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IBM CORPORATION (SWP)
C/O SUITER SWANTZ PC LLO
14301 FNB PARKWAY, SUITE 220
OMAHA NE 68154-5299

In re Application of:
BEARDALL, GAVIN D., et al.
Serial No.: 12/098,935
Filed: April 07, 2008

Title: **METHOD FOR LOCKING AN ELECTRICAL DEVICE TO A GIVEN LOCALE**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 07, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions set forth under section I. above are considered to have been met. However, the petition fails to comply with conditions set forth under section II. Items 5.2, 53, 6.2 and 6.3.

For these reasons cited above, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirement in item 5.2 and 5.3 above, the preexamination search document provided with the instant petition is deficient as follows: The database searches which are to be provided under section 8(A) are not sufficient. A database search that uses 'distance' or 'GPS' as two or more alternatives to "location" should also be included.

Regarding the requirement in item 6.2 above, the Accelerated Examination Support Document is deficient because section 9(B) titled "Identification of Limitations Disclosed by References" provides only a broad general description of each reference cited. However, the petition fails to identify all of the limitations in the claim of the application that are disclosed by each reference cited and specifying where each limitation is disclosed by each cited reference as required by item 6.2. Clarification is required

Regarding the requirement in items 6.2 and 6.3 above, petitioner does not provide an identification of claimed limitations and/or a detailed explanation of patentability of the claim ***with respect to each reference*** cited in the IDS in support of the Accelerated Examination Support Document. Petitioner has only identified claim limitations and also argued the patentability of the claim in regard to three of the six cited references in the IDS filed with the accelerated examination support document (WO0057378, GB2389004, and GB2393075). The Accelerated Examination Support Document does not provide an identification of claimed limitations and/or a detailed explanation of patentability of the claim with respect to the other three cited references WO2005109363, Power line communication NPL document, and Home automation NPL document *Therefore, any request for reconsideration must provide a detailed explanation in regard to the claim with respect to the other three cited references as set forth in items 6.2 and 6.3 above.*

If any request for reconsideration is filed, an updated preexamination search must be conducted as per items 5.2 and 5.3 above, and the Preexamination Search Document must be amended to indicate such; a new Information Disclosure Statement should be filed to cite any newly found prior art, and the Accelerated Examination Support Document must also be amended to include the necessary reference and discussion of any newly found and cited prior art in accordance with all of items 6 through 6.6 above.

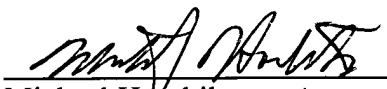
## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Michael Horabik, Quality Assurance Specialist, at (571) 272-3068.



Michael Horabik
Quality Assurance Specialist
Technology Center 2600
Communications

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IBM CORPORATION (SWP)
C/O SUITER SWANTZ PC LLO
14301 FNB PARKWAY, SUITE 220
OMAHA NE 68154-5299

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JUN 30 2008

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TECHNOLOGY CENTER 2600

In re Application of:
BEARDALL, GAVIN D. et al,
Serial No.: 12/098,935
Filed: April 07, 2008

Title: **METHOD FOR LOCKING AN ELECTRICAL DEVICE TO A GIVEN LOCALE**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on June 12, 2008 requesting reconsideration to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

All of the requirements to correct the deficiencies outlined in the petition decision mailed May 12, 2008 have been met.

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral

election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:

To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Michael Horabik, Quality Assurance Specialist, at (571) 272-3068.

Michael Horabik
Quality Assurance Specialist
Technology Center 2600
Communications

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/098,974 | 04/07/2008 | Joseph K. Chacko | GB920080078US1 | 3394 |

45046 7590 07/23/2008

IBM CORPORATION (SWP)
C/O SUITER SWANTZ PC LLO
14301 FNB PARKWAY, SUITE 220
OMAHA, NE 68154-5299

| EXAMINER | |
|---|---|
| HONG, STEPHEN S | |

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| 07/23/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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IBM CORPORATION (SWP)
C/O SUITER SWANTZ PC LLO
14301 FNB PARKWAY, SUITE 220
OMAHA NE 68154-5299

In re Application of: CHACO et al.
Serial No.: 12/098974
Filed: April 7, 2008
Docket: GB920080078US1
Title: METHOD FOR PROVIDING USER-DEFINITIONS OF TERMS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 7, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions I.1 – I.4, II.1 – II.4, II.6.4, and II.6.6 above are considered to have been met. However, the petition fails to comply with conditions II.5, II.6.1, II.6.2, II.6.3, and II.6.5 above. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

With respect to item **II.5.1 and II.5.2** above, petitioner is required to provide keywords and phrases encompassing limitations of each claim including those deemed by the applicant as patentable features distinguishing the claimed invention from the cited prior art used in any database search. The preexam search must be directed to the (instant) claimed invention and encompass all of the disclosed features of the (instant) claims.

