for the United States: Ichiro Asano and Shigeyoshi Fujii. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 17 March 2007.

On 15 March 2007, 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; a copy of the international application; and a preliminary amendment.

On 18 June 2007, the United Stated Designated/Elected Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 17 September 2007, applicant filed a request under 37 CFR 1.497(d). In a decision dated 29 November 2007, applicant's request was dismissed without prejudice.

On 28 January 2008, applicant filed the present request under 37 CFR 1.1497(d).

## DISCUSSION

The present submission seeks to correct the inventorship so as to add inventors Katsuhito Mutoh; Izumi Takao; Kazuto Ozaki; Kenichi Nakamuro; and Toshiyuki Matsushima to the application. Where, as here, the inventorship in the national stage declaration is not consistent with the inventorship in the international application, applicants must correct the inventorship pursuant to 37 CFR 1.497(d), 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; 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.

Applicants have satisfied items (1); (2); (3) and (4).

## CONCLUSION

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

Katsuhito Mutoh; Izumi Takao; Kazuto Ozaki; Kenichi Nakamuro; and Toshiyuki Matsushima Ernesto Mendoza will be added as inventors herein.

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

1 OCT 2009

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SENNIGER POWERS LLP (MTC)
100 NORTH BROADWAY
17TH FLOOR
ST LOUIS MO 63102

In re Application of :
WAN, Kam-To, et al. :
Application No.: 11/575,370 :
PCT No.: PCT/US2005/032862 :
Int. Filing Date: 15 September 2005 : DECISION
Priority Date: 15 September 2004 :
Attorney's Docket No.: MTC 6879.601 :
For: OXIDATION CATALYST AND ITS :
USE FOR CATALYZING LIQUID :
PHASE OXIDATION REACTIONS :

This decision responds applicants' request under 37 CFR 1.497(d), filed in the United States Patent and Trademark Office on 17 July 2009.

## BACKGROUND

On 15 November 2007, applicants filed declaration of the inventors listing only two inventors.

On 18 June 2009, the Office mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and that the declaration was not executed by inventors Brethauer and Liu.

On 17 July 2009, applicants submitted this request 37 CFR 1.497(d) request.

## DISCUSSION

Applicants file this request to remove Kerry Brethauer and Jingyue Liu as inventors. Applicants have indicated that these inventors are being removed because the application has been amended.

Under 37 CFR 1.41(a)(4), the inventorship of the international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92*bis*. An oath or declaration reflecting that international stage inventorship is required. Should applicants need to change the inventorship in the national stage application on account of a preliminary amendment, that can be done with a petition under 37 CFR 1.48(b), AFTER the application satisfies the requirements for entry into the national stage. Requests under 37 CFR 1.497(d) are to correct errors in

inventorship made during the international phase, not to change the inventorship on account of amendment.

If the inventorship was incorrectly listed during the international phase, applicants may clarify that the request was because the stated inventorship is not accurate for the international application. If however, the inventorship stated in the application is accurate for the international application, applicants are required to submit an oath or declaration in compliance with 37 CFR 1.497(a) - (b).

## CONCLUSION

For the above reasons, applicant's request under 37 CFR 1.497(d) is **REFUSED**.

An oath or declaration in compliance with 37 CFR 1.497(a)-(b) is required 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 further correspondence with respect to this matter may be filed electronically via EFS-Web, or if mailed, 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

- 4 JAN 2010

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SENNIGER POWERS LLP (MTC)
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17TH FLOOR
ST LOUIS MO 63102

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|---|---|---|
| In re Application of | : | |
| WAN, Kam-To, et al. | : | |
| Application No.: 11/575,370 | : | |
| PCT No.: PCT/US2005/032862 | : | |
| Int. Filing Date: 15 September 2005 | : | DECISION |
| Priority Date: 15 September 2004 | : | |
| Attorney's Docket No.: MTC 6879.601 | : | |
| For: OXIDATION CATALYST AND ITS USE FOR CATALYZING LIQUID PHASE OXIDATION REACTIONS | : | |

This decision responds applicants' response to the Notification of Defective Response, filed in the United States Patent and Trademark Office on 08 December 2009.

On 02 December 2009, the Office mailed a Notification of Defective Response (Form PCT/DO/EO/916) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required and that the complete declarations of the inventors must be submitted.

On 08 December 2009, applicants submitted declarations of the inventors.

The declaration of the inventors submitted on 08 December 2009 complies with 37 CFR 1.497(a)-(b). The petition under 37 CFR 1.48(b) remains in the file to be acted upon after the application satisfies the requirements for entry into the national stage.

This application is being forwarded to the National Phase Processing Branch of the Office of Patent Application Processing for further action consistent with this decision.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: 571-272-3292

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200 GILLINGHAM LANE
MD 200-9
SUGAR LAND TX 77478

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MAR 3 1 2010

**OFFICE OF PETITIONS**

In re Application of :
PROUVOST, LAURENT et al. :
Application No. 11/575,374 : ON PETITION
Filed: MAY 22, 2008 :
Attorney Docket No. 21.1248 :

This is a decision on the petition under 37 CFR 1.137(b), filed January 27, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office Action mailed June 16, 2009, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on September 17, 2009.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee of $1,620; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final Office Action of June 16, 2009 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Miranda Le at (571) 272-4112 or in her absence, the undersigned at (571) 272-7099.

The application file is being referred to Technology Center AU 2877 for appropriate action on the concurrently filed amendment.

David Bucci
Petitions Examiner
Office of Petitions

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DARBY & DARBY
P.O. BOX 770
CHURCH STREET STATION
NEW YORK NY 10008-0770

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NOV 0 3 2009

OFFICE OF PETITIONS

Applicant: Kenji Toda
Appl. No.: 11/575,386
International Filing Date: April 4, 2006
Title: FLUORESCENT SUBSTANCE FOR LIGHT-EMITTING DIODE
Attorney Docket No.: 09864/0206341-US0
Pub. No.: US 2009/0085009 A1
Pub. Date: April 2, 2009

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on April 27, 2009, 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 one of the foreign priority data claims was printed incorrectly.

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 on the front page of the publication wherein the date September 6, 2005 was misprinted as June 9, 2005 for JP2005-257956 may be Office error, but is not a material Office error under 37 CFR 1.221. The misprinting of the foreign priority data does not affect the understanding of the application. 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 error to the priority date also does not affect the

[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).

use of the patent application publication as a prior art reference, because the foreign priority date is not usable as a reference date.

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.

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

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

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

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 1/20/10 **Paper No.:** —

TO SPE OF : ART UNIT 3671

SUBJECT : Request for Certificate of Correction for Appl. No.: 11/575439 Patent No.: 7637687B2

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**

Virginia Tolbert
**Certificates of Correction Branch**
571-272-0460

**Thank You For Your Assistance**

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

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

**Comments:** _____

Thomas B. Will

Digitally signed by Thomas B. Will
DN: cn=Thomas B. Will, c=US, ou=3671
Reason: I am approving this document
Date: 2010.02.03 10:55:43 -05'00'

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APR 04 2007

TECHNOLOGY CENTER 3600

Fernandez & Associates
1047 El Camino Real
Suite 201
Menlo Park, CA 94025

In re application of
Dennis S. Fernandez
Application No. 11/585,467
Filed: October 23, 2006
For: ELECTRONIC INDIVIDUAL ENDORSEMENT

**DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 CFR 1.102**

This is a decision on the petition filed on October 23, 2006 to make the above-identified application special for Biotechnology under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DENIED**.

REGULATION AND PRACTICE

To be eligible for accelerated examination under 37 C.F.R. § 1.102(d) and pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published in the Federal Register on June 26, 2006 (71 Fed. Reg. 36323), the following conditions must be satisfied:

1. The application must be a non-reissue utility or design application filed under 37 CFR 1.111(a);
2. The application, the petition and the required fees must be filed electronically using the USPTO's electronic filing system (EFS), or EFS-web; if not filed electronically, a statement asserting that EFS and EFS-web were not available during the normal business hours;
3. The application, at the time of filing, must be complete under 37 CFR 1.51 and in condition for examination;
4. The application must contain three or fewer independent claims and twenty or fewer total claims and the claims must be directed to a single invention.

The petition to make special for Biotechnology under 37 C.F.R. § 1.102(d) is not acceptable at least because the application was not filed electronically as required in the above Federal Register Notice of June 26, 2006. It appears that the petition was filed under the guidelines for making an application special that were in effect prior to August 25, 2006. As of August 25, 2006 the new guidelines replaced the old guidelines. Since applicant's petition was received on October 23, 2006 with a Certificate of Mail date of the same date, the petition must be considered under the new guidelines and thus is properly **DENIED**.

For the above-stated reasons, the petition is denied. The application will therefore be taken up by the examiner for action in its regular turn.

Any inquiry regarding this decision should be directed to Steven N. Meyers, Quality Assurance Specialist, at (571) 272-6611.

Steven N. Meyers,
Quality Assurance Specialist
Technology Center 3600

Sm/sm: 4/1/07

24 JUN 2009
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United States Patent and Trademark Office
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28159
PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. Box 3001
Briarcliff Manor, NY 10510-8001

In re Application of :
RIBALTA *et al* :
U.S. Application No.: 11/575,505 :
PCT No.: PCT/IB2005/052948 : **DECISION**
Int. Filing Date: 09 September 2005 :
Priority Date: 24 September 2004 :
Attorney Docket No.: DE040254US :
For: METHOD OF MEDICAL MONITORING :

This is a decision on the papers filed 05 June 2008.

## BACKGROUND

On 19 March 2007, applicants filed papers to enter the national stage of PCT/IB2005/052948 which was accompanied by, *inter alia*, an executed declaration.

On 28 May 2008, 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 the current declaration was not in compliance with 37 CFR 1.497(a) and (b) because the last name of the second inventor was misspelled. A new declaration and surcharge fee were required. Applicants were given two months to comply with extensions of time available pursuant to 37 CFR 1.136(a).

On 05 June 2008, applicants filed the subject response.

## DISCUSSION

In the subject response, applicants claim that the "Request in the international application contains a typographical error, misspelling Mr. Rainer Schluess' last name by leaving off the final "s." Mr. Schluess' name is correctly spelled on the Declaration as it was originally submitted in this US application."

Section 201.03 of the Manual of Patent Examining Procedure (MPEP) states that where a typographical or transliteration error in the spelling of an inventor's name is discovered, the Office should simply be notified of the error. Reference to the notification will be made on the previously filed declaration.

Applicants' explanation meets the requirements of the MPEP and is sufficient to explain the name differences between the declaration and the international publication.

## CONCLUSION

For the reasons discussed above, the Declaration filed 19 March 2007 is deemed to be in compliance with 37 CFR 1.497(a) and (b).

A $130.00 surcharge fee pursuant to 37 CFR 1.492(h) is not required.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 09 September 2005, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 19 March 2007.

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

28 SEP 2007
United States Patent and Trademark Office

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CHARLOTTE NC 28226

| | | |
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| In re Application of | : | |
| Zhang et al. | : | |
| Application No.: 11/575,506 | : | DECISION |
| PCT No.: PCT/US05/37135 | : | |
| Int. Filing Date: 18 October 2005 | : | ON |
| Priority Date: 22 October 2004 | : | |
| Attorney Docket No.: 2000.190-8 | : | PETITION |
| For: Battery Separator With Z-Direction Stability | : | |

This is in response to the correspondence filed on 21 August 2007, which is being treated as a petition under 37 CFR 1.47(a).

## BACKGROUND

This international application was filed on 18 October 2005, claimed an earlier priority date of 22 October 2004, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 22 April 2007. Applicants filed *inter alia* the basic national fee on 19 March 2007.

On 27 July 2007, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(h).

## DISCUSSION

Inspection of the declaration filed on 21 August 2007 reveals that it has not been executed by joint inventor Tien Dao. An "Affidavit" accompanying the declaration alludes to "Mr. Tien Dao's employment agreement" which allegedly establishes that "he was under an obligation to assign..." the invention. These facts suggest that applicants may be attempting to seek relief under 37 CFR 1.47, specifically 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.

Regarding **requirement (1)**, the petition fee has not been paid paid. It has NOT been charged to counsel's Deposit Account, pending clarification as to whether relief under 37 CFR 1.47(a) is in fact being sought. Payment of this fee is required prior to further consideration on the merits under 37 CFR 1.47.

Regarding **requirement (2)**, petitioner has neither explicitly alleged that Tien Dao has refused to execute the application, nor that he could not be found or reached after diligent effort. Moreover, there is no substantive evidentiary showing on the issue of his unavailability. *See* MPEP 409.03(d). As such, requirement (2) has not been satisfied.

Regarding **requirement (3)**, the petition does not include an explicit statement of Tien Dao's last known address. Accordingly, requirement (3) has not been satisfied.

Regarding **requirement (4)**, the declaration of inventorship accompanying the instant petition is not acceptable because it appears to have been assembled using separate sheets signed by the individual inventors, which were then combined into a composite document. Attention is drawn to MPEP 201.03, which explains in part that

> An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

In view of this policy, it would not be appropriate to accept the declaration filed on 21 August 2007.

## DECISION

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

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

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

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

0 7 JAN 2008

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| In re Application of | : | |
| Zhang et al. | : | |
| Application No.: 11/575,506 | : | DECISION |
| PCT No.: PCT/US05/37135 | : | |
| Int. Filing Date: 18 October 2005 | : | ON |
| Priority Date: 22 October 2004 | : | |
| Attorney Docket No.: 2000.190-8 | : | PETITION |
| For: Battery Separator With Z-Direction Stability | : | |

This is in response to the renewed petition under 37 CFR 1.47(a) filed on 20 November 2007.

## DISCUSSION

In a Decision mailed on 28 September 2007, the submission filed on 21 August 2007 was treated under 37 CFR 1.47(a) and dismissed without prejudice because petitioner had not satisfied any of the requirements of 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.

Regarding **requirement (1)**, the petition fee was paid on 20 November 2007.

Regarding **requirement (2)**, petitioner presents a "Declaration of Phillip E. Bryson" which indicates that

> I had a diligent search conducted to locate Tien Dao. That search included: calls to his last known telephone number, a letter sent via regular mail to his last known address, a registered letter sent to his last known address, an email sent to his last known email address (tientdao@hotmail.com), and inquiries to his co-workers about his whereabouts. None of these efforts yielded any results.

Mr. Bryson does not state whether he has first-hand knowledge of the efforts undertaken, and does not provide any further details of these efforts - for instance, the dates and times of attempted telephone calls, the number called, copies of the letters sent (and any associated postal evidence), a copy of the email sent, and details of the inquiries made. Therefore, the record does not provide a sufficient basis to conclude that Mr. Dao was not available to execute the application within the meaning of 37 CFR 1.47(a). *See* MPEP 409.03(d). As such, requirement (2) has not been satisfied.

Regarding **requirement (3)**, the petition includes a statement of Tien Dao's last known address. Accordingly, requirement (3) has been satisfied.

Regarding **requirement (4)**, the declaration filed on 20 November 2007 is acceptable.

## DECISION

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

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

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

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

3 1 MAR 2008

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| In re Application of | : | |
| Zhang et al. | : | |
| Application No.: 11/575,506 | : | DECISION |
| PCT No.: PCT/US05/37135 | : | |
| Int. Filing Date: 18 October 2005 | : | ON |
| Priority Date: 22 October 2004 | : | |
| Attorney Docket No.: 2000.190-8 | : | PETITION |
| For: Battery Separator With Z-Direction Stability | : | |

This is in response to the correspondence filed on 11 February 2008.

## DISCUSSION

In a Decision mailed on 07 January 2008, the renewed petition under 37 CFR 1.47(a) filed on 20 November 2007 was dismissed, without prejudice, because "the record does not provide a sufficient basis to conclude that Mr. Dao was not available to execute the application within the meaning of 37 CFR 1.47(a)."

In response, petitioner now presents a declaration document executed by formerly non-signing joint inventor Tien Dao. As such, the petition under 37 CFR 1.47(a) is MOOT.

## DECISION

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

This application is being forwarded to the Office of Patent Application Processing for further processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **11 February 2008** (i.e., the date the executed declaration was filed).

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

Copied from 11575526 on 04/29/2008

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VOLPE AND KOENING, PC
UNITED PLAZA SUITE 1600
30 SOUTH 17TH STREET
PHILADELPHIA, PA 19103

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Applicant: GODOY
Appl. No.: 11/575,532
International Filing Date: September 19, 2005
Title: BEND STIFFENER
Attorney Docket No.: ZNA-PTO20
Pub. No.: US 2007/0292214 A1
Pub. Date: December 20, 2007

This is a decision on the request entitled "Request for Corrected Publication Pursuant to 37 CFR 1.221", requesting relief under both 37 CFR 1.221(a) and 37 CFR 1.221(b), received on January 30, 2008, for the above-identified application.

The request for republication under 37 CFR 1.221(a) is DISMISSED.

The request for a corrected publication under 37 CFR 1.221(b) is GRANTED.

A "request for republication of an application previously published" filed under 37 CFR 1.221(a) "must include a copy of the application in compliance with the Office's electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i)." If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

In the instant request, the request did not include a copy of the application in compliance with the Office's electronic system requirements, nor was it accompanied by the required fees. Therefore, the request under 37 CFR 1.221(a) is dismissed.

Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system, as a "Pre-Grant Publication."

With respect to 37 CFR 1.221(b), applicant has pointed out discrepancies between originally submitted claim 10 and published claim 10 amounting to a material mistake by the Office. Therefore, the request under 37 CFR 1.221(b) is granted.

It would greatly benefit the Office if the request for corrected publication pointed 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 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 Michael Cygan at (571) 272-7700, or to the undersigned at (571) 272-7709.

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

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Commissioner for Patents
United States Patent and Trademark Office
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05 DEC 2007

MEADWESTVA CORPORATION
Law Department
1021 Main Campus Dr.
Raleigh, NC 27606

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| In re Application of | : | |
| FALAT, et al. | : | |
| U.S. Application No.: 11/575,547 | : | DECISION ON PETITION |
| PCT No.: PCT/US05/24453 | : | |
| Int. Filing Date: 11 July 2005 | : | UNDER 37 CFR 1.137(b) |
| Priority Date: 23 July 2004 | : | |
| Attorney Docket No.: D-17077 | : | |
| For: MACHINE FOR SEALING CARTON | : | |

The petition to revive under 37 CFR 1.137(b) filed 19 March 2007 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 a compliant, 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

UNITED STATES PATENT AND TRADEMARK OFFICE

08 APR 2009

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HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

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|---|---|---|
| In re Application of BOTHA et al | : | |
| U.S. Application No.: 11/575,548 | : | |
| PCT Application No.: PCT/IB2005/053012 | : | DECISION |
| Int. Filing Date: 14 September 2005 | : | |
| Priority Date Claimed: 21 September 2004 | : | |
| Attorney Docket No.: 39145.2 | : | |
| For: AGGLOMERATION OF TITANIA | : | |

This is in response to the correspondence filed 24 February 2009, which is being treated as a request for status under 37 CFR 1.42 or 37 CFR 1.43.

## BACKGROUND

On 14 September 2005, applicant filed international application PCT/IB2005/053012, which claimed priority of an earlier South Africa application filed 21 September 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 30 March 2006. The thirty-month period for paying the basic national fee in the United States expired on 21 March 2007.

On 19 March 2007, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 24 February 2009, applicant filed the present request for status under 37 CFR 1.42 or 37 CFR 1.43.

## 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."

37 CFR 1.43 provides, " In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may make the necessary oath or declaration, and apply for and obtain the patent."

37 CFR 1.497(b)(2) specifies,

> 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 the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

The declaration filed 24 February 2009 would be in compliance with 37 CFR 1.42, 37 CFR 1.43, and 37 CFR 1.497. However, applicant has not specified whether inventor Pieter Adriaan Botha is deceased or incapacitated. Therefore, it cannot be determined whether to grant the application status under 37 CFR 1.42 or 37 CFR 1.43.

## CONCLUSION

For the reasons above, the request for status under 37 CFR 1.42 or 37 CFR 1.43 is DISMISSED without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available under 37 CFR 1.136(a).

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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3 0 APR 2009

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IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

In re Application of BOTHA et al :
U.S. Application No.: 11/575,548 :
PCT Application No.: PCT/IB2005/053012 : DECISION
Int. Filing Date: 14 September 2005 :
Priority Date Claimed: 21 September 2004 :
Attorney Docket No.: 39145.2 :
For: AGGLOMERATION OF TITANIA :

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

## BACKGROUND

On 14 September 2005, applicant filed international application PCT/IB2005/053012, which claimed priority of an earlier South Africa application filed 21 September 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 30 March 2006. The thirty-month period for paying the basic national fee in the United States expired on 21 March 2007.

On 19 March 2007, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 24 February 2009, applicant filed a request for status under 37 CFR 1.42.

On 08 April 2009, this Office mailed a decision dismissing the 24 February 2009 request for status.

## DISCUSSION

The decision mailed 08 April 2009 stated that it could not be determined whether inventor Pieter Botha was deceased or incapacitated. However, a review of the application data sheet filed 19 March 2007 reveals that inventor Botha is indicated as being deceased.

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

37 CFR 1.497(b)(2) specifies,

> 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 the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

The declaration filed 24 February 2009 is in compliance with 37 CFR 1.42 and 37 CFR 1.497.

## CONCLUSION

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

The decision mailed 08 April 2009 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 14 September 2005, and a date under 35 U.S.C. 371(c) of 24 February 2009.

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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GIBSON & DERNIER LLP
900 ROUTE 9 NORTH
SUITE 504
WOODBRIDGE, NJ 07095

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Tadashi Nakamura | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7629976 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/575,553 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/07/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **139** 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.

15 MAY 2007

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MEADWESTVACO CORPORATION
LAW DEPARTMENT
4850 NORTH CHURCH LANE
SUITE D
SMYRNA, GA 30080

In re Application of BOUTIN :
U.S. Application No.: 11/575,558 :
PCT Application No.: PCT/US2005/025360 :
Int. Filing Date: 18 July 2005 :
Priority Date Claimed: 16 July 2004 : DECISION
Attorney Docket No.: D-17044 :
For: A METHOD OF IDENTIFYING :
ABNORMAL OPERATION OF A :
MACHINE AND AN APPARATUS :
THEREFOR :

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 March 2007.

## BACKGROUND

On 18 July 2005, applicant filed international application PCT/US2005/025360, which claimed priority of an earlier United Kingdom application filed 16 July 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 23 February 2006. The thirty-month period for paying the basic national fee in the United States expired on 16 January 2007.

International application PCT/US2005/025360 became abandoned as to the United States for failure to timely pay the basic national fee.

On 19 March 2007, applicant filed the present petition under 37 CFR 1.137(b) along with U.S. national stage papers. The submission was assigned the above-identified U.S. application number. On the same day, applicant filed another set of U.S. national stage papers. That submission was assigned U.S. application number 11/575,556.

## DISCUSSION

The end result for an international application designating the United States is a single U.S. national stage application. Therefore, the submission of two different sets of application papers to enter the national stage in the United States was improper. U.S. application number 11/575,556 will no longer be processed. Applicant should not file any future communications with regard to U.S. application number 11/575,556.

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

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

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

With regard to item (3), applicant has provided the required statement.

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

## CONCLUSION

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

The serialization of U.S. application number 11/575,556 is hereby VACATED.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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

23 JUL 2007

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

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| In re Application of | : | |
| LEE, Chang-Hee et al. | : | |
| Application No.: 11/575,604 | : | |
| PCT No.: PCT/KR04/03406 | : | |
| Int. Filing Date: 22 December 2004 | : | COMMUNICATION |
| Priority Date: 22 December 2004 | : | |
| Attorney's Docket No.: Q98966 | : | |
| For: Broadband Light Source Using Fabry Perot Laser Diodes | : | |

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

## BACKGROUND

On 22 December 2004, applicants filed international application PCT/KR04/03406. The thirty-month for paying the basic national fee in the United States expired at midnight on 22 June 2007.

On 20 March 2007, applicants filed a first transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, payment of the basic national fee (small entity). These papers had an attorney docket number of Q98966 and were assigned U.S. Application Number 11/575,604.

On 20 April 2007, applicants filed a second transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, payment of the basic national fee (small entity). These papers had an attorney docket number of 5489.P091 and were filed by another firm at the address at the bottom of this correspondence. The papers were stamped with serial number 11/666,031.

## DISCUSSION

Two sets of papers to enter the national stage were submitted for international application PCT/KR04/03406. The end result for an international application designating the United States of America is a single U.S. national stage application. The undersigned contacted the attorney who filed the papers in U.S. Application No. 11/575,604 who verified that the multiple national stage filings were a result of a misunderstanding with the client.

Therefore, the submission of two sets of national stage papers to enter the United States was improper. As such, the papers stamped with serial number 11/666,031 have been placed in application number 11/575,604.

Applicants should use application number **11/575,604** in all future communications with the United States Patent and Trademark Office in regards to the U.S. national stage of international application PCT/KR04/03406.

With regard to payment of duplicate fees, the $2700.00 fees paid in relation to the papers stamped with serial number 11/666,031 are being refunded to applicants' Deposit Account No. 02-2666.

## CONCLUSION

For the reasons set forth above, the serialization of U.S. application number 11/666,031 is **VACATED**.

The application papers stamped with serial number 11/666,031 have been placed in application number 11/575,604 and the $2700.00 fees have been refunded to applicants' Deposit Account No. 02-2666.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing in accordance with this decision.

Bryan Lin
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-3303
Facsimile: (571) 273-0459

Stefan Staicovici
PCT Legal Examiner
Office of PCT Legal Administration
Telephone: (571) 272-1208

Cc: BLAKELY SOKOLOFF TAYLOR & ZAFMAN
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

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23 MAY 2008

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

| | | |
|---|---|---|
| In re Application of INCE et al | : | |
| U.S. Application No.: 11/575,608 | : | |
| PCT Application No.: PCT/US2004/031968 | : | |
| Int. Filing Date: 28 September 2004 | : | DECISION |
| Priority Date Claimed: none | : | |
| Attorney Docket No.: 10000.0009-00000 | : | |
| For: NEW FUNCTIONAL ADDITIVE IN POLYMERS | : | |

This is in response to applicant's "Petition Under 37 C.F.R. § 1.182 to Change the Order of Listed Inventors Names" filed 24 January 2008.

## BACKGROUND

On 28 September 2004, applicant filed international application PCT/US2004/031968. The thirty-month period for paying the basic national fee in the United States expired on 28 March 2007.

On 20 March 2008, 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 June 2007, 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 11 January 2008, applicant filed an executed declaration.

On 24 January 2008, applicant filed the present petition under 37 CFR 1.182.

## DISCUSSION

MPEP 605.04(f) states in relevant part,

> The order of names of joint patentees in the heading of the patent is taken from the order in which the typewritten names appear in the original oath or declaration. Care should therefore be exercised in selecting the preferred order of the typewritten names of the joint inventors, before filing, as requests for subsequent shifting of the names would entail changing numerous records in the Office. Since the particular order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned, no changes will be made except when a petition under 37 CFR 1.182 is granted. The petition should be directed to the attention of the Office of Petitions. The petition to change the order of names must be signed by either the attorney or agent of record or all the applicants. Applicants are strongly encouraged to submit an application data sheet showing the new order of inventor names to ensure appropriate printing of the inventor names in any patent to issue. It is suggested that all typewritten and signed names appearing in the application papers should be in the same order as the typewritten names in the oath or declaration. When the Office of Petitions grants a petition to change the order of the names of the inventors, the Office of Petitions will change the order of the names in the Office computer records and print a new bib-data sheet . . . .

In the present case, applicant has submitted a proper petition under 37 CFR 1.182 to change the order of the inventors names. The Office computer records have been updated. A new bibliographic data sheet is attached to this decision.

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 28 September 2004, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 11 January 2008.

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

ATTACHMENT: Bibliographic Data Sheet

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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RODMAN RODMAN
10 STEWART PLACE
SUITE 2CE
WHITE PLAINS, NY 10603

Mail Date: 05/21/2010

| | | |
|---|---|---|
| **Applicant** | : Karl Henrik Haugholt | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7633614 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/575,634 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 03/20/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **464** 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. |
|---|---|---|---|---|
| 11/575,638 | 03/20/2007 | Rajender Kamboj | 980057.411USPC | 1460 |

77059 7590 02/20/2009

Seed IP Law Group PLLC
701 Fifth Avenue
Suite 5400
Seattle, WA 98104

| EXAMINER | |
|---|---|
| WEDDINGTON, KEVIN E | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1614 | |

| 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

Carol J. Roth
Seed IP Law Group PLLC
701 Fifth Avenue
Suite 5400
Seattle WA 98104

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| In re Application of | : |
| Kamboj et al | : |
| Serial No.: 11/575,638 | :Decision on Petition |
| Filed: 20 March 2007 | : |
| Attorney Docket No.: 980057.411USPC | : |

This letter is in response to the Petition filed on 23 December 2008 requesting withdrawal of the restriction requirement.

**BACKGROUND**

This application was filed under the provisions of 35 U.S.C. 371 and as such is subject to PCT Unity of Invention practice.

On 15 May 2008, the examiner mailed a restriction requirement which the original 18 claims were divided into 4 groups. The examiner also required the election of a single species of disease or condition if Group II is elected. The examiner justified the restriction requirement using US restriction form paragraphs addressing the distinction. The examiner did not address burden.

On 9 June 2008, Applicants elected Group III, claims 10-17 with the traversal that the Office has not established that it would be a burden to examine the full scope of the claimed invention.

On 9 June 2008, the examiner considered the traversal and made the restriction requirement FINAL. Claims 1-9 and 18 were withdrawn from consideration as being directed to non-elected inventions. Claims 10-17 were searched and examined on the merits, as follows:

> Claims 10-17 were provisionally rejected under non-statutory obviousness type double patenting.

Claims 10-17 were rejected under 35 U.S.C. 112, 1st paragraph for scope of enablement
Claims 10-12 were rejected under 35 U.S.C. 102(b) as being anticipated by Anandan et al.

On 23 December 2008, applicants filed a response to the Office action, an amendment to the claims, several Terminal Disclaimers, and this petition.

**DISCUSSION**

The petition and file history have been carefully considered. Applicant wish to have the restriction requirement set forth between Group III and IV withdrawn.

Initially, it is pointed out that the restriction requirement was set forth using US restriction practice. This is incorrect.

Secondly, it is noted that Group III is directed to a compound while Group IV is directed to a composition comprising that compound. This is similar to ISPE Guidelines example 15, set forth below.

10.35 Example 15

Claim 1: Compound A.

Claim 2: An insecticide composition comprising compound A and a carrier.

Unity exists between claims 1 and 2. The special technical feature common to all the claims is compound A.

In Example 15, the compound and composition claims have unity of invention. For this same reason, unity of invention exists between Group III and Group IV.

In order to clarify the record, Group III and IV will be rejoined together and the original restriction requirement will be re-formatted as a lack of unity determination as follows:

This application is a national stage filing of a PCT and as such, is eligible for the restriction practice set forth in Chapter 10 of the International Preliminary Search and Examination Guidelines and Unity of Invention Practice set forth in MPEP Chapter 1800, particularly sections 1850 and 1893.03(d).

As provided in 37 CFR 1.475(a), a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in a national stage application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. See 37 CFR 1.475(e).

When Claims Are Directed to Multiple Categories of Inventions:

As provided in 37 CFR 1.475(b), a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or
(2) A product and process of use of said product; or
(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
(4) A process and an apparatus or means specifically designed for carrying out the said process; or
(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Otherwise, unity of invention might not be present. See 37 CFR 1.475(c).

Restriction has been required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claim 1 directed to a method of inhibiting hSCD using compound of Formula I
Group II, claims 2-9, directed to a method of treatment using compound of Formula I
Group III, claims 10-18, drawn to compound of Formula I and a composition comprising Formula I and a pharmaceutically acceptable carrier.

The groups of inventions listed above 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:

Groups I and II lack unity of invention because the groups do not share the same or corresponding technical feature. Claim 1 and Claim 2 are directed to methods of using the same compounds. In Group I, Claim 1, the preamble requires the technical feature of inhibiting hSCD activity by contacting a source of hSCD with compound of Formula I. In Group II, Claims 2-9, the preamble requires the technical feature of treating a disease or condition mediated by hSCD by administering the compound of Formula I to a mammal.

Groups (I and II) lack unity of invention with Group III because even though the inventions of these groups require the technical feature of the compound of Formula I, this technical feature is not a special technical feature as it does not make a contribution over the prior art in view of

Anandan et al, as set forth in the Office action mailed 26 September 2008.

Because the Applicants have elected Group III for examination and have received a first Office action on the merits for Group III, the lack of unity determination set forth in this petition decision is not providing applicants with an opportunity to elect another invention. Group III (claims 10-18) will be examined on the merits.

It is noted that the lack of unity determination must be assessed anew throughout prosecution, in relation to the claims as currently pending. Should the elected invention and the non-elected inventions be limited to technical features which make a contribution over the prior art, the lack of unity requirement should be withdrawn.

Moreover, MPEP 1893.05(d) provides the following guidance concerning rejoinder opportunities for application 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.

**DECISION**

The petition is **GRANTED**.

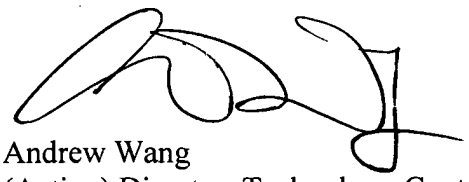
The restriction requirement set forth on 15 May 2008 between Group III and Group IV is hereby withdrawn.

Because the Office action mailed 26 September 2008 is incomplete with regard to the treatment of the composition claim 18, it is hereby vacated.

Should the shared technical feature become a contribution over the prior art the examiner should re-consider the lack of unity determination. Moreover, should all claims directed to the elected invention become in condition for allowance, the examiner should follow rejoinder practice set forth in MPEP 821.04.

**The application will be forwarded to the examiner for consideration of the papers filed on 23 December 2008 and for preparation of an Office action on compound and composition Claims 10-18 consistent with this decision.**

Should there be any questions about this decision, please contact Special Program Examiner Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.



Andrew Wang
(Acting) Director, Technology Center 1600

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**Morrison & Foerster, LLP**
**12531 High Bluff Drive**
**Suite 100**
**San Diego, CA 92130-2040**

MAILED

OCT 22 2009

OFFICE OF PETITIONS

In re Application of :
Marcel Bally et al. :
Application No. 11/575,655 : DECISION ON PETITION
Filed: May 15, 2008 : TO WITHDRAW
Attorney Docket No. B537 0047/TWB : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 6, 2009.

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 Morrison & Foerster, LLP has been revoked by the assignee of the patent application on April 9, 2009. 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 until otherwise notified by applicant.

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

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Oyen, Wiggs, Green & Mutala, LLP
480 – The Station
601 West Cordova Street
Vancouver, BC V6B 1G1
CANADA

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05 JUL 2007

WILLIAM J BUNDREN
THE LAW OFFICE OF WILLIAM J BUNDREN
734 LaRue Road
Millersville MD 21108

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|---|---|---|
| In re Application of | : | |
| HARRISON et al. | : | |
| Application No.: 11/575,679 | : | DECISION ON |
| PCT No.: PCT/CA2005/000974 | : | |
| Int. Filing Date: 21 June 2005 | : | PETITION UNDER |
| Priority Date: 21 June 2004 | : | |
| Attorney Docket No.: UTI.87.7US | : | 37 CFR 1.137(b) |
| For: USE OF HEAVY METALS IN THE TREATMENT OF BIOFILMS | : | |

This decision is in response to applicants' submission filed 21 March 2007 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 21 June 2005 , applicant filed international application PCT/CA2005/000974 which designated the U.S. and claimed a priority date of 21 June 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 29 December 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 21 December 2006.

On 21 March 2007, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee, an 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 31 March 2007.

As to item (2), applicant submitted the petition fee on 31 March 2007.

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 executed oath or declaration of the inventor 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.

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

15 JUL 2009

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HOUSTON TX 77056

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| In re Application of<br>BRUDER (Deceased) et al.<br>Application No.: 11/575,683<br>PCT No.: PCT/EP05/53938<br>Int. Filing Date: 10 August 2005<br>Priority Date: 21 September 2004<br>Attorney Docket no.: Serie 6484<br>For: AIR SEPARATION PROCESS USING CRYOGENIC DISTILLATION | : | DECISION ON<br><br>REQUEST<br><br>UNDER 37 CFR 1.42 |

This is a decision on applicant's Petition under 37 CFR 1.42 filed in the United States Patent and Trademark Office (USPTO) on 15 May 2009 as a request under 37 CFR 1.42.

## BACKGROUND

On 17 April 2009, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b) was required.

On 15 May 2009, applicant filed executed declaration to satisfy the requirements of 35 U.S.C. 371 that an oath or declaration of the inventors be furnished. The declaration appears to be in the French, German and English languages.

## DISCUSSION

The declaration appears to be in the French, German and English language. Pursuant to 37 CFR 1.69(b), unless the text of any oath or declaration in a language other than English is in the form provided by the Patent and Trademark Office..., *it must be accompanied by an English translation together with a statement that the translation is accurate. See also* MPEP 602.06. The declaration is not on the USPTO form nor is it accompanied by a statement that the translation is accurate. Such statement, that the English translation of the French/German declaration for this application is accurate, is required.

In addition, 37 CFR § 1.42 requires that in the case of the death of the inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent.

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal

representative and indicate the citizenship, residency and mailing address of the legal representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

The declaration identifies Anne-Marie Carrega-Gros as the executor of the estate of deceased inventor Olivier Bruder. However, the declaration is defective because the declaration must not only state the relationship to the deceased inventor but must also state the country of citizenship, former residency and mailing address for *both* the deceased inventor and the legal representative/executor to meet the requirements of 37 CFR 1.497(a) and (b).

What is required is a declaration, which identifies all inventors, and is executed by Anne-Marie Carrega-Gros. The declaration must identify her as executrix for the estate of deceased inventor Olivier Bruder and provide the executrix's citizenship, residency and mailing address as well as identify the deceased inventor, providing his citizenship, former residency and mailing address on the declaration. Any person acting as a legal representative of a deceased or incapacitated inventor should ensure that he is properly acting in such capacity.

Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42.

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **DISMISSED WITHOUT PREJUDICE.**

The declaration appears to be in the French, German and English languages and is unacceptable as submitted. A statement that the English translation of the declaration is accurate is required.

Moreover, a declaration, which identifies all inventors, and is executed by Anne-Marie Carrega-Gros, is required. The declaration must identify her as executrix for the estate of deceased inventor Olivier Bruder and provide the executrix's citizenship, residency and mailing address as well as identify the deceased inventor, providing his citizenship, former residency and mailing address on the declaration

Applicant is required to correct the above-noted defects including the furnishing of a oath/declaration in compliance with 37 CFR 1.42 and 1.497 within TWO (2) MONTHS from the mail date of this Decision.

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

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

21 DEC 2009

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|---|---|
| In re Application of<br>BRUDER (Deceased) et al.<br>Application No.: 11/575,683<br>PCT No.: PCT/EP05/53938<br>Int. Filing Date: 10 August 2005<br>Priority Date: 21 September 2004<br>Attorney Docket no.: Serie 6484<br>For: AIR SEPARATION PROCESS USING CRYOGENIC DISTILLATION | DECISION ON<br><br>REQUEST<br><br>UNDER 37 CFR 1.42 |

This is a decision on applicant's renewed Petition under 37 CFR 1.42 filed in the United States Patent and Trademark Office (USPTO) on as a request under 37 CFR 1.42. Applicant requests a one month extension of time, which is granted. No petition fee is required. The $130 petition fee, which was charged, will be refunded to applicant's deposit account.

## BACKGROUND

On 17 April 2009, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b) was required.

On 15 May 2009, applicant filed executed declaration to satisfy the requirements of 35 U.S.C. 371 that an oath or declaration of the inventors be furnished. On 15 July 2009, a decision was mailed indicating that the declaration appeared to be in the French, German and English languages and did not comply with 37 CFR 1.497(a) and (b).

On 05 October 2009, applicant filed the instant renewed petition with a newly executed declaration using Form PTO/SB/105.

## DISCUSSION

37 CFR § 1.42 requires that in the case of the death of the inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent.

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

The declaration identifies all inventors, and is executed by Anne-Marie Carrega-Gros as executrix for the estate of deceased inventor Olivier Bruder. The declaration provides the citizenship, residency and mailing address for all inventors, including the deceased inventor and the executrix. Accordingly, it is appropriate, at this time, to accord the application status under 37 CFR 1.42.

## CONCLUSION

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

The application will be forwarded to the U.S. Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is 05 October 2009.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

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OCT 0 9 2009

OFFICE OF PETITIONS

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

In re Application of :
AOYAMA et al. : DECISION ON PETITION
Application No. 11/575,738 :
Filed: 03/21/2007 :
Attorney Docket No. 082013 :

This is a decision on the petition under 37 CFR 1.181 (feeless), filed May 5, 2009, to withdraw the holding of abandonment in the above-identified application.

This application was held abandoned for failure to respond timely to the non-final Office action, mailed September 9, 2008, which set a three-month shortened statutory period for reply. In the absence of a timely filed response, the application was held abandoned on December 10, 2008. On April 10, 2009, the Office mailed a Notice of Abandonment.

In the petition, practitioner asserts that the firm did not receive the non-final Office action because the USPTO erroneously mailed the Office action to an incorrect correspondence address. Accordingly, petitioners request that the Office withdraw the holding of abandonment due to non-receipt, re-mail the non-final Office action, and restart the period for reply.

A review of the written record indicates an irregularity in the mailing of the non-final Office action. On August 26, 2008, prior to the mailing of the non-final Office action, the USPTO received a Statement under 37 CFR 3.73(b), a revocation of power of attorney, an appointment of a new power of attorney, and request to change the correspondence address of record to the address associated with Customer Number 38834. The USPTO records were not timely updated to reflect this new appointment of power of attorney or the change of correspondence address. Consequently, the USPTO mailed the non-final Office action to an incorrect address.