The guidelines for Applicants under the New Accelerated Exam Proc states as follows in Part I item 8 section 2.: A text search of the US patents and published patent applications that covers the subject matter of the independent claims using terms recognized in the art given their broadest reasonable interpretation. The search should consider **individual features by themselves and combinations of features**. The search should cover the **broadest scope encompassed by the claims as well as claims of narrow and intermediate breadth**.

Specifically and with respect to items 5.1 - 5.2 above, on the class/subclass search, given the total number of patents in all the class/subclasses listed as searched, **Petitioner should clarify if a limited classified search was conducted, and if so, how it was limited. Otherwise, a mere listing of class/subclass will be taken as a representation that all of the documents were reviewed in their entirety.**

Based upon the claimed subject matter of the instant application, a search in the following classes and subclasses is recommended in order to provide full coverage of where the most pertinent references are most likely to be found: **class 715 subclass 205** (Hypermedia) under which the application is classified.

**With respect to the text search,** the searches on the patents databases is found to be too restrictive, by trying to search for all search terms in very close proximity. A broader search such as the following is expected to generate several relevant results. On the other hand, the google search is found to be too broad. The search logic listed for the Google search "instant message provide user defined definition" is found to be too broad, returning over 200,000 hits.

Petitioner should review all claim limitations, especially those believed to be patentable distinctions from the cited references to ensure that the search covered these concepts, and update the search and/or provide any clarifications. **Any reference which teaches any portion of the limitation must be so identified even if the reference does not teach the entirety of the limitation.**

In addition, petitioner should **review the Identification of Limitations disclosed by References and the Detailed Explanation of Patentability** sections **in view of updated search, and changes and clarifications, and provide clarifications, as necessary, to ensure compliance with the requirement of items 6.2 and 6.3 above.**

Regarding the requirement of MPEP § 708.02(a)(I.)(I)(1) and item **6.1** above, the IDS submitted with the application lists reference WO2006115718 that have not been listed or discussed in the AESD. Further, the AESD does not provide an identification of how the claim limitations are taught by the each of these references. Nor is there an explanation of how the instant application distinguishes over these references. Further, the AESD discusses a reference Aaron et al (US 20060167993) that is neither listed in the IDS nor in the "References deemed most closely related" section of the AESD. Hence the IDS is deemed insufficient. If applicant wishes to cite references, that are not required in an AESD, for the examiner to consider, applicant may submit such references in a separate information disclosure statement (IDS) in compliance with 37 CFR 1.98. Applicant should clearly identify the IDS of the AESD that is in support of the petition to make special, and applicant should clearly identify the separate IDS containing references not discussed in the accelerated examination support document, and that is not in support of the petition to make special. Consistent with 37 CFR 10.18, any reference submitted in a separate IDS that is not part of an AESD is a representation by applicant to the USPTO that no reference submitted in the separate IDS is deemed closer to the subject matter of at least one claim than the references provided in the AESD. If applicant deems references found after the initial filing to be closer to the subject matter of at least one claim than the references provided in the AESD, then applicant needs to supplement the AESD to account for these references.

Regarding the requirement of MPEP § 708.02(a)(I.)(I)(3) and item **6.2 above**, the Accelerated Examination support Document only provides a general discussion of the references that was cited to be pertinent to the claimed invention, and reproduces the complete claim language as being not taught by the reference(s). Applicant should provide a claim-by-claim mapping of the pertinent subject matter disclosed in each of the references, specifically identifying each claim limitation and corresponding disclosure within the reference, citing to specific relevant portions of each reference. **Any reference which teaches any portion of the limitation must be so identified even if the reference does not teach the entirety of the limitation. Petitioner should review all claim limitations, especially those believed to be patentable distinctions from the cited references to ensure that the search covered these concepts, and update the search and/or provide any clarifications.**

In addition, petitioner should **review the Identification of Limitations disclosed by References and the Detailed Explanation of Patentability** sections **in view of updated search, and changes and clarifications, and provide clarifications, as necessary, to ensure compliance with the requirement of items 6.2 and 6.3 above.**

Regarding the requirement of MPEP § 708.02(a)(I.)(I) and item II 6.3; the Accelerated Examination Support Document (AESD) does not provide a detailed explanation of how each of the claims are patentable with the particularity required by 37 CFR 1.111(b) and (c). In section 9(C) of the AESD, petitioner asserts that "all of the references identified above" fail to teach or suggest the identified limitations; thus concluded that the claims are patentably distinguished over the references alone or in combination.

By identifying all limitations as those limitations that the reference(s) do not show or suggest, the petition fails to discuss the claimed limitations with respect to the references in accordance with the requirements of 37 CFR 1.111 (b) and (c). That is, the petition does not specifically properly

compare/contrast the claimed invention with respect to the relevant teachings in the prior art in the identified references. A general allegation that "all of the references fail to at least teach ... and therefore patentably distinguish over each of the references alone or in combination" does not comply with the requirements. Petitioner fails clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited. The Office cannot infer or guess what petitioner believes the differences between the claims and the teachings of the prior art to be. For these reasons, the petition does not meet the requirement of MPEP § 708.02(a)(I.)(I)(3).

It should be noted that while applicant's detailed explanation of how each of the claims are patentable over the cited references (every reference fails to teach **any** limitation of any independent claim) is technically acceptable, not finding even one reference that teaches even one claimed limitation is another indication of the inadequacy of the search. It is assumed that after the supplemental search is completed new references will be found that better read on the claimed invention and will be properly analyzed in the Support Document include with any renewed petition.

Petitioner is requested to clearly point out claim limitations not taught by any of the references and how the limitations are patentably distinguished over the references cited alone or in combination.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Mano Padmanabhan, at (571) 272-4210. If attempts to reach the undersigned by telephone are unsuccessful, Kakali Chaki, Quality Assurance Specialist, can be reached at (571) 272-3719.

/Mano Padmanabhan/

Mano Padmanabhan,
Quality Assurance Specialist
Technology Center 2100
Computer Architecture, Software and Information Security

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UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/098,974 | 04/07/2008 | Joseph K. Chacko | GB920080078US1 | 3394 |

45046 7590 09/30/2008

IBM CORPORATION (SWP)
C/O SUITER SWANTZ PC LLO
14301 FNB PARKWAY, SUITE 220
OMAHA, NE 68154-5299

| EXAMINER | |
|---|---|
| HONG, STEPHEN S | |

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| 09/30/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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IBM CORPORATION (SWP)
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OMAHA NE 68154-5299

In re Application of: CHACO et al.
Serial No.: 12/098974
Filed: April 7, 2008
Docket: GB920080078US1
Title: METHOD FOR PROVIDING USER-DEFINITIONS OF TERMS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the renewed petition filed on August 25, 2008, to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d). The original petition, submitted on April 7, 2008, was dismissed in the decision mailed on July 23, 2008.

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:

If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve-month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application. In addition, Applicant is reminded that due to the dismissal of the previous petition submission, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Mano Padmanabhan at (571) 272-4210. If attempts to reach the undersigned by telephone are unsuccessful, Kakali Chaki, Quality Assurance Specialist, can be reached at (571) 272-3719.

/Mano Padmanabhan/

Mano Padmanabhan
WQAS Technology Center 2100
Computer Architecture, Software, and Information Security

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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. |
|---|---|---|---|---|
| 12/099,000 | 04/07/2008 | Michael Arnouse | ARN-03-1221-CIP2 | 3440 |

35811 7590 11/07/2008

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ONE LIBERTY PLACE
1650 MARKET ST, SUITE 4900
PHILADELPHIA, PA 19103

| EXAMINER | |
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| MOAZZAMI, NASSER G | |
| **ART UNIT** | **PAPER NUMBER** |
| 2436 | |

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|---|---|
| 11/07/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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Paul Taufer
IP Group of DLA Piper US LLP
One Liberty Place
1650 Market St, Suite 4900
Philadelphia PA 19103

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NOV 07 2008

TECHNOLOGY CENTER 2100

In re Application of:
Arnouse
Serial No.: 12/099,000
Filed: April 7, 2008
Docket: ARN-03-1221-CIP2
For: **Portable Computing System, Apparatus and Method**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 7, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document.