In view of the above, the petition is **GRANTED** and the holding of abandonment is withdrawn.

Technology Center Art Unit 3651 has been advised of this decision. The matter is being referred to the Technology Center's technical support staff for re-mailing of the non-final Office action. The three-

month shortened statutory period for responding to the non-final Office action will be set to run from the date of the re-mailing of the Office action.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

0 7 JAN 2008
United States Patent and Trademark Office

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ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR 1-C-11
PLANO TX 75024

| | | |
|---|---|---|
| In re Application of | : | |
| Bergstrom et al. | : | |
| Application No. 11/575,746 | : | |
| PCT No.: PCT/SE05/01412 | : | |
| Int. Filing Date: 23 September 2005 | : | DECISION |
| Priority Date: 23 September 2004 | : | |
| Att. Docket No.: P19618-US1 | : | |
| For: Method And Arrangement For A Synchronized HSDPA Reconfiguration | : | |

This is in response to the response filed on 06 November 2007.

## BACKGROUND

This international application was filed on 23 September 2005, claimed an earliest priority date of 23 September 2004, and designated the United States. The International Bureau transmitted a copy of the published international application to the USPTO on 30 March 2006. The period for payment of the basic national fee in the United States expired as of midnight on 23 March 2007. On 21 March 2007, applicants filed *inter alia* the basic national fee.

On 10 September 2007, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(h), because the declaration "does not identify the application to which it is directed."

## DISCUSSION

In response to the Notification of Missing Requirements mailed on 10 September 2007, applicants have submitted a copy of a declaration filed under PCT Rule 4.17(iv). However, inspection of this declaration reveals that it was signed on 01 October 2007 and 07 October 2005, later than the international filing date. Since it was signed after the filing of the PCT Request form on the international filing date, it clearly was not included with that Request. As a later-filed document, it is not clear that the declaration as signed identified the application to which it was directed at the time it was signed. Therefore, an oath or declaration compliant with 37 CFR 1.497(a) and (b), properly identifying the application which is to be executed, is required.

## CONCLUSION

The declaration is **NOT ACCEPTED** as described above, without prejudice.

A proper response must be filed within **ONE (1) MONTH** from the mail date of this decision. Extensions of time may **NOT** be obtained under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT** with respect to the national stage in the United States.

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

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

0 4 AUG 2008

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ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR 1-C-11
PLANO TX 75024

In re Application of :
Bergstrom et al. :
Application No. 11/575,746 :
PCT No.: PCT/SE05/01412 :
Int. Filing Date: 23 September 2005 : DECISION
Priority Date: 23 September 2004 :
Att. Docket No.: P19618-US1 :
For: Method And Arrangement For A :
Synchronized HSDPA :
Reconfiguration

This is in response to the response filed on 07 February 2008.

## DISCUSSION

In a Decision mailed on 07 January 2008, and in response to the correspondence filed on 06 November 2007, the declaration was not accepted, without prejudice, because

> ... applicants have submitted a copy of a declaration filed under PCT Rule 4.17(iv). However, inspection of this declaration reveals that it was signed on 01 October 2007 and 07 October 2005, later than the international filing date. Since it was signed after the filing of the PCT Request form on the international filing date, it clearly was not included with that Request. As a later-filed document, it is not clear that the declaration as signed identified the application to which it was directed at the time it was signed. Therefore, an oath or declaration compliant with 37 CFR 1.497(a) and (b), properly identifying the application which is to be executed, is required.

In response, applicants have filed a newly executed declaration. However, inspection of the declaration reveals that it nominates "Karl Olof Joakim Bergstrom" in place of "BERGSTROM, Joakim" nominated in the published international application. That is, the first name shown on the publication corresponds to one of the middle names shown on the declaration. In that this discrepancy clearly represents more than a typographic error or phonetic misspelling, a proper petition under 37 CFR 1.182 would be required for the change to be accepted. *See* MPEP 605.04(b) and 605.04(c).

It is also noted that the fourth page of the declaration, signed by Jacques Sagne, appears to have been transmitted by facsimile and subsequently attached to the other three pages, which were not faxed. Applicants' attention is respectfully called to MPEP 201.03, which explains in part that

> An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so

that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

Since the declaration appears to have been compiled using sheets from more than one declaration document, it would not be appropriate to accept it in view of MPEP 201.03.

The Decision mailed on 07 January 2008 set a period for response as follows:

> A proper response must be filed within **ONE (1) MONTH** from the mail date of this decision. Extensions of time may **NOT** be obtained under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT** with respect to the national stage in the United States.

This period for response is analogous to that which would have been set by a Notification of Defective Response (Form PCT/DO/EO/916). This was appropriate, in that a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an acceptable declaration was mailed on 10 September 2007. As such, applicants were given additional time in which to perfect their response. Since the response filed on 07 February 2008 has been found to be defective for the reasons noted above, and no further timely response was filed, this international application stands ABANDONED with respect to the national stage in the United States.

## DECISION

The declaration is **NOT ACCEPTED** as described above, without prejudice.

The application is **ABANDONED**.

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

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

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13 NOV 2008

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PLANO TX 75024

In re Application of
Bergstrom et al.
Application No. 11/575,746
PCT No.: PCT/SE05/01412
Int. Filing Date: 23 September 2005
Priority Date: 23 September 2004
Att. Docket No.: P19618-US1
For: Method And Arrangement For A Synchronized HSDPA Reconfiguration

DECISION

The petition to revive under 37 CFR 1.137(b) filed on 09 September 2008 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 for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of a declaration compliant with 37 CFR 1.497(a) and (b), and has paid the petition 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 forwarded to the Office of Patent Application Processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **09 September 2008**.

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

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02 AUG 2007

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WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

| | | |
|---|---|---|
| In re Application of | : | |
| MARTIN, Darren James | : | |
| Application No.: 11/575,750 | : | DECISION |
| PCT No.: PCT/AU2005/000718 | : | |
| Int. Filing Date: 19 May 2005 | : | ON PETITION UNDER |
| Priority Date: 30 August 2004 | : | |
| Docket No.: DAVI-0011 | : | 37 CFR 1.137(b) |
| For: POLYMER COMPOSITE | : | |

Applicant's Petition Under 37 CFR 1.137(b), filed in the above-captioned application on 21 March 2007 is **GRANTED**.

Applicant indicates that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, as required by 37 CFR 1.137(b)(3). The appropriate 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.

Applicant has 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 June 2007.

Erin P. Thomson

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

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CST

April 1, 2010

| | | |
|---|---|---|
| In re application of | : | DECISION ON REQUEST TO |
| Ying Liang et al | : | PARTICIPATE IN PATENT |
| Serial No.11/575,782 | : | PROSECUTION HIGHWAY |
| Filed: March 22, 2007 | : | PILOT PROGRAM AND |
| For: IMPACT-MODIFIED | : | PETITION TO MAKE SPECIAL |
| POLYAMIDE COMPOUNDS | : | UNDER 37 CFR 1.102(d) |

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) pilot program filed on February 5, 2010.

The request and petition are **DISMISSED** as moot. Specifically, a non-final office action was mailed in this application on March 25, 2010.

A grantable request to participate in the PPH pilot program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the EPO, note where the EPO application with similar claims is not the same application from which the U.S. application claims priority that the applicant must identify the relationship between the EPO application with similar claims and the EPO priority application;

(2) Applicant must submit a copy of:
   a. The allowable/patentable claim(s) from the EPO application(s);
   b. An English translation of the allowable/ patentable claim(s), if applicable; and
   c. A statement that the English translation is accurate, if applicable;

(3) Applicant must:
   a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the EPO application(s); and
   b. Submit a claims correspondence table in English;

(4) Examination of the U.S. application has not begun;

(5) Applicant must submit:
a. A copy of all of the Office action (which are relevant to patentability) from each of the EPO application(s) containing the allowable claims that are the basis for the request;
b. An English language translation of the EPO Office action from (5)(a) above if applicable; and
c. A statement that the English translation is accurate;

(6) Applicant must submit:
a. An IDS listing the documents cited by the EPO examiner in the EPO office action (unless already submitted in this application)
b. Copies of documents except U.S. patents or U.S. patent application publications (unless already submitted in this application); and

(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH program and petition fail because:

(4) Examination of the U.S. application has begun. Specifically, note that a non-final office action was mailed on March 25, 2010.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://www.uspto.gov/ebc/index.html.

/Christine Tierney/

Christine Tierney
Quality Assurance Specialist
Technology Center 1700

1 4 OCT 2008

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P.O. Box 1450
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STITES & HARBISON PLLC (SYNTHES)
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA VA 22314

| | | |
|---|---|---|
| In re Application of | : | |
| GEISERT, Christophe, et al. | : | |
| Application No.: 11/575,790 | : | DECISION |
| PCT No.: PCT/IB2005/053051 | : | |
| Int. Filing Date: 16 September 2005 | : | ON REQUEST UNDER |
| Priority Date: 23 September 2004 | : | |
| Attorney's Docket No.: P08534US01/MP | : | 37 CFR 1.497(d) |
| For: SYSTEM AND METHOD FOR AN INTERVERTEBRAL IMPLANT | : | |

This decision is in response to request under 37 CFR 1.497(d), filed in the United States Patent and Trademark Office on 11 September 2007.

## BACKGROUND

On 16 September 2005, applicants filed international application PCT/IB2005/053051, listing 6 inventors as applicants and inventors for the purposes of the US and listing 2 people as "inventors".

On 11 June 2007, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) requiring additional claim fees, the surcharge for filing the search fee, examination fee or oath or declaration after 30 months and a new oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b).

On 11 September 2007, applicants filed this Request Under 37 CFR 1.497(d) along with additional claim fees.

## DISCUSSION

Applicants file this request to remove the "inventors" from the application, that is David Gerber and John Furda.

As Mr. Gerber and Mr. Furda were not listed as "applicants/inventors" for the purposes of the United States, they are not regarded as part of the inventive entity for the United States, stated during the international phase. This request is not required.
request.

However, a review of the declaration reveals it is composed of 3 pages one and 2 pages

two. While it is acceptable for inventors to execute separate copies of the oath or declaration, each inventor must execute an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the complete copy of the oath or declaration must be returned to the Office. It is not permitted to piece together pages from separately executed declarations to create a single composite declaration.

## CONCLUSION

For the above reasons, applicant's request under 37 CFR 1.497(d) is **DISMISSED AS MOOT**.

An oath or declaration in compliance with 37 CFR 1.497(a)-(b) is required within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed, 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

16 DEC 2008

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STITES & HARBISON PLLC (SYNTHES)
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA VA 22314

In re Application of :
GEISERT, Christophe, et al. :
Application No.: 11/575,790 :
PCT No.: PCT/IB2005/053051 :
Int. Filing Date: 16 September 2005 : DECISION
Priority Date: 23 September 2004 :
Attorney's Docket No.: P08534US01/MP :
For: SYSTEM AND METHOD FOR AN INTERVERTEBRAL IMPLANT :

This decision is in response to applicants' submission of a declaration of the inventors on 17 November 2008.

## BACKGROUND

On 14 October 2008, the Office mailed Decision On Request Under 37 CFR 1.497(d). It dismissed the request as moot, but indicated that the declaration of the inventors was defective.

On 17 November 2008, applicants filed a declaration of the inventors.

## DISCUSSION

The declaration of the inventors presented on 17 November 2008 complies with 37 CFR 1.497(a)-(b).

## CONCLUSION

This application is being referred to the National Phase Processing Branch of the Office of Patent Application Processing for further action consistent with this decision. The application has a 35 USC 371(c)(1), (c)(2) and (c)(4) date of 17 November 2008.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

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FOLEY & LARDNER LLP
975 PAGE MILL ROAD
PALO ALTO, CA 94304

**MAILED**

JUN 22 2009

**OFFICE OF PETITIONS**

In re Application of :
Herman Monstadt, et al. :
Application No. 11/575,796 : DECISION ON PETITION
Filed: March 21, 2007 : TO WITHDRAW
Attorney Docket No. 355492-4651 : 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 29, 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 request was signed by Lorna Tanner on behalf of all attorneys of record who are associated with customer No. 38706. All attorneys/agents associated with the Customer Number 38706 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future communications from the Office will be directed to the assignee of the entire interest at the first copied address below until otherwise properly notified by the applicant.

There are no pending Office actions at the present time.

Telephone inquiries concerning 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.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

cc: MICRO THERAPEUTICS, INC
9775 TOLEDO WAY
IRVINE, CA 92618

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 |
|---|---|---|---|
| 11/575,796 | 12/28/2007 | Hermann Monstadt | 355492-4651 |

**CONFIRMATION NO. 2222**

38706
FOLEY & LARDNER LLP
975 PAGE MILL ROAD
PALO ALTO, CA 94304

**POWER OF ATTORNEY NOTICE**

OC000000036405429

Date Mailed: 06/10/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 04/29/2009.

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

/amwise/

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

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**FOLEY & LARDNER LLP**
**975 PAGE MILL ROAD**
**PALO ALTO, CA 94304**

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JUL 31 2009

OFFICE OF PETITIONS

In re Application of
Monstadt et al.
Application No. 11/575,798
Filed: May 1, 2008
Attorney Docket No. EV3N.010NP

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 29, 2009.

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 Foley & Lardner LLP, were revoked by the assignee of the patent application on July 1, 2009. 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: KNOBBE, MARTENS, OLSON & BEAR, LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

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UNITED STATES DEPARTMENT OF COMMERCE
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MURATA MANUFACTURING COMPANY, LTD.
C/O KEATING & BENNETT, LLP
1800 Alexander Bell Drive
SUITE 200
Reston, VA 20191

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Yoichi Mochida | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7631559 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/575,799 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 03/22/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **504** 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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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

MAILED

JUN 15 2009

OFFICE OF PETITIONS

Applicant: Masahiro Segawa, et al.
Appl. No.: 11/575,820
International Filing Date: September 14, 2005
Title: RUN-FLAT TIRE
Attorney Docket No.: UNIU40.020APC
Pub. No.: US 2007/0209745 A1
Pub. Date: September 13, 2007

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on November 08, 2007, for the above-identified application.

The request is granted.

Applicant requests that the application be republished because the patent application publication contains an incorrect filing date for PCT/JP2005/016950, as the Office improperly published the date as September 15, 2005, not September **14**, 2005.

On June 07, 2007, a Filing Receipt was mailed by the Office, which listed the International Filing Date as September 15, 2005. 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 prior to export of the publication to the publisher.

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

33

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0 1 JUN 2009

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DARBY & DARBY PC
P.O. Box 770
Church Street Station
New York, NY 10008-0770

| | | |
|---|---|---|
| In re Application of | : | DECISION ON RENEWED |
| Nilsson et al | : | |
| Application No.: 11/576,871 | : | |
| PCT No.: PCT/DK05/000648 | : | |
| Int. Filing Date: 07 October 2005 | : | PAPERS FILED |
| Priority Date: 08 October 2004 | : | |
| Attorney's Docket No.: 20517/0206491-US0 | : | |
| For: CONTROLLED RELEASE... | : | |
| ACID ESTER | : | UNDER 37 CFR 1.42 |
| | : | |

This is a decision on the "RENEWED REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.42" filed 30 January 2009.

## BACKGROUND

In a decision from this office dated 03 December 2008, the papers filed on 27 May 2008 were not accepted under 37 CFR 1.42. The reason was that it was not clear if Bonna Robinson was the sole heir of the deceased inventor, Joseph R. ROBINSON.

On 30 January 2009, applicants submitted the renewed submission under 37 C.F.R. §1.42.

## DISCUSSION

Applicants have provided a proper supplemental declaration, which sets forth that Bonna Robinson is in fact the sole heir of the deceased inventor Joseph R. ROBINSON. Also, the supplemental declaration has no alteration on it with respect to the inventor Florian Schoenharting.

Accordingly, the requirements under 37 CFR 1.42 are satisfied and the declaration is acceptable at this time.

If she is executing the declaration as the sole heir of the deceased inventor then it is hereby construed as an indication that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed. If this interpretation is incorrect applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative(s) of the deceased inventor in response to this decision.

## CONCLUSION

The renewed submission filed under 37 CFR 1.42 is **ACCEPTED**.

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision. The 35 U.S.C.§ 371(c)(1), (c)(2), and (c)(4) date of this application as **30 January 2009**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3276
Fax: (571) 273-0459

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10 POST OFFICE ROAD - SUITE 100
SILVER SPRING MD 20910

MAILED

APR 22 2009

OFFICE OF PETITIONS

Applicant: Venturelli et al.
Appl. No.: 11/575,950
International Filing Date: September 24, 2004
Title: ASSEMBLY FOR THE TREATMENT OF BIFURCATIONS
Attorney Docket No.: 5955
Pub. No.: US 2007/0219625 A1
Pub. Date: September 20, 2007

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on October 29, 2007, for the above-identified application.

Applicant requests that the application be republished because the patent application publication contains material errors in the form of a PCT priority date of September 29, 2004 rather than the correctly filed date of September 24, 2004.

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 Michael Cygan, Legal Advisor, at (571) 272-7700, or the undersigned at (571) 272-7709.

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

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**TOWNSEND AND TOWNSEND AND CREW, LLP**
**TWO EMBARCADERO CENTER**
**8TH FLOOR**
**SAN FRANCISCO, CA 94111**

**RECEIVED**

DEC 22 2008

**OFFICE OF PETITIONS**

In re Application of :
**REDDINGTON,** John J. et al. :
Application No. 11/575,968 : DECISION ON PETITION
Filed: March 23, 2007 : TO WITHDRAW
Attorney Docket No. **VICAL1140-1** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 16, 2008.

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 December 11, 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 Tredelle Jackson at 571-272-2783.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**: _____

**DATE** : 6/1/09

**TO SPE OF** : ART UNIT **3765 (3700)**

**SUBJECT** : Request for Certificate of Correction for Appl. No.: **11/575,990** Patent No.: **7,426,944**

Attn: Bobby Muromoto Jr.

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)**
**South Tower - 9A22**
**Palm Location 7580**

*Ernest C. White, LIE*
**Certificates of Correction Branch**
703-308-9390 ext.122

**Thank You For Your Assistance**

---

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

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

**Comments:** _____

All Changes apply

_____

_____

/Gary L. Welch / **SPE** — 3765 / **Art Unit**

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02 JAN 2008

23322
IPLM GROUP, P.A.
Post Office Box 18455
Minneapolis, MN 55418

In re Application of:
HILL *et al*
U.S. Application No.: 11/576,035
PCT No.: PCT/GB2005/003709
Int. Filing Date: 26 September 2005
Priority Date: 24 September 2004
Attorney Docket No.: 237P004USWO
For: IMPROVEMENTS IN HIGH CONTENT SCREENING

**DECISION**

This decision is in response to applicants' petition to revive under 37 CFR 1.137(b) filed on 18 December 2007 which is hereby **GRANTED** as follows:

Applicants paid the Basic National fee as a response to the Form PCT/DO/EO/909 mailed 13 December 2007. The petition fee for a small entity has been paid. Applicants make the required statement pursuant to 37 CFR 1.137(b)(3). A terminal disclaimer is not required.

All requirements of 37 CFR 1.137(b) are satisfied.

This application is being forwarded to the Office of Patent Application Processing for further processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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JOSEPH J. CORSO
1801 East Ninth Street, Suite 1200
Cleveland, OH 44114-3108

| | | |
|---|---|---|
| In re Application of | : | DECISION ON REQUEST TO |
| Yasushi ENOKIDO et al. | : | PARTICIPATE IN PATENT |
| Application No. 11/576050 | : | PROSECUTION HIGHWAY |
| Filed: March 27, 2007-10-01 | : | PILOT PROGRAM AND PETITION |
| Attorney Docket No. OBA-42066 | : | TO MAKE SPECIAL UNDER |
| | : | 37 CFR 1.102(d) |

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) pilot program and the petition under 37 CFR 1.102(d), filed September 11, 2007, to make the above-identified application special.

The request and petition are **DISMISSED**.

A grantable request to participate in the PPH pilot program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
(3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
(4) Examination of the U.S. application has not begun;
(5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
(6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH pilot program and petition fail to include:

Where ALL the claims submitted in the US application are essentially the same as those allowed by the Japanese Patent Office. The originally filed Claim 5 and Claim 18 and dependent Claim 20 differ in that Claim 5 of the JPO state that it is "0.5 to 4.5wt% of B and 0.02 to 0.5wt% of one

or both of AL and Cu". The underlined portion is missing from Claim 18 of the preliminary amendment.

Applicant is given a time period of **ONE MONTH or THIRTY DAYS**, whichever is longer, from the mailing date of this decision to correct the deficiencies. **NO EXTENSION OF TIME UNDER 37 CFR 1.136 IS PERMITTED.** If the deficiencies are not corrected with the time period given, the application will await action in its regular turn.

Response must be faxed to Kathryn Gorgos at 571 273-1012.

Telephone inquiries concerning this decision should be directed to Kathryn Gorgos at 571 272-1012.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://www.uspto.gov/ebc/index.html.

Kathryn Gorgos
TC 1700 TQAS

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/576,050 | | Yasushi Enokido | OBA-42066 | 5799 |

116 7590 12/06/2007

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 1744 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 12/06/2007 | 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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JOSEPH J. CORSO
1801 East Ninth Street, Suite 1200
Cleveland, OH 44114-3108

DEC - 6 2007

| | | |
|---|---|---|
| In re Application of | : | DECISION ON REQUEST TO |
| Masaki IWASAKI et al | : | PARTICIPATE IN PATENT |
| Application No. 11/576050 | : | PROSECUTION HIGHWAY |
| Filed: March 27, 2007 | : | PILOT PROGRAM AND PETITION |
| Attorney Docket No. OBA-42066 | : | TO MAKE SPECIAL UNDER |
| | : | 37 CFR 1.102(d) |

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) pilot program and the petition under 37 CFR 1.102(d) filed September 21, 2007 and the preliminary amendment, filed December 03, 2007, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH pilot program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
(3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
(4) Examination of the U.S. application has not begun;
(5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
(6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Kathryn Gorgos at 571 272-1012.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://www.uspto.gov/ebc/index.html.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Kathryn Gorgos
TQAS TC 1700

2 6 MAR 2009

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SUITE 1200
CLEVELAND OH 44114-3108

| | | |
|---|---|---|
| In re Application of | : | |
| ENOKIDO, Yasushi, et al. | : | |
| Application No.: 11/576,050 | : | DECISION ON |
| PCT No.: PCT/JP2005/021083 | : | |
| Int. Filing Date: 17 November 2005 | : | PETITION |
| Priority Date: 17 November 2004 | : | |
| Attorney Docket No.: OBA-42066 | : | UNDER 37 CFR 1.182 |
| For: RARE EARTH SINTERED MAGNET | : | |

This is a decision on applicant's petition under 37 CFR 1.182, filed in the United States Patent and Trademark Office on 11 September 2007.

## BACKGROUND

On 27 March 2007, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The electronic information entered upon filing indicated this application was a national phase of PCT/US2005/021083 The papers listed international application no. PCT/JP2005/021083.

On 11 September 2007, applicant filed this petition to correct the above discrepancy. It has been treated as a petition under 37 CFR 1.182 and the fee will be charged to applicant's deposit account as authorized.

## DISCUSSION

Applicants have explained that the paperwork was intended as a national stage entry of PCT/JP2005/021083. The indications will be corrected in the file and the file will be processed as a national stage entry of PCT/JP2005/021083.

## CONCLUSION

For the reasons listed above, the Petition Under 37 CFR 1.182 is **GRANTED**.

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

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

2 5 FEB 2009

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RANBAXY INC.
600 COLLEGE ROAD EAST
SUITE 2100
PRINCETON NJ 08540

| | | |
|---|---|---|
| In re Application of | : | |
| Mehta et al. | : | |
| Application No. 11/576,066 | : | |
| PCT No.: PCT/IB2005/002838 | : | |
| Int. Filing Date: 26 September 2005 | : | DECISION |
| Priority Date: 27 September 2004 | : | |
| Atty. Docket No.: RL1-584US | : | |
| For: Muscarinic Receptor Antagonists | : | |

This is in response to the correspondence filed on 01 August 2008.

## BACKGROUND

This international application was filed on 26 September 2005, claimed an earlier priority date of 27 September 2004, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 06 April 2006. The 30 month time period for paying the basic national fee in the United States expired at midnight on 27 March 2007. Applicants filed, *inter alia*, the basic national fee on 27 March 2007.

On 28 March 2008, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to counsel, requiring the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

On 19 May 2008, applicants filed a response, including a declaration and the surcharge.

On 21 July 2008, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to counsel, indicating the "current oath or declaration" to be defective because the "first name of the 4th inventor (Shelly vs. Shelley) is spelled differently than that which is printed on the IA.. Please submit a corrected, newly executed declaration, or provide an explanation for the name change."

## DISCUSSION

Inspection of the declaration filed on 19 May 2008 reveals that it names "Shelly AERON" in place of "AERON, Shelley" who was nominated in the published international application. Counsel states that "the spelling of the first name of the 4th inventor Shelly AERON is spelled correctly on the executed Declaration submitted to the United States Patent and Trademark Office on May 21, 2008. Inventor AERON's first name as spelled on International Application No. PCT/IB2005/002838 was a typographical error." In view of this explanation, it would be appropriate to accept the declaration filed on 19 May 2008 for purposes of compliance with 37 CFR 1.497(a) and (b). *See* MPEP 605.04(b).

## DECISION

The declaration is **ACCEPTED**, as discussed above.

This application is being forwarded to the Office of Patent Application Processing. Its date under 35 U.S.C. 371(c)(1), (2) and (4) is **19 May 2008**.

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

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22 FEB 2008

Schwegman, Lundberg & Woessner, P.A.
P.O. Box 2938
Minneapolis, MN 55402

In re Application of
PAGE, Mark V.
U.S. Application No.: 11/576,072
PCT No.: PCT/US06/35312
Int. Filing Date: 30 September 2005
Priority Date: 01 October 2004
Attorney Docket No.: 1842.080US1
For: GAMING MACHINE WITH AUTO-DETECT FEATURE ACTIVATION

DECISION ON PETITION UNDER 37 CFR 1.47(b)

This decision is in response to applicant's "(Petition under 37) Rule 1.47(b) to File Application Without Inventor" filed 16 January 2008 to accept the application without the signature of the sole inventor, Mark Page. The $200 petition fee has been submitted.

## BACKGROUND

On 30 September 2005, applicant filed international application PCT/US06/35312 which claimed a priority date of 01 October 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 01 April 2007.

On 27 March 2007, applicant filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1)and a copy of the international application.

On 10 September 2007, the United Stated Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 16 January 2008, applicant filed a petition under 37 CFR 1.47(b).

## DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the

nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of items (1) - (4). However, items (5) and (6) have not been satisfied.

Applicant here has submitted the appropriate petition fee. Item (1) is therefore satisfied.

Regarding item (2), the petition asserts that the nonsigning inventor has refused to execute the declaration. Before a refusal to execute the application can be claimed, section 409.03(d) of the MPEP requires that the nonsigning inventor be provided with a copy of the complete application, including specification, drawings and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made."

Here, the evidence submitted to demonstrate Mark Page's refusal to execute the application papers is contained in the statement of Rodney Lacy included in the petition, and the exhibits thereto. These materials provide the required firsthand statement regarding the delivery to the nonsigning inventor of a copy of the complete application, and the nonsigning inventor's refusal to execute the application, with documentary evidence supporting the statement. Item (2) is therefore satisfied.

Regarding item (3), applicant has provided the last known address of the nonsigning inventor. Accordingly, item (3) is therefore satisfied.

Regarding item (4), the petition was accompanied by an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor. Item (4) is therefore satisfied.

Regarding item (5), section 409.03(f) of the MPEP states the following:

> When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that: (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Here, petitioner states in the present petition that "the application was assigned to WMS Gaming Inc., as evidence by the assignment from Mark V. Page recorded at Reel 016847, Frame 0820." Specifically, the assignment is directed to U.S. Provisional Serial No. 60/615,049. However, the assignment does not expressly refer to the international application and the present petition does not confirm that the international application includes only subject matter contained in the assigned U.S. priority application. Under such circumstances, a statement is required from a person with firsthand knowledge

confirming that the invention disclosed in the international application is the same as that disclosed in the assigned priority application (see MPEP section 409.03(f): "An assignment of an application and any 'reissue, division, or continuation of said application' does not itself establish an assignment of a continuation-in-part application."). Until the required supplemental materials described above are provided, item (5) is not considered satisfied.

Regarding item (6), the petition does not include the required express statement that granting of the present petition is necessary to preserve the rights of the 37 CFR 1.47(b) applicant. Item (6) is therefore not satisfied.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Mark Page under 37 CFR 1.47(b) 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.

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

Anthony Smith

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

UNITED STATES PATENT AND TRADEMARK OFFICE

15 SEP 2008

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Mark V. Page
3917 Alexander Avenue
East Chicago, IN 46312

In re Application of
PAGE, Mark V.
U.S. Application No.: 11/576,072
PCT No.: PCT/US05/35312
Int. Filing Date: 30 September 2005
Priority Date: 01 October 2004
Attorney Docket No.: 1842.080US1
For: GAMING MACHINE WITH AUTO-DETECT FEATURE ACTIVATION

Dear Mark V. Page:

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

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

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

Counsel of Record:
Schwegman, Lundberg & Woessner, P.A.
P.O. Box 2938
Minneapolis, MN 55402

UNITED STATES PATENT AND TRADEMARK OFFICE

15 SEP 2008

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Schwegman, Lundberg & Woessner, P.A.
P.O. Box 2938
Minneapolis, MN 55402

In re Application of
PAGE, Mark V.
U.S. Application No.: 11/576,072
PCT No.: PCT/US05/35312
Int. Filing Date: 30 September 2005
Priority Date: 01 October 2004
Attorney Docket No.: 1842.080US1
For: GAMING MACHINE WITH AUTO-DETECT FEATURE ACTIVATION

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(b)

In a decision mailed by this Office on 22 February 2008, the petition under 37 CFR 1.47(b) was dismissed without prejudice for failing to satisfy all the requirements of a grantable petition. Specifically, petitioner had not submitted: (1) an adequate showing that the 37 CFR 1.47(b) applicant has a proprietary interest in the present application and (2) a statement that granting the petition is necessary to preserve the rights of the parties or to prevent irreparable damage.

On 22 April 2008, petitioner filed the renewed petition considered herein. The renewed petition includes supplemental materials which, in combination with the previously filed materials, adequately demonstrate that the 37 CFR 1.47(b) applicant WMS Gaming Inc. has the necessary proprietary interest. Further, the petition also includes a statement from counsel that the granting of this petition is necessary to preserve the rights of the parties or prevent irreparable damage, satisfying this requirement.

The renewed petition under 37 CFR 1.47(b) is **GRANTED**. The application is accepted without the signature of nonsigning inventor Mark V. Page.

A notice of the acceptance of the application under 37 CFR 1.47(b) will be published in the Official Gazette, and a letter informing the nonsigning inventor of the application will be forwarded to the inventor's last-known address, as set forth in the 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 16 January 2008.

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

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0 2 NOV 2007

SNELL & WILMER L.L.P. (MATSUSHITA)
600 ANTON BOULEVARD
SUITE 1400
COSTA MESA, CA 92626

In re Application of MIURA et al :
U.S. Application No.: 11/576,098 :
PCT Application No.: PCT/JP2005/018443 :
Int. Filing Date: 05 October 2005 : DECISION
Priority Date Claimed: 05 October 2004 :
Attorney Docket No.: 50478-7500 :
For: PLASMA DISPLAY PANEL AND :
PRODUCTION METHOD THEREFOR :

This is in response to applicant's "Petition to Change an Inventor's Name in a Patent Application Pursuant to 37 C.F.R. §1.182" filed 28 September 2007.

## BACKGROUND

On 05 October 2005, applicant filed international application PCT/JP2005/018443, which claimed priority of an earlier Japan application filed 05 October 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 13 April 2006. The thirty-month period for paying the basic national fee in the United States expired on 05 April 2007.

On 27 March 2007, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1) and an executed declaration.

On 25 May 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that the name of the fifth inventor on the declaration does not match that shown in the published international application.

On 28 September 2007, applicant filed the present petition under 37 CFR 1.182.

## DISCUSSION

MPEP 605.04(c) states in relevant part,

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

The present response states that the fifth inventor's name has changed due to marriage. Applicant has submitted an appropriate petition under 37 CFR 1.182 with the requisite $400.00 petition fee along with an affidavit as described above.

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 05 October 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 27 March 2007.

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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**PRICE HENEVELD COOPER DEWITT & LITTON, LLP**
**695 KENMOOR, S.E.**
**P O BOX 2567**
**GRAND RAPIDS MI 49501**

COPY MAILED

AUG 2 9 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Nicholas S. Duesbery | : | |
| Application No. 11/576,112 | : | DECISION ON PETITION |
| Filed: November 19, 2007 | : | TO WITHDRAW |
| Attorney Docket No. VAN67 P-333A | : | 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 5, 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.

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

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Nicholas S. Duesbery**
**344 Madison Avenue SE**
**Grand Rapids, MI 49503**

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**Price Heneveld Cooper Dewitt & Litton, LLP**
**695 Kenmoor, S.E.**
**P.O. Box 2567**
**Grand Rapids, MI 49501**

COPY MAILED

SEP 29 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Nicholas S. Duesbery | : | |
| Application No. 11/576,112 | : | DECISION ON PETITION |
| Filed: November 19, 2007 | : | TO WITHDRAW |
| Attorney Docket No. VAN67 P-333A | : | FROM RECORD |
| | : | |

This is a decision on renewed the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 18, 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 Douglas H. Siegel on behalf of all attorneys of record. All attorneys/agents have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the first named inventor Nicholas S. Duesbery at the address indicated below.

There is no outstanding Office action at this time.

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

J. Williams

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Nicholas S. Duesbery**
**344 Madison Avenue SE**
**Grand Rapids, MI 49503**

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/576,112 | 11/19/2007 | Nicholas S. Duesbery | VAN67 P-333A |

**CONFIRMATION NO. 6340**

277
PRICE HENEVELD COOPER DEWITT & LITTON, LLP
695 KENMOOR, S.E.
P O BOX 2567
GRAND RAPIDS, MI 49501

**POWER OF ATTORNEY NOTICE**

*OC00000032314075*

Date Mailed: 09/29/2008

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/18/2008.

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

/tswilliams/

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

25 AUG 2009

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NASTECH PHARMACEUTICAL COMPANY INC
MDRNA, Inc.
3830 MONTE VILLA PARKWAY
BOTHELL WA 98021-7266

| | | |
|---|---|---|
| In re Application of | : | DECISION |
| CHEN et al. | : | |
| Application No.: 11/576,139 | : | |
| PCT No.: PCT/US2005/035259 | : | |
| Int. Filing Date: 27 September 2005 | : | |
| Priority Date: 27 September 2004 | : | |
| Attorney Docket No.: 04-17US | : | |
| For: METHOD OF TREATING AN INFLAMMATORY DISEASE BY DOUBLE STRANDED RIBONUCLEIC ACID | : | |

This decision is in response to applicants' petition under 37 CFR 1.497(d) filed 27 March 2007.

## BACKGROUND

On 27 September 2005, applicants filed international application PCT/US2005/035259 which designated the U.S. and claimed a priority date of 27 September 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 06 April 2006. The thirty-month period for paying the basic national fee in the United States expired at midnight on 27 March 2007.

On 27 March 2007, 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 instant petition under 37 CFR 1.497(d), a declaration of inventors, a statement from Michael E. Houston Jr., a consent of assignee statement, and a statement under 37 CFR 3.73(b).

## DISCUSSION

37 CFR 1.497(d), provides:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an

inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92*bis* subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;

(2) The processing fee set forth in Sec. 1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see Sec. 3.73(b) of this chapter); and

(4) Any new oath or declaration required by paragraph (f) of this section.

Items (1)-(3) have been satisfied. Item (4) is not required.

The declaration of inventors filed 27 March 2007 is in compliance with 37 CFR 1.497(a)-(b).

## CONCLUSION

The request under 37 CFR 1.497(d) is **GRANTED** 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 in accordance with this decision including processing the application in the name of Lishan Chen, Kunyuan Cui, Michael E. Houston, Jr., and Yuching Chen as inventors.

/Daniel Stemmer/

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

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OFFICE OF PETITIONS

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

In re Application of :
**FONT,** Dominique et al. :
Application No. 11/576,160 : DECISION ON PETITION
Filed: August 03, 2007 : TO WITHDRAW
Attorney Docket No. **26230** : 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 16, 2009.

The request is **moot** because a revocation of power of attorney has been previously filed.

A review of the file record indicates that the power of attorney to OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. has been revoked by the assignee of the patent application on November 11, 2009. 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 Tredelle Jackson at 571-272-2783.

/Tredelle D. Jackson/
Paralegal Specialist
Office of Petitions

cc: **OWENS CORNING**
**2790 COLUMBUS ROAD**
**GRANVILLE OH 43023**

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LICATA & TYRRELL P.C.
66 E. MAIN STREET
MARLTON, NJ 08053

Mail Date: 07/30/2010

| | | |
|---|---|---|
| **Applicant** | : Jay C. Dunlap | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7666616 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/23/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/576,168 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/03/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **230** 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. |
|---|---|---|---|---|
| 11/576,180 | 03/28/2007 | Andreas Wengert | R.309889 | 7434 |

2119 7590 05/04/2010

RONALD E. GREIGG
GREIGG & GREIGG P.L.L.C.
1423 POWHATAN STREET, UNIT ONE
ALEXANDRIA, VA 22314

| EXAMINER | |
|---|---|
| MCGRAW, TREVOR EDWIN | |
| ART UNIT | PAPER NUMBER |
| 3752 | |
| MAIL DATE | DELIVERY MODE |
| 05/04/2010 | 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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RONALD E. GREIGG
GREIGG & GREIGG P.L.L.C.
1423 POWHATAN STREET, UNIT ONE
ALEXANDRIA VA 22314

*In re* Application of:
WENGERT, ANDREAS
Serial No.: 11/576,180
Filed: March 28, 2007
Docket: R.309889
Title: INJECTOR FOR FUEL INJECTION IN AN INTERNAL COMBUSTION

DECISION ON PETITION

This is a decision on the petition filed on April 12, 2010 seeking withdrawal of the finality of the Office action mailed November 12, 2009. This petition is being considered pursuant to 37 CFR §1.181. No fee is required.

The petition is dismissed as moot.

In finding petitioner's points of argument persuasive, the requested relief is granted. The examiner was requested to mail a corrected Office action as requested in the petition. In view of the new Office action mailed April 30, 2010, decision on the petition is moot and is dismissed.

Any inquiry regarding this decision should be directed to Henry C. Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DISMISSED AS MOOT.

Robert Olszewski
Technology Center 3700

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RONALD E. GREIGG
GREIGG & GREIGG P.L.L.C.
1423 POWHATAN STREET, UNIT ONE
ALEXANDRIA, VA 22314

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Wolfgang Ripper | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7571603 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/11/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/576,192 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 03/28/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **154** 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.

25 MAY 2007

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LEYDIG VOIT & MAYER, LTD
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6731

| | | |
|---|---|---|
| In re Application of NORFRAY | : | |
| U.S. Application No.: 11/576,198 | : | |
| PCT Application No.: PCT/US2005/027060 | : | DECISION |
| Int. Filing Date: 29 July 2005 | : | |
| Priority Date Claimed: 22 September 2004 | : | |
| Attorney Docket No.: 257478 | : | |
| For: METHOD FOR MONITORING EARLY TREATMENT RESPONSE | : | |

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 28 March 2007.

## BACKGROUND

On 29 July 2005, applicant filed international application PCT/US2005/027060, which claimed priority of an earlier United States application filed 22 September 2004. The thirty-month period for paying the basic national fee in the United States expired on 22 March 2007.

International application PCT/US2005/027060 became abandoned as to the United States for failure to timely pay the basic national fee.

On 28 March 2007, applicant filed the present petition under 37 CFR 1.137(b).

## DISCUSSION

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

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

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

With regard to item (3), applicant has provided the required statement.

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

## CONCLUSION

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

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/576,205 | 01/30/2008 | Masakazu Hironiwa | Q100843 | 7729 |

23373 7590 06/16/2010

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

| EXAMINER | |
|---|---|
| HERNDON, HEATHER R | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2176 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 06/16/2010 | 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):

sughrue@sughrue.com
PPROCESSING@SUGHRUE.COM
USPTO@SUGHRUE.COM

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Sughrue, Mion, PLLC
2100 Pennsylvania Ave., N.W., Suite 800
Washington, DC 20037

In re Application of: HIRONIWA M.
Application No. 11/576,205
Filed: March 28, 2007
For: Data processing device and data processing method.

DECISION ON REQUEST TO PARTICIPATE IN PATENT PROSECUTION HIGHWAY PROGRAM AND PETITION TO MAKE SPECIAL UNDER 37 CFR 1.102(d)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed January 14, 2010 to make the above-identified application special.

The petition is **GRANTED.**

A grantable request to participate in the PPH program and petition to make special require:

(1) The U.S. application is
(a) a Paris Convention application which either
(i) validly claims priority under 35 U.S.C. 119(a) and 37 CFR 1.55 to one or more applications filed in the JPO, or
(ii) validly claims priority to a PCT application that contains no priority claims,

Or

(b) a national stage application under the PCT (an application which entered the national stage in the U.S. from a PCT international application after compliance with 35 U.S.C. 371), which PCT application
(i) validly claims priority to an application filed in the JPO, or
(ii) validly claims priority to a PCT application that contains no priority claims, or
(iii) contains no priority claim,

Or

(c) a so-called bypass application filed under 35 U.S.C. 111 (a) which validly claims benefit under 35 U.S.C. 120 to a PCT application, which PCT application
(i) validly claims priority to an application filed in the JPO, or

(ii) validly claims priority to a PCT application that contains no priority claims, or
(iii) contains no priority claim.