An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The **conditions I 1-4, II 1-5, II 5.1, II 5.3, II 6.1, II 6.4 and II 6.6 above are considered to have been met. However, the petition fails to comply with conditions II 5.2, II 6.2-6.3 and II 6.5 above**. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirement of MPEP § 708.02(a)(I.)(H) and item II.5.2 above, the preexamination search does not encompass all of the features of the claims, and does not appear to have given the claims the broadest reasonable interpretation.

Specifically, the text search strategy should be added to supplement the classified search performed. Here is an example search strategy that would complete this requirement.

1) (smart near card OR card OR trust$3 near platform near module) with (activat$3 OR start$3 OR power$3 near on) with (lap$1top OR personal near computer OR PC OR computer OR PDA portable near digital near assistant OR (cell mobile) near phone)

2) (smart near card OR card OR trust$3 near platform near module) near3 (activat$3 OR start$3 OR power$3 near on) near3 (lap$1top OR personal near computer OR PC OR computer OR PDA OR portable near digital near assistant OR (cell mobile) near phone)

3) (smart near card OR card OR trust$3 near platform near module) near3 (activat$3 OR start$3 OR power$3 near on) adj (lap$1top OR personal near computer OR PC OR computer OR PDA OR portable near digital near assistant OR (cell mobile) near phone)

This strategy should or rough equivalent should be performed on a database that includes US Patents, US PG Pubs, Foreign Patents and Non Patent Literature.

Or is the default operator. Petitioner should review all claim limitations, especially those asserted as patentable distinctions from the cited references to ensure that the search covers these concepts, and update the search and/or provide any clarifications if deemed necessary.

The search document states that the classes and subclasses list in the classified search where searched by an extensive keyword search. What search strategy was used? It should be noted that it is rare that a text search by itself would be considered a complete search strategy. MPEP 904.02 A recommended search strategy is a couple of the most relevant subclasses are searched by themselves

viewing each document or combined in a text search with a few relevant terms. A larger subset of subclasses can be combined with more search terms.

Finally, based upon the claimed subject matter of the instant application, a search in the following class and subclasses is recommended in order to provide full coverage of where the most pertinent references are most likely to be found: Class 726 Information Security Subclasses 9 (Access Control using Tokens e.g. smart cards) and Class 235 Registers Subclass 375 (Systems Controlled by Data Bearing Records) for subject matter dealing with access control of portable computers. This additional search area was confirmed with an examiner in the pertinent art area.

With regard to the requirement of MPEP § 708.02(a)(I)(2) and item 6.2 above, Petitioners identification of limitations in the independent claims is proper however none of the dependent claims have been discussed. Petitioner must provide a detailed discussion of each of the identified references, identifying subject matter by way of figure, page, column and line numbers, as appropriate, as they pertain to ALL of the claim limitations of the instant application.

With regard to the requirement of MPEP § 708.02(a)(I)(2-3) and item 6.3 above, Petitioners statement of how certain features are not taught or rendered obvious by each individual reference alone is proper however the support document fails to discuss how the combination of references fails to render the claims obvious. Nor does the support document discuss whether any of the features not taught by the references one could take official notice of and thus be obvious.

Regarding the requirement of MPEP § 708.02(a)(I.)(5) and item II.6.5 above, the preexamination support document fails to provide a proper showing of the 112 1st support for each and every claim feature for the applications that this application claims priority on and this application. A single set of paragraph numbers are referenced for each claim feature but the record is not clear as to whether these paragraphs refer to this application's specification, the provisional application's specification, the parent's specifications specification or all 3 spefications. Clarification is required.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Tod Swann, Quality Assurance Specialist, at (571) 272-3612. A second point of contact is QAS Kim Huynh whose number is (571)-272-4147.

/Tod R Swann/

Tod R Swann
Technology Center 2400

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WASHINGTON, DC 20231
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TECHNOLOGY CENTER 2100

IP GROUP OF DLA PIPER US LLP
ONE LIBERTY PLACE
1650 MARKET ST, SUITE 4900
PHILADELPHIA PA 19103

In re Application of:
Arnouse, Michael
Serial No.: 12/099,000
Filed: April 07, 2008
Docket: ARN-03-1221-CIP2
For: **Portable Computing System, Apparatus and Method**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the renew petition filed on December 17, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The original petition to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d), submitted on April 07, 2008 was dismissed in the decision mailed on November 07, 2008.