Where the JPO application that contains the allowable/patentable claims is not the same application for which priority is claimed in the U.S. application, applicant must identify the relationship between the JPO application that contains the allowable/patentable claims and the JPO priority application claimed in the U.S. application.

(2) Applicant must submit a copy of:
a. The allowable/patentable claim(s) from the JPO application(s) or if a copy of the allowable/patentable claims is available via the Dossier Access System (DAS) applicant may request the USPTO obtain a copy from the DAS, however if the USPTO is unable to obtain a copy from the DAS the applicant will be required to submit a copy;
b. An English translation of the allowable/patentable claim(s) and
c. A statement that the English translation is accurate;

(3) Applicant must:
a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s) and
b. Submit a claims correspondence table in English;

(4) Examination of the U.S. application has not begun;

(5) Applicant must submit:
a. Documentation of prior office action:
i. a copy of the office action(s)just prior to the "Decision to Grant a Patent" from each of the JPO application(s) containing the allowable/patentable claim(s) or
ii. if the allowable/patentable claims(s) are from a "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
iii. if the JPO application is a first action allowance then no office action from the JPO is necessary should be indicated on the request/petition form;

Further, if a copy of the documents from a or b above is available via the Dossier Access System (DAS) applicant may request the USPTO obtain a copy from the DAS, however if the USPTO is unable to obtain a copy from the DAS the applicant will be required to submit a copy; b. An English language translation of the JPO Office action from (5)(a)(i)-(ii) above c. A statement that the English translation is accurate;

(6) Applicant must submit:
a. An IDS listing the documents cited by the JPO examiner in the JPO office action (unless already submitted in this application)
b. Copies of the documents except U.S. patents or U.S. patent application publications (unless already submitted in this application);

(7) The required petition fee under 37 CFR 1.17(h).

The petition is **GRANTED.**

The request to participate in the PPH pilot program and petition are found to comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Mano Padmanabhan at 571-272-4210.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://www.uspto.gov/ebc/index.html.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

/Mano Padmanabhan/

_____

Mano Padmanabhan
Quality Assurance Specialist, Technology Center 2100, Workgroup 2180
571-272-4210

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www.uspto.gov

DITTHAVONG, MORI AND STEINER, PC
918 PRINCE STREET
ALEXANDRIA, VA 22314

COPY MAILED
DEC 05 2008

Applicant: Schmidt
Appl. No.: 11/576,238
International Filing Date: September 27, 2005
Title: METHOD AND APPARATUS FOR CLOCK-PULSE SYNCHRONIZATION WITH AN OFFSET QPSK-MODULATED TRANSMISSION SIGNAL
Attorney Docket No.: 01012-1048
Pub. No.: 2007/0263742 A1
Pub. Date: November 15, 2007

This is a decision on the request for corrected of patent application publication under 37 CFR 1.221(b), received on January 15, 2008, for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication contains material errors in the publication wherein several formulas in the specification are not correct. It is noted that the requestor has failed to identify whether these errors occurred on behalf of the PTO. Even if the errors arose on behalf of the PTO, the request is dismissed.

The request is dismissed, as the paper was not signed in compliance with 37 CFR 1.31-1.34, 37 CFR 10.14, 37 CFR 10.18, and 37 CFR 10.47. Applicant is reminded that only registered practitioners may practice before the Office. The paper was signed on behalf of one of the two people listed below the signature line; however the signature does not match any of the attorneys listed on the power of attorney.

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 or revised patent application publication other than 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 with respect to the mathematical formula may be Office errors, but they are not material Office errors under 37 CFR 1.221. The errors in the specification are not material Office errors under 37 CFR 1.221 because the quality of the text is poor, as it is very small. The errors noted by requestor in the specification are due to the quality of the text, as the text of the

[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).

mathematical formulas is very small. The text is not clear due to the size, which makes it difficult to electronically reproduce by digital imaging and optical character recognition. See 37 CFR 1.52 and PCT Rule 11.9(d)(1).

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

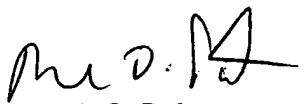
It would greatly benefit the Office if the request for corrected publication pointed out what was printed incorrectly in the application, where the error occurs in the publication and where the correct text or drawing is found in the application papers. Marked up relevant copies of the applications papers 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.

Applicants are advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application in compliance with the Office 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 any 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

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

1 0 JUN 2008

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

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

In re Application of :
ANTHEUNIS, Roland A. B., et al. :
Application No.: 11/576,340 : DECISION
PCT No.: PCT/IB2005/053101 :
Int. Filing Date: 21 September 2005 : ON PETITION UNDER
Priority Date: 29 September 2004 :
Docket No.: NL04 1025 US1 : 37 CFR 1.137(b)
For: CHARGING METHOD AND CIRCUIT :
USING INDIRECT CURRENT :
SENSING :

Applicant's Petition Under 37 CFR 1.137(b), filed in the above-captioned application on 02 April 2008 is **GRANTED**.

Applicant indicates that the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional, as required by 37 CFR 1.137(b)(3). The appropriate response and petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

Applicant has supplied a declaration 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 will be charged to deposit account no. 50-4019, as authorized.

This application is being forwarded to the National Stage Processing Branch of the Office of Patent Application Processing 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 02 April 2008.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

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

MAIL

APR 09 2010

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

LEE, HONG, DEGERMAN, KANG & WAIMEY
660 S. FIGUEROA STREET
Suite 2300
LOS ANGELES CA 90017

In re Application of
KIM, BEOM JOON et al
Application No. 11/576,342
Filed: March 29, 2007
Attorney Docket No. 2101-3314

DECISION ON REQUEST TO PARTICIPATE IN PATENT PROSECUTION HIGHWAY PROGRAM AND PETITION TO MAKE SPECIAL UNDER 37 CFR 1.102(d)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed March 05, 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the KIPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the KIPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
(3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the KIPO application(s);
(4) Examination of the U.S. application has not begun;
(5) Applicant must submit a copy of all the office actions from each of the KIPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
(6) Applicant must submit an IDS listing the documents cited by the KIPO examiner in the KIPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Michael Horabik at 571-272-3068.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

/Michael Horabik/

Michael Horabik
Quality Assurance Specialist
Technology Center 2600
Communications

07 JAN 2008

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POST OFFICE BOX 1449
GREENVILLE SC 29602-1449

| | | |
|---|---|---|
| In re Application of | : | |
| MYRICK et al. | : | |
| Application No.: 11/576,359 | : | DECISION |
| PCT No.: PCT/US2005/035617 | : | |
| Int. Filing Date: 04 October 2005 | : | |
| Priority Date: 04 October 2004 | : | |
| Attorney's Docket No.: USC-33-PCT-US | : | |
| For: THERMAL SELECTIVITY MULTIVARIATE OPTICAL COMPUTING | : | |

This decision is in response to applicant's petition under 37 CFR 1.137(b) filed 06 August 2007 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 04 October 2005, applicants filed international application PCT/US2005/035617, which designated the U.S. and claimed a priority date of 04 October 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 28 December 2006. The thirty-month period for paying the basic national fee in the United States expired at midnight on 04 April 2007.

On 30 March 2007, applicants filed a submission for entry into the national stage in the United States. The submission did not include the U.S. Basic National Fee.

On 25 July 2007, the USPTO mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States for failure to provide the U.S. Basic National Fee by thirty months from the priority date.

On 20 October 2007, applicants filed the instant petition under 37 CFR 1.137(b).

## DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

Item (1) has been satisfied. The U.S. Basic National Fee was submitted on 06 August 2007.

As to item (2), applicant submitted the petition fee on 06 August 2007.

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 executed oath or declaration of the inventor 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.

/Daniel Stemmer/

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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Ronald R. Santucci
Frommer Lawrence & Haug L.L.P.
745 Fifth Avenue
New York, NY 10151

Mail Date: 06/02/2010

| | | |
|---|---|---|
| **Applicant** | : Le-Ngoc Lan | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7661309 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/576,397 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/13/2007 | : 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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BACHMAN & LAPOINTE, P.C.
900 CHAPEL STREET
SUITE 1201
NEW HAVEN CT 06510

MAILED

APR 17 2009

OFFICE OF PETITIONS

Applicant: Fleury
Appl. No.: 11/576,414
International Filing Date: March 30, 2005
Title: METHOD FOR THE CONTINUOUS IMPLEMENTATION OF POLYMERISATION PROCESSES
Attorney Docket No.: 07-191
Pub. No.: 2008/0188950 A1
Pub. Date: August 7, 2008

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on October 6, 2008, 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.

It would greatly benefit the Office if **applicant did not provide copies of papers**, which were previously submitted and/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.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

24 JUL 2008

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00110
DANN, DORFMAN, HERRELL & SKILLMAN
1601 Market Street
Suite 2400
Philadelphia, PA 19103-2307

In re Application of :
HIMMLER *et al* :
U.S. Application No.: 11/576,415 :
PCT No.: PCT/GB05/003791 :
Int. Filing Date: 30 September 2005 : **DECISION**
Priority Date: 01 October 2003 :
Attorney Docket No.: 0380-P04307US00 :
For: NANOPARTICLES COMPRISING :
ANTIGENS AND ADJUVANTS, AND :
IMMUNOGENIC STRUCTURES :

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 11 April 2008.

## BACKGROUND

On 14 December 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) was required. Applicants were given two months to respond with extensions of time available.

On 11 April 2008, applicants filed a response which was accompanied by, *inter alia*, the subject petition, a declaration executed by eight inventors; a declaration of Simon J. Kiddle; exhibits A - C; and the required fees.

## DISCUSSION

Applicants claim that Ralf Kircheis cannot be located after a diligent effort and have filed the subject petition in response to the Form PCT/DO/EO/905 mailed 03 October 2007.

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. Items (2) and (4) are not yet satisfied.

The petition fee of $200.00 has been paid. The last known address of Ralf

Kircheis was provided in the petition. Items (1) and (3) of 37 CFR 1.47(a) are satisfied.

Regarding item (2), applicants' burden in showing that an inventor cannot be reached is explained in section 409.03(d)(I) 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 a declaration by Simon Kiddle who states that he attempted to contact Ralf Kircheis by sending correspondence on the application to his last known address which was returned indicating that Dr. Kircheis had moved with no forwarding address. Petitioners provided documentary evidence of the letter and postal receipt as required. No further attempts were made to locate the nonsigning inventor as Mr. Kiddle states that he has "no other way of contacting Dr. Kircheis, such as by phone or by email."

These efforts alone are not sufficient to meet the diligent effort requirements of section 409.03(d)(I) of the MPEP. Petitioners must also show that they made an attempt to ascertain the whereabouts of Dr. Kircheis and were unsuccessful despite their diligent effort.

Some possible steps petitioners may use to determine the whereabouts of the nonsigning inventor include, but are not limited to, contacting former employers of Dr. Kircheis for any forwarding address, email or telephone number, contacting the nonsigning inventors' former co-workers to determine if they have any information on the whereabouts of Dr. Kircheis, using the internet to perform a name search for Dr. Kircheis, searching internet telephone directories and contacting relevant professional organizations that Dr. Kircheis may be a member of.

Petitioners must also provide a statement of facts by a person having firsthand knowledge, that fully describes the exact facts which are relied on to establish that a diligent effort to locate Dr. Kircheis was made. Petitioners should provide copies of

documentary evidence to corroborate their effort. For these reasons, item (2) is not yet satisfied.

Concerning item (4), the 37 CFR 1.47(a) applicants submitted a declaration signed by eight of nine named co-inventors on behalf of themselves and the nonsigning joint inventor.

However, it appears that petitioners submitted one complete declaration and a portion of several other declarations. The declaration submitted is a 3-page declaration consisting of 7 pages (five page 2's). While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. By providing only a partial declaration, it is not clear what inventive entity was listed on the declaration signed by each co-inventor.

Petitioners must provide a complete copy of each declaration presented. For this reason, item (4) of 37 CFR 1.47(a) is also not satisfied.

## CONCLUSION

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

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web or if mailed 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.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

2 1 NOV 2008

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DANN, DORFMAN, HERRELL & SKILLMAN
1601 Market Street
Suite 2400
Philadelphia, PA 19103-2307

In re Application of :
HIMMLER *et al* :
U.S. Application No.: 11/576,415 :
PCT No.: PCT/GB05/003791 :
Int. Filing Date: 30 September 2005 : **DECISION**
Priority Date: 01 October 2003 :
Attorney Docket No.: 0380-P04307US00 :
For: NANOPARTICLES COMPRISING :
ANTIGENS AND ADJUVANTS, AND :
IMMUNOGENIC STRUCTURES :

This is a decision on the papers filed on 24 September 2008 which are treated as a renewed petition under 37 CFR 1.47(a).

## BACKGROUND

On 24 July 2008, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Applicants were given two months to respond with extensions of time available.

On 24 September 2008, applicants filed the renewed petition which was accompanied by a declaration executed by all inventors including the nonsigning inventor.

## DISCUSSION

In the renewed petition, applicants submitted a declaration executed by all the inventors including the nonsigning inventor, Mr. Ralf Kircheis.

No further action on the petition under 37 CFR 1.47(a) is required.

## CONCLUSION

For the reason discussed above, the petition under 37 CFR 1.47(a) is **DISMISSED** as **MOOT**.

The declaration filed 24 September 2008 is in compliance with 37 CFR 1.497(a) and (b).

**11/576,415**

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 30 September 2005, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 24 September 2008.

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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27 MAR 2008

IPLM GROUP, P.A.
POST OFFICE BOX 18455
MINNEAPOLIS MN 55418

| | | |
|---|---|---|
| In re Application of | : | |
| JONES, et al. | : | |
| U.S. Application No.: 11/576,417 | : | DECISION ON PETITION |
| PCT No.: PCT/GB05/03764 | : | |
| Int. Filing Date: 30 September 2005 | : | UNDER 37 CFR 1.137(b) |
| Priority Date: 01 October 2004 | : | |
| Attorney Docket No.: 237P005USWO | : | |
| For: COMPOSITE CONDUCTIVE MATERIAL | : | |

The petition to revive under 37 CFR 1.137(b) filed 18 December 2007 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 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 and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors and payment of additional fees are required.

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

29 MAY 2007

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

In re Application of LOUDIER et al :
U.S. Application No.: 11/576,418 :
PCT Application No.: PCT/FR2005/002062 :
Int. Filing Date: 09 August 2005 :
Priority Date Claimed: 10 September 2004 : DECISION
Attorney Docket No.: 306510US79PCT :
For: METHOD OF MONITORING A MESSAGE :
STREAM TRANSMITTED AND/OR :
RECEIVED BY AN INTERNET ACCESS :
PROVIDER WITHIN A :
TELECOMMUNICATION NETWORK :

This is in response to applicant's "Petition to Revive Under 37 C.F.R. 1.137(b)" filed 30 March 2007.

## BACKGROUND

On 09 August 2005, applicant filed international application PCT/FR2005/002062, which claimed priority of an earlier France application filed 10 September 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 23 March 2006. The thirty-month period for paying the basic national fee in the United States expired on 10 March 2007.

International application PCT/FR2005/002062 became abandoned as to the United States for failure to timely pay the basic national fee.

On 30 March 2007, applicant filed the present petition under 37 CFR 1.137(b).

## DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire

delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

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

With regard to item (3), applicant has provided the required statement.

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

## CONCLUSION

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

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a translation of the international application into English must be filed.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/576,428 | 03/30/2007 | Jan Looft | 53296 | 1857 |

7590 01/30/2009

ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.
1300 19TH STREET, N.W.
SUITE 600
WASHINGTON,, DC 20036

| EXAMINER | |
|---|---|

| ART UNIT | PAPER NUMBER |
|---|---|
| 3654 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 01/30/2009 | 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.

Patent Publication Branch
Office of Data Management

18 AUG 2009

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

| | | |
|---|---|---|
| In re Application of | : | |
| YOSHIMURA et al. | : | |
| U.S. Application No. 11/576,430 (11/576,432) | : | |
| PCT No.: PCT/JP05/17966 | : | |
| Int. Filing Date: 29 September 2005 | : | DECISION |
| Priority Date: 30 September 2004 | : | |
| Attorney Docket No.: TAKIT-0212 | : | |
| For: ELECTROPHOTOGRAPHIC TRANSFER PAPER | : | |

The above-identified application is before the Office of PCT Legal Administration for consideration of matters under 35 U.S.C. 371.

## BACKGROUND

On 29 September 2005, applicant filed international application No. PCT/JP05/17966, which claimed a priority date of 30 September 2004. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 30 March 2007.

On 30 March 2007, applicant electronically filed, through the law firm of Millen, White, Zelano & Branigan, a transmittal letter for entry into the national stage in the United States (Form PTO-1390). The transmittal referenced attorney docket number TAKIT-0212 and was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). The submission, identifying International Application No. PCT/JP05/17966, was assigned U.S. application number 11/576,430.

On the same day, through the same law firm, applicant electronically filed a second transmittal letter for entry into the national stage in the United States bearing the same attorney docket number and referencing the same international application PCT/JP05/17966. These papers were assigned U.S. application number 11/576,423.

## DISCUSSION

As is evident from the above recited facts, two sets of papers to enter the national stage have been submitted for international application number PCT/JP05/17966 (United States application numbers 11/576,430 and 11/576,423). 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 by above-named counsel and assigned application number 11/576,430 were the first of the two filings to be processed by the USPTO, with such U.S. application file being associated with the international application in the USPTO's PALM system. Accordingly, U.S. application number 11/576,430 is the application file that will continue to be processed as the national stage of PCT/JP05/17966. The second set of national stage materials filed on 30 March 2007 and originally assigned U.S. application number 11/576,423 will be placed in the present application file, and U.S. application number 11/576,423 will be discontinued.

Applicants should use application number **11/576,430** in all future communications with the United States Patent and Trademark Office (USPTO).

Application number 11/576,423 will be discontinued.

## CONCLUSION

U.S. application number 11/576,430 is the national stage of PCT/JP05/17966.

Application number 11/576,423 will be discontinued. These papers will be moved to application **11/576,430**.

Cynthia M. Kratz
Attorney-Advisor
PCT Legal Office
Office of PCT Legal Administration
Tel.: 571-272-3286
Facsimile: 571-273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

26 FEB 2009

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MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

In re Application of:
KORNBLUM, Harley, I., et al.
U.S. Application No.: 11/576,444
PCT No.: PCT/US2005/035355
International Filing Date: 30 September 2005
Priority Date: 30 September 2004
Attorney's Docket No.: 220002068700
For: COMPOSITIONS AND METHODS FOR DIAGNOSING AND TREATING BRAIN CANCER AND IDENTIFYING NEURAL STEM CELLS

DECISION ON REQUEST UNDER 37 CFR 1.497(d)

This decision is issued in response to the materials filed by applicants on 25 September 2008, treated herein under 37 CFR 1.497(d) as a request to add Houman HEMMATI as an additional inventor of record herein, so as to permit acceptance of the declarations previously filed on 05 June 2008. Deposit Account No. 03-1952 will be charged the required $130 processing fee.

## BACKGROUND

On 30 September 2005, applicants filed international application PCT/US2005/035355. The application claimed a priority date of 30 September 2004, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 30 March 2007. The published international application identified eight applicant/inventors for the U.S.

On 30 March 2007, 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 26 February 2008, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that the following additional materials were required: (1) an oath or declaration in compliance with 37 CFR 1.497, the surcharge for filing the oath or declaration later than thirty months after the priority date; and (3) additional sequence listing materials.

On 05 June 2008, applicants filed a response to the Notification of Missing Requirements (with two-month extension fee). The response included the required sequence listing materials

and surcharge payment, as well as declaration documents executed by the eight inventors of record and an additional inventor, Houman D. HEMMETI.

On 17 July 2008, the DO/EO/US mailed a "Notification Of Defective Response" (Form PCT/DO/EO/916) indicating that the declaration filed 05 June 2008 could not be accepted because it include the additional inventor, Houman D. HEMMETI, who was not of record herein.

On 25 September 2008, applicants filed (with five-month extension fee) the materials treated herein under 37 CFR 1.497(d) as a request to add Houman HEMMATI as an additional inventor of record, so as to permit acceptance of the previously filed declarations.

## DISCUSSION

Section 1893.01(e) of the MPEP states the following regarding changes in the inventorship of an international application entering the national stage (emphasis added):

> The inventorship of an international application entering the national stage under 35 U.S.C. 371 is that inventorship set forth in the international application, which includes any changes effected under PCT Rule 92*bis*. See 37 CFR 1.41(a)(4). Accordingly, **an oath or declaration that names an inventive entity different than that set forth in the international application will not be accepted for purposes of entering the U.S. national phase unless the requirements under 37 CFR 1.497(d) are satisfied.** These requirements include: (A) 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; (B) the processing fee set forth in 37 CFR 1.17(i); and (C) the written consent of the assignee if an assignment has been executed by any of the original named inventors (see 37 CFR 3.73(b)).

The declarations filed by applicants on 05 June 2008 name an inventive entity different than that set forth in the international application. Specifically, Houman D. HEMMETI has been added as an additional inventor. Accordingly, applicants must satisfy the requirements of 37 CFR 1.497(d) before such declaration can be accepted.

The present submission includes the required statement of non-deceptive intent from the person to be added and removed as an inventor (Houman D. HEMMETI), as well as the authorization to charge applicants' Deposit Account for the required processing fee. Requirements (A) and (B) are therefore satisfied. In addition, applicants have submitted the consent of the assignees to the requested change in inventorship, and such consent has been provided in compliance with 37 CFR 3.73(b). Requirement (C) is therefore also satisfied.

Based on the above, applicants have satisfied the requirements of a grantable request to add Houman D. HEMMETI as an additional inventor of record under 37 CFR 1.497(d). In view of this change in inventorship, the declarations filed 05 June 2008, which include Houman D. HEMMETI as an additional inventor, are no longer defective for failure to properly identify the inventors of record.

## CONCLUSION

Applicants' request to correct inventorship under 37 CFR 1.497(d) is **GRANTED**. The inventorship of record herein is corrected to include added inventor Houman D. HEMMETI.

Based on the correction of inventorship, the declarations filed on 05 June 2008 are acceptable in compliance with 37 CFR 1.497(a) and (b).

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 05 June 2008.

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

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**OFFICE OF PETITIONS**

In re Application of :
Carlo Stelliferi et al. :
Application No. 11/576,468 : DECISION ON PETITION
Filed: September 21, 2007 : TO WITHDRAW
Attorney Docket No. 128.1002 : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR. § 1.36(b), filed May 8, 2009.

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

A review of the file record indicates that the power of attorney to attorneys/agents associated with Customer Number 50438 has been revoked by the assignee of the patent application on April 28, 2009. 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 JoAnne Burke at 571-272- 4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK NY 10016

16 SEP 2009

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P.O. BOX 3001
BRIARCLIFF MANOR NY 10510

| | | |
|---|---|---|
| In re Application of | : | |
| BEMELMANS et al. | : | |
| Application No.: 11/576,469 | : | |
| PCT No.: PCT/IB2005/053234 | : | |
| Int. Filing Date: 30 September 2005 | : | DECISION |
| Priority Date: 05 October 2004 | : | |
| Attorney Docket No.: US040406US3 | : | |
| For: ROLLABLE DISPLAY DEVICE | : | |

This decision is in response to applicants' petition under 37 CFR 1.497(d) filed 18 June 2009 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 30 September 2005, applicants filed international application PCT/IB2005/053234 which designated the U.S. and claimed a priority date of 05 October 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 13 April 2006. The thirty-month period for paying the basic national fee in the United States expired at midnight on 05 April 2007.

On 02 April 2007, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee and a declaration of inventors.

On 18 November 2008, 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 the declaration of inventors filed 02 April 2007 executed an incorrect application number and listed one more inventor than is listed on the published international application.

On 18 June 2009, applicants submitted the instant petition under 37 CFR 1.497(d), a declaration of inventors, and a petition/fee for a five-month extension of time.

## DISCUSSION

Petition Under 37 CFR 1.497(d)

37 CFR 1.497(d), provides:

> (d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92*bis* subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:
>
> (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
>
> (2) The processing fee set forth in Sec. 1.17(i); and
>
> (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see Sec. 3.73(b) of this chapter); and
>
> (4) Any new oath or declaration required by paragraph (f) of this section.

Items (1)-(3) have been satisfied. Item (4) is not required.

Declaration of Inventors

The declaration of the inventors submitted 18 June 2009 does not comply with 37 CFR 1.497(a)-(b) because it does not list the correct inventorship. There is a difference in names in the named inventor between the published international application (Hjalmar E. A. Huitema) and the declaration of the inventor (Edzar Huitema). Because this difference in names is more than a mere typographical error, a transliteration error, or a phonetic misspelling of applicant's legal name, a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of $400 as well as a statement from the inventor.

## CONCLUSION

The request under 37 CFR 1.497(d) is **GRANTED** for the reasons set forth above.

Applicant is hereby given the time limit of **TWO (2) MONTHS** from the mail date of this communication in order to file a proper response. Extensions of time may be obtained under 37 CFR 1.136(a).

**Failure to timely file a proper response to this decision in a timely manner will result in abandonment of the application with regards to national stage prosecution in the United**

**States.**

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

/Daniel Stemmer/

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

- 1 FEB 2010

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| | | |
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| In re Application of | : | |
| BEMELMANS et al. | : | |
| Application No.: 11/576,469 | : | |
| PCT No.: PCT/IB2005/053234 | : | |
| Int. Filing Date: 30 September 2005 | : | DECISION |
| Priority Date: 05 October 2004 | : | |
| Attorney Docket No.: US040406US3 | : | |
| For: ROLLABLE DISPLAY DEVICE | : | |

This decision is in response to applicants' "PETITION IN ACCORDANCE WITH 37 CFR 1.497(d) TO CORRECT NAME OF INVENTORSHIP", which has properly been treated as a petition under 37 CFR 1.182, filed 30 October 2009 in the United States Patent and Trademark Office (USPTO). The petition is **DISMISSED** as **MOOT**.

## BACKGROUND

On 30 September 2005, applicants filed international application PCT/IB2005/053234 which designated the U.S. and claimed a priority date of 05 October 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 13 April 2006. The thirty-month period for paying the basic national fee in the United States expired at midnight on 05 April 2007.

On 02 April 2007, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee and a declaration of inventors.

On 18 November 2008, 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 the declaration of inventors filed 02 April 2007 executed an incorrect application number and listed one more inventor than is listed on the published international application.

On 18 June 2009, applicants submitted a petition under 37 CFR 1.497(d), a declaration of inventors, and a petition/fee for a five-month extension of time.

On 15 September 2009, a decision was mailed granting applicants' petition under 37 CFR 1.497(d). The decision also indicated that the declaration of the inventors submitted 18 June 2009 did not comply with 37 CFR 1.497(a)-(b) because there was a difference in names in one of the the named inventors between the published international application (Hjalmar E. A. Huitema) and the declaration of the inventor (Edzar Huitema) and that a proper petition under 37 CFR 1.182 was required in order to resolve the matter.

On 30 October 2009, applicants submitted the instant petition under 37 CFR 1.182 and a declaration of inventors.

## DISCUSSION

The declaration of inventors filed 30 October 2009 and executed by inventor Huitema lists the same name as is listed on the declaration of inventors (Hjalmar E. A. Huitema). Accordingly, a petition under 37 CFR 1.182 is no longer required. The petition fee of $400 paid on 30 October 2009 has been refunded to Deposit Account 12-1216.

The declarations of inventors filed 18 June 2009 and 30 October 2009 are in compliance with 37 CFR 1.497(a)-(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 in accordance with this decision including processing the application in the name of David J. E. BEMELMANS, Kenny DARMADJI, Hjalmar E. A. HUITEMA, Raymond LAFARRE, and Nicolaas W. SCHELLINGERHOUT as inventors.

/Daniel Stemmer/

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

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United States Patent and Trademark Office
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1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

12/14/09

| | | |
|---|---|---|
| In re Application of | : | |
| BRANDT, HELMUT | : | DECISION ON REQUEST TO |
| Application No. 11/576,517 | : | PARTICIPATE IN PATENT |
| Filed: April 2, 2007 | : | PROSECUTION HIGHWAY |
| Attorney Docket No. P/3453-32 V3383 | : | PROGRAM AND PETITION |
| For COMBINATION OF SKIN BOOT AND SKI | : | 37 CFR 1.102(d) |

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed December 11, 2009 to make the above-identified application special.

The request and petition are granted.

A grantable request to participate in the PPH pilot program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the EPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the EPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
(3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the EPO application(s);
(4) Examination of the U.S. application has not begun;
(5) Applicant must submit a copy of all the office actions from each of the EPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
(6) Applicant must submit an IDS listing the documents cited by the EPO examiner in the EPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
(7) The required petition fee under 37 CFR 1.17(h).

Applicant is encouraged to cite and submit all relevant prior art references, if any, to facilitate examination in this application.

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

All other inquiries concerning the examination or status of the application should be directed to Mickey Yu, the SPE of Art Unit 3728, 571-272-4562 and also accessible in the PAIR system at http://www.uspto.gov/ebc.index.html.

The application is being forwarded to the examiner for action on the merits commensurate with this decision. Telephone inquiries concerning this decision should be directed to Henry C. Yuen, at 571-272-4856.

/Henry C. Yuen/

_____

Henry C. Yuen, Special Programs Examiner
Technology Center 3700 – Mechanical Engineering,
Manufacturing and Products
571-272-4856

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**ABELMAN, FRAYNE & SCHWAB**
**666 THIRD AVENUE, 10TH FLOOR**
**NEW YORK NY 10017**

MAILED

APR 28 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Mohamed Radwan Rafaat Atassi | : | |
| Application No. 11/576,615 | : | DECISION ON PETITION |
| Filed: April 4, 2007 | : | |
| Attorney Docket No. 208,116 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 12, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed June 30, 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 October 1, 2008. A Notice of Abandonment was mailed January 8, 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 Amendment, (2) the petition fee of $810.00, and (3) an adequate statement of unintentional delay.

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

This application is being referred to Technology Center AU 3753 for appropriate action by the Examiner in the normal course of business on the reply received.

Joan Olszewski
Petitions Examiner
Office of Petitions

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www.uspto.gov

RONALD E. GREIGG
GREIGG & GREIGG P.L.L.C.
1423 POWHATAN STREET, UNIT ONE
ALEXANDRIA VA 22314

In re Application of:
SCHELHAS, PETER et al
Serial No. 11/576,640
Filed: Apr. 4, 2007
Docket: R.309523
Title: DEVICE FOR PUMPING FUEL

6/24/09

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition filed June 17, 2009 under 37 CFR 1.181 requesting withdrawal of the finality of the last Office action mailed March 17, 2009.

The petition is **granted.**

In finding petitioner's points of argument persuasive, the requested relief is granted. The finality of the last Office action mailed March 17, 2009 is hereby withdrawn. The examiner has been instructed to enter and consider the amendment and arguments filed on June 17, 2009 and issue an Office action fully answering all arguments presented by the applicant in his amendment of June 17, 2009.

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, Director
Technology Center 3700

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
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www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/576,671 | | Carlo Scianna | 920530-102334 | 4767 |

23644 7590 11/14/2007
BARNES & THORNBURG LLP
P.O. BOX 2786
CHICAGO, IL 60690-2786

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2821 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 11/14/2007 | 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):

patent-ch@btlaw.com

13 NOV 2007

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William M. Lee, Jr.,
BARNES & THORNBURG LLP
P.O. Box 2786
Chicago, IL 60690-2786

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Carlo Scianna | : | |
| Application No.: 11/576,671 | : | |
| PCT No.: PCT/US2005/017551 | : | |
| Int. Filing Date: 19 May 2005 | : | PETITION UNDER |
| Priority Date: 19 May 2004 | : | |
| Attorney's Docket No.: 920530-102334 | : | |
| For: DIMMING CIRCUIT LED... | : | |
| TRIAC IN CONDUCTION | : | 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 C.F.R. 1.137(b)," filed on 04 April 2007.

## BACKGROUND

On 19 May 2005, this international application was filed, claiming an earliest priority date of 19 May 2004.

The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 19 November 2006. This international application became abandoned with respect to the United States at midnight on 19 November 2006 for failure to pay the required basic national fee.

On 4 April 2007, applicant filed the instant petition under 37 CFR 1.137(b) and a Transmittal letter for entry into the national stage in the United States, which was accompanied by the basic national fee and the petition fee. However, no executed declaration was filed at such time.

## DISCUSSION

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

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

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

## DECISION

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

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

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

29 SEP 2008

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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

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| In re Application of | : | |
| HOIDAL, Dag et al. | : | |
| Application No.: 11/576,680 | : | DECISION |
| PCT No.: PCT/IB2006/000666 | : | |
| Int. Filing Date: 23 March 2006 | : | ON PETITION UNDER |
| Priority Date: 24 March 2005 | : | |
| Docket No.: MEISS98.002APC | : | 37 CFR 1.137(b) |
| For: CARRIER RACK FOR A BICYCLE | : | |

Applicant's Petition For Revival Under 37 CFR 1.137(b), filed in the above-captioned application on 31 July 2008 is **GRANTED**.

Applicant states that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," as required by 37 CFR 1.137(b)(3). The appropriate reply and petition fee have been submitted. A terminal disclaimer is not required as the application was filed on or after 08 June 1995. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

Applicant has furnished a declaration of the inventors in compliance with 37 CFR 1.497(a)-(b). The surcharge for furnishing the search fee, examination fee or oath or declaration after 30 months from the priority date has been paid.

This application is being forwarded to the National Stage Processing Branch of the Office of Patent Application Processing for further action consistent with this decision. The application has a 35 USC 371(c)(1), (c)(2) and (c)(4) date of 31 July 2008.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

0 8 AUG 2008

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2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

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| In re Application of | : | |
| Suzuki et al. | : | |
| Application No.: 11/576,686 | : | |
| PCT No.: PCT/JP2005/018368 | : | |
| Int. Filing Date: 04 October 2005 | : | DECISION |
| Priority Date: 06 October 2004 | : | |
| Attorney Docket No.: SHIGA3.019APC | : | |
| For: Process For Producing Ink Jet Recording Material | : | |

This is in response to the "Request For Correction..." filed on 13 April 2007, which is being treated as a petition under 37 CFR 1.182.

## BACKGROUND

International application PCT/JP2005/018368 was filed on 04 October 2005, claimed an earliest priority date of 06 October 2004, and designated the United States. The International Bureau transmitted a copy of the published international application to the USPTO on 13 April 2006. Consequently, the thirty month period for payment of the basic national fee in the United States expired as of midnight on 06 April 2007. On 04 April 2007, applicants filed *inter alia* a basic national fee in application 11/576,686.

## DISCUSSION

Petitioner states, in part, that "It has come to our attention that during the electronic submission of the above-referenced National Stage application, the incorrect International Application Number was entered into the EFS Web system. The Electronic Acknowledgement Receipt indicates the international Application No. as PCT/JP2005/018382. However, the correct International Application No. for the present application is PCT/JP2005/018368, as indicated in all of the written documents submitted in connection with the present application."

Inspection of the Electronic Acknowledgment Receipt dated 04 April 2007 confirms petitioner's statement that "PCT/JP05/18382" was entered into EFS-Web. Meanwhile, review of the remaining documents of record reveals that, e.g., the Preliminary Amendment and the Application Data Sheet filed on 04 April 2007 refer to PCT/JP2005/018368. This discrepancy rendered it unclear which international application was intended to enter the national stage under 35 U.S.C. 371; the instant petition under 37 CFR 1.182 is required to resolve the ambiguity. In view of the totality of the evidence of record, it would be appropriate to accept petitioner's statement that this application was intended to be the national stage of PCT/JP2005/018368.

Petitioner urges that "in light of the user's inability to double check PCT information initially provided to the EFS Web system, it is believed that no fee should be required for making this request, and respectfully request that any required fee be waived." In support of this request, petitioner describes features of the EFS-Web filing system which allegedly limit applicants' ability to audit and/or correct the data entered into EFS-Web. This argument, however, does not relieve applicant of the duty to exercise due care in the initial entry of the

relevant data. Therefore, this situation does not appear to warrant a waiver or refund of the petition fee. Accordingly, the $400.00 petition fee is being charged to Deposit Account No. 11-1410, as authorized in the petition.

## DECISION

The petition under 37 CFR 1.182 is **GRANTED** as described above.

This application is the U.S. national stage under 35 U.S.C. 371 of PCT/JP2005/018368.

This application is being returned to Technology Center 4172.

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

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DEMONT & BREYER, LLC
100 COMMONS WAY, Ste. 250
HOLMDEL NJ 07733

**MAILED**

JUN 09 2010

OFFICE OF PETITIONS

In re Application of

Chachra, et al.

Application No. 11/576,689

Filed: April 4, 2007

Attorney Docket No. **591-295US**

DECISION ON PETITION

This is a decision on the petition under 37 CFR §1.137(b), March 23, 2010, to revive the above-identified application.

The petition is **granted**.

This application became abandoned for failure to timely remit the issue fee of $1,510.00 and the publication fee of $300.00 as required by the Notice of Allowance and Issue Fee Due (the "Notice") mailed December 22, 2009. The Notice set forth a three (3) month statutory period for reply. No response was received within the allowable period. Accordingly, this application became abandoned on March 23, 2010.

The issue fee and publication fee were received on March 23, 2010.

The application is being forwarded to the Office of Data Management for further processing.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

22 OCT 2007

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342 LAMBTON QUAY
WELLINGTON NZ
NEW ZEALAND

| | | |
|---|---|---|
| In re Application of | : | |
| CAMPBELL, Wayne, Mason, et al. | : | |
| Application No.: 11/576,690 | : | DECISION |
| PCT No.: PCT/NZ2005/000259 | : | |
| Int. Filing Date: 10 October 2005 | : | ON REQUEST UNDER |
| Priority Date: 08 October 2004 | : | |
| Attorney's Docket No.: CDH 505625USPR | : | 37 CFR 1.497(d) |
| For: BETA-SUBSTITUTES PORPHYRINS | : | |

This decision is in response to applicant's request under 37 CFR 1.48(a), filed in the United States Patent and Trademark Office on 09 August 2007. The request has been treated as a request under 37 CFR 1.497(d).

## BACKGROUND

On 10 October 2005, applicant filed international application PCT/NZ2005/000259, claiming a priority date of 08 October 2004. A copy of the international application was transmitted to the Office by the International Bureau on 13 April 2006. The deadline for entry into the national stage in the United States was midnight on 08 April 2007.

On 04 April 2007, applicant filed a submission for entry into the national stage in the United States, accompanied by, *inter alia*, the U.S. Basic National Fee.

On 12 June 2007, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration and the surcharge for late filing of the search fee, examination fee or the oath or declaration were required. The Notification set a two month period for response.

On 09 August 2007, applicants filed this request, accompanied by a declaration of the inventors and a credit card authorization.

## DISCUSSION

Applicant's credit card was declined. Applicant has not yet paid the surcharge for late filing of the search fee, examination fee or the oath or declaration and has not paid the petition fee in connection with this request. This request will not be treated on the merits until the petition fee is paid.

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.

However, while this request is not being treated on the merits, a couple points were noted.

The declaration of the inventors is defective. While it is acceptable for inventors to execute separate copies of the declaration. The complete copy of the declaration as executed by the inventor must be submitted. Here applicants have submitted one page 1 and 2 and two pages 3. Each page 3 lists the same inventors, but were separately executed. This indicates that at least two copies of the declaration were executed. It is unacceptable to piece together pages from separately executed declarations to create a single composite declaration.

Applicant has not indicated whether this application was assigned, but it is noted that the international application lists an applicant other than the inventors for every other country. If the US patent rights have not been assigned, applicants must affirmatively state such. If the application has been assigned, the consent of the assignee has not been furnished and a copy of the assignment has not been recorded with the USPTO. 37 CFR 3.73

## CONCLUSION

For the above reasons, applicant's 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)". Extensions of time are available under 37 CFR 1.136(a).

A response to this decision can be filed electronically or mailed 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.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

16 JUN 2008

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WELLINGTON NZ
NEW ZEALAND

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|---|---|---|
| In re Application of | : | |
| CAMPBELL, Wayne, Mason, et al. | : | |
| Application No.: 11/576,690 | : | DECISION |
| PCT No.: PCT/NZ2005/000259 | : | |
| Int. Filing Date: 10 October 2005 | : | ON REQUEST UNDER |
| Priority Date: 08 October 2004 | : | |
| Attorney's Docket No.: CDH 505625USPR | : | 37 CFR 1.497(d) |
| For: BETA-SUBSTITUTES PORPHYRINS | : | |

This decision is in response to applicant's renewed request under 37 CFR 1.497(d), filed in the United States Patent and Trademark Office on 21 April 2008 and 22 April 2008.

## BACKGROUND

On 22 October 2007, the Office mailed Decision On Request Under 37 CFR 1.497(d), refusing applicants' request and setting a two month period for reply.

On 21 April 2008, applicants filed this renewed request and submitted an additional declaration on 22 April 2008.

## DISCUSSION

Applicants renew their request to add Michael Graetzal and Md. Khaja Nazeerudding as inventors.

A request under 37 CFR 1.497(d) requires: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in §1.17(i); and (3) the written consent of the assignee, if an original named inventor has executed an assignment.

Items (1), (2) and (3) have been satisfied. Applicants have provided the statements from the inventors being added. Applicants have provided the processing fee. Applicants state that the application has not been assigned.

## CONCLUSION

For the above reasons, applicant's request under 37 CFR 1.497(d) is **GRANTED**.