Renew petition filed December 17, 2008 in response to the dismissed decision mailed November 07, 2008, has been considered and found deficient with respect to Condition II. 6.5.

Applicant (Cruz, Richard Reg. No. 52,783) was contacted on December 16, 2008 and requested a supplemental/renew petition to correct noted deficiency with respect to above mentioned condition for showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification for the parent application. Condition states that if instant application claims the benefit of one or more applications under title 35, United States Code, the showing where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists is required.

The renew petition to make the application special is **GRANTED** as the Supplemental Accelerated Support Document filed December 17, 2008 meets the requirements of conditions II 6.2 that were noted deficient in the renew petition.

The application is eligible for accelerated examination and the renewed petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323) as

the original identified deficiencies for failing to comply with the requirements for the pre-examination search encompassing all of the features of the claims, and giving the claims the broadest reasonable interpretation, the statement of patentability must provide a detailed explanation of how each of the claims are patentable and the concise statement of the utility must be of the invention as defined in each of the independent claims (reference must be made to independent claims 1, 14 and 20) have been corrected.

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent

claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:

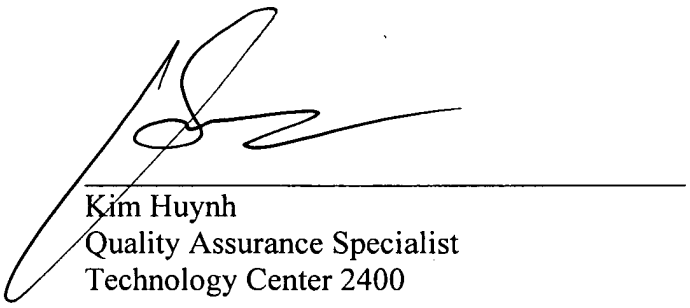
If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Tod Swann, Quality Assurance Specialist, at (571) 272-3612. A second point of contact is WQAS Kim Huynh at (571) 272-4147.

/bp/



Kim Huynh
Quality Assurance Specialist
Technology Center 2400

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,000 | 04/07/2008 | Michael Arnouse | ARN-03-1221-CIP2 | 3440 |

35811 7590 12/19/2008

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ONE LIBERTY PLACE
1650 MARKET ST, SUITE 4900
PHILADELPHIA, PA 19103

| EXAMINER | |
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| LOUIE, OSCAR A | |

| ART UNIT | PAPER NUMBER |
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| 2436 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 12/19/2008 | PAPER |

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The time period for reply, if any, is set in the attached communication.

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OFFICE OF PETITIONS

In re Application of :
Seefeldt et al. :
Application No. 12/099,009 :
Filed: April 7, 2008 :
Attorney Docket No. BARL-010/01US :
302124-2069

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 13, 2009.

The request is **DISMISSED** as involving a moot issue.

A review of the file record indicates that the power of attorney to the attorneys/agents associated with Customer Number 25226 was revoked by the assignee of the patent application on August 26, 2009. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Liana Walsh
Petitions Examiner
Office of Petitions

cc: COOLEY GODWARD KRONISH LLP
ATTN: PATENT GROUP
SUITE 1100
777 - 6TH STREET, NW
WASHINGTON DC 20001

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,032 | 04/07/2008 | Michael Arnouse | ARN-08-1059R | 3500 |

35811 7590 11/07/2008

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ONE LIBERTY PLACE
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PHILADELPHIA, PA 19103

| EXAMINER | |
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| ART UNIT | PAPER NUMBER |
| 2431 | |

| MAIL DATE | DELIVERY MODE |
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| 11/07/2008 | PAPER |

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The time period for reply, if any, is set in the attached communication.

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Paul Taufer
IP Group of DLA Piper US LLP
One Liberty Place
1650 Market St, Suite 4900
Philadelphia PA 19103

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NOV 07 2008

TECHNOLOGY CENTER 2100

In re Application of:
Arnouse
Serial No.: 12/099,032
Filed: April 7, 2008
Docket: ARN-03-1221-CIP2
For: **Portable Computing System, Apparatus and Method**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 7, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document.

An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions I 1-4, II 1-5, II 5.1, II 5.3, II 