This application is being referred to the National Stage Processing Branch of PCT Operations for further action consistent with this decision. The application has a 35 USC 371(c)(1), (c)(2) and (c)(4) date of 22 April 2008.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

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

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**MORGAN & FINNEGAN TRANSITION TEAM**
**C/O LOCKE LORD BISSELL & LIDDELL**
**3 WORLD FINANCIAL CENTER**
**NEW YORK NY 10281-2101**

MAILED

MAY 25 2010

OFFICE OF PETITIONS

In re Application of :
Ariane Touati et al :
Application No. 11/576,760 : DECISION ON PETITION
Filed: April 5, 2007 :
Attorney Docket No. 4953-0006 :

This is a decision on the petition, filed January 4, 2010, under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to reply to the final rejection Office action mailed March 18, 2009, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed on November 19, 2009.

Petitioner asserts that the Office action dated March 18, 2009 was not received.

A review of the written record indicates that the Office received a Revocation of Power of Attorney on December 29, 2008, prior to the mailing of the Office action of March 18, 2009. It is noted that the Revocation of Power of Attorney submitted on December 29, 2008, is not acceptable because the person signing the Power provided no statement that the Merigeault Shona was authorized to act on behalf of the assignee. A Statement Under 37 CFR 3.73(b) authorizing Amold I, Rady to act on behalf of the assignee was provided. However, applicants were not notified that the Revocation of Power of Attorney submitted on December 29, 2008 and resubmitted on January 4, 2010 was not proper. Accordingly, the Notice of Abandonment mailed November 19, 2009 is hereby vacated and the holding of abandonment withdrawn.

**Petitioner is encouraged to submit an appropriate power of attorney identifying the desired Customer Number. A courtesy copy of this decision is being mailed to the person signing the instant petition**

This application is being referred to the Technology Center technical support staff of Art Unit 1796 for remailing the Office action of March 18, 2009 and resetting the period for reply.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

cc:

**LERNER, DAVID, LITTENBERG,**
**KRUMHOLZ & MENTLIK**
**600 SOUTH AVENUE WEST**
**WESTFIELD, NJ 07090**

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SHARP KABUSHIKI KAISHA
C/O KEATING & BENNETT, LLP
1800 Alexander Bell Drive
SUITE 200
Reston, VA 20191

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Keiichi Ina | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7605885 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/20/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/576,771 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 11/29/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **159** 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.

12 JUN 2008

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CARGILL & ASSOCIATES, P.L.L.C.
56 MACOMB PLACE
MT. CLEMENS, MI 48043

In re Application of SMARSH et al :
U.S. Application No.: 11/576,788 :
PCT Application No.: PCT/US2005/031877 :
Int. Filing Date: 08 September 2005 : DECISION
Priority Date Claimed: 08 September 2004 :
Attorney Docket No.: TruTech P-306 :
For: AUTOMATED INSPECTION :
COMPARATOR/SHADOWGRAPH :
SYSTEM

This is in response to applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 18 April 2008.

## BACKGROUND

On 08 September 2005, applicant filed international application PCT/US2005/031877, which claimed priority of an earlier United States application filed 08 September 2004. The thirty-month period for paying the basic national fee in the United States expired on 08 March 2007.

International application PCT/US2005/031877 became abandoned as to the United States for failure to timely pay the basic national fee.

On 05 April 2007 applicant submitted the requisite basic national fee.

On 18 April 2008, applicant filed the present petition under 37 CFR 1.137(b).

## DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire

delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

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

With regard to item (3), applicant has provided the required statement.

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

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 08 September 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 05 April 2007.

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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GIFFORD, KRASS, SPRINKLE,ANDERSON & CITKOWSKI, P.C
PO BOX 7021
TROY, MI 48007-7021

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Hartmut S. Engel | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7607795 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/27/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/576,796 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/05/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **230** 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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31 JUL 2007

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1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

In re Application of :
RYTSCHKOW (deceased) et al. :
Serial No.: 11/576,803 :
PCT No.: PCT/CZ05/00042 :
Int. Filing Date: 25 May 2005 : DECISION ON
Priority Date: 06 October 2004 :
Atty. Docket No.: P/3751-7 V3436 :DECLARATION
For: METHOD FOR PURIFYING LIQUIDS BY USING:
IONIZED AERATION :

This is in response to applicant's Submission on Declaration was filed in the United States Patent and Trademark Office on 26 June 2007.

Status Under 37 CFR 1.42

37 CFR § 1.42 requires that in the case of the death of the inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent.

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

**DISCUSSION**

The published international application PCT/CZ05/00042 listed the deceased inventor as Wiadislav Rytschkow and the heiress of the deceased inventor as Svetlana Rytschkowa. The others inventors listed on the published international application were: Oleg Lysytchuk, Miroslav Spurny and Jaroslav Hegr.

The executed declaration identifies the inventors as Wladislav Rytschkow, Oleg Lysytchuk and Miroslave Spruny. The declaration does not identify the heir(s) of the deceased

inventor or inventor Jaroslav Hegr.

The execution for deceased inventor does not meet the requirements of 37 CFR 1.497(b). Although the declaration identifies Wladislav Rytschkow (deceased), it does not identify the heir(s) of deceased inventor. It is unclear who executed the declaration on behalf of the deceased inventor. The declaration is also defective because it does not state the country of citizenship, residency and mailing address for *both* the deceased inventor and all of the legal representative/heirs, to meet the requirements for compliance with 37 CFR 1.497.

Moreover, it is unclear whether the only heir is Svetlana Rytschkowa. If she is not the only heir, the declaration must be executed by all of the heirs of the deceased inventor. It is also unclear whether a legal representative of the deceased's estate has been appointed or is statutorily required to be appointed. (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.)

In situations where it is not clear that the declaration includes the signatures of all the heirs (e.g., indicates heir/heirs as opposed to sole heir/all heirs), the Office requires a statement by either those signing or the attorney which sets forth that they are in fact all the heirs of the deceased inventor. The statement must also set forth that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed.

Furthermore, the declaration does not the fourth inventor Jaroslav Hegr. A newly executed declaration is required as the declaration does not properly identify all of the inventors and their respective citizenship, mailing address and residency.

While it is acceptable for applicants to execute separate copies of the declaration, the entire declaration, as executed by the inventor (or heiress), must be submitted. "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." See MPEP 201.03. What is required is one declaration where all inventors have signed or separate complete declarations. The requirements of 37 CFR 1.497 (a) and (b) have not been met and the declaration is unacceptable as filed.

Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42. The declaration is unacceptable under 37 CFR 1.497 (a) and (b).

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **DISMISSED WITHOUT PREJUDICE.**

Applicant is required to submit a statement by either those signing or the attorney which sets forth that they are in fact all the heirs of the deceased inventor. Such statement must also set forth that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed.

What is required is a newly executed declaration, in accord with the requirements of 37 CFR 1.497(a) and (b), where all inventors have signed or separate complete declarations.

Applicant must respond within **TWO (2) MONTHS** from the mail date of this decision. 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.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

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27 MAR 2008

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Alexandria, VA 22313-1450
www.uspto.gov

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

In re Application of :
RYTSCHKOW (deceased) et al. :
Serial No.: 11/576,803 :
PCT No.: PCT/CZ05/00042 :
Int. Filing Date: 25 May 2005 : DECISION ON
Priority Date: 06 October 2004 :
Atty. Docket No.: P/3751-7 V3436 :DECLARATION
For: METHOD FOR PURIFYING LIQUIDS BY USING:
IONIZED AERATION :

This is in response to applicant's "Response to Decision on Petition" was filed in the United States Patent and Trademark Office on 31 January 2008. Applicant requests a four month extension of time, which is granted.

## BACKGROUND

On 26 June 2007, applicant filed a declaration executed by two of the four inventors named in the international application. The declaration failed to identify the fourth inventor and was executed by an apparent heir to a deceased inventor, as identified in the published international application.

On 31 July2007, a decision was mailed to applicant indicating that the declaration was unacceptable as executed and that a new declaration was required.

On 31 January 2008, applicant filed a response along with a four month extension of time. Applicant did not file a newly executed declaration.

## DISCUSSION

In response to the 31 July 2007 decision, a "Declaration of Applicants to Delete An Inventor" was submitted to delete the fourth inventor, Jaroslav Hegr. To delete an inventor, applicant must submit a petition under 37 CFR 1.497(d), which states:

> If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application,.... and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:
>
> (1)A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application

occurred without deceptive intention on his or her part;

(2)The processing fee set forth in § 1.17(i); and

(3)If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and

(4)Any new oath or declaration required by paragraph (f) of this section.

Here, the inventor who wishes to be deleted, Jaroslav Hegr, must submit a statement which states "that any error in inventorship in the international application occurred without deceptive intention on his part." Furthermore, a processing fee is required and the written consent of the assignee is required. As discussed below, a new declaration, which is in compliance with 37 CFR 1.497(b) is also required; that is, Svetlana Rytschkowa, must execute a new declaration. The declaration must identify allthe inventors, stating their citizenship, residency and mailing address. The declaration must also state the heiress' citizenship, residency and mailing address and must identify Ms. Rytschkowa as the heiress for deceased inventor, Wladislav Rytschkow.

Status Under 37 CFR 1.42

37 CFR § 1.42 requires that in the case of the death of the inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent.

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

The executed declaration submitted on 26 June 2007, identified the inventors as Wladislav Rytschkow, Oleg Lysytchuk and Miroslave Spruny. The declaration did not identify the heir(s) of the deceased inventor. This declaration is unacceptable with regard to the deceased inventor and his heir.

The execution of the declaration for deceased inventor does not meet the requirements of 37 CFR 1.497(b). Although the declaration identifies Wladislav Rytschkow (deceased), it does not identify Svetlana Rytschkowa as the heir of deceased inventor. The declaration is also defective because it does not state the country of citizenship, residency and mailing address for *both* the deceased inventor and the heir, to meet the requirements for compliance with 37 CFR 1.497.

As previously stated, it is unclear whether the only heir is Svetlana Rytschkowa. If she is not the only heir, the declaration must be executed by all of the heirs of the deceased inventor. It is also unclear whether a legal representative of the deceased's estate has been appointed or is statutorily required to be appointed. (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.)

In situations where it is not clear that the declaration includes the signatures of all the

heirs (e.g., indicates heir/heirs as opposed to sole heir/all heirs), the Office requires a statement by either those signing or the attorney which sets forth that they are in fact all the heirs of the deceased inventor. The statement must also set forth that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed.

The requirements of 37 CFR 1.497 (a) and (b) have not been met and the declaration is unacceptable as filed. Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42. The declaration is unacceptable under 37 CFR 1.497 (a) and (b).

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 and 37 CFR 1.497(d) is **DISMISSED WITHOUT PREJUDICE.**

Applicant is required to submit a statement by either those signing or the attorney which sets forth that they are in fact all the heirs of the deceased inventor. Such statement must also set forth that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed.

What is required is a newly executed declaration, in accord with the requirements of 37 CFR 1.497(a) and (b), where the heir of the deceased inventor has signed in accord with this decision.

Applicant must respond within **TWO (2) MONTHS** from the mail date of this decision. 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.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

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

25 SEP 2008

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Alexandria, VA 22313-1450
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OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

In re Application of :
RYTSCHKOW (deceased) et al. :
Serial No.: 11/576,803 :
PCT No.: PCT/CZ05/00042 :
Int. Filing Date: 25 May 2005 : DECISION ON
Priority Date: 06 October 2004 :
Atty. Docket No.: P/3751-7 V3436 :DECLARATION
For: METHOD FOR PURIFYING LIQUIDS BY USING:
IONIZED AERATION :

This is in response to applicant's "Response to Decision on Petition" was filed in the United States Patent and Trademark Office on 22 July 2008. Applicant requests a two month extension of time, which is granted.

## BACKGROUND

On 26 June 2007, applicant filed a declaration executed by two of the four inventors named in the international application. The declaration failed to identify the fourth inventor and was executed by an apparent heir to a deceased inventor, as identified in the published international application.

On 31 July 2007, a decision was mailed to applicant indicating that the declaration was unacceptable as executed and that a new declaration was required.

On 31 January 2008, applicant filed a response along with a four month extension of time. Applicant did not file a newly executed declaration.

On 27 March 2008, a decision dismissing the petition was mailed indicating that a petition under 37 CFR 1.497(d) to delete inventor Hegr was required and that the declaration did not fulfil the requirements of 37 CFR 1.42.

## DISCUSSION

Under 37 CFR 1.497(d), where 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,.... and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

(1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application

occurred without deceptive intention on his or her part;

(2) The processing fee set forth in § 1.17(i); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and

(4) Any new oath or declaration required by paragraph (f) of this section.

Here, Jaroslav Hegr the inventor who wishes to be deleted, submitted a statement which states "that the error in inventorship in the international application occurred without deceptive intention." Furthermore, a processing fee was paid and the written consent of the assignee was provided. The petition to delete inventor Hegr is granted.

Status Under 37 CFR 1.42

37 CFR 1.497(a)(3) requires that the declaration identify each inventor and the country of citizenship of each inventor. 37 CFR 1.497(b)(2) requires the declaration to state the relationship of the person (under 37 CFR 1.42) making the declaration for a deceased inventor. 37 CFR 1.497(b)(2) further states that, if the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration must state that the person is a legal representative and indicate the citizenship, residency and mailing address of the legal representative. The declaration must also state the citizenship, residency and last mailing address of the deceased inventor to comply with 37 CFR 1.497(a)(3).

A new declaration, which is in compliance with 37 CFR 1.497(b) was submitted., which was executed by Svetlana Rytschkowa, the heiress of deceased inventor Wladislav Rytschkowa. The declaration identifies the citizenship, residency and mailing address of all inventors and Ms. Rytschkowa, as the sole the heiress for deceased inventor, Wladislav Rytschkow. Counsel of record indicates that Ms. Rytschkowa is the sole heir to deceased inventor Wladislav Rytschkow and that no legal representative has been or is required to be appointed.

The requirements of 37 CFR 1.497 (a) and (b) have now been met and the declaration is acceptable as filed. Accordingly, it is appropriate, at this time, to accord the application status under 37 CFR 1.42. The declaration is acceptable under 37 CFR 1.497 (a) and (b).

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **GRANTED**. The petition under 37 CFR 1.497(d) to delete inventor JAROSLAV HEGR under 37 CFR 1.497(d) 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 July 2008.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Telephone: 571-272-3286
Facsimile: 571-273-0459

3 1 JUL 2008

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

In re Application of :
Sawada et al. :
Application No.: 11/576,846 :
PCT No.: PCT/JP2005/18458 :
Int. Filing Date: 05 October 2005 : DECISION
Priority Date: 07 October 2004 :
Attorney Docket No.: 306565US8PCT :
For: Server :

This is in response to the petition under 37 CFR 1.182 filed on 26 September 2007.

## DISCUSSION

This international application was filed on 05 October 2005 and claimed a priority date of 07 October 2004. The United States was designated. The International Bureau transmitted a copy of the published international application to the USPTO on 13 April 2006. The thirty month period for payment of the basic national fee in the United States expired as of midnight on 07 April 2007. On 06 April 2007, applicants filed *inter alia* the basic national fee.

## DISCUSSION

Inspection of the declaration of the inventors filed on 26 September 2007 reveals that it nominates "Junko Izawa" in place of "ARAI, Junko" nominated in the published international application. In that this is clearly more than a mere typographic error or phonetic misspelling of applicant's name, a proper petition under 37 CFR 1.182 is required to resolve the discrepancy in the nominated inventive entity in order for the declaration to be accepted. *See* MPEP §§ 605.04(b) and 605.04(c).

Applicants have filed a petition under 37 CFR 1.182 addressing this discrepancy in the inventor's name. Petitioner indicates that the discrepancy arose "due to her marriage which occurred subsequent to the filing of the International application." Petitioner provides a "Declaration of Junko IZAWA," signed by the inventor in both names, attesting to this change. In view of the totality of the evidence of record, it would be appropriate to accept the name as "Junko Izawa" on the executed declaration.

## DECISION

The petition under 37 CFR 1.182 is **GRANTED**, as described above.

This application is being forwarded to the Office of Patent Application Processing for further processing. The declaration filed on 26 September 2007 is **ACCEPTED** for purposes of compliance with 37 CFR 1.497(a) and (b) and 35 U.S.C. 371(c)(4).

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

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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27 MAR 2009

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

In re Application of Henrik Nilsson et al :
U.S. Application No.: 11/576,871 :
PCT Application No.: PCT/DK2005/000648 : DECISION
Int. Filing Date: 07 October 2005 :
Priority Date Claimed: 08 October 2004 :
Attorney Docket No.: 20517/0206491-US0 :
For: CONTROLLED RELEASE :
PHARMACEUTICAL COMPOSITIONS
COMPRISING A FUMARIC ACID ESTER

This is in response to the declaration filed 08 January 2008, which is being treated as a request for status under 37 CFR 1.42.

## BACKGROUND

On 07 October 2005, applicant filed international application , which claimed priority of an earlier Denmark application PCT/DK2005/000648, filed 08 October 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 07 October 2005. The thirty-month period for paying the basic national fee in the United States expired on 08 April 2007.

On 06 April 2007, 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 09 November 2007, the DO/EO/US mailed a Notice of Missing Requirements (Form PCT/DO/EO 905) which indicated an Oath or Declaration of an inventors in compliance with 37 CFR 1.497 (a) and (b), and among other things are required.

On 08 January 2008, applicant filed the present response which is treated as a request for status under 37 CFR 1.42.

## DISCUSSION

37 CFR 1.42 provides, "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent."

Effective 07 November 2000, 37 CFR 1.497(b)(2) specifies that, where a person making the declaration is the legal representative of a deceased inventor, the declaration shall state the following: (1) the relationship of the person to the inventor, (2) the facts the inventor would have been required to state, upon information and belief, (3) that the person is the legal representative of the deceased inventor, and (4) the citizenship, residence, and mailing address of the legal representative.

The declaration filed on 08 January 2008 contains non-initialed and non-dated alterations (in particular, with respect to the second inventor) and is therefore unacceptable. See 37 CFR 1.42(c) and MPEP 602.01.

## CONCLUSION

For the reasons above, the request for status under 37 CFR 1.42 is DISMISSED without prejudice.

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

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 Cole
PCT Legal Examiner
PCT Legal Office

Telephone: 571-272-3281

Cathy Lam
PCT Legal Administration Detailee

Telephone : 571-272-6095

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P.O BOX 1450
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P.O. Box 770
Church Street Station
New York, NY 10008-0770

| | | |
|---|---|---|
| In re Application of | : | DECISION ON RENEWED |
| Nilsson et al | : | |
| Application No.: 11/576,871 | : | |
| PCT No.: PCT/DK05/000648 | : | |
| Int. Filing Date: 07 October 2005 | : | PAPERS FILED |
| Priority Date: 08 October 2004 | : | |
| Attorney's Docket No.: 20517/0206491-US0 | : | |
| For: CONTROLLED RELEASE... | : | |
| ACID ESTER | : | UNDER 37 CFR 1.42 |
| | : | |

This is a decision on the "REQUEST FOR RECONSIDERATION" which is being treated Renewed Request Under 37 CFR 1.42," filed on 27 May 2008.

## BACKGROUND

In a decision from this office dated 27 March 2008, the papers filed on 08 January 2008 were not accepted under 37 CFR 1.42.

On 27 May 2008, applicants submitted the renewed submission under 37 C.F.R. §1.42.

## DISCUSSION

Applicants indicate that the second inventor's alterations on the Declaration has been initialed and dated on May 23, 2008. Any alternation or initialed 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.

Also, the declaration is unacceptable because it is not clear that Bonna Robinson is the sole heir or just the legal representative for the deceased inventor, Joseph R. ROBINSON. (see MPEP § 409.01(a)).

That is, there may be other heirs who are required to also sign the declaration. The declaration must indicate that he is the sole heir for the deceased inventor or is the legal representative (not including the term heir next to it so as to avoid confusion) for the deceased inventor, Joseph R. ROBINSON, to accept the application under 37 CFR 1.42.

## CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **not accepted**.

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. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.42." Extensions of time are available under 37 CFR 1.136(a).

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

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3276
Fax: (571) 273-0459

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14 AUG 2009

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P.O. Box 770
Church Street Station
New York, NY 10008-0770

| | | |
|---|---|---|
| In re Application of | : | DECISION ON RENEWED |
| Nilsson et al | : | |
| Application No.: 11/576,871 | : | |
| PCT No.: PCT/DK05/000648 | : | |
| Int. Filing Date: 07 October 2005 | : | PAPERS FILED |
| Priority Date: 08 October 2004 | : | |
| Attorney's Docket No.: 20517/0206491-US0 | : | |
| For: CONTROLLED RELEASE... | : | |
| ACID ESTER | : | UNDER 37 CFR 1.42 |
| | : | |

This is a decision on the "RENEWED REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.42" filed 30 January 2009.

## BACKGROUND

In a decision from this office dated 03 December 2008, the papers filed on 27 May 2008 were not accepted under 37 CFR 1.42. The reason was that it was not clear if Bonna Robinson was the sole heir of the deceased inventor, Joseph R. ROBINSON.

On 30 January 2009, applicants submitted the renewed submission under 37 C.F.R. §1.42.

## DISCUSSION

Applicants have provided a proper supplemental declaration, which sets forth that Bonna Robinson is in fact the sole heir of the deceased inventor Joseph R. ROBINSON. Also, the supplemental declaration has no alteration on it with respect to the inventor Florian Schoenharting.

Accordingly, the requirements under 37 CFR 1.42 are satisfied and the declaration is acceptable at this time.

If she is executing the declaration as the sole heir of the deceased inventor then it is hereby construed as an indication that no legal representative of the deceased's estate has been appointed or is statutorily required to be appointed. If this interpretation is incorrect applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative(s) of the deceased inventor in response to this decision.

## CONCLUSION

The renewed submission filed under 37 CFR 1.42 is **ACCEPTED**.

The application is being returned to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this decision. The 35 U.S.C.§ 371(c)(1), (c)(2), and (c)(4) date of this application as **30 January 2009**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (571) 272-3276
Fax: (571) 273-0459

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

TYCO HEALTHCARE - EDWARD S. JARMOLOWICZ
15 HAMPSHIRE STREET
MANSFIELD MA 02048

In re Application of
MABUCHI et al.
Application No.: 11/576,873
PCT No.: PCT/EP05/10774
Int. Filing Date: 06 October 2005
Priority Date: 06 October 2004
Atty Docket No.:H-KN-00187(US)TYCK 0187.1
For: ORGAN FIXING EQUIPMENT AND ORGAN FIXING EQUIPMENT SET

DECISION ON

under 37 CFR 1.497(d)

This is a decision on applicant's' "Petition to Correct Inventorship of a Patent under 37 CFR 1.48(a)", filed on 03 July 2008 in the United States Patent and Trademark Office (USPTO), requesting acceptance of the declaration in the above reference application.

## BACKGROUND

On 11 June 2007, 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, were required.

On 10 July 2007, applicant filed a response along with an executed declaration.

On 03 July 2008, applicant filed a "Petition to Correct Inventorship of a Patent under 37 CFR 1.48(a)", treated as a petition under 37 CFR 1.497(d), along with an executed declaration.

## DISCUSSION

At the outset, it is noted that 37 CFR 1.48(a) is directed to non-provisional applications. A national stage application is not considered a non-provisional application until the requirements of 35 U.S.C. 371 are complete. Thus, a petition under 37 CFR 1.48(a) does not apply to the instant application at this time. Such request to correct inventorship is treated as a petition under 37 CFR 1.497(d), to correct an inventive entity if different from the inventive entity identified in the international application.

Hitoshi Mabuchi and Norifumi Fujiwara were named as inventors in the published international application PCT/EP05/10774. The declaration submitted with the petition identified Hitoshi Mabuchi and Shigeaki Funamura as co-inventors and thus was not in compliance with 37 CFR 1.497(a) and (b).

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s) (See 37 CFR 3.73(b)).

Applicant satisfied Items (1) and (2) above. With regard to Item (3), it appears from the USPTO records that an assignment of the application has occurred; however, the Written Consent of the assignee consenting to the addition of Shigeaki Funamura and deletion of Norifumi Fujiwara as inventors in this application to correct the inventorship under 37 CFR 1.497(d)(3) was not provided. Item (3) above is not yet satisfied.

Accordingly, applicant has not met all of the requirements to add Shigeaki Funamura as co-inventor and to delete Norifumi Fujiwara in the above-identified international application. The petition under 37 CFR 1.497(d) is hereby dismissed.

## CONCLUSION

The petition under 37 CFR 1.1497(d) to Correct Inventor's Names in the above-captioned application is **DISMISSED WITHOUT PREJUDICE.** The written consent of the assignee to add Shigeaki Funamura and to delete Norifumi Fujiwara as co-inventor in the above-identified international application is required.

Any reconsideration on the merits of the renewed petition under 37 CFR §1.497(d) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.497(d)." No petition fee is required.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

05 DEC 2008

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TYCO HEALTHCARE - EDWARD S. JARMOLOWICZ
15 HAMPSHIRE STREET
MANSFIELD MA 02048

| | |
|---|---|
| In re Application of | : |
| MABUCHI et al. | : |
| Application No.: 11/576,873 | : |
| PCT No.: PCT/EP05/10774 | : DECISION ON |
| Int. Filing Date: 06 October 2005 | : |
| Priority Date: 06 October 2004 | : RENEWED PETITION |
| Atty Docket No.:H-KN-00187(US)TYCK 0187.1 | : |
| For: ORGAN FIXING EQUIPMENT AND ORGAN FIXING EQUIPMENT SET | :under 37 CFR 1.497(d) |

This is a decision on applicant's "Renewed Petition under 37 CFR 1.497(d)", filed on 30 October 2008 in the United States Patent and Trademark Office (USPTO), requesting acceptance of the declaration in the above reference application.

## BACKGROUND

On 11 June 2007, 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, were required.

On 10 July 2007, applicant filed a response along with an executed declaration.

On 03 July 2008, applicant filed a "Petition to Correct Inventorship of a Patent under 37 CFR 1.48(a)", treated as a petition under 37 CFR 1.497(d), along with an executed declaration.

On 08 September 2008, a decision dismissing the petition was mailed indicating that applicant had not provided the written consent of the assignee. On 30 October 2008, applicant filed the instant renewed petition.

## DISCUSSION

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any error in inventorship occurred without deceptive intention on his or her part; (2) the fee set forth in § 1.17(i); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s) (See 37 CFR 3.73(b)).

Applicant previously satisfied Items (1) and (2) above. With regard to Item (3), the

Written Consent of the assignee consenting to the addition of Shigeaki Funamura and deletion of Norifumi Fujiwara as inventors in this application to correct the inventorship under 37 CFR 1.497(d)(3) is now provided. Item (3) above is satisfied.

Accordingly, applicant has met all of the requirements to add Shigeaki Funamura as co-inventor and to delete Norifumi Fujiwara in the above-identified international application. The petition under 37 CFR 1.497(d) is hereby granted.

## CONCLUSION

The renewed petition under 37 CFR 1.497(d) to add Shigeaki Funamura as co-inventor and to delete Norifumi Fujiwara in the above-captioned application is **GRANTED.**

The declaration submitted on 03 July 2008 and executed by Hitoshi Mabuchi and Shigeaki Funamura is acceptable and in compliance with 37 CFR 1.497(a) and (b).

The application will be forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date is **03 July 2008.**

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

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

0 9 JUL 2007

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KURT F. JAMES
SENNIGER POWERS
ONE METROPOLITAN SQUARE
16TH FLOOR
ST. LOUIS, MISSOURI 63102

In re Application of
SUSAMI MIYASAKA
Application No.: 11/576,876
PCT Application No.: PCT/EP05/10773
Int'l Filing Date: 06 October 2005
Priority Date: 06 October 2004
Attorney Docket No.: H-KN-00186(US)
For: CONNECTION STRUCTURE OF TRANSFUSION LINE, AND CONNECTOR HAVING CONNECTION STRUCTURE

DECISION ON PETITION

under 37 CFR 1.182

This is a decision on applicant's "Petition under 37 CFR 1.182 to Correct Electronic Acknowledgment Receipt" filed in the United States Patent and Trademark Office on 14 April and 25 April 2007. Applicant, in effect, requests correction of the PCT application number in the national stage application papers filed in the United States Patent and Trademark Office on 06 April 2007. The $400 petition fee has been charged to applicant's deposit account per his authorization.

On 14 April and 25 April 2007, applicant filed the instant petition under 37 CFR 1.182 to correct the international application number in the U.S. national stage application to PCT/**EP**05/10773. Applicant filed the U.S. national stage papers originally on 06 April 2007, which incorrectly referenced PCT/**2005**/10773. However, the Application Data Sheet was filed referencing PCT/EP2005/10773.

Applicant's petition under 37 CFR 1.182 to correct the international application no. to PCT/EP05/10773 on the national stage papers filed on 06 April 2007 is **GRANTED**.

This application is being returned to the National Stage Processing Branch of the Office Of PCT Operations for processing in accord with this decision, including correcting USPTO records so as to identify the present application as a national stage of PCT/EP05/10773.

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

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

RECEIVED
25 APR 2007
Legal Staff
International Division

Law Offices of

SENNIGER POWERS

One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102

Telephone (314) 231-5400
Facsimile (314) 231-4342

**FACSIMILE TRANSMITTAL COVER SHEET**

**DATE:** 4/25/07 **FILE NUMBER:** H-KN-00186(US) / TYCK 0186.1
**PTO FACSIMILE NUMBER:** 571-273-0459

**PLEASE DELIVER THIS FACSIMILE TO:** Cynthia Kratz
**THIS FACSIMILE IS BEING SENT BY:** Kurt F. James
**NUMBER OF PAGES:** 4 **INCLUDING COVER SHEET**

**TIME SENT:** 10:05 Am **OPERATOR'S NAME** Debra Staas

**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Debra S. Staas
Typed or printed name of person signing certification

/Debra S. Staas/ April 25, 2007
Signature Date

**Type of paper transmitted:** Petition Under 37 CFR 1.182 to Correct Electronic Acknowledgement Receipt

**Applicant's Name:** Susumi Miyasaka

**Serial No.:** 11/576,876 **Examiner:** TBA

**Filing Date:** 04/06/07 **Art Unit:** _____ **Confirmation No.:** 6745

**Application Title:** Connection Structure of a Transfusion Line

**IF YOU DO NOT RECEIVE ALL PAGES CLEARLY, CALL BACK AS SOON AS POSSIBLE. CONFIRMING NUMBER IS (314) 231-5400.**

H-KN-00186(US)
TYCK 0186.1

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

Application of: Susumi Miyasaka
Serial No.: 11/576,876
Filed: April 6, 2007
Confirmation No.: 6745
For: CONNECTION STRUCTURE OF A TRANSFUSION LINE

ATTENTION: Cynthia Kratz

April 25 2007

**PETITION UNDER 37 CFR 1.182 TO CORRECT ELECTRONIC ACKNOWLEDGEMENT RECEIPT**

1. Statement of the Facts

On April 13, 2007, the above-identified patent application by electronic filing. The filing was a nationalization of PCT/EP2005/010773. All papers filed with the Patent and Trademark Office referencing the PCT application number show the correct application number of the PCT application. This includes particularly the Application Data Sheet.

When the application was filed, the electronic filing system asks for the PCT application number separately from the Application Data Sheet. When the application number was entered, the letters "EP" were inadvertently left out of the PCT application number. Apparently as a result of this, the Electronic Acknowledgement of Filing repeated the application number without the letters "EP". The undersigned has been advised that the application has been held back from entry into PALM because of this error.

CONCLUSION

The correct PCT application number of the present application is readily apparent from the documents filed with the case, and specifically from the Application Data Sheet. Accordingly, applicant requests that number be corrected where ever incorrectly entered in the United States Patent and Trademark Office, including specifically the Electronic Acknowledgement of Filing, and that the application be entered in PALM and where ever necessary to undertake the regular examination of this application.

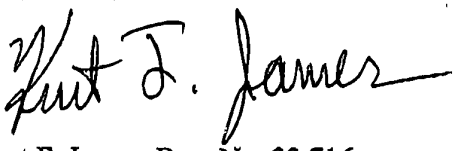
H-KN-00186(US)
TYCK 0186.1

The undersigned is not aware of a particular rule that covers the current situation. The typographical error that occurred is regretted. However, it appears that the correct PCT number could have been readily ascertained by the Patent and Trademark Office to correct the error without the necessity of filing a petition. An error in the ADS can be fixed by filing a substitute ADS. Accordingly, waiver of the petition fee is requested under 1.183.

Please charge the $400 petition fee and any other fees which may be necessary to Deposit Account 19-1345.

In view of the foregoing, the Patent Owner requests that this Petition be granted.

Respectfully submitted,



Kurt F. James, Reg. No. 33,716
SENNIGER POWERS
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

KFJ/dss

# FEE TRANSMITTAL

Application Number 11/576,876 Art Unit
Filing Date April 6, 2007 Confirmation No. 6745
Inventor(s) Susumi Miysaka
Examiner Name TBA
Attorney Docket Number H-KN-00186(US) / TYCK 0186.1

☐ Applicant claims small entity status.

## METHOD OF PAYMENT

☒ The Commissioner is hereby authorized to charge the indicated fees to Deposit Account No. 19-1345. The Commissioner is hereby authorized to charge any under payment or credit any over payment to Deposit Account No. 19-1345.

☐ Check Enclosed. The Commissioner is hereby authorized to charge any under payment or credit any over payment to Deposit Account No. 19-1345.

## FEE CALCULATION

1. ☐ BASIC FILING, SEARCH AND EXAMINATION FEES
(Type: _____) Subtotal (1) $_____

2. ☐ EXCESS CLAIM FEES

Total Claims ___ - ___ (HP) = 0 x Fee ___ = $0.00
Indep Claims ___ - ___ (HP) = 0 x Fee ___ = $0.00
Multiple Dependent Claims Fee $
(HP = highest number of claims paid for)

Subtotal (2) $0.00

3. ☐ APPLICATION SIZE FEE

Total Pages N/A - 100 = NaN ÷ 50 = 0 x $___ = $0.00
(Application + Drawings) (round up to whole #)

Subtotal (3) $0.00

4. ☒ OTHER FEE(S)

☐ _____ month extension of time
☐ Information disclosure statement
☐ 37 CFR 1.17(q) processing fee
☐ Non-English specification
☐ Notice of Appeal
☐ Filing a brief in support of appeal
☐ Request for oral hearing
☒ Other: Petition Under 37 CFR 1.182 to Correct Electronic Acknowledgement Receipt

Subtotal (4) $400.00

**TOTAL AMOUNT OF PAYMENT** $400.00

Kurt F. James 04/25/07
Kurt F. James Date
Reg. No. 33,716 Telephone: 314-231-5400

KFJ/dss

By Facsimile

**********
*** RX REPORT ***
**********

RECEPTION OK

| | |
|---|---|
| TX/RX NO | 7905 |
| RECIPIENT ADDRESS | 3142314342 |
| DESTINATION ID | |
| ST. TIME | 04/25 11:03 |
| TIME USE | 00'37 |
| PGS. | 4 |
| RESULT | OK |

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**WARE FRESSOLA VAN DER SLUYS & ADOLPHSON, LLP**
**BRADFORD GREEN, BUILDING 5**
**755 MAIN STREET, P O BOX 224**
**MONROE CT 06468**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Dornhof, Konstantin | : | |
| Application No. 11/576,885 | : | ON PETITION |
| Filed: April 8, 2007 | : | |
| Attorney Docket No. 870-003-230 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed February 28, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Amendment, (2) the petition fee, 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 request to change the address of record should be filed. 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) 272-3206.

This matter is being referred to Technology Center AU 2837 for further examination on the merits.

Liana Walsh
Petitions Examiner
Office of Petitions

cc: OLIVER INTELLECTUAL PROPERTY LLC
P.O. BOX 1670
COTUIT, MA 02635

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13 MAY 2008

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Office of Intellectual Property Counsel
3M Innovative Properties Copany
P.O. Box 33427
St. Paul, Minnesota 55133-3427

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Zhu et al | : | |
| Application No.: 11/576,931 | : | |
| PCT No.: PCT/US2005/036924 | : | |
| Int. Filing Date: 13 October 2005 | : | PETITION |
| Priority Date: N/A | : | |
| Attorney's Docket No.: 59392US004 | : | |
| For: METHOD FOR ... SENSITIVE ADHESIVES | : | UNDER 37 CFR 1.182 |

This decision is in response to the "Communication" filed on 07 February 2008, to accept entry of the above identified application into the national stage with the corrected international application number of PCT/US05/036924. Petitioner has been charged the petition fee of $400.00 to the Deposit Account No.: 13-3723.

## BACKGROUND

On 13 October 2005, this international application was filed.

On 09 April 2007, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied, inter alia, by the requisite basic national fee as required by 35 U.S.C. 371 (c)(1). However, no oath or declaration of the inventors accompanied the transmittal letter.

On 07 February 2008, petitioner filed a petition under 37 CRF 1.182 stating that at the time of filing the application, the international application number was by a typographical error the PCT number was inadvertently type as PCT/US06/036924 rather than the correct number PCT/US05/036924.

## DISCUSSION

Petitioner states that the PCT number was typed as PCT/US06/036924 in the Transmittal letter (Form PTO-1390) because of a typographical error rather than entering the correct international application serial number PCT/US05/036924. The filing on 09 April 2007, however, did have the correct PCT application number PCT/US2005/036924 on the preliminary amendment to the specification. Accordingly, there is sufficient evidence that the correct international application PCT number is PCT/US05/036924.

Therefore, petition to accept the correct PCT number of PCT/US05/036924 for the instant application is granted, and will be reflected in the filing receipt.

**DECISION**

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

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

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

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POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

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JUL 17 2009

OFFICE OF PETITIONS

Applicants: Zaghib, et al.
Appl. No.: 11/576,940
International Filing Date: October 11, 2005
Title: APROTIC POLYMER/MOLTEN SALT TERNARY MIXTURE SOLVENT, METHOD FOR THE PRODUCTION AND USE THEREOF IN ELECTROCHEMICAL SYSTEMS
Attorney Docket No.: 1032013-000179
Pub. No.: US 2009/0029263 A1
Pub. Date: January 29, 2009

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on February 24, 2009 for the above-identified application.

Applicant requests that the application be republished because the patent application publication contains a material error in dependent claims 2 and 40.

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.

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

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17 DEC 2007

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KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, OR 97204-2988

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| KEW et al | : | |
| Application No.: 11/576,941 | : | |
| PCT No.: PCT/US2005/036241 | : | |
| Int. Filing Date: 07 October 2005 | : | PETITION UNDER |
| Priority Date: 08 October 2004 | : | |
| Attorney's Docket No.: 6395-68633-08 | : | |
| For: MODULATION OF ... | : | |
| SYNONYMOUS CODONS | : | 37 CFR 1.137(b) |

This decision is in response to applicant's "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. 1.137(b)," filed on 19 November 2007.

## BACKGROUND

On 07 October 2005, this international application was filed, claiming an earliest priority date of 08 October 2004.

On 09 April 2007, applicant filed the instant petition under 37 CFR 1.137(b) and a Transmittal letter for entry into the national stage in the United States The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 09 April 2007 (since the 8th fell on a Sunday). This international application became abandoned with respect to the United States at midnight on 09 April 2007 for failure to pay the required basic national fee.

On 09 November 2007, the United States Patent and Trademark Office mailed the Notification of Abandonment (PCT/DO/EO/909) since applicant has failed to provide the Copy of the International Application by 30 months (37 CFR 1.495(b)(2)).

On 19 November 2007, 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. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

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

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

## DECISION

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

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is 19 November 2007.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

16 JUN 2008

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29689
David A. Guerra
INTERNATIONAL PATENT GROUP, LLC
2025 17th Avenue, N.W.
Calgary, Alberta T2M 0S7
Canada

In re Application of :
SHIAO, Shin-Jen :
U.S. Application No.: 11/576,955 :
PCT No.: PCT/CN2005/001749 :
Int. Filing Date: 24 October 2005 :
Priority Date: 22 October 2004 : **DECISION**
Attorney Docket No.: AP138-07 :
For: PHARMACEUTICAL COMPOSITION AND NON DEPENDENCE COFFEE COMPRISING EDIBLE CARBOXYLIC ACID AND/OR ITS ACID SALTS AND COFFEINE :

This decision is in response to the request to withdraw as attorneys of record and change of correspondence address filed 03 January 2008, which is hereby **GRANTED** as follows:

As set forth in 37 CFR 1.36, a registered attorney or agent may withdraw, upon application to and approval by the Commissioner, so long as sufficient time remains for applicant to respond to any pending action. In the present case, the request to withdraw filed 03 January 2008, is signed by David A. Guerra, on behalf of the attorneys associated with customer number 29689.

With the response filed on 03 January 2008, there is currently no action required on this application within the next 30 days, so the requirement of "at least 30 days between *approval* of withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a)," is satisfied.

For the reasons above, the request to withdraw as agents of record is **GRANTED** as to the attorneys associated with customer number 29689.

A copy of this communication and all future communication will be directed to the address of applicant, Shin-Jen Shiao, 4F-6, No. 98 Jianzhong Road, Hsinchu 300,

Taiwan.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

cc: Shin-Jen Shiao,
4F-6, No. 98 Jianzhong Road,
Hsinchu 300
Taiwan

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26 JUN 2008

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Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, Minnesota 55133-3247

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Paiva et al | : | |
| Int. Application: PCT/US05/036516 | : | |
| Application No.: 11/576,961 | : | REQUEST UNDER |
| Int. Filing Date: 12 October 2005 | : | |
| Priority Date: 12 October 2004 | : | |
| Attorney's Docket No.: 60133US005 | : | |
| For: PROTECTIVE FILMS AND RELATED METHODS | : | 37 CFR 1.497(d) |

This is a decision on petitioner's "REQUEST TO CORRECT INVENTORSHIP UNDER 37 CFR 1.48(a)" filed on 01 May 2008, which is being treated as a request under 37 CFR 1.497(d) to add joint inventors Jeffrey T. Anderson, Roy Wong, Susan K. Yarmey, Mark A. Strobel, Joel A. Getschel, Albert I. Everaerts, Gregory F. King, John T. Brady, Duane D. Fansler, Kanta Kumar, Jeffrey D. Malmer, Mario A. Perez, Deborah A. Strobel, Wendy L. Thompson, Michael C. Palazzotto, Stefan H. Gryska, Sharon Wang, Mikhail Pekurovsky, Mark F. Ellis, Edward G. Stewart, Robert M. Jennings, Gerald R. A. Hofmann, Kelly J. Gibbens, Gzehegn D. Damte, and Jie Yang in the executed declaration. A petition fee of $130.00 as been charged to petitioner's Deposit Account No. 13-3723 as authorized in the request.

## BACKGROUND

On 12 October 2005, applicants filed international application No. PCT/US05/036516 and claiming a priority date of 12 October 2004.

On 10 April 2007, 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, and an executed declaration.

On 01 February 2008, 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 1.47(a) and (b), identifying the application by International application number and international filing date... except for Inventor Adriana Paiva, the other inventors listed on the declaration are not mentioned on the published application." The notice also indicated that the items set forth above must be submitted within two (2) months from date of this Notice or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 01 May 2008, applicants filed, inter alia, a copy of the executed declaration filed on 10 April 2007 and a request under 37 CFR 1.497(d) to add the joint inventors listed above on the executed declaration.

## DISCUSSION

A submission under 37 CFR 1.497(d) must include:

(1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;

(2) the fee set forth in § 1.17(I); and

(3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied items (2) - (3) under 37 CFR 1.497(d), but not item (1).

With respect to item (1), the statements submitted on 01 May 2008 are sufficient because the statements state that the error in inventorship occurred without a deceptive intent in the national stage application.

With respect to item (2), the processing fee of $130.00 has been charged to the Deposit Account No.: 13-3723.

With respect to item (3), 3M Innovative Properties Company, the assignee, consents to the correction of inventorship to the above application and it has submitted a copy of the assignment showing that it is the assignee of the above application and has establish its right to take action under 37 CFR §3.73(b).

Accordingly, the requests are deemed to satisfy requirements (1), (2), and (3) under 37 CFR 1.497(d).

## CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **GRANTED.**

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing consistent with this decision. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **10 April 2007**.

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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WORKMAN NYDEGGER/Leica
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, UT 84111

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Alastair Green | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7646339 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/12/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/576,971 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 05/24/2007 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **238** 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

10 MAR 2009

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07278
DARBY & DARBY P.C.
P.O. Box 770
Church Street Station
New York, NY 10008-0770

In re Application of :
PITTARD *et al* :
U.S. Application No.: 11/576,975 :
PCT No.: PCT/US2005/036733 :
Int. Filing Date: 11 October 2005 : **DECISION**
Priority Date: 10 October 2004 :
Attorney Docket No.: 21276/1201927-US1 :
For: MULTIPLE TRANSMITTER REMOTE :
CONTROL SYSTEM :

This decision is in response to the papers filed 06 October 2008.

Applicants responded to the Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 21 February 2008 which stated that the declaration filed 26 October 2007 was not in compliance with 37 CFR 1.497(a) and (b) as it lists priority information not listed on the international application. Applicants claim that the priority claim for U.S. Provisional Application No. 60/541,466 filed 02 February 2004 is appropriate as it was "timely made in accordance with 37 CFR 1.78" as the reference was made in the specification of PCT/US2005/036733. As such, the declaration properly identifies the priority claim.

Applicants' claim is dismissed. Any priority claim over 12 months from the international filing date of the underlying PCT application is ineffective. Nonetheless, the declaration filed 26 October 2007 is still in compliance with 37 CFR 1.497(a) and (b) even with the inappropriate priority claim. Therefore, the Form PCT/DO/EO/905 mailed 21 February 2008 is hereby **VACATED**.

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

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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STITES & HARBISON PLLC
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA, VA 22314

Mail Date: 04/21/2010

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|---|---|---|
| **Applicant** | : Mauno Ruuska | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7596892 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/06/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/576,976 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 01/11/2008 | : 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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ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

COPY MAILED
JAN 08 2009

Applicant: Greiving
Appl. No.: 11/576,978
International Filing Date: October 14, 2005
Title: METHOD FOR CLEANING 3-HYDROXYAMIDINOPHENYLALANINE DERIVATIVES BY THE PRECEPITATION AND RECRYSTALLIZATION OF SALT AND AN AROMATIC SULFONIC ACID
Attorney Docket No.: 2923-808
Pub. No.: 2008/0039626 A1
Pub. Date: February 14, 2008

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on March 26, 2008, 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.

It would greatly benefit the Office if the request for corrected publication pointed 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

Inquiries relating to this matter may be directed to Michael Cygan at (703) 272-770, or to the undersigned at (571) 272-7709.

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

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23 AUG 2007

Townsend and Townsend and Crew LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834

In re Application of :
TU et al. :
Application No.: 11/576,992 : DECISION ON PETITION
PCT No.: PCT/US05/36538 : UNDER 37 CFR 1.137(b)
Int. Filing Date: 08 October 2005 :
Priority Date: 08 October 2004 :
Attorney Docket No.: 021935-000510US :
For: HIGH EFFICIENCY LIGHT-EMITTING :
DIODES

The petition to revive under 37 CFR 1.137(b) filed 10 April 2007 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
Fax: (571) 273-0459

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26 NOV 2007

DAVIS WRIGHT TREMAINE, LLP/Seattle
1201 Third Avenue, Suite 2200
SEATTLE WA 98101-3045

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| In re Application of | : | |
| Clinton et al. | : | |
| Application No.: 11/576,996 | : | |
| PCT No.: PCT/US05/35961 | : | |
| Int. Filing Date: 05 October 2005 | : | DECISION |
| Earlier Priority Date: 05 October 2004 | : | |
| Attorney Docket No.: 49321-165 | : | |
| For: Compositions And Methods For Treating Disease | : | |

The petition to revive under 37 CFR 1.137(b) filed on 10 April 2007 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 for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of the basic national fee, and has paid the petition 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 forwarded to the Office of Patent Application Processing for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

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

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SUITE 1600
CHICAGO, IL 60603-3406

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|---|---|---|
| In re Application of MACMAHON et al | : | |
| U.S. Application No.: 11/577,058 | : | |
| PCT Application No.: PCT/GB2005/004113 | : | DECISION |
| Int. Filing Date: 24 October 2005 | : | |
| Priority Date Claimed: 22 October 2004 | : | |
| Attorney Docket No.: 1410-77200 | : | |
| For: POD FOR PREPARING A BEVERAGE | : | |

This is in response to applicant's petition under 37 CFR 1.47(a) filed 16 March 2009.

## BACKGROUND

On 24 October 2005, applicant filed international application PCT/GB2005/004113, which claimed priority of an earlier United Kingdom application filed 22 October 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 27 April 2006. The thirty-month period for paying the basic national fee in the United States expired on 22 April 2007.

On 11 April 2007, 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 October 2008, 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 16 March 2009, 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 inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.
>
> * * *
>
> Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Satwinder Panesar cannot be found. The petition sufficiently demonstrates that a diligent effort was made to locate inventor Panesar as evidenced by the two letters sent to inventor Panesar, the inquiry to Panesar's former employer, and the Internet search (see affidavit of Joseph Shipley, ¶¶ 7, 8, 10, and 11). However, the fact that the 23 August 2007 letter was refused by the recipient suggests that perhaps inventor Panesar can in fact be located. It is unclear whether the letter was refused by Panesar personally or by subsequent occupant of Panesar's last known address. If Panesar still resides at his last known address, it would not be reasonable to conclude that Panesar cannot be found, but his refusal to accept the letter may constitute a refusal to sign the application papers (which has not been

asserted by petitioner). Further details surrounding the refusal of the 23 August 2007 letter should be provided.

With regard to item (3) above, the requisite $200.00 petition fee will be charged to Deposit Account No. 06-1135 as authorized in the petition.

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

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

UNITED STATES PATENT AND TRADEMARK OFFICE

28 JUL 2009

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CHICAGO, IL 60603-3406

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|---|---|---|
| In re Application of MACMAHON et al | : | |
| U.S. Application No.: 11/577,058 | : | |
| PCT Application No.: PCT/GB2005/004113 | : | DECISION |
| Int. Filing Date: 24 October 2005 | : | |
| Priority Date Claimed: 22 October 2004 | : | |
| Attorney Docket No.: 1410-77200 | : | |
| For: POD FOR PREPARING A BEVERAGE | : | |

This is in response to applicant's renewed petition under 37 CFR 1.47(a) filed 08 June 2009.

## BACKGROUND

On 24 October 2005, applicant filed international application PCT/GB2005/004113, which claimed priority of an earlier United Kingdom application filed 22 October 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 27 April 2006. The thirty-month period for paying the basic national fee in the United States expired on 22 April 2007.

On 11 April 2007, 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 October 2008, 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 16 March 2009, applicant filed a petition under 37 CFR 1.47(a).

On 08 April 2009, this Office mailed a decision dismissing the 16 March 2009 petition.

On 08 June 2009, 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.

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

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

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

The petition states that joint inventor Satwinder Panesar refuses to sign the application papers. The petition sufficiently demonstrates that a bona fide attempt was made to present a copy of the application papers to Panesar for signature. Specifically, petitioner sent a letter to Panesar on 23 August 2007, but Panesar refused to accept delivery of the letter (see affidavit of

Joseph Shipley, ¶¶11-12, and Exhibit C). Furthermore, the petition adequately demonstrates that Panesar refuses to sign. In particular, Panesar's refusal to accept correspondence from petitioner is deemed a constructive refusal to cooperate. Thus, it can be concluded with reasonable certainty that Panesar refuses to join in the application.

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 24 October 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 16 March 2009.

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

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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P.O. BOX 1450
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28 JUL 2009

Satwinder Panesar
18 Lethen View
Tullibody, Clackmannashire
United Kingdom
FK 10 2 GE

In re Application of MACMAHON et al
U.S. Application No.: 11/577,058
PCT Application No.: PCT/GB2005/004113
Int. Filing Date: 24 October 2005
Priority Date Claimed: 22 October 2004
For: POD FOR PREPARING A BEVERAGE

Dear Satwinder Panesar:

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

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

Bryan Lin

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

FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406
Attorney Docket No.: 1410-77200

UNITED STATES PATENT AND TRADEMARK OFFICE

28 OCT 2009

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SUITE 1600
CHICAGO, IL 60603-3406

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|---|---|---|
| In re Application of MACMAHON et al | : | |
| U.S. Application No.: 11/577,078 | : | |
| PCT Application No.: PCT/GB2005/004108 | : | |
| Int. Filing Date: 24 October 2005 | : | DECISION |
| Priority Date Claimed: 22 October 2004 | : | |
| Attorney Docket No.: 1410-77199 | : | |
| For: FLEXIBLE PAD FOR PREPARING A BEVERAGE | : | |

This is in response to applicant's petition under 37 CFR 1.47(a) filed 01 September 2009.

## BACKGROUND

On 24 October 2005, applicant filed international application PCT/GB2005/004108, which claimed priority of an earlier United Kingdom application filed 22 October 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 27 April 2006. The thirty-month period for paying the basic national fee in the United States expired on 23 April 2007.

On 11 April 2007, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 01 June 2009, 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 01 September 2009, 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,

> 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 that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

The petition states that joint inventor Satwinder Panesar 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 Panesar for signature. In particular, although the declaration and assignment documents were apparently sent to Panesar (see affidavit of Joseph Shipley, ¶10) there is no indication that the specification, claims, and drawings were ever sent to Panesar. Furthermore, a copy of the cover letter sent to Panesar has

not been provided. Until it is shown that petitioner attempted to present a complete copy of the application papers to Panesar, Panesar's apparent refusal to accept such papers will not be deemed a constructive refusal to cooperate. Thus, it would not be reasonable to conclude at the present time that Panesar refuses to join in the application.

With regard to item (3) above, the requisite petition fee will be charged to Deposit Account No. 06-1135 as authorized in the petition.

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 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 1.47(a)". No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail 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.

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

| | | |
|---|---|---|
| In re Application of MACMAHON et al | : | |
| U.S. Application No.: 11/577,078 | : | |
| PCT Application No.: PCT/GB2005/004108 | : | |
| Int. Filing Date: 24 October 2005 | : | DECISION |
| Priority Date Claimed: 22 October 2004 | : | |
| Attorney Docket No.: 1410-77199 | : | |
| For: FLEXIBLE PAD FOR PREPARING A BEVERAGE | : | |

This is in response to applicant's renewed petition under 37 CFR 1.47(a) filed 25 November 2009.

## BACKGROUND

On 24 October 2005, applicant filed international application PCT/GB2005/004108, which claimed priority of an earlier United Kingdom application filed 22 October 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 27 April 2006. The thirty-month period for paying the basic national fee in the United States expired on 23 April 2007.

On 11 April 2007, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 01 June 2009, 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 01 September 2009, applicant filed a petition under 37 CFR 1.47(a).

On 28 October 2009, this Office mailed a decision dismissing the 01 September 2009 petition.

On 25 November 2009, 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,

> 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 that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

The petition states that joint inventor Satwinder Panesar refuses to sign the application papers. The petition adequately demonstrates that a bona fide attempt was made to present a complete copy of the application papers to Panesar for signature. In particular, the application papers were sent to Panesar on 23 August 2007 (see affidavit of Joseph Shipley, ¶10). Furthermore, the petition sufficiently illustrates Panesar's refusal to sign. In particular, Panesar's refusal to accept the application papers (see Shipley affidavit, ¶11, and Exhibit D) is deemed a constructive refusal to cooperate. Thus, it can be concluded with reasonable certainty that Panesar refuses to join in the application.

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 24 October 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 01 September 2009.

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

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

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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05 FEB 2010

Satwinder Panesar
18 Lethen View
Tullibody, Clackmannanshire
FK 10 2 GE
United Kingdom

In re Application of MACMAHON et al
U.S. Application No.: 11/577,078
PCT Application No.: PCT/GB2005/004108
Int. Filing Date: 24 October 2005
Priority Date Claimed: 22 October 2004
For: FLEXIBLE PAD FOR PREPARING A BEVERAGE

Dear Satwinder Panesar:

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

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

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

FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406
Attorney Docket No.: 1410-77199

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18 FEB 2010

49691
IP STRATEGIES
12 ½ Wall Street
Suite E
Asheville, NC 28801

In re Application of
GERMER *et al*
U.S. Application No.: 11/577,085
PCT No.: PCT/EP2005/010967
Int. Filing Date: 12 October 2005
Priority Date: 12 October 2004
Docket No.: GRUNP75
For: SERVERLESS REPLICATION OF DATABASES

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

Applicants' petition to revive under 37 CFR 1.137(b) filed on 08 December 2009 is hereby **GRANTED** as follows:

A declaration in compliance with 37 CFR 1.497(a) and (b) was provided. The petition fee has been paid. Applicants made 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.

The four-month extension fee of $1,730 is not required and is credited back to Deposit Account No. 50-1998.

This application is being forwarded to the United States Designated/Elected Office for further processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

United States Patent and Trademark Office

08 DEC 2008

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PROSKAUER ROSE LLP
1001 PENNSYLVANIA AVE, N.W.,
SUITE 400 SOUTH
WASHINGTON DC 20004

In re Application of :
Burbank :
Application No. 11/577,126 :
PCT No.: PCT/US2005/036603 :
Int. Filing Date: 16 September 2005 : DECISION
Priority Date: 28 October 2004 :
Atty. Docket No.: 53951-145USNATL :
For: Blood Treatment Dialyzer/Filter Design :
To Trap Entrained Air In A Fluid Circuit :

This is in response to the "Request To Correct Inventor's Name" filed on 13 April 2007.

## BACKGROUND

This international application was filed on 16 September 2005, claimed an earlier priority date of 28 October 2004, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 28 April 2007. Applicants filed, *inter alia*, the basic national fee on 12 April 2007.

## DISCUSSION

Counsel "requests a correction of the inventor's name," from James M. Burbank (as nominated in the published international application) to "James M. BRUGGER." MPEP 605.04(b) states in part that

> *Except for correction of a typographical or transliteration error in the spelling of an inventor's name, a request to have the name changed from the typewritten version to the signed version or any other corrections in the name of the inventor(s) will not be entertained, unless accompanied by a petition under 37 CFR 1.182 together with an appropriate petition fee.*

In that the requested change clearly represents more than the correction of a typographical or transliteration error, a formal petition under 37 CFR 1.182 would be required in order for the change to be accepted. It is noted that no executed oath or declaration has been filed in this application as of the date of this Decision.

## DECISION

The request is **DISMISSED**, without prejudice.

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

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

This application is being returned to the Office of Patent Application Processing for further processing.

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

United States Patent and Trademark Office

1 4 AUG 2009

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MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN VA 22102-3833

In re Application of
Burbank/Brugger
Application No. 11/577,126
PCT No.: PCT/US2005/036603
Int. Filing Date: 16 September 2005
Priority Date: 28 October 2004
Atty. Docket No.: 53951-145USNATL
For: Blood Treatment Dialyzer/Filter Design
To Trap Entrained Air In A Fluid Circuit

DECISION

This is in response to the petition under 37 CFR 1.182 filed on 14 January 2009.

## DISCUSSION

In a Decision mailed on 08 December 2008, the "Request to Correct Inventor's Name" filed on 13 April 2007 was dismissed, without prejudice, because

> Counsel "requests a correction of the inventor's name," from James M. Burbank (as nominated in the published international application) to "James M. BRUGGER." ...In that the requested change clearly represents more than the correction of a typographical or transliteration error, a formal petition under 37 CFR 1.182 would be required in order for the change to be accepted. It is noted that no executed oath or declaration has been filed in this application as of the date of this Decision.

In response, applicants have now formally petitioned under 37 CFR 1.182 for acceptance of the name change. Petitioner attributes the discrepancy to a "clerical error" during the international phase. However, petitioner has not provided appropriate evidence (such as a first-hand statement by the inventor) that the names Burbank and Brugger refer to the same person, and that that person is in fact the inventor. In the absence of an appropriate showing, it would not be appropriate to accept the name change under 37 CFR 1.182 at this time.

## DECISION

The request is **DISMISSED**, without prejudice.

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

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

17 DEC 2009

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SUITE 500
MCLEAN VA 22102-3833

In re Application of :
Brugger :
Application No. 11/577,126 :
PCT No.: PCT/US2005/036603 :
Int. Filing Date: 16 September 2005 : DECISION
Priority Date: 28 October 2004 :
Atty. Docket No.: T4342-14494US04 :
For: Blood Treatment Dialyzer/Filter Design :
To Trap Entrained Air In A Fluid Circuit :

This is in response to the petition under 37 CFR 1.182 filed on 14 October 2009.

## DISCUSSION

In a Decision mailed on 14 August 2009, the petition under 37 CFR 1.182 filed on 14 January 2009 was dismissed, without prejudice, because

> petitioner has not provided appropriate evidence (such as a first-hand statement by the inventor) that the names Burbank and Brugger refer to the same person, and that that person is in fact the inventor. In the absence of an appropriate showing, it would not be appropriate to accept the name change under 37 CFR 1.182 at this time.

In response, petitioner has provided a "Statement of the Inventor" signed by James M. Brugger, who makes appropriate explanatory statements. In view of the totality of the evidence currently of record, including Mr. Brugger's statement, it would be appropriate to accept his name as it appears on the Declaration filed on 18 December 2008, "BRUGGER, James M." Consequently, the Declaration filed on 18 December 2008 is being accepted for purposes of compliance with 37 CFR 1.497(a) and (b).

The duplicate $400.00 petition fee (fee code 1462) paid on 14 October 2009 was not required, and it is being refunded to Deposit Account 50-1165.

## DECISION

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

This application is being returned to the Office of Patent Application Processing for further processing, including the correction of the electronic records of the USPTO to list "BRUGGER, James M." as the sole inventor. The date of the application under 35 U.S.C. 371(c)(1), (2) and (4) is **18 December 2008**.

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

14 JUL 2009

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BARNES & THORNBURG LLP
11 SOUTH MERIDIAN
INDIANAPOLIS IN 46204

| | | |
|---|---|---|
| In re Application of | : | |
| HELBING, Clarence H. | : | |
| Application No.: 11/577,130 | : | DECISION ON |
| PCT No.: PCT/US2005/036332 | : | |
| Int. Filing Date: 11 October 2005 | : | PETITION |
| Priority Date: 13 October 2004 | : | |
| Attorney Docket No.: 20121-201940 | : | UNDER 37 CFR 1.42 |
| For: POLYESTER BINDING COMPOSITIONS | : | |

This application is before the Office of PCT Legal Administration for matters arising under 35 USC 371. A review of the declaration reveals an indication that inventor Clarence Helbing is deceased. Applicants' submission has been treated as a request for status under 37 CFR 1.42.

## BACKGROUND

On 06 November 2008, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required.

On 06 February 2009, applicants submitted this declaration executed by the legal representatives of the deceased inventor.

## DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

The declaration must list the inventors and their citizenships and the legal representative and the legal representative's citizenship, residence and postal address. See 37 CFR 1.497. The declaration lists the information for the legal representatives, but does not identify the inventor and his citizenship. As such, the declaration does not satisfy 37 CFR 1.497(a)-(b) and 37 CFR 1.42.

## CONCLUSION

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

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 and the surcharge for late filing of the search fee, examination fee or oath or declaration, within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN

ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed, 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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BARNES & THORNBURG LLP
11 SOUTH MERIDIAN
INDIANAPOLIS IN 46204

| | | |
|---|---|---|
| In re Application of | : | |
| HELBING, Clarence H. | : | |
| Application No.: 11/577,130 | : | DECISION ON |
| PCT No.: PCT/US2005/036332 | : | |
| Int. Filing Date: 11 October 2005 | : | REQUEST |
| Priority Date: 13 October 2004 | : | |
| Attorney Docket No.: 20121-201940 | : | UNDER 37 CFR 1.42 |
| For: POLYESTER BINDING COMPOSITIONS | : | |

This decision is in response to applicant's renewed request for status under 37 CFR 1.42, filed in the United States Patent and Trademark Office on 18 September 2009.

## BACKGROUND

On 14 July 2009, the Office mailed Decision On Petition Under 37 CFR 1.42, dismissing applicant's request for status under 37 CFR 1.42.

On 18 September 2009, applicants submitted this renewed request for status, accompanied by a declaration executed by the legal representatives of the deceased inventor.

## DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

The declaration must list the inventors and their citizenships and the legal representative and the legal representative's citizenship, residence and postal address. See 37 CFR 1.497. The new declaration satisfies 37 CFR 1.497(a)-(b) and 37 CFR 1.42.

## CONCLUSION

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

This application is being referred to the National Phase Processing Branch of the Office of Patent Application Processing for further action consistent with this decision.

/Erin P. Thomson/

Erin P. Thomson
Attorney Advisor
PCT Legal Administration

Telephone: (571) 272-3292

0 6 JUN 2007

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www.uspto.gov

Scott F. Yarnell
Intellectual Property Department
Hunton & Williams LLP
1900 K Street, N.W. Suite 1200
Washington, DC 20006-1109

In re Application of :
BURRIEZ et al. :
U.S. Application No. 11/577,162 :
PCT No.: PCT/EP05/11651 :
Int. Filing Date: 11 October 2005 : DECISION
Priority Date: 12 October 2004 :
Attorney Docket No.: 66692.000004 :
For: DEVICE AND METHOD FOR PACKAGING IN BLOCK FORM A SHEATHED HOT-MELT ADHESIVE PRODUCT :

The above-identified application is before the Office of PCT Legal Administration for consideration of matters under 35 U.S.C. 371.

## BACKGROUND

On 11 October 2005, applicant filed international application No. PCT/EP05/11651, which claimed a priority date of 12 October 2004. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 12 April 2007.

On 12 April 2007, applicant filed, through Scott F. Yarnell of the law firm of Hunton & Williams LLP, a transmittal letter for entry into the national stage in the United States (Form PTO-1390) which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; a preliminary amendment; and an unexecuted declaration. The submission, identifying international application no. PCT/EP05/11651, was assigned U.S. application number 11/577,162.

On 12 April 2007, applicant filed, through Jeff B. Vockrodt of the law firm of Hunton & Williams LLP, a second transmittal letter for entry into the national stage in the United States referencing the international application PCT/EP05/11651, which was accompanied by, *inter alia*, a second basic national fee; a copy of the international application; a preliminary amendment; and an application data sheet. These papers were assigned U.S. application number 11/665,254.

## DISCUSSION

As is evident from the above recited facts, two sets of papers to enter the national stage have been submitted for international application number PCT/EP05/11651 (United States application numbers 11/577,162 and 11/665,254). 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 by above-named counsel and assigned application number 11/577,162 were the first of the two filings to be processed by the USPTO, with such U.S. application file being associated with the international application in the USPTO's PALM system. Accordingly, U.S. application number 11/577,162 is the application file that will continue to be processed as the national stage of PCT/EP05/11651. The second set of national stage materials filed on12 April 2007 and originally assigned U.S. application number 11/665,254 will be placed in the present application file, and U.S. application number 11/665,254 will be discontinued.

Applicants should use application number 11/577,162 in all future communications with the United States Patent and Trademark Office (PTO). Application number 11/665,254 will be discontinued.

## CONCLUSION

Application no. 11/577,162 is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing to: (1) merge the papers filed in U.S. Application no. 11/665,254 into U.S. Application no. 11/577,162 and (2) refund the filing fees of $950 paid in connection with the application number 11/665,254 to deposit account no. 50-0206.

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

22 MAY 2009

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FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO IL 60603-3406

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|---|---|---|
| In re Application of | : | |
| MACMAHON et al. | : | |
| Application No.: 11/577,169 | : | DECISION |
| PCT No.: PCT/GB2005/004095 | : | |
| Int. Filing Date: 24 October 2005 | : | |
| Priority Date: 22 October 2004 | : | |
| Attorney Docket No.: 1410-67706 | : | |
| For: FLEXIBLE PAD FOR PREPARING A BEVERAGE | : | |

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 20 March 2009 in the United States Patent and Trademark Office (USPTO). The petition is **GRANTED**.

## BACKGROUND

On 24 October 2005, applicants filed international application PCT/GB2005/004095, which designated the United States and claimed a priority date of 22 October 2004 . A copy of the international application was communicated from the International Bureau to the USPTO on 27 April 2006. The thirty-month period for paying the basic national fee in the United States expired at midnight on 23 April 2007 (22 April 2007 being a Sunday).

On 12 April 2007, 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 20 October 2008, the United States Designated/Elected Office (DO/EO/US) issued a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 20 March 2009, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a three-month extension of time, a declaration of inventors, a statement of facts by Joseph E. Shipley, and a copy of a "Return Package Form" from the delivery company used by petitioner.

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(i); (2) factual proof that the missing joint 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 Deposit Account 06-1135. Thus, item (1) has been met.

Items (3) and (4) have also been met.

Item (2) has been met as well. It has been established that Mr. Panesar was presented with a copy of the application papers including the specification (declaration of Joseph E. Shipley and delivery information). Mr. Panesar's conduct constitutes a refusal to sign.

## CONCLUSION

For the reasons set forth above, 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 **20 March 2009**.

/Daniel Stemmer/

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

22 MAY 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

Satwinder Panesar
18 Lethen View
Tullibody, Clackmannanshire
United Kingdon FK 10 2 GE

In re Application of
MACMAHON et al.
Application No.: 11/577,169
PCT No.: PCT/GB2005/004095
Int. Filing Date: 24 October 2005
Priority Date: 22 October 2004
Attorney Docket No.: 1410-67706
For: FLEXIBLE PAD FOR PREPARING A BEVERAGE

Dear Mr. Panesar:

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/

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

FITCH EVEN TABIN & FLANNERY
120 S. LASALLE STREET
SUITE 1600
CHICAGO IL 60603-3406

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/577,173 | 10/16/2007 | Felix Flachsmann | 102790-234/30148 US | 1411 |

27389 7590 06/02/2009

NORRIS, MCLAUGHLIN & MARCUS
875 THIRD AVE
18TH FLOOR
NEW YORK, NY 10022

| EXAMINER | |
|---|---|
| RODRIGUEZ-GARCIA, VALERIE | |
| **ART UNIT** | **PAPER NUMBER** |
| 1626 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/02/2009 | 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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NORRIS, MCLAUGHLIN & MARCUS
875 THIRD AVE
18TH FLOOR
NEW YORK NY 10022

Applicant: Flachsmann et al.
Appl. No.: 11/577,173
Filing Date: October 16, 2007
Title: ORGANIC COMPOUNDS
Attorney Docket No.: 102790-234/30148 US
Pub. No.: US 2009/0036690 A1
Pub. Date: February 5, 2009

This is a decision on the request for republication of patent application publication under 37 CFR 1.221(a), filed on May 26, 2009, for the above-identified application.

The request under 37 CFR 1.221(a) is DISMISSED.

37 CFR 1.221(a) requires "a copy of the application in compliance with the Office 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.

The applicant did not supply a copy of the application in compliance with the Office electronic filing system, as required by 37 CFR 1.221(a) because **the Applicant submitted the papers as a "Document for an existing application", which are entered into the application file, and not as a "Pre-Grant Publication" submission.** The request for republication does not comply with the electronic filing system requirements, thus republication will not take place.

Any request for republication under 37 CFR 1.221(a), must be submitted via the EFS system, **as a Pre-Grant publication submission.** The applicant is directed to the following website for additional instructions on how to submit a Pre-Grant Publication submission via the electronic filing system:

http://www.uspto.gov/ebc/portal/efs/pgpub_quickstart.pdf

Any questions or requests 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

Telephone inquiries regarding this correspondence should be directed to The Office of Data Management at 571-272-4200.

Office of Data Management
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14 NOV 2008

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HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

| | | |
|---|---|---|
| In re Application of | : | |
| Almstead et al | : | |
| Application No.: 11/577,191 | : | |
| PCT No.: PCT/US2005/036676 | : | |
| Int. Filing Date: 13 October 2005 | : | DECISION |
| Priority Date: 13 October 2004 | : | |
| Attorney's Docket No.: P3040US01 | : | |
| For: Compounds for Nonsense Suppression, and Methods for Their Use | : | |

This is in response to petitioner's "CORRECTION OF ENTITY STATUS PURSUANT TO 37 CFR 1.28 AND REQUEST FOR REFUND," filed on 12 August 2008 requesting a refund because the status of the current application is a small entity status and was erroneously filed as a large entity status.

## BACKGROUND

On 13 October 2005, applicants filed international application PCT/US2005/036673, which claimed priority to an earlier application filed 13 October 2004.

On 12 April 2007, 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. However, no additional fees were paid at such time.

On 29 November 2007, applicants submitted a "New Power of Attorney and Correspondence Address," which indicated, inter alia, that any additional fees due or any overpayment made that the Commissioner is authorized to charge or credit the Deposit Account No.: 08-2461.

On 10 December 2007, 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 additional claim fees of $2230 as a non-small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due" 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 09 May 2008, applicants filed an Electronic Patent Application Fee Transmittal paying the amount of $4,760 via the Deposit Account No.: P30430US01.

On 12 August 2008, applicant filed a request for a refund of $2,380.00 because the application was erroneously filed as large entity status rather than the correct status of small entity.

## DISCUSSION

37 CFR 1.28(a) provides:

> (a) *Refunds based on later establishment of small entity status.* A refund pursuant to § 1.26 part, 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 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 two months of the date of payment of, the fee. (Emphasis added).

The three-month period for refunds under 37 CFR 1.28(a) starts from the date of receipt of an authorization to charge fees and not from the date of debit of the fee to a deposit account. Note MPEP 509.03.

In the present case, the 12 August 2008 request for a refund of a portion of the fees paid for the present application based upon on the subsequent establishment of small entity status, was **not made within three months as required under 37 CFR 1.28(a)** of the payment of the large entity fees on 09 May 2008. Accordingly, petitioner is not entitled to a refund of any portion of the large entity fees paid on the present application.

## CONCLUSION

The petition under 37 CFR 1.28 is **DISMISSED**, without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.28 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 1.28." 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
Tel: (571) 272-3276
Fax: (571) 273-0459

15 MAY 2009

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HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

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|---|---|---|
| In re Application of | : | DECISION ON |
| Almstead et al | : | |
| Application No.: 11/577,191 | : | |
| PCT No.: PCT/US2005/036676 | : | |
| Int. Filing Date: 13 October 2005 | : | PETITION UNDER |
| Priority Date: 13 October 2004 | : | |
| Attorney's Docket No.: P3040US01 | : | |
| For: Compounds for Nonsense Suppression, and | : | |
| Methods for Their Use | : | 37 CFR 1.137(b) |

This decision is responsive to applicants' "PETITION FOR REVIVAL OF AN APPLICATION OR PATENT ABANDONED UNDER 37 CFR 1.137(b)" filed on 12 March 2009 requesting the acceptance of the executed declaration.

## BACKGROUND

On 23 September 2008, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) because the declaration was not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.

Also, in a decision from this Office on 14 November 2008, the petition under 37 CFR 1.28 was dismissed.

On 12 March 2009, petitioner submitted a petition under 37 CFR 1.137(b), which was accompanied by, *inter alia*, a petition and its corresponding fee and an executed declaration.

## DISCUSSION

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

Petitioner has provided: (1) the proper reply by submitting an executed declaration that satisfies the conditions set forth under 37 CFR 1.497(a) and (b), (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 all the items under 37 CFR 1.137(b).

**DECISION**

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

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **12 March 2009**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Examiner
Tel: (571) 272-3276
Fax: (571) 273-0459

United States Patent and Trademark Office

0 6 APR 2009

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HOFFMAN & BARON LLP
6900 Jericho Turnkpike
Syossett, NY 11791

In re Application of CAMPBELL et al.
Application No.: 11/577,192
PCT No.: PCT/US2005/037052
Int. Filing Date: 13 October 2005
Priority Date: 13 October 2004
Attorney Docket No: 1368-22 PCT B/US
For: COMPOUNDS FOR NONSENSE SUPPRESSION, AND METHODS FOR THEIR USE

DECISION ON PETITION TO REVIVE UNDER 37 C.F.R. 1.137 (b)

This decision is in response to applicants' "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER37 C.F.R. 137(b)" filed in the United States Patent and Trademark Office (USPTO) on 16 March 2009.

## BACKGROUND

On 13 October 2005, applicant filed international application PCT/US2005/037052, which claimed priority to an earlier US provisional application filed 13 October 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 April 2007. Accordingly, the thirty month period for paying the basic national fee in the United States expires at midnight 13 April 2008.

On 12 April 2007, 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).

On 06 September 2007, a Notice of Missing Requirements under 35 U.S.C. 371 was issued by the United States Designated/Elected Office requesting an additional claim fee, an oath or declaration in compliance with 37 CFR 1.497(a) and a late submission surcharge.

On 6 March 2008, a Response to Notification of Missing requirements was filed and accompanied by, inter alia.: a combined declaration and power of attorney, a late submission surcharge, claim fee, search fee and examination fee.

On 22 September 2008, a Notice of Defective Response was issued by the United States Designated/Elected Office indicating that the declaration filed on 6 March 2008 was defective.

On 23 October 2008, the above-identified application became abandoned for failure to file a timely reply to the Notice of Defective Response which was mailed on September 22, 2008

On 16 March 2009, applicants filed the present petition under 37 C.F.R 1.137(b) to revive the application, which was accompanied by, inter alia, an executed oath, a correction of entity status pursuant 37 C.F. R. 1.28 and an assertion of small entity status pursuant 37 C.F.R. 1.27(c).

## DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived 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), applicants have provided a complete oath. However, the oath contains non-initialed alternations and is not acceptable. See MPEP 602.01.

Regarding item (2), the $810 petition fee has been charged to the deposit account 08-2461 authorized by applicants.

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

Regarding 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 **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 1.137 (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 Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with contends of the letter marked to the attention of the PCT Legal Office.

Sarah McPartlin
Examiner
Office of PCT Legal Administration
Administration
Tel: (571) 272-6095
Fax: (571) 273-0459

Leonard Smith
PCT Legal Examiner
Office of PCT Legal

United States Patent and Trademark Office

1 4 APR 2009

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

HOFFMAN & BARON LLP
6900 Jericho Turnkpike
Syossett, NY 11791

In re Application of CAMPBELL et al.
Application No.: 11/577,192
PCT No.: PCT/US2005/037052
Int. Filing Date: 13 October 2005
Priority Date: 13 October 2004
Attorney Docket No: 1368-22 PCT B/US
For: COMPOUNDS FOR NONSENSE SUPPRESSION, AND METHODS FOR THEIR USE

SUPPLEMENTAL DECISION ON PETITION TO REVIVE UNDER 37 C.F.R. 1.137 (b)

This decision is in response to applicants' "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER37 C.F.R. 137(b)" filed in the United States Patent and Trademark Office (USPTO) on 16 March 2009.

## BACKGROUND

On 13 October 2005, applicant filed international application PCT/US2005/037052, which claimed priority to an earlier US provisional application filed 13 October 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 April 2007. Accordingly, the thirty month period for paying the basic national fee in the United States expires at midnight 13 April 2008.

On 12 April 2007, 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).

On 06 September 2007, a Notice of Missing Requirements under 35 U.S.C. 371 was issued by the United States Designated/Elected Office requesting an additional claim fee, an oath or declaration in compliance with 37 CFR 1.497(a) and a late submission surcharge.

On 6 March 2008, a Response to Notification of Missing requirements was filed and accompanied by, inter alia.: a combined declaration and power of attorney, a late submission surcharge, claim fee, search fee and examination fee.

On 22 September 2008, a Notice of Defective Response was issued by the United States Designated/Elected Office indicating that the declaration filed on 6 March 2008 was defective.

On 23 October 2008, the above-identified application became abandoned for failure to file a timely reply to the Notice of Defective Response which was mailed on September 22, 2008

On 16 March 2009, applicants filed the present petition under 37 C.F.R 1.137(b) to revive the application, which was accompanied by, inter alia, an executed oath, a correction of entity status pursuant 37 C.F. R. 1.28 and an assertion of small entity status pursuant 37 C.F.R. 1.27(c).

## DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived 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), applicants have provided a complete oath. This is an appropriate response.

Regarding item (2), the $810 petition fee has been charged to the deposit account 08-2461 authorized by applicants.

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

Regarding 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 has an international filing date of 13 October 2005. This application is being referred to the National Stage Processing (DO/EO/US) for further processing in accordance with this decision.

Sarah McPartlin
Examiner
Office of PCT Legal Administration
Administration
Tel: (571) 272-6095
Fax: (571) 273-0459

Leonard Smith
PCT Legal Examiner
Office of PCT Legal

UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/577,215 | 04/13/2007 | Noriharu Miyaho | 20898/0206344-US0 | 1874 |

7278 7590 03/04/2010

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

| EXAMINER | |
|---|---|
| CHO, HONG SOL | |

| ART UNIT | PAPER NUMBER |
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| 2467 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/04/2010 | PAPER |

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The time period for reply, if any, is set in the attached communication.

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

In re Application of: Noriharu Miyaho et al.

Application No. 11/577215
Filed: April 3, 2007
For: EXCHANGE NODE AND EXCHANGE NODE CONTROL METHOD

DECISION ON REQUEST TO PARTICIPATE IN PATENT PROSECUTION HIGHWAY PROGRAM AND PETITION TO MAKE SPECIAL UNDER 37 CFR 1.102(d)

MAILED

MAR 04 2010

DIRECTOR OFFICE
TECHNOLOGY CENTER 2400

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed Feb 3, 2010, to make the above-identified application special.

The petition is **DISMISSED.**

A grantable request to participate in the PPH program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;

(2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;

(3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);

(4) Examination of the U.S. application has not begun;

(5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;

(6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and

(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH program and petition failed to meet the requirement of items (2) and (5) above. Applicant failed to submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate, as well as a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate.

Accordingly, the Petition is **DISMISSED**.

Applicant is given a time period of ONE MONTH or THIRTY DAYS, whichever is longer, to correct the deficiencies. NO EXTENSION OF TIME UNDER 37 CFR 1.136 IS PERMITTED.

If the deficiencies are not corrected with the time period given, the application will await action in its regular turn.

Responses must be submitted by EFS-Web using the document description "Petition to make special under Pat Pros Hwy".

Telephone inquiries concerning this decision should be directed to Hassan Kizou at 571-272-3088

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://www.uspto.gov/ebc/index.html.

Hassan Kizou
Quality Assurance Specialist
Technology Center 2400

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 11/577,215 | 04/13/2007 | Noriharu Miyaho | 20898/0206344-US0 | 1874 |

7278 7590 05/06/2010

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

| EXAMINER | |
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| CHO, HONG SOL | |

| ART UNIT | PAPER NUMBER |
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| 2467 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/06/2010 | 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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www.uspto.gov

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

In re Application of: Noriharu Miyaho et al.
Application No. 11/577215
Filed: April 13, 2007
For: EXCHANGE NODE AND EXCHANGE NODE CONTROL METHOD

DECISION ON REQUEST TO PARTICIPATE IN PATENT PROSECUTION HIGHWAY PROGRAM AND PETITION TO MAKE SPECIAL UNDER 37 CFR 1.102(d)

MAILED

MAY 06 2010

DIRECTOR OFFICE
TECHNOLOGY CENTER 2400

This is a decision on the renewed request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed Feb 3, 2010, to make the above-identified application special.

The petition is **DISMISSED AS MOOT.**

A grantable request to participate in the PPH program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;

(2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;

(3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);

(4) Examination of the U.S. application has not begun;

(5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;

(6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and

(7) The required petition fee under 37 CFR 1.17(h).

A Notice of allowance was mailed on April 21, 2010, accordingly, the Petition is **DISMISSED AS MOOT**.

Telephone inquiries concerning this decision should be directed to Hassan Kizou at 571-272-3088

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://www.uspto.gov/ebc/index.html.

/Hassan Kizou/

Hassan Kizou
Quality Assurance Specialist
Technology Center 2400

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No.**:20090407

**DATE** : April 7, 2009

**TO SPE OF** : ART UNIT 3662

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7432850

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

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - PK 3-910**
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

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

☒ **Approved** **All** changes apply.

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

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

**Comments:**

**SPE:** Thomas H. Tarcza **Art Unit** 3662

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United States Patent and Trademark Office
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KLARQUIST SPARKMAN, LLP
121 S.W. SALMON STREET
SUITE #1600
PORTLAND, OR 97204-2988

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Alan T. Remaley | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7572771 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/11/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/577,259 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/13/2007 | : 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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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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**LOWE HAUPTMAN HAM & BERNER, LLP**
**1700 DIAGONAL ROAD**
**SUITE 300**
**ALEXANDRIA VA 22314**

**COPY MAILED**

AUG 2 7 2008

**OFFICE OF PETITIONS**

In re Application of
Barry W. JOHNSTON
Application No. 11/577,265
Filed: April 13, 2007
Attorney Docket No. **233-015**

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 July 31, 2008, 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 by Barry Johnston attesting to his age. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

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 3748 for action on the merits commensurate with this decision.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

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

COPY MAILED

AUG 12 2008

Applicant: Maeda et al.
Appl. No.: 11/577,267
International Filing Date: June 6, 2005
Title: METHOD FOR PRODUCING MANGANESE DRY CELL NEGATIVE ELECTRODE ZINC MATERIAL
Attorney Docket No.: 306981US3X PCT
Pub. No.: US 2008/0029189 A1
Pub. Date: February 7, 2008

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on March 21, 2008, 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 application wherein two of the inventors were omitted.

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 omission of an inventor's name and residence do not affect the understanding of the application. The mistakes do not affect the public's ability to appreciate the technical disclosure of the patent application publication, or determine the scope of the patent application publication or determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.

[1]Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239, Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

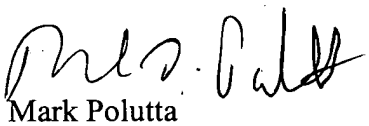
The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application compliance with the Office's electronic filing system requirements and be accompanied by the 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

0 9 NOV 2007

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BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 4807-1238

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| KAROLY CSEPI | : | |
| Application No.: 11/577,391 | : | |
| PCT No.: PCT/HU2004/000091 | : | |
| Int. Filing Date: 30 September 2004 | : | PETITION UNDER |
| Priority Date: NA | : | |
| Attorney's Docket No.: VAR0103PUSA | : | |
| For: UNIVERSAL ICE-SKATE AND | : | |
| ROLLER-SKATE | : | 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 C.F.R. 1.137(b)," filed on 17 April 2007.

## BACKGROUND

On 30 September 2004, this international application was filed.

The deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 30 March 2007. This international application became abandoned with respect to the United States at midnight on 30 March 2007 for failure to pay the required basic national fee.

On 17 April 2007, applicant filed the instant petition under 37 CFR 1.137(b) and a Transmittal letter for entry into the national stage in the United States, which was accompanied by the basic national fee, the petition fee, and an executed declaration.

## DISCUSSION

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

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

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

**DECISION**

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

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **17 April 2007**.

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

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07 SEP 2007

JEFFER, MANGELS, BUTLER & MARMARO, LLP
1900 AVENUE OF THE STARS, 7TH FLOOR
LOS ANGELES, CA 90067

In re Application of YEAROUT :
U.S. Application No.: 11/577,398 :
PCT Application No.: PCT/US2005/023389 :
Int. Filing Date: 29 June 2005 : DECISION
Priority Date Claimed: 30 June 2004 :
Attorney Docket No.: 67301-5002 :
For: REVERSIBLE ABSORPTION :
REFRIGERATION :

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 17 April 2007.

## BACKGROUND

On 29 June 2005, applicant filed international application PCT/US2005/023389, which claimed priority of an earlier United States application filed 30 June 2004. The thirty-month period for paying the basic national fee in the United States expired on 30 December 2006.

International application PCT/US2005/023389 became abandoned as to the United States for failure to timely pay the basic national fee.

On 17 April 2007, applicant filed the present petition under 37 CFR 1.137(b).

## DISCUSSION

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

With regard to item (1), applicant has provided the required reply under 35 U.S.C. 371.

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

With regard to item (3), applicant has provided the required statement.

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

## CONCLUSION

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

The application has an International Filing Date under 35 U.S.C. 363 of 29 June 2005, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 17 April 2007.

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

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

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SWANSON & BRATSCHUN, L.L.C.
8210 SOUTHPARK TERRACE
LITTLETON CO 80120

MAILED

FEB 11 2009

OFFICE OF PETITIONS

Applicant: Vrbinc, et al
Appl. No.: 11/577,414
International Filing Date: October 19, 2005
Title: SOLID PHARMACEUTICAL COMPOSITION COMPRISING DONEPEZIL HYDROCHLORIDE
Attorney Docket No.: 0183.12
Pub. No.: 2008/0063705 A1
Pub. Date: May 13, 2008

This is a decision on the request for corrected of patent application publication under 37 CFR 1.221(b), received on May 13, 2008, 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.

It would greatly benefit the Office if **applicant did not provide copies of papers**, which were previously submitted and/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.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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18 JUN 2007

Barry A. Stein
Caesar, Rivise, Bernstein, Cohen & Pokotilow, Ltd.
1635 Market Street, 12th Floor
Seven Penn Center
Philadelphia, PA 19103

In re Application of :
LANE, et al. :
U.S. Application No.: 11/577,457 :
PCT No.: PCT/US05/34520 : DECISION ON PETITION
Int. Filing Date: 27 September 2005 :
Priority Date: 26 October 2004 : UNDER 37 CFR 1.182
Attorney's Docket No.: L1143/20004 :
For: DEVICE AND METHOD FOR INDICATING :
PATRON USAGE OF A DRINK AND/OR SEAT :

This decision is in response to applicant's "Petition Under 37 CFR §1.182" filed 12 June 2007 in the United States Patent and Trademark Office (USPTO) to correct the error in the Transmittal Letter filed 18 April 2007. Applicant is advised that the petition fee for a petition filed under 37 CFR 1.182 is $400.00. As authorized, this fee will be charged to deposit account number 03-0075.

## BACKGROUND

On 27 September 2005, applicant filed international application PCT/US05/34520, which claimed priority of an earlier U.S. application filed 26 October 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 26 April 2007.

On 18 April 2007, 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 application data sheet and a preliminary amendment. The EFS-Web transmittal information identified the international application number as PCT/US02/34520.

On 05 June 2007, applicant filed an executed declaration.

On 12 June 2007, applicant filed the present petition under 37 CFR 1.182.

## DISCUSSION

The identifying information provided on the application data sheet and accompanying papers filed by applicant on 18 April 2007, i.e., the title, applicant-inventor information, priority

date, and international filing date all correspond to that of PCT/US05/34520. For these reasons, as well as the explanation provided in the present petition, it has been concluded that the national stage papers filed 18 April 2007 sufficiently identified international application PCT/US05/34520. Pursuant to petitioner's request, the national stage papers assigned U.S. application number 11/577,457 will be treated as a U.S. national stage submission for PCT/US05/34520.

## 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 11/577,457 as the U.S. national stage application of PCT/**US05**/34520; specifically, the consideration of applicant's declaration filed 05 June 2007 and if appropriate 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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**OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.**
**1940 DUKE STREET**
**ALEXANDRIA VA 22314**

MAILED

JUN 21 2010

OFFICE OF PETITIONS

In re Application of :
Sergey Aleynikov :
Application No. 11/577,468 : DECISION ON PETITION
Filed: April 2, 2008 : TO WITHDRAW
Attorney Docket No. 307051US30PCT : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 17, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. 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 Bradley D. Lytle on behalf of all attorneys/agents associated with customer number 22850. All attorneys/agents of record have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The correspondence address has been changed and is copied below.

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: Sergey Aleynikov
c/o IDT Corporation
520 Broad Street
Newark, NJ 07102

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 11/577,468 | 04/02/2008 | Sergey Aleynikov | 307051US30PCT |

**CONFIRMATION NO. 4602**

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

**POWER OF ATTORNEY NOTICE**

*OC00000042207275*

Date Mailed: 06/21/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 05/17/2010.

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

/kainabinet/

---

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

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11 SEP 2007

PHILIPS ELECTRONICS NORTH AMERICA CORPORATION
INTELLECTUAL PROPERTY & STANDARDS
370 W. TRIMBLE ROAD MS 91/MG
SAN JOSE CA 95131

| | |
|---|---|
| In re Application of FERK et al. | |
| Application No.: 11/577,473 | DECISION ON PETITION |
| PCT No.: PCT/IB05/53322 | |
| Int. Filing: 10 October 2005 | UNDER 37 CFR 1.47(a) |
| Priority Date: 18 October 2004 | |
| Attorney Docket No.: NL041150US1 | |
| For: SCISSORS AND DRIVES FOR SCISSORS | |

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 27 June 2007, to accept the application without the signature of joint inventor, Reinhard Ferk.

## BACKGROUND

On 18 April 2007, 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 08 June 2007, 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 27 June 2007, applicant filed the instant petition along with a declaration, executed by the joint inventor on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor, Reinhard Ferk alleging that Mr. Ferk refuses to sign the application.

## DISCUSSION

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

The petition included the requisite petition fee which will be charged to applicant's deposit account per his authorization, satisfying Item (1). With regard to item (4), the declaration

executed by the available joint inventors on their behalf and on behalf of the non-signing inventor was submitted and is in compliance with 37 CFR 1.497(a) and (b). Thus, Item (4) is satisfied. However, Item (3) is not satisfied because the last known address of the non-signing inventor was not provided.

With respect to Item (2)[1] above, Petitioner provided a first hand statement of facts of Helmut Weber, a European patent attorney, in support of the petition under 37 CFR 1.47(a). According to Mr. Weber on 15 March 2006, he contacted nonsigning inventor Ferk by telephone, informing him that he would send him documents for signing. Unfortunately, Mr. Weber does not clearly state which invention or application he is referring to and which documents he would send.

Mr. Weber further indicates that notes he made regarding the telephone calls to Mr. Ferk are attached as "Attachment A3" and "Attachment A5". However, these records are in the German language; an English translation is necessary for such evidence to be considered. Likewise email communications (Attachment A1et seq.) were submitted as evidence of Mr. Ferk's refusal. However, these emails were also in the German language. An English translation of these documents is also required.

---

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

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or , if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... *It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray*, 115 USPQ 80 ( Comm'r Pat. 1956)
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

(Emphasis added.)

Moreover, from the evidence presented, it is clear that inventor Ferk was not presented with a complete copy of the application papers, including *specification, claims and drawings* and declaration. What is required is that Mr. Ferk be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for this application. Such is required before it can be concluded that the inventor refuses to sign. 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. Thus, it cannot be concluded that Mr. Ferk refused to sign the application at issue here as the evidence does not support such conclusion. See MPEP Section 409.03 for further details in the preparation of a renewed petition under 37 CFR 1.47(a).

In sum, Petitioner has satisfied Items (1) and (4) above. However, Petitioner has not satisfied (3). The nonsigning inventor's last known address is required. 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 11/577,473 (specification, including claims, drawings, and declaration)* to the nonsigning inventor for his signature and (2) Mr. Ferk's refusal to sign, either in writing or by telephone, these documents. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

## CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Office of PCT Legal Administration

Telephone: (571) 272-3286
Facsimile (571) 272-0459

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PHILIPS ELECTRONICS NORTH AMERICA CORPORATION
INTELLECTUAL PROPERTY & STANDARDS
370 W. TRIMBLE ROAD MS 91/MG
SAN JOSE CA 95131

In re Application of FERK et al.
Application No.: 11/577,473
PCT No.: PCT/IB05/53322
Int. Filing: 10 October 2005
Priority Date: 18 October 2004
Attorney Docket No.: NL041150US1
For: SCISSORS AND DRIVES FOR SCISSORS

: DECISION ON PETITION
: UNDER 37 CFR 1.47(a)

This is a decision on applicant's renewed petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 14 December 2007, to accept the application without the signature of joint inventor, Reinhard Ferk.

## BACKGROUND

On 18 April 2007, 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 08 June 2007, 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 27 June 2007, applicant filed a petition along with a declaration, executed by the joint inventor on behalf of the nonsigning inventor. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signature of inventor, Reinhard Ferk alleging that Mr. Ferk refuses to sign the application.

On 11 September 2007, a decision dismissing the petition was mailed to applicant indicating that the last known address of the non-signing inventor was not provided and that Petitioner has not demonstrated a *bona fide* attempt was made to present a copy of the application papers for U.S. application 11/577,473 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature and Mr. Ferk's refusal to sign the application papers.

On 14 December 2007, Petitioner filed a renewed petition under 37 CFR 1.47(a).

## DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Petitioner previously satisfied Items (1) and (4). Item (3) is now satisfied because the last known address of the non-signing inventor has been provided.

With respect to Item (2) above, Petitioner provided a first hand statement of facts of Daniel L. Michalek, Sr. Intellectual Property Administrator for Philips Intellectual Property & Standards of Koninklijke Philips Electronics, N.V., in support of the petition under 37 CFR 1.47(a). According to Mr. Michalek, on 17 September 2007, he sent, via Federal Express, a copy of the patent application 11/557,473 including specification, drawings, declaration, and assignment to the nonsigning inventor Reinhard Ferk for review and signature. A copy of the Federal Express Track Shipment Detailed Results was attached to his statement, which indicates that delivery to Mr. Ferk's last known address occurred on 20 September 2007. Thereafter, on 08 October 2007, Mr. Ferk sent Mr. Michalek an email indicating receipt of the documents. On the same day, Mr. Michalek phoned Mr. Ferk, wherein Mr. Ferk informed him of his refusal to sign the declaration and assignment.

From the evidence presented, it is clear that inventor Ferk was presented with a complete copy of the application papers, including specification, claims and drawings and declaration and that he refused to sign the declaration. Thus, it can concluded that Mr. Ferk refused to sign the application at issue here as the evidence now supports such conclusion.

In sum, Petitioner has satisfied Items (1) - (4) above. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

## CONCLUSION

The petition under 37 CFR §1.47(a) is **GRANTED**.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 27 June 2007. The application has an international filing date of 10 October 2005 under 35 U.S.C. 363, and a date of 27 June 2007 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.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Office of PCT Legal Administration

Telephone: (571) 272-3286
Facsimile (571) 272-0459

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**NEW YORK, NY 10036-8403**

**MAILED**

APR 0 2 2009

**OFFICE OF PETITIONS**

In re Application of :
Narifumi **TOJIMA, et al.** :
Application No. 11/577,484 : DECISION GRANTING PETITION
Filed: April 18, 2007 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. **P/2850-174 V3573** :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 31, 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 February 26, 2009 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 2837 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

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[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment of the application.*

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SUITE 1600
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|---|---|---|
| In re Application of | : | |
| MACMAHON et al. | : | |
| Application No.: 11/577,519 | : | DECISION |
| PCT No.: PCT/GB2005/004106 | : | |
| Int. Filing Date: 24 October 2005 | : | |
| Priority Date: 22 October 2004 | : | |
| Attorney Docket No.: 1410-67709 | : | |
| For: PAD FOR PREPARING A BEVERAGE | : | |

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 19 October 2007 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 24 October 2005, applicants filed international application PCT/GB2005/004106, which designated the United States and claimed a priority date of 22 October 2004. A copy of the international application was communicated from the International Bureau to the USPTO on 27 April 2006. The thirty-month period for paying the basic national fee in the United States expired at midnight on 23 April 2007 (22 April 2007 being a Sunday).

On 19 April 2007, 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 July 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) were required.

On 19 October 2007, 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 declaration of inventors, the surcharge under 37 CFR 1.492(h), a declaration of facts by Devon R. Gorski-Hanshaw, a copy of a return package form from a delivery service, and a copy of an Internet database search for non-signing inventor Satwinder Panesar.

## 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 Deposit Account 06-1135. Thus, item (1) has been met.

Items (3) and (4) have also been met.

Item (2) has been met regarding non-signing inventor Satwinder Panesar. However, item (2) has not been met regarding non-signing inventor Heather Hudson. A communication was delivered to Heather Hudson on 21 September 2007. As of the date of the filing of the petition, Ms. Hudson had not responded to the 21 September 2007 communication. However, a copy of the communication sent to Ms. Hudson has not been provided. Nor has a copy of a receipt of the package by Ms. Hudson been provided. Additionally, there does not appear to have been any follow-up, either by letter or by phone, with Ms. Hudson regarding the communication. Mr. Hudson could have received the documents and simply forgotten about them. Follow-up to the 21 September 2007 communication is required to establish a refusal to sign.

## CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. **Failure to timely file the proper response will result in abandonment of this application.** Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

/Daniel Stemmer/

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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| In re Application of | : | |
| MACMAHON et al. | : | |
| Application No.: 11/577,519 | : | DECISION |
| PCT No.: PCT/GB2005/004106 | : | |
| Int. Filing Date: 24 October 2005 | : | |
| Priority Date: 22 October 2004 | : | |
| Attorney Docket No.: 1410-67709 | : | |
| For: PAD FOR PREPARING A BEVERAGE | : | |

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 28 January 2008 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 24 October 2005, applicants filed international application PCT/GB2005/004106, which designated the United States and claimed a priority date of 22 October 2004. A copy of the international application was communicated from the International Bureau to the USPTO on 27 April 2006. The thirty-month period for paying the basic national fee in the United States expired at midnight on 23 April 2007 (22 April 2007 being a Sunday).

On 19 April 2007, 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 July 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h) were required.

On 19 October 2007, 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 declaration of inventors, the surcharge under 37 CFR 1.492(h), a declaration of facts by Devon R. Gorski-Hanshaw, a copy of a return package form from a delivery service, and a copy of an Internet database search for non-signing inventor Satwinder Panesar.

On 26 November 2007, a decision was mailed dismissing applicants' petition under 37

CFR 1.47(a) without prejudice. Specifically, factual proof that the missing joint inventor Heather Hudson refuses to execute the application or cannot be reached after diligent effort had not been provided.

On 28 January 2008, applicants submitted the instant renewed petition under 37 CFR 1.47(a), which was accompanied by a second declaration of facts by Devon R. Gorski-Hanshaw, a declaration of facts by Joseph E. Shipley, copies of delivery confirmations, and copies of internet searches.

## 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 26 November 2007, items (1), (3), and (4) have been met for both non-signing inventors Satwinder Panesar and Heather Hudson and item (2) has been met for non-signing inventor Satwinder Panesar.

Item (2) has now been met for non-signing inventor Heather Hudson.

## CONCLUSION

For the reasons set forth above, 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 **19 October 2007**.

/Daniel Stemmer/

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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Satwinder Panesar
18 Lethen View
Tullibody
Alloa
United Kingdon FK 10 2 GE

In re Application of
MACMAHON et al.
Application No.: 11/577,519
PCT No.: PCT/GB2005/004106
Int. Filing Date: 24 October 2005
Priority Date: 22 October 2004
Attorney Docket No.: 1410-67709
For: PAD FOR PREPARING A BEVERAGE

Dear Mr. Panesar:

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/

Daniel Stemmer
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

FITCH EVEN TABIN & FLANNERY
120 S. LASALLE STREET
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Heather Hudson
11334 Silver Oak Lane
Stonebridge Estates Development
San Diego, CA 92131

In re Application of
MACMAHON et al.
Application No.: 11/577,519
PCT No.: PCT/GB2005/004106
Int. Filing Date: 24 October 2005
Priority Date: 22 October 2004
Attorney Docket No.: 1410-67709
For: PAD FOR PREPARING A BEVERAGE

Dear Ms. Hudson:

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/

Daniel Stemmer
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

FITCH EVEN TABIN & FLANNERY
120 S. LASALLE STREET
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Suite 1600
Chicago, IL 60603-3406

In re Application of
MACMAHON *et al*
U.S. Application No.: 11/577,525
PCT No.: PCT/GB2005/004104
Int. Filing Date: 24 October 2005
Priority Date: 22 October 2004
Attorney Docket No.: 1410-67708
For: FLEXIBLE PAD FOR PREPARING A BEVERAGE

**DECISION**

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed 05 February 2008.

## BACKGROUND

On 21 December 2007, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 05 February 2008, applicants filed the instant petition which was accompanied by, *inter alia*, the $130.00 surcharge fee; a declaration executed by six joint inventors; declarations by Devon R. Gorski-Hanshaw and Joseph E. Shipley; and other documentary evidence.

## DISCUSSION

Applicants claim that they are unable to be reach two of the inventors after diligent effort and have filed the subject petition under 37 CFR 1.47(a) in response to the Form PCT/DO/EO/905 mailed 21 December 2007.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor(s) cannot be located or refuse(s) to cooperate; (3) a statement of the last known address(es) of the nonsigning joint inventor(s); (4) and an oath or declaration executed by the signing joint inventor(s) on their behalf and on behalf of the nonsigning joint inventor(s). Items (1), (2) and (3) are satisfied.

Concerning item (1), the $200.00 petition fee has been charged to Deposit Account No. 06-1135 as authorized.

Regarding item (2), for co-inventor, Satwinder Panesar, the 37 CFR 1.47(a) applicants claim that a complete copy of the subject application was provided to his current address at 18 Lethan View, Tullibody, Alloa, United Kingdom FK 10 2 GE on 23 August 2007. In his declaration Mr. Gorski-Hanshaw states that he "received a call from our shipping company, Mercury ship, reporting that Mr. Panesar refused to accept the package." A copy of the letter from Mercury Express Mail Delivery Management states that the recipient refused delivery. This conduct constitutes a refusal as contemplated in section 409.03(d) of the MPEP, *Refusal to Join*.

For co-inventor, Heather Hudson, the 37 CFR 1.47(a) applicants claim that she cannot be located. A review of the evidence supports applicants claim that a 'diligent effort' was made to contact Ms. Hudson. This evidence included a statement of facts outlining the steps taken to locate Ms. Hudson in the declaration of Mr. Gorski-Hanshaw, copies of the correspondence sent to her last known address, documentary evidence of searches for Ms. Hudson made in the internet and a statement by counsel of telephone calls placed to her cell and home phone numbers. Counsel states that he believed that the cell phone number was Ms. Hudson's and left a message to return the call. Ms. Hudson has not yet contacted petitioners as of the date of filing the petition. This is sufficient to meet the requirements of section 409.03(d) of the MPEP, *Inventor Cannot Be Reached*. Item (2) is satisfied for both inventors.

With regards to item (3), the last known addresses for both Mr. Panesar and Ms. Hudson were provided in the petition. This meets the requirements of § 409.03(e) MPEP and is sufficient to satisfy item (3).

With regards to item (4), the 37 CFR 1.47(a) applicants submitted a declaration signed by six of the nine named inventors on their own behalf and on behalf of the nonsigning joint inventors as required by item (4) of 37 CFR 1.47(a). Two of the missing inventors are discussed in the subject petition.

The international publication ("WO 2006/043102") also lists Mark NORTON as an inventor in PCT/GB2005/004104. However, the declaration provided in the subject national phase application does **not** list Mr. Norton as an inventor. There is also no record that a change pursuant to PCT Rule 92*bis* was made and accepted in the international application removing Mr. Norton as an inventor in the international application. Accordingly, this declaration is not accepted.

If Mr. Norton is not an inventor, applicants must show either that Mr. Norton was removed as an inventor in the international application, or file a petition under 37 CFR 1.497(d) to remove an inventor for the declaration to be in compliance with 37 CFR 1.497(a) and (b). If, on the other hand, Mr. Norton is still an inventor, applicants must

explain why the declaration was submitted listing the wrong inventive entity and why the other inventors executed this declaration. Applicants must also provide a new declaration signed by the proper inventive entity.

For the reasons noted above, applicants have not yet satisfied item (4) of 37 CFR 1.47(a).

## CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web, or if mailed 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.

James Thomson
Attorney Advisor
Office of PCT Legal Administration
(571) 272-3302

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120 S. Lasalle Street
Suite 1600
Chicago, IL 60603-3406

In re Application of :
MACMAHON *et al* :
U.S. Application No.: 11/577,525 :
PCT No.: PCT/GB2005/004104 :
Int. Filing Date: 24 October 2005 : **DECISION**
Priority Date: 22 October 2004 :
Attorney Docket No.: 1410-67708 :
For: FLEXIBLE PAD FOR PREPARING A BEVERAGE :

This decision is in response to applicants' renewed petition under 37 CFR 1.47(a) filed 12 May 2008.

## BACKGROUND

On 10 March 2008, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed. Applicants failed to satisfy item (4) of 37 CFR 1.47(a). Applicants were given two months to respond.

On 12 May 2008, applicants filed a renewed petition which was accompanied by, *inter alia*, a declaration executed by seven of the nine co-inventors on behalf of the two nonsigning joint inventors.

## DISCUSSION

As previously stated, a petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor(s) cannot be located or refuse(s) to cooperate; (3) a statement of the last known address(es) of the nonsigning joint inventor(s); (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors.

Items (1), (2) and (3) were completed in the initial petition.

Concerning item (4), the 37 CFR 1.47(a) applicant submitted another copy of the declaration previously submitted, this time including the page signed by co-inventor, Mark Norton. Applicants' state that this page was inadvertently excluded in the original petition as the signature page was double-sided and the reverse side, which Mr. Norton had signed, was left out. This explanation is acceptable.

The declaration is signed by seven of the nine co-inventors on behalf of themselves and the nonsigning joint inventors. This declaration complies with 37 CFR 1.497(a) and (b) and meets the requirements of section 409.03(a) of the MPEP. Item (4) of 37 CFR 1.47(a) is now satisfied.

All requirements of 37 CFR 1.47(a) are complete.

## CONCLUSION

Applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 24 October 2005 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 12 May 2008.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record and will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

UNITED STATES PATENT AND TRADEMARK OFFICE

0 3 JUL 2008

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Mr. Satwinder Panesar
18 Lethen View
Tullibody, Alloa
United Kingdom FK 10 2 GE

In re Application of
MACMAHON *et al*
U.S. Application No.: 11/577,525
PCT No.: PCT/GB2005/004104
Int. Filing Date: 24 October 2005
Priority Date: 22 October 2004
Attorney Docket No.: 1410-67708
For: FLEXIBLE PAD FOR PREPARING A BEVERAGE

Mr. Panesar:

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

U.S. Counsel: FITCH EVEN TABIN & FLANNERY
120 S. Lasalle Street
Suite 1600
Chicago, IL 60603-3406

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03 JUL 2008

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Ms. Heather Hudson
11334 Silver Oak Lane
Stone Bridge estates Development
San Diego, CA 92131

In re Application of
MACMAHON *et al*
U.S. Application No.: 11/577,525
PCT No.: PCT/GB2005/004104
Int. Filing Date: 24 October 2005
Priority Date: 22 October 2004
Attorney Docket No.: 1410-67708
For: FLEXIBLE PAD FOR PREPARING A BEVERAGE

Ms. Hudson:

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

U.S. Counsel: FITCH EVEN TABIN & FLANNERY
120 S. Lasalle Street
Suite 1600
Chicago, IL 60603-3406

19 MAY 2009
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Foley and Lardner LLP
Suite 500
3000 K Street NW
Washington, D.C. 20007

| | | |
|---|---|---|
| In re Application of: | : | |
| SCHWARTZ, Craig A. | : | DECISION |
| U.S. Application No.: 11/577,529 | : | |
| PCT No.: PCT/US05/37713 | : | |
| International Filing Date: 21 October 2005 | : | |
| Priority Date: 21 October 2004 | : | |
| Attorney's Docket No.: 041828-0107 | : | |
| For: BARRIER SYSTEM FOR PROTECTION AGAINST LOW-FLYING PROJECTILES | : | |

This is in response to "Request for Withdrawal as Attorney or Agent and Change of Correspondence Address" filed 07 January 2009 which is being treated as a Petition to Withdraw from Representation under 37 CFR 1.36. No petition fee is required.

## DISCUSSION

The criteria for effecting a proper withdrawal of attorney are spelled out in Section 402.06 of the Manual of Patent Examining Procedure (M.P.E.P.) which reads, in part, as follows:

> In the event that a notice of withdrawal is filed by an attorney or agent of record . . . appropriate procedure will be followed pertaining to the withdrawal. The withdrawal is effective when approved rather than when received.
>
> To expedite the handling of requests for permission to withdraw as attorney or agent, under 37 CFR 1.36, Form PTO/SB/83 may be used. Because the Office does not recognize law firms, each attorney of record must sign the notice of withdrawal, or the notice of withdrawal must contain a clear indication of one attorney signing on behalf of another.

Since all of the criteria delineated in Section 402.06 of the M.P.E.P. have been met, Petition to Withdraw from Representation under 37 CFR 1.36 is **GRANTED** and is effective as of the mail date of this decision.

All communications will be forwarded to:

Craig A. Schwartz
6514 Mink Hollow Road
Highland, MD 20777

## CONCLUSION

In view of the above discussion, counsel's Request for Withdrawal is **GRANTED**.

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

cc: Craig A. Schwartz
6514 Mink Hollow Road
Highland, MD 20777

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. |
|---|---|---|---|---|
| 11/577,552 | 04/19/2007 | Hiroyuki Nakashinden | 09792909-6962 | 5575 |

7590 08/31/2009

SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, WILLIS TOWER
CHICAGO, IL 60606-1080

| EXAMINER | |
|---|---|
| VO, ANH T N | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2861 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/31/2009 | 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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MILLER MATTHIAS & HULL
ONE NORTH FRANKLIN STREET
SUITE 2350
CHICAGO IL 60606

**COPY MAILED**

JUL 13 2009

**OFFICE OF PETITIONS**

In re Application of :
Christian Bratu :
Application No. 11/577,563 : DECISION ON
Filed: April 19, 2007 : PETITION
Attorney Docket No. 28944/50077 :

This is in response to the petition to revive under 37 CFR 1.137(b), filed June 9, 2009.

The petition under 37 CFR 1.137(b) is **GRANTED**.

The above application became abandoned for failure to timely file corrected drawings in response to the Notice of Allowability, mailed February 4, 2009. This Notice set a statutory period for reply of three months. No reply having been received, the application became abandoned on May 5, 2009. The Office mailed a Notice of Abandonment on June 3, 2009.

With the instant petition, applicant paid the petition fee, submitted the required reply in the form of drawings, and made the proper statement of unintentional delay.

The matter is being forwarded to the Office of Data Management for processing into a patent.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

19 NOV 2008

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United States Patent and Trademark Office
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LEMPIA BRAIDWOOD LLC
223 W. JACKSON BLVD.
SUITE 620
CHICAGO IL 60606

| | | |
|---|---|---|
| In re Application of | : | |
| THOMAS | : | |
| Application No.: 11/577,579 | : | DECISION |
| PCT No.: PCT/EP2005/010947 | : | |
| Int. Filing Date:12 October 2005 | : | |
| Priority Date: 21 October 2004 | : | |
| Attorney's Docket No.: 10112-07 GZT-01 | : | |
| For: STAR-SHAPED DECORATIVE OBJECT | : | |

This decision is in response to applicant's petitions under 37 CFR 1.137(b) filed 30 August 2007 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 12 October 2005, applicants filed international application PCT/EP2005/010947, which designated the U.S. and claimed a priority date of 21 October 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 04 May 2006. The thirty-month period for paying the basic national fee in the United States expired at midnight on 23 April 2007 (21 April 2007 being a Saturday).

On 19 April 2007, applicants filed a submission for entry into the national stage in the United States. The submission did not include the U.S. Basic National Fee.

On 27 August 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States of America for failure to pay the U.S. Basic National Fee within 30 months of the priority date.

On 30 August 2007, applicants filed the instant petition under 37 CFR 1.137(b). The petition did not include any fees or an authorization to charge any fees.

## 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), the basic national fee was submitted on 30 August 2007.

As to item (2), applicant submitted the petition fee on 30 August 2007

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.

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 executed oath or declaration of the inventor in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(h).

/Daniel Stemmer/

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 11/577,583 | 04/19/2007 | Masako Shimura | 049441-0148 | 5892 |

22428 7590 03/25/2009

FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

| EXAMINER |
|---|
| MELLER, MICHAEL V |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1655 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/25/2009 | 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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MAR 25 2009

Stephen A. Bent
FOLEY & LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

| | |
|---|---|
| In re Application of | : |
| SHIMURA et al. | : |
| Serial No.: 11/577,583 | : PETITION DECISION |
| Filed: October 21, 2005 | : |
| Attorney Docket No.: 049441-0148 | : |

This is in response to the petition under 37 CFR 1.181 and 1.144, filed November 7, 2008, requesting the Director to reconsider the lack of unity requirement. The delay in acting upon this petition is regretted.

**BACKGROUND**

This application is a national stage filing under 35 USC 371 of PCT/JP05/19415 and, as such, is eligible for PCT unity of invention practice.

On December 20, 2007, the examiner mailed a restriction requirement in which claims 1-52 were divided in 4 groups. The examiner further required an election of species.

On March 3, 2008, applicants responded by electing Group II (claims 40-49) without traverse. Applicants elected the specific compound "tetrahydroisohumulone" and specific disease "eye disease" with traverse.

On May 9, 2008, the examiner prepared a non-final Office action. The examiner asserted that because WO03/035007 teaches the tetrahydroisohumulone, the claims lack unity. The examiner made the requirement final. Claims 40-49 were rejected under 35 USC 112, 1st paragraph for lack of written description and under 35 USC 102(b) and 103 as being anticipated by and unpatentable over WO03/035007.

On November 7, 2008, applicants filed this petition to request that the Office reconsider the lack of unity determination, along with amendments to the claims and a response to the non-final rejections.

**DISCUSSION**

The petition and file history have been carefully considered.

At the onset, it is noted that because this application has been filed under 35 USC 371, it is entitled to PCT unity of invention rules. However the restriction requirement was incorrectly set forth under US restriction requirement rules. In this decision, PCT unity of invention rules will be applied to the currently pending claims.

A) Consideration of Unity of Invention Among Group I and Group II

The petition requests that the restriction requirement between Groups I and II be withdrawn because these groups share a technical relationship. This argument has been considered but is not deemed persuasive for the following reasons.

Group I is directed to composition and a food/medicine. Group II is directed to a method of using the composition of Group I. Unity may be found lacking when the same or corresponding technical feature does not make a contribution over the prior art. See PCT Rule 13.2. In this instance, Groups I and II do not share a technical feature which makes a contribution over the prior art in view of WO03/035007 so unity of invention between Group I and II is lacking.

B) Consideration of requirement to elect a compound and a disease

The response asserts that the Examiner's treatment of the various compound/disease pairs as separate inventions rather than distinct species is improper because unity of invention is not lacking. The petition cites PCT Rule 13.1 and 13.2, and MPEP 803.02 for the proposition that restriction can only be required where there is a lack of unity.

PCT Rule 13.2 states that unity of invention is present when the groups share a technical feature that makes a contribution over the prior art. The petition states that each of the claims 40-49 recites "isohumulones" or "isomerized hop extract". However, this broad feature does not make a contribution over the prior art in view of the outstanding prior art rejections which apply to claims 40-49. For this reason, claims 40-49 share fail to provide a special technical feature over the art and with the claims under examination. Since all claims to the elected method have been examined and rejected under 35 USC 102 and 103 and under 35 USC 112, 1st paragraph, any further examination of the broad generic claim or any non-elected species is not required at this time.

Applicant is correct that in view of the presence of the generic linking claim 40, the election of a single species of compound and disease can not be treated as a restriction to a single invention. The election of species requirement for a single disease and compound will be examined as such, following MPEP 803.02, 809 and 821.04.

**DECISION**

The petition is **GRANTED-IN-PART** for the reasons set forth above.

The restriction requirement made between Group I and II is maintained.

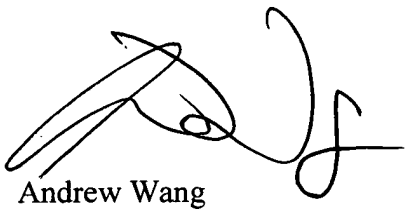
The election of a single species of disease and compound is maintained, in view of the fact that there is no allowable generic claim that encompasses the elected and non-elected species.

In view of the presence of the generic linking claim 40, the election of a single species of compound and disease will not be treated as a restriction to a single invention. The election of species requirement for a single disease and compound will be examined as such, following the guidance in MPEP 803.02, 809 and 821.04.

**The application will be forwarded to the examiner for further action consistent with this decision and for consideration of the papers filed November 7, 2008. Should a generic claim become allowable, the unity of invention requirement amongst any species encompassed by the allowable generic claim should be withdrawn per MPEP 821.04.**

Any request for reconsideration must be filed within two (2) months of the mailing date of this decision.

Should there be any questions about this decision, please contact Quality Assurance Specialist Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-0512 or by facsimile sent to the general Office facsimile number, 571-273-8300.



Andrew Wang
(Acting) Director, Technology Center 1600
jb/jg

UNITED STATES PATENT and TRADEMARK OFFICE

26 JUN 2009

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WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA PA 19104-2891

| | | |
|---|---|---|
| In re Application of | : | |
| MUSTELIN et al | : | DECISION ON |
| Application No.: 11/577,591 | : | |
| Int. Application: PCT/US2005/037537 | : | |
| Int. Filing Date: 19 October 2005 | : | REQUEST UNDER |
| Priority Date: 21 October 2004 | : | |
| Attorney's Docket No.: BURN-0044 | : | |
| For: COMPOSITIONS AND METHOD... | : | |
| YERSINIA SPP INFECTION | : | 37 CFR 1.497(d) and 1.181 |

This is a decision on applicants' "PETITION TO ADD NAME OF OMITTED INVENTOR UNDER 37 CFR 1.497(d) ... OF DEFECTIVE RESPONSE" filed on 15 September 2008, which is being treated as a request under 37 CFR 1.497(d) to add joint inventor Lutz TAUTZ in the executed declaration.

## BACKGROUND

On 19 October 2005, applicant filed international application No. PCT/US2005/037537, which claims a priority date of 21 October 2004.

On 19 April 2007, applicant 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 was filed at such time.

On 09 May 2008, 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 1.47(a) and (b), identifying the application by International application number and international filing date... is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68" must be submitted within two months from date of this Notice or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 13 June 2008, applicants filed an executed declaration.

On 21 July 2008, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916), which indicated that, inter alia, that Lutz TAUTZ.

On 15 September 2008, applicants filed a "Request under 37 CFR 1.497(d)," which included, *inter alia*, an executed declaration and a request to add Lutz TAUTZ, who was not originally listed in the PCT application, as an inventor in the above-identified patent application.

## DISCUSSION

### 37 CFR 1.497(d):

A submission under 37 CFR 1.497(d) must include:

> (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
>
> (2) the fee set forth in § 1.17(i); and
>
> (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see 37 CFR §3.73(b) of this chapter).

A review of the application file reveals that applicants have satisfied items (1) - (3) under 37 CFR 1.497(d).

With respect to item (1), the statement submitted by Lutz TAUTZ is sufficient because the statement states that the error in inventorship occurred without a deceptive intent.

With respect to item (2), the processing fee of $130.00 has been paid.

With respect to item (3), Burnham Institute, the assignee, consents to the correction of inventorship to the above application and it has filed in the requisite papers establishing their right to take action under 37 CFR §3.73(b). In addition, Margaret M. Dunbar has authorization to act on behalf of the assignee.

Accordingly, the requests are deemed to satisfy requirements (1), (2), and (3) under 37 CFR 1.497(d).

For the reasons above, the request under 37 CFR 1.497(d) is **GRANTED.**

### CORRECTION OF SPELLING (37 CFR 1.181):

The correct middle name of the first joint-inventor is "Mikael" so it reads as Tomas **Mikael** MUSTELIN as filed in the executed declaration on 13 June 2008, and not as it appeared in the publication of the international application, which the middle name was spelled as "Michael." Accordingly, the correct name, Tomas **Mikael** MUSTELIN, now appears in the declaration as filed on 13 June 2008 to the USPTO.

## DECISION

For the reasons above, the petition under 37 CFR 1.181 is **GRANTED** that the correct spelling of the first joint inventor is Tomas **Mikael** MUSTELIN.

## CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **GRANTED.**

For the reasons above, the petition under 37 CFR 1.181 is **GRANTED.**

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing consistent with this decision.

Rafael Bacares
~~PCT~~ Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 272-0459

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LUCAS & MERCANTI, LLP
475 PARK AVENUE SOUTH
15TH FLOOR
NEW YORK NY 10016

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OCT 10 2008

OFFICE OF PETITIONS

In re Application of

Nguyen, et al.

Application No. 11/577,619

Filed: April 20, 2007

Attorney Docket No. INA-107

: DECISION ON

: PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 17, 2008, to revive the above-identified application.

The petition is **granted**.

This application became abandoned on August 20, 2008, for failure to file timely new corrected drawings as required by the Notice of Allowability mailed May 19,2008[1]. The aforementioned notice set forth a three (3) month statutory period for reply. No reply was received within the allowable period. A Notice of Abandonment was mailed on September 11, 2008.

The new corrected drawings and declaration, filed August 20, 2008, are noted.

The application is being forward to the Office of Patent Publication for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

[1] It is noted that a Supplemental Notice of Allowability was mailed on August 20, 2008, and on August 21, 2008. This notice did not indicate, however, that the Notice of Allowability mailed May 19, 2008, was withdrawn.

UNITED STATES PATENT and TRADEMARK OFFICE

21 AUG 2008

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FITCH, EVEN, TABIN & FLANNERY
120 South LaSalle Street, Suite 1600
Chicago, IL 60603-3406 U.S.A.

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| MacMahon et al | : | |
| PCT No.: PCT/GB2005/004117 | : | |
| Application No: 11/577,631 | : | |
| Int. Filing Date: 24 October 2005 | : | PETITION UNDER |
| Priority Date: 22 October 2004 | : | |
| Attorney's Docket No.: 1410-67710 | : | |
| For: POD FOR PREPARING A BEVERAGE | : | 37 CFR 1.47(a) |

This is in response to the "PETITION UNDER 37 CFR 1.47(a)" filed on 05 February 2008. The petition fee of $200.00 has been charged to petitioner's Deposit Account No. 06-1135 as specified in the petition.

## BACKGROUND

On 24 October 2005, petitioner filed international application PCT/GB2005/004117, which claimed priority to an earlier application filed 22 October 2004.

On 20 April 2007, 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 05 December 2007, 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... is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68" must be submitted within two months from the date of mailing or 32 months from the priority date for the application, whichever is later in order to avoid abandonment of the national stage application.

On 05 February 2008, petitioner filed, *inter alia*, the present petition in support of filing an executed Declaration without the signatures of Satwinder Panesar and Heather Hudson.

## 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:

**INVENTOR CANNOT BE REACHED:**

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under **37 CFR 1.47**, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.
>
> The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under **37 CFR 1.47**.
>
> Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under **37 CFR 1.47**. **37 CFR 1.43** may be available under these circumstances. See **MPEP § 409.02**. Such a petition under **37 CFR 1.47** will be dismissed as inappropriate.
>
> The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioner has satisfied requirements (1), (2), (3) and (4) under 37 CFR 1.47(a).

Regarding requirement (1), petitioner has provided the fee under 37 CFR 1.17(g).

Regarding requirement (2) the statements of Devon R. Gorski-Hanshaw and Joseph E. Shipley 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 inventors for their signature as stipulated under MPEP 409.03(d). In this instance, Devon R. Gorski-Hanshaw mailed Mr. Panesar and Ms. Hudson a copy of the application papers and their actions reflect a refusal on their part to sign the required papers.

Consequently, the current record does sufficiently establish Mr. Panesar and Ms. Hudson refusal to join in the application because petitioner has shown a *bona fide* attempt was made to deliver the complete application to them and that they refused to sign the required as evidenced by their actions.

Regarding requirement (3), petitioner has provided a statement of the last known addresses of the missing inventors.

Satwinder Panesar
18 Lethen View
Tullibody, Alloa
United Kingdom FK 10 2 GE

Heather Hudson
11334 Silver Oak Lane
Stonebridge Estates Development
San Diego, Ca 92131

Regarding requirement 4, petitioner has provided an executed declaration signed by John MacMahon, Mark Norton, Adam Fennel, Bary Zeller, Susan Bodett, Anilkumar Gaonkar and Lee Rowan on their behalf and on the behalf of the nonsigning joint inventors Satwinder Panesar and Heather Hudson.

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 **05 February 2008.**

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

21 AUG 2008

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Heather Hudson
11334 Silver Oak Lane
Stonebridge Estates Development
San Diego, Ca 92131

In re Application of
MacMahon et al
PCT No.: PCT/GB2005/004117
Application No: 11/577,631
Int. Filing Date: 24 October 2005
Priority Date: 22 October 2004
Attorney's Docket No.: 1410-67710
For: POD FOR PREPARING A BEVERAGE

Dear: Hudson

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

FITCH, EVEN, TABIN & FLANNERY
120 South LaSalle Street, Suite 1600
Chicago, IL 60603-3406 U.S.A.

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Satwinder Panesar
18 Lethen View
Tullibody, Alloa
United Kingdom FK 10 2 GE

In re Application of
MacMahon et al
PCT No.: PCT/GB2005/004117
Application No: 11/577,631
Int. Filing Date: 24 October 2005
Priority Date: 22 October 2004
Attorney's Docket No.: 1410-67710
For: POD FOR PREPARING A BEVERAGE

Dear: Panesar

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

FITCH, EVEN, TABIN & FLANNERY
120 South LaSalle Street, Suite 1600
Chicago, IL 60603-3406 U.S.A.

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**AKERMAN SENTERFITT**
**P.O. BOX 3188**
**WEST PALM BEACH, FL 33402-3188**

**MAILED**

MAY 15 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Michel Morand | : | |
| Application No. 11/577,691 | : | NOTICE |
| Filed: February 4, 2008 | : | |
| Attorney Docket No. 789-112 | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue patent under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-6059.

The patent file will be forwarded to the Files Repository.

Alicia Kelley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

24 JUN 2008

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SMITH IP SERVICES, P.C.
P.O. Box 997
Rockwall TX 75087

| | |
|---|---|
| In re Application of | |
| FREYER, Rune | |
| Application No.: 11/577,698 | DECISION ON PETITION |
| PCT No.: PCT/NO2005/000398 | UNDER 37 CFR 1.137(b) |
| Int. Filing Date: 21 October 2005 | |
| Priority Date: 22 October 2004 | |
| Attorney Docket No.: 2006-IP-019778 U1 US | |
| For: A METHOD AND A DEVICE FOR SETTING A CASING | |

The petition to revive under 37 CFR 1.137(b) filed 09 June 2008 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
Fax: (571) 273-0459

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0 2 DEC 2008

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27667
HAYES SOLOWAY P.C.
3450 E. Sunrise Dr., Suite 140
Tucson, AZ 85718

In re Application of :
CHIBA *et al* :
U.S. Application No.: 11/577,715 :
PCT No.: PCT/JP2005/005784 :
Int. Filing Date: 28 March 2005 : **DECISION**
Priority Date: 19 November 2004 :
Attorney Docket No.: SHIG CCIW0104QC :
For: BIO-CO-CR-MO ALLOY WITH ION ELUTION SUPPRESSED BY STRUCTURE CONTROL, AND PROCESS FOR PRODUCING SAME :

This decision is in response to applicants' petition filed on 25 August 2008 which is treated under 37 CFR 1.181 and is hereby **GRANTED** as follows:

A review of the above-captioned application reveals that an executed declaration was submitted upon initial entry into the national stage on 20 April 2007.

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 04 January 2008 stating that the declaration filed 20 April 2007 does not comply with 37 CFR 1.497(a) and (b) because the "International Application Number listed where Prior Foreign Applications number listed."

This statement is erroneous. The declaration filed 20 April 2007 is in compliance with 37 CFR 1.497(a) and (b).

As such, the Form PCT/DO/EO/905 mailed 04 January 2008 was sent, in error, and is hereby **VACATED**.

The 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 should be recorded as 20 April 2007, not 24 January 2008. Accordingly, 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 10 July 2008 are **VACATED**.

The $65.00 surcharge fee will be credited to Deposit Account No. 08-1391.

This application is being forwarded to the National Stage Processing Division of the

Office of PCT Operations for continued processing including mailing a corrected Notification of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) Indicating a 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 of 20 April 2007. A new filing receipt indicating a "Filing or 371(c) Date" of 20 April 2007 is also requested.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

29 JAN 2009

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WOMBLE CARLYLE SANDRIDGE & RICE, PLLC
ATTN: PATENT DOCKETING 32ND FLOOR
P.O. BOX 7037
ATLANTA GA 30357-0037

In re Application of :
Turin :
Application No. 11/577,776 :
PCT No.: PCT/US2005/022279 :
Int. Filing Date: 24 June 2005 : DECISION
Priority Date: 24 June 2004 :
Att. Docket No.: F081 1080US :
For: Novel Aldehydic Musks And :
Derivatives Thereof :

The petition to revive under 37 CFR 1.137(b) filed on 23 April 2007 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 for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional." Said statement is being accepted in satisfaction of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has filed the required reply in the form of the basic national fee. The $1500.00 petition fee (fee code 1453) is being charged to Deposit Account 09-0528, per the authorization included in the Transmittal Letter filed on 23 April 2007. 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 Office of Patent Application Processing for further processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

/George Dombroske/
George Dombroske
PCT Legal Examiner
Office of PCT Legal Administration
Tel: (571) 272-3283
Fax: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

16 MAY 2008

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Gerard F. Diebner
GREENBERG TRAURIG LLP
Met Life Building
200 Park Avenue, 34th Floor
New York, New York 10166

| | |
|---|---|
| In re Application of<br>SHAARI, Christopher<br>Application No.: 11/577,838<br>PCT No.: PCT/US2005/033982<br>Int. Filing Date: 23 September 2005<br>Priority Date: 23 September 2004<br>For: TREATING NEOPLASMS WITH NEUROTOXIN | DECISION ON<br><br>PETITION<br><br>UNDER 37 CFR 1.137(b) |

This decision is in response to applicant's "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 C.F.R. 137(b)" filed in the United States Patent and Trademark Office (USPTO) on 24 April 2007.

## BACKGROUND

Applicant filed international application PCT/US2005/033982, which designated the U.S. and claimed priority date of 23 September 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 23 March 2007. Accordingly, PCT/US2005/033982 became abandoned as to the United States of America at midnight 23 March 2007 for failure to timely pay the Basic National Fee.

On 24 April 2007, applicant filed a submission for entry into the national stage in the United States, which was accompanied by, inter alia, the U.S. Basic National Fee and a petition under 37 CFR 1.137(b).

## DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived 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), applicants have provided the required reply.

Regarding item (2), the $750 petition fee has been charged to Deposit Account No. 501561 as authorized by applicants.

Regarding item (3), the requisite statement has been provided.

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**.

This application is being referred to the National Stage Processing (DO/EO/US) for further processing in accordance with this decision,

Shian Luong
Special Programs Examiner
Office of PCT Legal Administration
Tel: (571) 272-4557
Fax: (571) 273-0459

Leonard Smith
Supervisory PCT Legal Examiner
Office of PCT Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

02 JUL 2008

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NORRIS, MCLAUGHLIN & MARCUS
875 THIRD AVE
18TH FLOOR
NEW YORK NY 10022

In re Application of:
CORRADINI, Fabio, et al.
U.S. Application No.: 11/577,844
PCT Application No.: PCT/GB2005/003897
International Filing Date: 10 October 2005
Priority Date: 29 October 2004
Attorney's Docket No.: 102792-733/11501P6
For: IMPROVEMENTS IN OR RELATING TO A WATER SOFTENING PRODUCT

DECISION ON PETITION
(37 CFR 1.182)

This decision is issued in response to applicant's "Petition Under 37 CFR 1.182" filed 18 June 2008. The $400 petition fee has been submitted.

## BACKGROUND

On 10 October 2005, applicant filed international application PCT/GB2005/003897. The international application claimed a priority date of 29 October 2004, and it designated the United States. On 04 May 2006, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for payment of the basic national fee in the United States was thirty months from the priority date, i.e., 29 April 2007.

On 24 April 2007, applicants submitted an application via the EFS-Web electronic filing system. The documents filed, including the preliminary amendment and the copy of the "Written Opinion Of The International Searching Authority" (Form PCT/ISA/237) and "International Search Report" (Form PCT/ISA/210), specifically identified the international application number as PCT/GB2005/003897. However, during the electronic filing process, applicants identified the international application number as PCT/GB2005/003987.

On 09 October 2007, applicants filed an executed declaration directed to international application PCT/GB2005/003897 and the $130 surcharge for filing the declaration later than thirty months after the priority date.

On 18 June 2008, applicants filed the "Petition Under 37 CFR 1.182" considered herein. The petition seeks to correct the error in the international application number provided during the

electronic filing process, so as to permit the present application to be treated as the U.S. national stage of PCT/GB2005/003897.

## DISCUSSION

As set forth above, the data entered by applicants during the electronic filing process incorrectly identified the international application to which the present national stage filing was directed. Correction of this error is required before the materials filed 24 April 2007 can be treated as having been directed to international application PCT/GB2005/003897, as necessary to avoid abandonment of this international application with respect to the United States.

In the present petition, applicants confirm that the identification of international application PCT/GB2005/003987 during the electronic filing process was the result of a typographical error and that the correct international application herein is PCT/GB2005/003897. The petition also notes that the correct international application number was contained in the papers filed on 24 April 2007, for example, the preliminary amendment. Finally, applicants have provided the required petition fee.

The present submission satisfies the requirements for a grantable petition to correct the inadvertent error in the international application number identified during the electronic filing process. Accordingly, the materials filed herein on 24 April 2007 will be treated as having been directed to international application PCT/GB2005/003897.

## CONCLUSION

Applicants' petition under 37 CFR 1.182 is **GRANTED**.

The materials filed herein on 24 April 2007 will be treated as the U.S. national stage of PCT/GB2005/003897.

The 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 09 October 2007.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

11 JUN 2009

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24504
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
600 Galleria Parkway, S.E.
Ste. 1500
Atlanta, GA 30339-5994

In re Application of :
KOCH *et al* :
U.S. Application No.: 11/577,855 :
PCT No.: PCT/CH2005/000626 :
Int. Filing Date: 25 October 2005 :
Priority Date: 25 October 2004 :
Attorney's Docket No.: 821628-1010 : **DECISION**
For: APPARATUS FOR STIMULATING THE :
HUMAN BODY BY MEANS OF :
VIBRATIONS :

The decision is in response to the petition under 37 CFR 1.47(b) submitted on 16 April 2009.

## BACKGROUND

On 26 January 2009, 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), additional claim fees and a surcharge fee were required. Petitioner was given two-months to respond with extensions of time available pursuant to 37 CFR 1.136(a).

On 16 April 2009, the 37 CFR 1.47(b) applicant submitted the instant petition which was accompanied by, *inter alia*, a $200.00 petition fee; a $130.00 surcharge fee; a one-month extension and $130.00 extension fee; a declaration signed by the 37 CFR 1.47(b) applicant; and other documentary evidence in support of the petition.

## DISCUSSION

The 37 CFR 1.47(b) applicant claims that both Michael Koch and Thomas Schuler refuse to cooperate and have filed the subject petition in response to the Form PCT/DO/EO/905 mailed 26 January 2009.

A petition under 37 CFR 1.47(b) requires (1) the petition fee, (2) factual proof that the inventors refuse to execute the application or cannot be located, (3) a statement of the last known addresses of the inventors, (4) an oath or declaration by

the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventors, (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. **Item (5) is not yet satisfied.**

The 37 CFR 1.47(b) applicant submitted the $200.00 petition fee. Item (1) is satisfied.

Concerning item (2), the 37 CFR 1.47(b) applicant provided a declaration by Jeroen Helfrich who states that he sent a complete copy of the subject application to the nonsigning inventors by registered mail along with instructions to cooperate on 13 February 2009. Copies of these letters and postal receipts were provided. The 37 CFR 1.47(b) applicant also provided a declaration by Jordi Kox who states that he sent an email to co-inventor Thomas Schuler on 27 February 2009 and a facsimile to co-inventor Michael Koch requesting a response to the 13 February 2009 letter. Both inventors responded several times and together on 12 March 2009 via email requesting additional royalties. Copies of the responses were provided. The 12 March 2009 response constitutes a written refusal to cooperate as contemplated by section 409.03(d)(II) of the MPEP. Item (2) is satisfied.

The last known addresses of both inventors are listed in the petition. Item (3) is satisfied.

Regarding item (4), section 409.03(b)(A) of the MPEP states that where a corporation is the 37 CFR 1.47(b) applicant, an officer normally signs the necessary declaration. Here, the 37 CFR 1.47(b) applicant provided a declaration signed by Mark C. Minter as President of Power Plate International Limited. This is sufficient to meet the requirements of sections 324 and 409.03(b)(A) of the MPEP. The name, address and citizenship of the nonsigning inventors are also recorded on the declaration pursuant to 37 CFR 1.497(a) and (b). Item (4) is satisfied.

With regard to item (6), section 409.03(g) of the Manual of Patent Examining Procedure (MPEP) states that "[i]rreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage." In the petition, the 37 CFR 1.47(b) applicant includes such a statement.

With regards to item (5), the 37 CFR 1.47(b) applicant claims proprietary interest in the above-captioned national stage application of PCT/CH2005/000626 by way of assignment dated November 2006 of the priority document EP 04 405.659.6. A copy of an assignment between Heat-Wave AG to the 37 CFR 1.47(b) applicant, Power Plate International Ltd. was provided which shows that the assignee, Power Plate International Ltd. received "all priority rights and all other rights" from Heat-Wave AG. The 37 CFR 1.47(b) applicant was also listed as the applicant in the international

application pursuant to PCT Rule 92 *bis*. A copy of the Form PCT/IB/306 mailed 20 April 2007 in the international application was provided.

However, as stated in § 409.03(f) of the MPEP:

> When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that
>
> (A) the invention has been assigned to the applicant, or
>
> (B) the inventor has agreed in writing to assign the invention to the applicant, or
>
> (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

Here, the 37 CFR 1.47(b) applicant has demonstrated that they own all the rights in the subject application possessed by Heat-Wave AG. However, the 37 CFR 1.47(b) applicant must also show that Heat-Wave AG has sufficient proprietary interest in the subject invention. *See* 409.03(f) MPEP.

If petitioner is unable to demonstrate the proprietary interest for Heat-Wave AG through an assignment, or an agreement to assign (employment contract with the required statements of facts by persons having first-hand knowledge of the circumstances) is sufficient to meet the requirements of item (5) for HeatWave AG, a legal memorandum may be used to satisfy this requirement. *See* 409.03(f) MPEP.

For this reason, item (5) of 37 CR 1.47(b) is not yet satisfied.

## CONCLUSION

Applicant's petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. No additional petition fee is required. Extensions of time are available.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the

attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

UNITED STATES PATENT AND TRADEMARK OFFICE

26 FEB 2010

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30567
LEVENFELD PEARLSTEIN, LLC
2 North LaSalle
Suite 1300
Chicago, IL 60602

In re Application of :
KOCH *et al* :
U.S. Application No.: 11/577,855 :
PCT No.: PCT/CH2005/000626 :
Int. Filing Date: 25 October 2005 : **DECISION**
Priority Date: 25 October 2004 :
Attorney's Docket No.: 821628-1010 :
For: APPARATUS FOR STIMULATING THE HUMAN BODY BY MEANS OF VIBRATIONS :

The decision is in response to the papers filed 11 January 2010 which are treated as a renewed petition under 37 CFR 1.47(b).

## BACKGROUND

On 11 June 2009, a decision dismissing applicants' petition under 37 CR 1.47(b) was mailed. Applicants were given two months to respond with extensions of time available under 37 CFR 1.136(a).

On 11 January 2010, applicants submitted an executed declaration, a $65.00 surcharge fee and a five-month extension with a $1,175.00 extension fee.

## DISCUSSION

In response to the decision mailed 11 June 2009, applicants included a declaration signed by the joint inventors, Michael Koch and Thomas Schuler. This declaration complies with 37 CFR 1.497(a) and (b).

The declaration authorizes that the correspondence address be changed to the address associated with customer number 30567.

No further action on the petition under 37 CFR 1.47(b) is required.

## CONCLUSION

Accordingly, the petition under 37 CFR 1.47(b) is **DISMISSED** as **MOOT**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 25 October 2005, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 11 January 2010.

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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29 AUG 2007

RENNER OTTO BOISSELLE & SKLAR, LLP
1621 EUCLID AVENUE
NINETEENTH FLOOR
CLEVELAND OH 44115

| | | |
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| In re Application of | : | |
| CHEICH et al. | : | |
| Application No.: 11/577,949 | : | DECISION ON |
| PCT No.: PCT/US2005/038811 | : | |
| Int. Filing Date: 25 October 2005 | : | PETITION UNDER |
| Priority Date: 25 October 2004 | : | |
| Attorney Docket No.: RANPP0380USA | : | 37 CFR 1.137(b) |
| For: MOTOR-FREE DUNNAGE CONVERTING SYSTEM AND METHOD | : | |

This decision is in response to applicants' petition under 37 CFR 1.137(b) filed 25 July 2007 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 25 October 2005, applicant filed international application PCT/US2005/038811 which designated the U.S. and claimed a priority date of 25 October 2004. A copy of the international application was communicated to the USPTO from the International Bureau on 04 May 2006. The thirty-month period for paying the basic national fee in the United States expired at midnight on 25 April 2007.

On 25 April 2007, applicant filed a transmittal letter for entry into the national stage in the United States. The submission was not accompanied by the Basic National Fee.

On 16 July 2007, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States of America for failure to pay the U.S. Basic National Fee by thirty months from the priority date.

On 25 July 2007, applicants submitted the instant 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 25 July 2007.

As to item (2), applicant submitted the petition fee on 25 July 2007.

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 executed oath or declaration of the inventor 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.

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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12 FEB 2009

RENNER OTTO BOISSELLE & SKLAR, LLP
1621 EUCLID AVENUE
NINETEENTH FLOOR
CLEVELAND OH 44115

| | | |
|---|---|---|
| In re Application of: | : | |
| MCGEORGE, Jeffrey, Bruce | : | DECISION ON PETITION |
| U.S. Application No.: 11/577,954 | : | |
| PCT No.: PCT/AU2005/001305 | : | |
| International Filing Date: 30 August 2005 | : | |
| Priority Date: 31 August 2004 | : | |
| Atty Docket No.: CULP0196US | : | |
| For: A SECURITY SYSTEM | : | |

The petition for revival under 37 CFR 1.137(b) filed 25 April 2007 in the above-captioned application is hereby **GRANTED** as follows:

The present application became abandoned with respect to the United States at midnight on 28 February 2007 based on applicant's failure to enter the U.S. national stage and pay the basic national fee prior to the expiration of thirty months from the priority date.

The present petition for revival was accompanied by payment of the petition fee and the "required reply" in the form of a request for entry into the U.S. national stage and payment of the small entity basic national fee. In addition, the petition includes a statement from the sole inventor that "the entire delay in filing the request under 35 U.S.C. 371 from the due date for the required request until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," satisfying the requirement of 37 CFR 1.137(b)(3). Based on the above, the requirements of 37 CFR 1.137(b) have been satisfied. Accordingly, the request to revive the international application is appropriately granted. It is noted that applicants' 25 April 2007 submission included an executed declaration in compliance with 37 CFR 1.497.

This application is being referred to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision, including requiring submission of the $65 small entity surcharge for filing the declaration later than thirty months after the priority date. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 25 April 2007.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

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25 FEB 2009

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MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN TX 78767-0398

In re Application of:
KUKLA, Hubert, et al.
U.S. Application No.: 11/577,960
PCT No.: PCT/EP2005/011235
International Filing Date: 19 October 2005
Priority Date: 26 October 2004
Atty Dkt No.: 5646-02200/C103400WOUS
For: METHOD AND DEVICE FOR DECRYPTING BROADBAND DATA

DECISION

This communication is issued in response to the "Request For Review Of Fees" filed by applicants on 23 February 2009, requesting a review and correction of the fees charged and refunded by the USPTO in the present application. No petition fee is required.

## BACKGROUND

On 19 October 2005, applicants filed international application PCT/EP2005/011235. The application claimed a priority date of 26 October 2004, and it designated the United States. On 04 May 2006, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 26 April 2007.

On 25 April 2007, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the $300 large entity basic national fee.

On 18 September 2008, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that the following additional materials were required: (1) an oath or declaration in compliance with 37 CFR 1.497; (2) the $130 surcharge for filing the oath or declaration later than thirty months after the priority date; (3) the $410 large entity search fee; and (4) the $210 large entity examination fee.

On 07 October 2008, applicants filed a response to the Notification Of Missing Requirements that included an executed declaration, a claim of small entity status, an authorization to charge Deposit Account No. 50-1505 for required fees, and electronic payment of the following fees: $65 small entity late-declaration surcharge, $110 small entity examination fee, and $215 small entity search fee.

On 17 November 2008, the USPTO refunded to applicants' Deposit Account the fees submitted on 07 October 2008 (i.e., the $65 surcharge, $110 examination fee, and the $215 search fee). At the same time the USPTO charged applicants' Deposit Account $130 a the large entity surcharge for filing the declaration later than thirty months after the priority date.

On 19 November 2008, the DO/EO/US mailed a Notification Of Acceptance (Form PCT/DO/EO/903) indicating that the requirements of 35 U.S.C. 371(c) were satisfied as of 07 November 2008. On the same date, a filing receipt was mailed identifying the 35 U.S.C. 371(c) date as 07 October 2008.

On 23 February 2009, applicants filed the "Request For Review Of Fees" considered herein. The submission requests a review and correction of the fees charged and refunded by the USPTO in the present application.

## DISCUSSION

As discussed above, applicants' 07 October 2008 submission asserted small entity status and was accompanied by payment of the small entity amount for the remaining fees required herein, that is, the late-declaration surcharge, the search fee, and the examination fee.

The 17 November 2008 refund of the applicants' 07 October 2008 fee payment was improper, as such fees are required in the present application. Accordingly, Deposit Account No. 50-1505 will be charged for these required fees, specifically: $65 small entity late-declaration surcharge, $110 small entity examination fee, and $215 small entity search fee. These fees will be treated as having been filed herein on 07 October 2008.

In addition, the 17 November 2008 charge to applicants' Deposit Account for the $130 large-entity surcharge was also improper, as such fee is not required herein. This $130 fee will therefore be refunded to the Deposit Account.

## CONCLUSION

Applicants' request for review of and correction of the fees charged and refunded herein is **GRANTED** as follows.

Deposit Account No. 50-1505 will be charged again for the required, previously-paid small entity fees that were improperly refunded to applicant, specifically: $65 for the small entity late-declaration surcharge, $110 for the small entity examination fee, and $215 for the small entity search fee.

Deposit Account No. 50-1505 will be refunded the unnecessary $130 large-entity surcharge charged on 17 November 2008.

Based on the above corrections, applicants will have paid the fees required for the present application at this time.

The application will be referred to GAU 2432 for examination.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

DATE 8/21/07

APPLICATION NUMBER 11/577,964

DOC CODE PET.OOC.OIPE

DOC DATE 8/21/07

# DELIVER THE ATTACHED FIFLE/DOCUMENT TO THE TC SCANNING CENTER

CONTRACTOR: THE ATTACHED FILE/DOCUMENT MUST BE INDEXED AND SCANNED INTO IFW WITHIN **8** WORK HOURS; UPLOADING OF THE SCANNED IMAGES SHOULD OCCUR NO LATER THAN **16** WORK HOURS FOLLOWING RECEIPT OF THIS REQUEST

AFTER SCANNING, ORIGINAL DOCUMENTS SHOULD BE BOXED IN ACCORDANCE WITH INSTRUCTIONS

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21 AUG 2007

James R. Shay
Shay Law Group, LLP
2755 Campus Drive, Suite 210
San Mateo, CA 94403

| | | |
|---|---|---|
| In re Application of | : | |
| KUIPER, et al. | : | DECISION ON PETITION |
| Application No.: 11/577,964 | : | |
| Filed: April 25, 2007 | : | UNDER 37 CFR 1.182 |
| Atty. Docket No.: 10002-707.US2B | : | |

This is a decision on applicant's "Petition Under 37 CFR § 1.182 to Convert Application" filed on 04 June 2007 in the United States Patent and Trademark Office (USPTO). Applicant has authorized the charging of the $400.00 petition fee to deposit account number 50-4050.

## BACKGROUND

On 24 October 2005, applicant filed international application PCT/US05/38335, which claimed priority of an earlier application filed 25 October 2004. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 25 April 2007.

On 25 April 2007, applicant electronically filed a transmittal letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee and a substitute specification. Applicant had filed an additional transmittal for entry into the United States under 35 U.S.C. 371 earlier in the day.

On 04 June 2007, applicant filed the present petition to convert the above-identified application to a continuation application of application PCT/US05/38335 under 35 U.S.C. 111 and 37 CFR 1.53(b).

## DISCUSSION

There can only be one U.S. national stage application for a given PCT international application. Thus, the filing of two national stage applications is improper.

Applicant is entitled to claim benefit under 35 U.S.C. 120 and 365(c) of the filing date of the international application for the common subject matter, since this application (Application No. 11/577,964) and the international application (PCT/US05/38335) designating the United States were copending on 25 April 2007. In order to obtain benefit of the earlier international application, applicant must amend the beginning of the specification of this application or provide an application data sheet (37 CFR 1.76) to include a proper reference to the parent

international application. (See MPEP § 1893.03(c))

## CONCLUSION

The petition to convert the application from a national stage application under 35 U.S.C. 371 to a 35 U.S.C. 111 filing is **GRANTED**.

This application is being returned to Office of Initial Patent Examination for processing of the application under 35 U.S.C. 111(a).

Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: (571) 272-3294
Fax: (571) 273-0459

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PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON MA 02110

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OFFICE OF PETITIONS

Applicants: Riemer, et al.
Appl. No.: 11/577,981
International Filing Date: October 24, 2005
Title: PROCESS FOR PRODUCING A CORROSION-PROTECTED STEEL SHEET
Attorney Docket: 20496-567
Pub. No.: US 2009/0098295 A1
Pub. Date: April 16, 2009

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on June 1, 2009, for the above-identified application.

Applicant requests that the application be republished because the patent application publication contains a material error in the drawings wherein the sole figure (Fig. 1) submitted with the application on April 25, 2007, is missing in the publication.

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 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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**THIRD FLOOR**
**PASADENA CA 91103-3842**

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SEP 08 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Harvey L. Deutsch | : | DECISION ON PETITION |
| Application No. 11/577,987 | : | TO WITHDRAW |
| Filed: April 25, 2007 | : | FROM RECORD |
| Attorney Docket No. 16105-3US | : | |

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed July 29, 2009.

The request is **NOT APPROVED**.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71,* or, if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

Therefore, as there is currently no Statement under 37 CFR 3.73(b) currently of record in the instant application, the Office cannot change the correspondence address to the address on the Request to Withdraw.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Currently, there is no Office action that requires a reply.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Joan Olszewski
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
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**PASADENA CA 91103-3842**

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OCT 07 2009

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|---|---|---|
| In re Application of | : | |
| Harvey L. Deutsch | : | DECISION ON PETITION |
| Application No. 11/577,987 | : | TO WITHDRAW |
| Filed: April 25, 2007 | : | FROM RECORD |
| Attorney Docket No. 16105-3US | : | |

This is a decision on the renewed request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed September 24, 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 will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40 (c).

The request was signed by David A. Farah on behalf of all attorneys of record who are associated with Customer No. 23676.

All attorneys/agents associated with Customer Number 23676 have been withdrawn. Applicants are reminded that there is no attorney of record at this time.

All future correspondence will be directed to the assignee at the address indicated below.

Currently, there is no outstanding Office action that requires a reply.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: The Catheter Exchange, Inc.
16633 Ventura Boulevard, Suite 735
Encino CA 91436

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0 8 JUN 2009

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TRASKBRITT, P.C.
P.O. BOX 2550
SALT LAKE CITY UT 84110

In re Application of:
MAES, Tamara, et al
U.S. Application No.: 11/578,001
PCT No.: PCT/EP2005/003787
International Filing Date: 14 April 2005
Priority Date: 14 April 2004
Atty's Docket No.: 2676.02-8009US
For: A METHOD FOR SELECTIVELY DETECTING SUBSETS OF NUCLEIC ACID MOLECULES

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This decision is issued in response to applicants' petition under 37 CFR 1.47(a) filed 26 November 2008. Applicants have paid the required petition fee.

## BACKGROUND

On 14 April 2005, applicants filed international application PCT/EP2005/003787. The international application claimed a priority date of 14 April 2004, and it designated the United States. On 27 October 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 14 October 2006.

On 05 October 2006, 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 31 July 2008, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and additional sequence listing materials were required.

On 26 November 2008, applicants filed a response to the Notification Of Missing Requirements (with required extension fee) that included additional sequence listing materials, a partially executed declaration, and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of co-inventor Maria del Mar Benito Amengual, whom applicants assert has refused to execute the application.

On 18 May 2009, the DO/EO/US mailed a "Notification Of Acceptance" (Form PCT/DO/EO/903) indicating that the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) were satisfied as of 26 November 2008.

## 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 executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have provided the required petition fee, and the petition states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

> An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Applicants have filed a declaration executed by two of the three inventors of record which contains an unsigned signature block for the non-signing inventor. This declaration can be accepted as having been executed by the signing inventors on their own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute 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 MPEP also states the following:

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, applicants have provided a firsthand statement, accompanied by supporting documents, from Jonathan Baker regarding the efforts made to obtain the signature of the non-signing inventor. The statement indicates that Mr. Baker communicated with the non-signing inventor via email, that the inventor indicated to Mr. Baker that she would not sign the declaration without additional payment, and that a copy of the complete application, accompanied by a request for signature, was forwarded twice to the last known address of the

non-signing inventor.[1] However, petitioner has not provided an English translation of the accompanying copies of the email communications from the non-signing inventor, as required to confirm the inventor's refusal purportedly contained in such messages. Petitioner has also failed to provide an English translation of the attached delivery receipts that evidence the attempted mailings to the non-signing inventor's last known address. Applicants must provide an English translation of these supporting documents before it can be concluded that a request for signature accompanied by a copy of the complete application has been properly forwarded to the non-signing inventor, and that the inventor has refused to provide the signed declaration in response to such request(s). Until such supplemental materials are submitted, item (4) of a grantable petition is not satisfied.

It is noted that, based on the above, the present record does not include a fully executed declaration in compliance with 37 CFR 1.497 or a grantable petition under 37 CFR 1.47(a). Accordingly, the Notification Of Acceptance mailed 18 May 2009, which indicated that applicants had satisfied the declaration requirement of 35 U.S.C. 371(c)(4), was issued prematurely. Accordingly, the Notification of Acceptance is appropriately vacated.

## 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 additional materials required to satisfy item (4) of a grantable petition, as discussed above and in the MPEP. 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).

The Notification Of Acceptance (Form PCT/DO/EO/903) mailed 18 May 2009 was issued prematurely and is hereby **VACATED**.

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

[1] It is noted that the email dated 15 September 2008 also indicates that a copy of the complete application was forwarded to the non-signing inventor with such email; however, Mr. Baker does not confirm this in his statement.

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22 SEP 2009

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P.O. BOX 2550
SALT LAKE CITY UT 84110

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| In re Application of: | : | |
| MAES, Tamara, et al | : | DECISION ON RENEWED |
| U.S. Application No.: 11/578,001 | : | PETITION UNDER |
| PCT No.: PCT/EP2005/003787 | : | 37 CFR 1.47(a) |
| International Filing Date: 14 April 2005 | : | |
| Priority Date: 14 April 2004 | : | |
| Atty's Docket No.: 2676.02-8009US | : | |
| For: A METHOD FOR SELECTIVELY DETECTING SUBSETS OF NUCLEIC ACID MOLECULES | : | |

This decision is issued in response to applicants' "Response To Dismissal Of Petition Under 37 CFR 1.47(A)" filed 10 August 2009, treated herein as a renewed petition. No additional petition fee is required.

## BACKGROUND

The procedural background for the present application was set forth in the decision mailed 08 June 2009. The decision dismissed without prejudice applicants' petition under 37 CFR 1.47(a) for failure to satisfy all the requirements of a grantable petition. Specifically, applicants had not provided an adequate showing that the non-signing inventor refused to execute the application.

On 10 August 2009, applicants filed the renewed petition considered herein.

## DISCUSSION

The previous decision indicated that an English translation of the email communications and delivery receipts submitted with the original petition was necessary before it could be concluded that the inventor had refused to execute the present application. The renewed petition includes English translations of the previously filed supporting materials.

Applicants' present submission, in combination with the materials submitted with the original petition, provide an acceptable showing that the non-signing inventor has refused to execute the present application. Applicants have therefore now satisfied the final element of a grantable petition under 37 CFR 1.47(a).

## CONCLUSION

The renewed petition under 37 CFR 1.47(a) is **GRANTED**. The application is accepted without the signature of non-signing inventor Maria del Mar Benito AMENGUAL.

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 petition.

The application is being referred 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 26 November 2008.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

22 SEP 2009

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Maria del Mar Benito Amengual
Calle Marques de Sentmenat 63 1°-1ª
08029 Barcelona
SPAIN

In re Application of: MAES, Tamara, et al
U.S. Application No.: 11/578,001
PCT No.: PCT/EP2005/003787
International Filing Date: 14 April 2005
Priority Date: 14 April 2004
Atty's Docket No.: 2676.02-8009US
For: A METHOD FOR SELECTIVELY DETECTING SUBSETS OF NUCLEIC ACID MOLECULES

Dear Ms. Benito Amengual:

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:
TRASKBRITT, P.C.
P.O. BOX 2550
SALT LAKE CITY UT 84110

UNITED STATES PATENT AND TRADEMARK OFFICE

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Patent Administrator
FMC CORPORATION
1735 Market Street
Philadelphia, PA 19103

In re Application of :
LIU *et al* :
U.S. Application No.: 11/578,005 :
PCT No.: PCT/US2005/012398 : **DECISION**
Int. Filing Date: 13 April 2005 :
Priority Date: 14 April 2004 :
Attorney Docket No.: 60380-USA :
For: DISPERSIBLE PESTICIDAL :
COMPOSITIONS :

This petition is in response to the papers filed on 15 August 2008 which are treated as a petition under 37 CFR 1.8(b). No fee is required.

## BACKGROUND

On 25 May 2007, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration was required. Applicants were given two months to respond with extensions of time available.

On 24 July 2007, applicant purportedly filed an executed declaration and surcharge fee via facsimile. However, these papers are not located in the file.

On 01 August 2008, 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 Form PCT/DO/EO/905 mailed 025 May 2007.

On 15 August 2008, applicants filed the subject petition accompanied by, *inter alia*, a copy of an "Auto-Reply Facsimile Transmission" along with copies of the documents purportedly filed 24 July 2007.

## DISCUSSION

Applicants claim that they responded to the Form PCT/DO/EO/905 via facsimile transmission on 24 July 2007. However, this response is not present in the file. As such, the subject application went abandoned for failure to respond to an office action.

37 CFR 1.8 *Certificate of mailing or transmission*, states in part:

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit 's report confirming transmission may be used to support this statement.

Here, applicants provided a copy of the documents purportedly filed 24 July 2007. Applicants also included a copy of the "Auto-Reply Facsimile Transmission" received from the USPTO. In addition, applicants' statements in the petition are sufficient to satisfy item (3) of 37 CFR 1.8(b).

A review of the evidence shows that the USPTO received a facsimile on 24 July 2007. The "Auto-Reply Facsimile Transmission" certifies that 9 pages (incl. Cover) were received by the USPTO. The response and declaration submitted list the proper U.S. application number, title and applicant. Moreover, a review of USPTO financial records show that a $130.00 surcharge fee was received in the subject application on 24 July 2007.

This evidence meets the requirements of 37 CFR 1.8(b) and is sufficient for a grantable petition.

## CONCLUSION

Applicants' petition under 37 CFR 1.8(b) is **GRANTED**.

The Form PCT/DO/EO/909 mailed 01 August 2008 is hereby **VACATED**.

The declaration originally filed 24 July 2007 is in compliance with 37 CFR 1.497(a) and (b).

**11/578,005**

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 13 April 2005, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 24 July 2007.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

David A. Einhorn, Esq.
Baker & Hostetler LLP
45 Rockefeller Plaza
New York, NY 10111

Mail Date: 07/23/2010

| | | |
|---|---|---|
| **Applicant** | : Bong-Jin Kim | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7662810 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 11/578,007 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/06/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **644** 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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ONE LIBERTY PLACE
1650 MARKET ST, SUITE 4900
PHILADELPHIA PA 19103

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|---|---|---|
| In re Application of | : | |
| ZELLER et al. | : | |
| Application No.: 11/578,009 | : | DECISION |
| PCT No.: PCT/FR2005/000873 | : | |
| Int. Filing Date: 11 April 2005 | : | |
| Priority Date: 09 April 2004 | : | |
| Attorney Docket No.: BDM-06-1355 | : | |
| For: DEVICE FOR FOLLOWING THE PENETRATION OF AN INSTRUMENT IN AN ANATOMICAL STRUCTURE | : | |

This is a decision on applicants' petition under 37 CFR 1.47(a) filed 08 October 2007 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 11 April 2005, applicants filed international application PCT/FR2005/000873, which designated the United States and claimed a priority date of 09 April 2004. A copy of the international application was communicated from the International Bureau to the USPTO on 03 November 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 10 October 2006 (09 October 2006 being a Federal holiday).

On 06 October 2006, 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 10 July 2007, 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) was required. The NOTIFICATION set a two-month extendable period for response.

On 08 October 2007, 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 declaration of inventors, a copy of a letter dated 26 October 2006 from Yasmine Tarasewicz/Beatrice Pola to Cabinet Versini-Campinchi & Associes and an English translation thereof, a copy of a letter dated 28 November 2006 from Beatrice Pola to Cabinet Versini-Campinchi & Associes and an

English translation thereof, and a copy of a letter dated 19 September 2007 from Dominique Menard of the law firm Lovells to Cabinet Versini-Campinchi & Associes and an English translation thereof.

## 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.

Item (1) has been satisfied.

Item (2) has not been satisfied. MPEP § 409.03(d) 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.

No statement of facts by a person having firsthand knowledge has been presented. Additionally, it is not clear how it is known that Cabinet Versini-Campinchi & Associes is Mr. Vanacker's representative.

Item (3) has been satisfied.

Item (4) has not been satisfied. The declaration filed 08 October 2007 is an improper composite declaration, consisting of one of Page 1, one of Page 2, and three of Page 3. Each inventor must be presented with a complete declaration which lists all of the inventors, and the signature of each inventor must appear on at least one complete declaration. Multiple complete declarations may be submitted, but it is not permissible to combine pages of separate documents.

## 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. A proper response must specify whose signature is below non-signing inventor Fergus Francis Murray's name. **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/

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

29 MAY 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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PHILADELPHIA PA 19103

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| In re Application of | : | |
| ZELLER et al. | : | |
| Application No.: 11/578,009 | : | DECISION |
| PCT No.: PCT/FR2005/000873 | : | |
| Int. Filing Date: 11 April 2005 | : | |
| Priority Date: 09 April 2004 | : | |
| Attorney Docket No.: BDM-06-1355 | : | |
| For: DEVICE FOR FOLLOWING THE PENETRATION OF AN INSTRUMENT IN AN ANATOMICAL STRUCTURE | : | |

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 12 March 2008 in the United States Patent and Trademark Office (USPTO).

## BACKGROUND

On 11 April 2005, applicants filed international application PCT/FR2005/000873, which designated the United States and claimed a priority date of 09 April 2004. A copy of the international application was communicated from the International Bureau to the USPTO on 03 November 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 10 October 2006 (09 October 2006 being a Federal holiday).

On 06 October 2006, 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 10 July 2007, 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) was required. The NOTIFICATION set a two-month extendable period for response.

On 08 October 2007, 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 declaration of inventors, a copy of a letter dated 26 October 2006 from Yasmine Tarasewicz/Beatrice Pola to

Cabinet Versini-Campinchi & Associes and an English translation thereof, a copy of a letter dated 28 November 2006 from Beatrice Pola to Cabinet Versini-Campinchi & Associes and an English translation thereof, and a copy of a letter dated 19 September 2007 from Dominique Menard of the law firm Lovells to Cabinet Versini-Campinchi & Associes and an English translation thereof.

On 26 November 2007, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.47(a). Specifically, it was noted that factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort had not been provided.

On 12 March 2008, applicants filed the instant renewed petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a petition/fee for a two month extension of time, a statement of facts from Sabine Tracol, a copy of a letter dated 21 January 2008 from Sabine Tracol to non-signing inventor Gerard Vanacker and an Englsih translation thereof, and a copy of a letter dated 16 February 2008 from Elisabeth Nenon to Ms. Tracol and an English translation thereof.

## 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 26 November 2007, items (1) and (3) have been satisfied.

Items (2) and (4) have now been satisfied as well.

## CONCLUSION

For the reasons set forth above, 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 **12 March 2008**.

/Daniel Stemmer/

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

2 9 MAY 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Gerard Vanacker
Villa Saint-Antoine
2 rue du Sautiquer
83380 LESS ISSAMBRES
France

In re Application of
ZELLER et al.
Application No.: 11/578,009
PCT No.: PCT/FR2005/000873
Int. Filing Date: 11 April 2005
Priority Date: 09 April 2004
Attorney Docket No.: BDM-06-1355
For: DEVICE FOR FOLLOWING THE PENETRATION OF AN INSTRUMENT IN AN ANATOMICAL STRUCTURE

Dear Mr. Vanacker:

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/

Daniel Stemmer
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

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1650 MARKET ST, SUITE 4900
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07 AUG 2009

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SALIWANCHIK LLOYD & SALIWANCHIK
A PROFESSIONAL ASSOCIATION
PO Box 142950
GAINESVILLE FL 32614

| | |
|---|---|
| In re Application of | : |
| BEHRENS et al. | : |
| Application No.: 11/578,013 | : DECISION ON RESPONSE |
| PCT No.: PCT/EP05/04246 | : |
| Int. Filing: 20 April 2005 | : |
| Priority Date: 20 April 2004 | : |
| Attorney Docket No.: VOS-107 | : |
| For: AGONISTS OF A BITTER TASTE RECEPTOR AND USES THEREOF | : |

This application is before the PCT Legal Office for consideration of applicant's Response to Notification of Defective Response, filed on 23 May 2009 in the United States Patent and Trademark Office (USPTO) in the above-captioned application.

## BACKGROUND

On 10 October 2006, prior to the thirty month deadline for filing a national stage application, applicant filed a transmittal requesting entry into national stage under 35 U.S.C. 371 along with the basic national filing fee.

On 21 May 2008, two one-page executed declarations were submitted in the above referenced application. One declaration contained an alteration to the first name of the fourth inventor. Moreover, each declaration identified only some of the joint inventors.

On 23 February 2009, a Notification of Missing Requirements was mailed to applicant, indicating, *inter alia*, that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), and the surcharge for filing the declarations after the thirty month period, was required. The notice explained that the first name of the fourth inventor was spelled differently in the published international application and that the 4th inventor had not initialed the correction to her first name on the declaration.

On 14 April 2009, in response to applicant's request under PCT Rule 92*bis*, the International Bureau mailed a Form PCT/IB/345 indicating that the notification to change the inventor's name was filed after the expiration of the time limit set forth in PCT Rule 92*bis* and thus, was refused. Applicant was advised to seek consideration of the matter before the designated Offices.

On 16 April 2009, applicant filed a copy of one of the previously filed executed declarations, on which the fourth inventor initialed and dated the changes to her first name on the declaration.

On 01 May 2009, a Notification of Defective Response was mailed to applicant indicating that the declaration was "not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68"

and that the spelling of the fourth inventor's name did not correspond with the spelling on the published international application.

## DISCUSSION

Applicant now requests the correction of the fourth inventor's first name and explains the error is a typographical error. See MPEP 201.03. [1] Applicant indicates that the fourth inventor's correct first name is **Christina**, rather than Christian as incorrectly indicated in the international application as the result of a typographical error. Applicant's explanation of the difference in inventor's name is accepted and noted for the record. For this reason, the Request is **GRANTED**. No petition fee is required.

However, Applicant is advised that the executed one-page declarations submitted on 21 May 2008 are not acceptable for two reasons. First, applicant presented two declarations; each declaration only identified some of the joint inventors. One declaration identifies inventors Behrens, Brockhoff and Kuhn and the box at the bottom of the page was checked indicating: "Additional inventor or a legal representative are being named on 1 additional form(s) attached hereto".

However, the second declaration identifies only inventors Meyerhof and Winnig and the box at the bottom of the page indicating additional inventors on another page was not checked. This suggests that these inventors may not have been aware of the joint inventors named in the first declaration. Since each declaration identifies only some of the joint inventors, and the box indicating additional inventors could be found on an additional page was not checked on both declarations, the declarations are not acceptable. It appears that each declaration may have been presented independent of the other. These declarations are not in compliance with 37 CFR 1.497(a). A newly executed declaration is required.

The second reason the declaration is unacceptable is that it was altered after it was executed.

Section 602.01 of the MPEP states the following:

> The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed. If the wording is not correct or if all of the required affirmations have not been made, or if it has not been properly subscribed to, a new oath or declaration must be required....

(Emphasis added.)

Any changes made in ink in the application or oath prior to signing should be initialed and dated by the applicants prior to execution of the oath or declaration. The Office will not consider whether non-initialed and/or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration. Thus, the declaration is unacceptable and does not satisfy the requirements of 37 CFR 1.497(a). A newly executed declaration, in compliance with 37 CFR 1.497(a) and (b), is required.

---

[1] Section 201.03 of the Manual of Patent Examining Procedure states where a typographical or transliteration error in the spelling of an inventor's name is discovered, the Office should simply be notified of the error to correct the name of the inventor.

## CONCLUSION

Applicant's request for the correction of the fourth inventor's first name to Christina, due to a typographical error, is GRANTED.

As explained above, the declarations submitted on 21 May 2008 are unacceptable. Since the Notification of Missing Requirements mailed on 23 February 2009 did not clearly point out the deficiencies in the declarations, the Notification is hereby **VACATED**. A new Notification of Missing Requirements will be issued indicating that a newly executed declaration, in compliance with 37 CFR 1.497(a) and (b), is required.

This application is being forwarded to the National Stage Processing Branch of the International Division for further processing in accordance with this decision.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Office of PCT Legal Administration

Telephone: (571) 272-3286
Facsimile: (571) 272-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

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VENABLE LLP
P.O. BOX 34385
WASHINGTON, DC 20043-9998

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Richard B. Kaner | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7645308 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/12/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/578,029 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/12/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **681** 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 NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 11/518,074 | 09/08/2006 | John Whitman | 2269-4294.5US (98-1208.05 |

TRASK BRITT, P.C./ MICRON TECHNOLOGY
P.O. BOX 2550
SALT LAKE CITY UT 84110

DATE MAILED: September 17, 2007

**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) filed August 15, 2007, 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.

Any inquiries concerning this decision should be directed to the Pre-Grant Publication Division at (703) 605-4283.

Barbara J. Debnam
Pre-Grant Publication Division

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27 FEB 2008

JORDAN AND HAMBURG LLP
122 East 42nd Street
New York, NY 10168

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| Tsuneo URISU et al | : | |
| Application No.: 11/578,081 | : | |
| PCT No.: PCT/JP2005/008312 | : | |
| Int. Filing Date: 21 April 2005 | : | PETITION UNDER |
| Priority Date: 28 April 2004 | : | |
| Attorney Docket No.: PU040304 | : | |
| For: BIOCHIP PRODUCTION ... | : | |
| ANALYSIS METHOD | : | 37 CFR 1.181 |

This is in response to applicants' submission "PETITION UNDER 37 CF 1.181" filed on 20 August 2007 requesting that the correct inventor's name for the second listed inventor is Mitsukazu SUZUI.

## BACKGROUND

On 12 October 2006, applicants filed in the United States Patent and Trademark Office (PTO) a Transmittal Letter (Form PTO-1390) accompanied by, *inter alia*, the basic national fee, but no executed declaration or oath filed at such time.

On 26 December 2006, applicants filed an executed declaration.

On 15 June 2007, 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, in that the second inventor's first name on the declaration doesn't correspond with the name on the published international application" The notice also indicated that all of the items set forth above must be submitted within two (2) months from the date of this notice or by 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment.

On 20 August 2007, applicants submitted the current petition, which explains that the first name of the second inventor listed is Mitsukazu Suzui.

## DISCUSSION

The correct name of the second joint-inventor is "**Mitsukazu Suzui**" as submitted in the executed Declaration filed on 26 December 2006. Applicants indicate that the mistake was due to a transliteration process and that name he wishes to use is **Mitsukazu Suzui**. The correct name, Mitsukazu Suzui, will be reflected in the US national stage processing.

Applicants' response is accepted as a sufficient response to the Notification of Missing Requirements (FORM PCT/DO/EO/905) mailed on 15 June 2007.

## DECISION

For the reasons above, the petition under 37 CFR 1.182 is **GRANTED.** The application will be granted a 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4) date of **26 December 2006.**

For the reasons above, the application may enter into national stage processing at this time. The application is being returned to DO/EO/US for processing as the U.S. National Stage of the above-identified international application.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

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www.uspto.gov

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

Applicant: Cody
Appl. No.: 11/578,083
International Filing Date: April 12, 2005
Title: NAVIGATION SIGN
Attorney Docket: TOMKN1.001APC
Pub. No.: US 2008/0086259 A1
Pub. Date: April 10, 2008

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DEC 10 2008

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b), received on June 4, 2008, for the above-identified application.

The request is GRANTED.

Applicant is advised, in the future, to verify the accuracy of information presented on filing receipts, and notify the Office of any errors, such that publications will issue originally with the correct information.

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 Michael Cygan at (571) 272-7700, or to the undersigned at (571) 272-7709.

Mark Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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MORRISON & FOERSTER LLP
425 MARKET STREET
SAN FRANCISCO CA 94105-2482

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DEC 03 2009

OFFICE OF PETITIONS

In re Application of

Peter Jonathon Legg
Application No. 11/578,090
Filed: June 6, 2007
Attorney Docket No. 9010/96596

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 CFR § 1.36(b), filed September 10, 2009.

The request is **NOT APPROVED**.

The request cannot be approved because the address for neither the first named inventor nor the assignee of record was not provided in the request. Therefore, the change in correspondence address is improper.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71* or, the most current address information provided for the first named inventor. 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at 571-272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

15 NOV 2007

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Alexandria, VA 22313-1450
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National Institutes of Health
c/o Venable LLP
P. O. Box 34385
Washington, D.C. 20043-9998

In re Application of
GOLDING et al.
Application No.: 11/578,122
PCT No.: PCT/US05/12222
Int. Filing Date: 11 April 2005
Priority Date: 09 April 2004
Attorney Docket No.: 31978-236747
For: PEPTIDE THAT ELICITS NEUTRALIZING ANTIBODIES TARGETING THE HIV CO-RECEPTOR, CCR5

DECISION ON PETITION UNDER 37 CFR 1.181

This decision is issued in response to applicants' "Response To Notification Of Missing Requirements" filed 25 July 2007 treated in part herein as a petition to confirm the filing of an acceptable declaration under 37 CFR 1.497 and a request for transfer of computer readable form of sequence listing under 37 CFR 1.821(e). No petition fee is required.

## BACKGROUND

On 11 April 2005, applicants filed international application PCT/US05/12222. The application claimed a priority date of 09 April 2004. Subsequent to the filing of the international application, pursuant to PCT Rule 26ter, applicants filed therein a declaration of inventorship under PCT Rule 4.17(iv). This declaration was executed by Hana Golding and Surender Khurana; however, the declaration did not specifically identify the international application to which it was directed, that is, PCT/US05/12222.

On 27 July 2006, a copy of the international application was communicated to the United States Patent and Trademark Office ("USPTO") by the International Bureau ("IB"). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 10 October 2006. (09 October 2006 was a federal holiday.)

On 10 October 2006, 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, a request for transfer of computer readable form of sequence listing under 37 CFR 1.821(e); and a copy of the declaration filed in the international application.

On 29 June 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" (Form PCT/DO/EO/905) indicating that the declaration filed by applicants was defective for failure to properly identify the application to which it was directed. Furthermore, the Notification indicated that a Sequence Listing had not been filed as required by 37 CFR 1.821(c) and (e). Specifically, the Notification indicated that "there was never a CRF filed in the parent application PCT/US05/12222 indicates that no Sequence listing diskette or CD was submitted."

On 25 July 2007, applicants filed the present response to the Notification Of Missing Requirements. The submission was not accompanied by a new oath or declaration or the required sequence listing materials. This argument is treated herein as a petition under 37 CFR 1.181.

## DISCUSSION

### *Rule 4.17(iv) Declaration*

The instructions to the Rule 4.17(iv) declaration state: "[w]here the declaration was not included in the request, but is furnished later, the PCT application number MUST be indicated within the text of Box No. VIII (iv)." Consistent with this instruction, the text of the Rule 4.17(iv) declaration includes a line that expressly requires entry of the PCT international application number "if furnishing the declaration pursuant to Rule 26ter."

Here, the executed Rule 4.17(iv) declaration was not filed with the original international application materials. Accordingly, the declaration was required to include the PCT application number for the application to which it was directed, that is, PCT/US05/12222. Because the declaration does not include this PCT application number, the declaration is defective for failure to properly identify the specification to which it was directed.

Applicants argue that the declaration is adequate because "the declaration was properly submitted with the PCT application." However, a review of the PCT/US05/12222 reveals that the Rule 4.17(iv) declaration was not filed with the PCT Request on 11 April 2005, but rather on 01 July 2005. (It is noted that an unsigned Rule 4.17 declaration was submitted on 11 April 2005.)

Based on the above, and as set forth in the Notification Of Missing Requirements mailed 29 June 2007, the declaration filed herein is defective for failure to properly identify the application to which it was directed.

### *Sequence Listing*

Applicants requested (on 01 October 2005 and 25 July 2007) the transfer of the computer readable form (CRF) of PCT/US05/12222 in place of filing a CRF for the present application. Pursuant to 37 CFR 1.821(e),

> If the computer readable form of a new application is to be identical with the computer readable form of another application of the applicant on file in the Office, reference may be made to the other application and computer readable form in lieu of filing a duplicate computer readable form in the new application if the computer readable form in the other application was compliant with all of the requirements of this subpart. The new application must be accompanied by a letter making such reference to the other application and computer readable form, both of which shall be completely identified. In the new application, applicant must also request the use of the compliant computer readable "Sequence Listing" that is already on file for the other application and must state that the paper or compact disc copy of the "Sequence Listing" in the new application is identical to the computer readable copy filed for the other application.

However, as stated in the Notification of Missing Requirements (Form PCT/DO/EO/905), there is no indication that a computer readable form was filed in PCT/US05/12222. Further, if a CRF had been filed, it would have been forwarded the European Patent Office/International Searching Authority for the purpose of the international search and not retained by this Office. Therefore, applicants are required to submit Sequence Listing as required by 37 CFR 1.821-1.825.

## CONCLUSION

Applicants' request is **DISMISSED**.

A proper response, as discussed in the Notification of Missing Requirements dated 29 June 2007, must be filed within **ONE (1) MONTH** of the date of mailing of this Decision. No extensions of this time limit may be obtained under 37 CFR 1.136(a), but the period for response set forth in the Notification of Missing Requirements may be extended up to a maximum of five months.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (571) 272-3298
Fax: (571) 273-0459

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P.O. Box 1450
Alexandria, VA 22313-1450
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22 JAN 2008

National Institutes of Health
c/o Venable LLP
P. O. Box 34385
Washington, D.C. 20043-9998

In re Application of :
GOLDING et al. :
Application No.: 11/578,122 : DECISION ON PETITION
PCT No.: PCT/US05/12222 : UNDER 37 CFR 1.181
Int. Filing Date: 11 April 2005 :
Priority Date: 09 April 2004 :
Attorney Docket No.: 31978-236747 :
For: PEPTIDE THAT ELICITS NEUTRALIZING ANTIBODIES TARGETING THE HIV CO-RECEPTOR, CCR5

This decision is issued in response to applicants' "Reply to Decision on Petition under 37 CFR 1.181" filed 11 December 2007. No petition fee is required.

## BACKGROUND

The procedural background for this application was set forth in detail in the decisions mailed on 15 November 2007.

The 15 November 2007 decision: (1) refused to accept the previously filed declaration of inventorship under PCT Rule 4.17(iv); and (2) refused applicants' request to transfer the computer readable form (CRF) of PCT/US05/12222 in place of filing a CRF for the present application.

On 11 December 2007, applicants filed the materials considered herein as a renewed petition under 37 CFR 1.181.

## DISCUSSION

*Rule 4.17(iv) Declaration*

The international application forwarded to the USPTO by the International Bureau included a Declaration of Inventorship under PCT Rules 4.17(iv) and 51bis.1(a)(iv) for the purposes of the designation of the United States of America. The declaration was executed

by the named inventor is in compliance with 37 CFR 1.497(a)-(b). Further, the declaration properly identified the PCT application and thus satisfied the provisions of 35 U.S.C. 371(c)(4). Therefore, the Notification Of Missing Requirements mailed 29 June 2007 and the Decision on Petition dated 15 November 2007 are hereby **VACATED**.

*Sequence Listing*

The present petition is accompanied by a Sequence Listing in Paper and Computer Readable Form. A review of the Sequence Listing by the Biotechnology Systems Branch of the Scientific and Technical Information Center (STIC) reveals that the nucleotide and/or amino acid sequence disclosure contained in the application complies with the requirement for such a disclosure as set forth in 37 CFR 1.821 -1.825.

## CONCLUSION

As construed above, applicants' petition under 37 CFR 1.181 is **GRANTED**.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

10 APR 2009

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WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON VA 20190

In re Application of:
SUN, Ronggal, et al.
U.S. Application No.: 11/578,124
PCT No.: PCT/US2005/042602
International Filing Date: 23 November 2005
Priority Date: 01 December 2004
Atty's Docket No.: 08560014AB
For: RECOMBINANT BCG STRAINS WITH ENHANCED ABILITY TO ESCAPE THE ENDOSOME

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This decision is issued in response to applicants' petition under 37 CFR 1.47 filed 21 February 2009, treated herein under 37 CFR 1.47(a).[1] Deposit Account No. 50-2041 will be charged the required $200 petition fee.

## BACKGROUND

On 23 November 2005, applicants filed international application PCT/US2005/042602. The international application claimed a priority date of 01 December 2004, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 01 June 2007.

On 10 October 2006, applicants' filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and an unexecuted declaration.

On 29 August 2008, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required.

On 21 February 2009, applicants filed a response to the Notification Of Missing Requirements (with required extension fee) that included a partially executed declaration and the petition under 37 CFR 1.47(a) considered herein. The petition seeks acceptance of the application without the signature of inventor David Michael HONE, whom applicants assert has refused to execute the application.

[1] The petition references 37 CFR 1.47(b); however, where, as here, some but not all of the inventors have executed the declaration, the applicable provision is 37 CFR 1.47(a).

## 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 executed by the other inventors on behalf of themselves and the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Applicants here have provided the authorization to charge Deposit Account No. 50-2041 the required petition fee, and the petition states the last known address of the non-signing inventor. Items (1) and (2) are therefore satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

> An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Applicants have filed a declaration executed by two of the three inventors of record which contains an unsigned signature block for the non-signing inventor. This declaration can be accepted as having been executed by the signing inventors on their own behalf and on behalf of the non-signing inventor. Item (3) is therefore satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to execute 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 MPEP also states the following:

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, as evidence of the inventor's refusal applicants have provided a statement from Rita Khanna indicating that, under her guidance, a copy of the application and declaration was provided to the non-signing inventor, and that despite repeated inquiries, the inventor has failed to provide the requested signed declaration. However, this statement is not supported by any documentary evidence (i.e., a copy of the cover letter, delivery receipt, etc.), nor does it provide any detail with respect to the "repeated inquiries" referred to therein. Absent additional firsthand and documentary information confirming the delivery of the application and signature request to the inventor and providing the details of the inquiries made, the statement of Ms. Khanna is not sufficient to support the conclusion that the inventor has refused to execute the application.

The petition also includes a statement from counsel indicating that another request for signature, accompanied by a copy of the application, was forwarded to the inventor via Federal

Express. A copy of the cover letter and the Federal Express shipment receipt for this signature request are included with the petition. However, applicants have not provided any evidence confirming that this correspondence was successfully delivered to the inventor. Moreover, this correspondence was forwarded to the inventor less than one week before the filing of the present petition. Under these circumstances, even if the correspondence was successfully delivered to the inventor, the inventor's failure to provide a response within such a short time frame is not indicative of a refusal to sign. Applicants must supplement the petition with evidence confirming delivery of the signature request to the inventor and a statement indicating that a response has still not been received from the inventor with respect to such signature request.

Based on the above, the present record does not provide an acceptable showing that the non-signing inventor has refused to execute the application. Accordingly, item (4) is not satisfied.

## CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the additional materials required to satisfy item (4) of a grantable petition, as discussed above and in the MPEP. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

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23 JUL 2009

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11491 SUNSET HILLS ROAD
SUITE 340
RESTON VA 20190

In re Application of:
SUN, Ronggal, et al.
U.S. Application No.: 11/578,124
PCT No.: PCT/US2005/042602
International Filing Date: 23 November 2005
Priority Date: 01 December 2004
Atty's Docket No.: 08560014AB
For: RECOMBINANT BCG STRAINS WITH ENHANCED ABILITY TO ESCAPE THE ENDOSOME

DECISION ON RENEWED PETITION UNDER 37 CFR 1.47(a)

This decision is issued in response to applicants' "Renewed Petition Under 37 CFR 1.47(a)" filed 09 June 2009. No additional petition fee is required.

## BACKGROUND

The procedural background for the present application was set forth in the decision mailed on 10 April 2009. The decision dismissed without prejudice applicant's original petition under 37 CFR 1.47(a) for failure to satisfy all requirements of a grantable petition. Specifically, applicants had not provided an acceptable showing that the non-signing inventor refused to execute the application or cannot be located after diligent effort.

On 09 June 2009, applicants filed the renewed petition considered herein.

## DISCUSSION

The previous decision stated that applicants had failed to provide an acceptable showing that the non-signing inventor had refused to execute the application. Specifically, the decision stated that applicants had not provided the required firsthand and documentary materials needed to support the statement from Rita Khanna regarding efforts made under her direction to obtain the inventor's signature. In addition, the decision stated that the showing with respect to the request for signature forwarded via Federal Express by attorney Michael E. Whitham was not sufficient to demonstrate the inventor's refusal to sign because: (1) applicants did not provide any evidence confirming that this correspondence was successfully delivered to the inventor; and (2) even if the correspondence was successfully delivered to the inventor, the inventor's failure to provide a response within one week was not indicative of a refusal to sign.

The renewed petition confirms that a response has still not been received from the inventor with respect to the signature request delivered by Federal Express to his last known address on 17 February 2009, and it includes a copy of Federal Express tracking data confirming that the Federal Express package was delivered to the inventor's last known address on such date.[1] However, the petition does not include any evidence confirming that this is a current address for the inventor and that the inventor therefore received the signature request (e.g., a signed delivery receipt). Evidence of receipt of the signature request by the inventor is especially important where, as here, applicants are requesting that the inventor's failure to respond be interpreted as a refusal to sign the application. This is because, absent some confirmation of receipt, the present record is as consistent with a conclusion that the signature request was delivered to an out-dated address as it is with a conclusion that the inventor has received the signature request but refused to respond.

Based on the above, applicants have still not provided an acceptable showing that the non-signing inventor has refused to execute the application or cannot be located after diligent effort. This final element of a grantable petition under 37 CFR 1.47(a) therefore remains unsatisfied.

## CONCLUSION

Applicants' renewed 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 additional materials required to satisfy item (4) of a grantable petition, as discussed above and in the MPEP. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

[1] The renewed petition includes no further supporting materials with respect to the efforts made by Rita Khanna to obtain the inventor's signature.

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30 OCT 2009

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WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON VA 20190

| | | |
|---|---|---|
| In re Application of: | : | |
| SUN, Ronggal, et al. | : | DECISION ON SECOND |
| U.S. Application No.: 11/578,124 | : | RENEWED PETITION UNDER |
| PCT No.: PCT/US2005/042602 | : | 37 CFR 1.47(a) |
| International Filing Date: 23 November 2005 | : | |
| Priority Date: 01 December 2004 | : | |
| Atty's Docket No.: 08560014AB | : | |
| For: RECOMBINANT BCG STRAINS | : | |
| WITH ENHANCED ABILITY TO | : | |
| ESCAPE THE ENDOSOME | : | |

This decision is issued in response to applicants' "Petition For A One Month Extension Time And Second Renewed Petition Under 37 CFR §1.47(a)" filed 24 September 2009 and supplemented on 29 October 2009. No additional petition fee is required.

## BACKGROUND

The procedural background for the present application was set forth in the decisions mailed on 10 April 2009 and 23 July 2009. The decisions dismissed without prejudice applicants' petition under 37 CFR 1.47(a) for failure to satisfy all requirements of a grantable petition. Specifically, applicants had not provided an acceptable showing that the non-signing inventor had refused to execute the application or could not be located after diligent effort.

On 24 September 2009, applicants filed the "Petition For A One Month Extension Time And Second Renewed Petition Under 37 CFR §1.47(a)" considered herein (with required extension fee).

On 29 October 2009, applicants filed the "Supplement To Second Renewed Petition Under 37 CFR § 1.47(a)" also considered herein.

## DISCUSSION

The second renewed petition includes supplemental materials describing the additional efforts made to obtain the signature of the non-signing inventor. This includes identifying a current address for the non-signing inventor and forwarding to the inventor at such address a request for signature, accompanied by a copy of the complete application. The renewed petition includes a copy of the Federal Express receipt confirming receipt of the signature request by the

non-signing inventor, and it confirms that the inventor has not provided the signed declaration in response to the signature request.

The materials filed with the present second renewed petition, in combination with those previously submitted, provide an acceptable showing that inventor David HONE has refused to execute the application.

Based on the above, applicants have now satisfied the final requirement of a grantable petition under 37 CFR 1.47(a).

## CONCLUSION

The second renewed petition under 37 CFR 1.47(a) is **GRANTED**. The application is accepted without the signature of non-signing inventor David HONE.

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 petition.

The application is being referred 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 21 February 2009.

Richard M. Ross
Attorney Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3296
Facsimile: (571) 273-0459

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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30 OCT 2009

David HONE
17609 Soper Street
Poolesville, Maryland 20837

In re Application of: SUN, Ronggal, et al.
U.S. Application No.: 11/578,124
PCT No.: PCT/US2005/042602
International Filing Date: 23 November 2005
Priority Date: 01 December 2004
Atty's Docket No.: 08560014AB
For: RECOMBINANT BCG STRAINS WITH ENHANCED ABILITY TO ESCAPE THE ENDOSOME

Dear Mr. HONE:

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:
Michael E. Whitham
WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C.
11491 SUNSET HILLS ROAD
SUITE 340
RESTON VA 20190

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Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

Mail Date: 04/21/2010

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| **Applicant** | : Tudor Arvinte | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7662393 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/578,136 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/10/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **227** 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.

05 FEB 2008

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8110 Gatehouse Road
Suite 100 East
PO BOX 747
FALLS CHURCH, VA 22040-0747

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| In re Application of | : | DECISION ON |
| AISO et al | : | |
| PCT No.: PCT/JP2004/018677 | : | |
| Application No: 11/578,141 | : | PETITION UNDER |
| Int. Filing Date: 8 December 2004 | : | |
| Priority Date: 8 April 2004 | : | |
| Attorney's Docket No.: 1254-0249PUS3 | : | |
| For: THERAPEUTIC AGENT FOR MOTOR NEURON DISEASE | : | 37 CFR 1.47(a) |

This is in response to the "PETITION UNDER 37 CFR 1.47(a)" filed on 30 October 2007.

## BACKGROUND

On 8 December 2004, applicants filed international application PCT/JP2004/018677, which claimed priority to an earlier application filed 8 April 2004.

On 10 October 2006, 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 30 May 2007, 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" 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 stated that the declaration must be submitted within two months from the date of this notice or 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 30 October 2007, petitioners filed an executed declaration without the signature of Yoshiko KITA.

## 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 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 (1), the petition fee of $200.00 has been charged to Deposit Account No.: 02-2448.

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, Ms. Yoshiko KITA. However, even though Ms. Nishimoto asserts she has first hand knowledge but it is unclear how? It appears from the evidence presented that she does not have first hand since it Hiraki & Associates that mailed and contacted Ms. Kita. Was Ms. Nishimoto involved in writing and mailing the application papers and the other correspondences? Was Ms. Nishimoto the person that Ms. Kita contacted in Hiraki & Associates, when she refused to join the application?

Accordingly, it does not appear that Ms. Nishimoto was the person who performed those actions listed in the petition in sections 4 - 8, and it is unclear how she has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Ms. Nishimoto was not the person who performed the actions listed in the petition, petitioner will need to submit statements, with specific facts on the actions referred to by the petition, in sections 4 - 8, by persons who have first-hand knowledge of such facts.

Regarding requirement (3), petitioner has provided a statement of the last known address of the missing inventor.

Regarding requirement (4), petitioner has provided a properly executed declaration.

Consequently, the petition does not satisfy all the requirements under 37 CFR 1.47(a).

## CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 273-0459

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12 MAY 2008

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| In re Application of | : | DECISION ON |
| AISO et al | : | |
| PCT No.: PCT/JP2004/018677 | : | |
| Application No: 11/578,141 | : | PETITION UNDER |
| Int. Filing Date: 8 December 2004 | : | |
| Priority Date: 8 April 2004 | : | |
| Attorney's Docket No.: 1254-0249PUS3 | : | |
| For: THERAPEUTIC AGENT FOR MOTOR NEURON DISEASE | : | 37 CFR 1.47(a) |

This is in response to the "RENEWED PETITION UNDER 37 CFR 1.47(a)" filed on 04 April 2008.

## BACKGROUND

In a decision from this Office on 05 February 2008, the initial petition under 37 CFR 1.47(a) was dismissed. The decision stated that item (2) had not been satisfied.

On 04 April 2008, petitioner submitted a "Renewed Petition Under 37 CFR 1.47(a)" requesting reconsideration of the Office's decision of 05 February 2008 with respect to accepting the above application without the signature of Ms. Yoshiko KITA.

## 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 on behalf of the non-signing joint inventor.

The renewed petition of 04 April 2008 has satisfied item (2) under 37 CFR 1.47(a).

Regarding item (2), the statements by Mr. Takashi SASAKI and Ms. Noriko KAKANISHI, have first-hand knowledge of the facts of the previous petition, and they have provided statements outlining the steps taken to mail the application papers to the non-signing inventor Ms. KITA and her refusal via e-mail on February 12,2007.

Consequently, at this time it can be concluded that Mr. KITA has refused to sign the documents.

Petitioner has now satisfied item (2) 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 forwarded to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371. The application will be given a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of **30 October 2007.**

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (571) 272-3276
Facsimile: (571) 272-0459

1 4 DEC 2007

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| In re Application of | : | |
| CHIBA et al. | : | |
| U.S. Application No. 11/578,142 | : | DECISION ON |
| PCT No.: PCT/JP05/07286 | : | REQUEST UNDER 37 CFR 1.42 |
| Int. Filing Date: 08 April 2005 | : | & |
| Priority Date: 08 April 2004 | : | PETITION UNDER |
| Attorney Docket No.: 1254-0249PUS3 | : | 37 CFR 1.47(a) |
| For: THERAPEUTIC AGENT FOR NEURODEGENERATIVE DISEASE | : | |

This decision issued in response to applicants' "Petition under 37 CFR 1.47(a)" filed 03 December 2007 to accept the application without the signature of joint-inventor, Yoshiko KITA. The petition fee has been submitted. Additionally, the declaration filed 03 December 2007 is being treated as a Request under 37 CFR 1.42. No petition fee is required.

## BACKGROUND

On 08 April 2005, applicants filed international application PCT/JP05/07286 which claimed a priority date of 08 April 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 20 October 2005. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 10 October 2006.

On 10 October 2006, 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 translation of the international application; and a preliminary amendment.

On 01 August 2007, 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. Furthermore, the Notification indicated that a Sequence Listing had not been filed as required by 37 CFR 1.821-1.825. The notification set a two-month time limit in which to respond.

On 03 December 2007, 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, (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 the Yoshiko KITA has refused to sign the application. Section 409.03(d) of the MPEP, **Proof of Unavailability or Refusal**, states, in part:

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Regarding item (2) above, a review of the present petition reveals that applicants have not satisfied item (2) above, in that petitioner has not provided sufficient proof that the inventor refuses to execute the application. Petitioner has provided a "Statement of

Facts" (by Tomo Nishimoto) outlining the efforts to reach Yoshiko KITA and copies of the letters sent to Ms. KITA. However, the statements made with regards to the efforts to reach Ms. KITA constitutes secondhand knowledge, at best, in that the majority of the actions to which Tomo Nishimoto is averring to were conducted by a staff member at Hiraki & Associates.

Regarding item (4) above, an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor has been submitted with the present petition. A review of the declaration filed reveals that the sixth joint inventor, Ikuo NISHIMOTO, is deceased.

*Declaration of the Inventors under 37 CFR 1.42*

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

> In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

The declaration filed 03 December 2007 is executed by Tomo NISHIMOTO as the legal representative of the deceased inventor and provides her residence, post office address and country of citizenship. In addition, the declaration provides the residence, post office address and country of citizenship of the deceased inventor. The declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b).

For the reasons stated above, it would not be appropriate to accept the application without the signature of Yoshiko KITA under 37 CFR 1.47(a) at this time.

## CONCLUSION

For the above reasons, the petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

The request for status under 37 CFR 1.42 is **ACCEPTED**.

The sequence listing and sequence listing in computer readable form have been forwarded to Scientific and Technical Information Center for further processing.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box

1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

12/13/2007 SBASHEIR 00000002 022448 11578142
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07 MAR 2008

Birch, Stewart, Kolasch, & Birch, LLP
P.O. Box 747
Falls Church, VA 22040-0747

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| In re Application of | : | |
| CHIBA et al. | : | |
| U.S. Application No. 11/578,142 | : | DECISION ON |
| PCT No.: PCT/JP05/07286 | : | PETITION |
| Int. Filing Date: 08 April 2005 | : | UNDER |
| Priority Date: 08 April 2004 | : | 37 CFR 1.47(a) |
| Attorney Docket No.: 1254-0249PUS3 | : | |
| For: THERAPEUTIC AGENT FOR NEURODEGENERATIVE DISEASE | : | |

This decision is issued in response to applicants' "Renewed Petition under 37 CFR 1.47(a)" filed 14 February 2008 and applicants' "Supplemental Renewed Petition under 37 CFR 1.47(a)" filed 20 February 2008 to accept the application without the signature of joint-inventor, Yoshiko KITA. No petition fee is required.

## BACKGROUND

On 08 April 2005, applicants filed international application PCT/JP05/07286 which claimed a priority date of 08 April 2004. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 20 October 2005. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee in the United States was to expire 30 months from the priority date, 10 October 2006.

On 10 October 2006, 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 translation of the international application; and a preliminary amendment.

On 01 August 2007, 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. Furthermore, the Notification indicated that a Sequence Listing had not been filed as required by 37 CFR 1.821-1.825. The notification set a two-month time limit in which to respond.

On 03 December 2007, applicants filed a petition under 37 CFR 1.47(a). In decision dated 14 December 2007, applicants' petition under 37 CFR 1.47(a) was dismissed without prejudice.

On 14 February 2008, applicants filed a "Renewed Petition under 37 CFR 1.47(a)."

On 20 February 2008, applicants filed a "Supplemental 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, (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.

Applicants here have submitted the appropriate petition fee. Item (1) is therefore satisfied.

Regarding item (2), the petition asserts that the nonsigning inventor has refused to execute the declaration. Before a refusal to execute the application can be claimed, section 409.03(d) of the MPEP requires that the nonsigning inventor be provided with a copy of the complete application, including specification, drawings and claims. The MPEP also requires "a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made."

Here, the evidence submitted to demonstrate Yoshiko KITA's refusal to execute the application papers is contained in the Statements by Noriko Nakanishi and Takaxhi Sasaki included in the petition, and the exhibits thereto. These materials provide the required firsthand statement regarding the delivery to the nonsigning inventor of a copy of the complete application, and the nonsigning inventor's refusal to execute the application, with documentary evidence supporting the statement. Item (2) is therefore satisfied.

Regarding item (3), applicants have provided the last known address of the nonsigning inventor. Accordingly, item (3) is therefore satisfied.

Regarding item (4), 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 declarations executed by two of the three inventors and including an unsigned signature box identifying the nonsigning inventor (Yoshiko KITA). This declaration is treated as having been executed by the available inventors on their behalf and on behalf of the nonsigning inventor. Further, the declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b). Item (4) is therefore satisfied.

For the reasons stated above, it is appropriate to accept the application without the signature of Yoshiko KITA under 37 CFR 1.47(a) at this time.

## CONCLUSION

The petition under 37 CFR 1.47(a) is **GRANTED**.

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(a) will be published in the Official Gazette.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (571) 273-0459

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Alexandria, VA 22313-1450
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00466
YOUNG & THOMPSON
745 South 23rd Street
Arlington, VA 22202

In re Application of :
HASCHKE, Heinz :
U.S. Application No.: 11/578,155 :
PCT No.: PCT/AT2005/000130 :
Int. Filing Date: 14 April 2005 :
Priority Date: 16 April 2004 :
Attorney Docket No.: 4301-1171 :
For: METHOD FOR THE PRODUCTION OF :
PACKAGING MATERIAL SYSTEMS :
FOR TECHNICAL . . . :

**DECISION ON PAPERS FILED UNDER 37 CFR 1.42**

This is a decision on the declaration filed on 11 October 2006 which has been treated as a petition under 37 CFR 1.42. No fee is required.

## BACKGROUND

On 11 October 2006, applicant submitted papers to enter the national stage of PCT/AT2005/000130 which was accompanied by, *inter alia*, a declaration signed by the legal representative of a deceased inventor.

## 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 citizenship, residence and address of the deceased inventor Heinz Haschke is listed on the declaration pursuant to 37 CFR 1.497(a)(3) and 37 CFR 1.63(c)(1).

Moreover, the citizenship, residence and address of the legal representative of the deceased inventor, Erica Haschke, is also listed on the declaration as required by 37 CFR 1.497(b)(2).

## CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

**11/578,155**

This application is being forwarded to the Office of Patent Application Processing for continued processing.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

Mail Date: 04/20/2010

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| **Applicant** | : Toshihito Kumagai | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7601734 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/13/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 11/578,169 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/11/2006 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **171** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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08 DEC 2006

Erik Dessen
Elisenbergveien 35 A
N-0265
Oslo, Norway

In re Application of: Erik Dessen
Application No.: 11/578,173
PCT Application No.: PCT/NO03/00323
Int. Filing Date: 24 September 2003
Priority Date Claimed: 27 September 2002
Attorney Docket No.: N/A
For: Method for the Filling of Particulate Material in Vertical Tubes.

DECISION ON PETITION UNDER 37 CFR 1.137(b)

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 11 October 2006.

## BACKGROUND

On 24 September 2003, Applicant filed international application PCT/NO03/00323, which claimed a priority of an earlier application from Norway filed on 27 September 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 27 March 2005.

International application PCT/NO03/00323 became abandoned as to the United States for failure to timely pay the basic national fee.

On 11 October 2006, applicant filed the present petition under 37 CFR 1.137(b).

## 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) the required reply, (2) the petition 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 and fee (if the international application was filed prior to June 8, 1995).

With regard to Item (1), applicant has provided the required reply under 35 U.S.C. 371. A copy of the international application and the basic national fee has been filed in the United States Receiving Office (RO/US).

With regard to Item (2), the appropriate petition fee of $1500 as required by 37 CFR 1.17(m) has been paid.

With regard to Item (3), Applicant's statement that "[t]he entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" has been satisfied.

With regard to Item (4), a terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that applicant has satisfied the requirements of 37 CFR 1.137(b), and that the application satisfies the requirements of 35 U.S.C. 371 for entry into the national stage in the United States.

## CONCLUSION

For the reason set forth above, the petition to revive the international application abandoned under 37 CFR 1.137(b) is **GRANTED** as to the National Stage in the United States of America, and will be processed, under 35 U.S.C. 371, as application number **11/578,173**, at this time.

The application has an international filing date of 24 September 2003, under 35 U.S.C. 363, and a 35 U.S.C. 371(c)(1), (2) and (4) date of 11 October 2006.

Application number **11/578,173** is being forwarded to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision.

Taofiq A. Solola, PhD. JD.
PCT Legal Administration
Telephone: 571-272-6094
Facsimile: 571-272-0459

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration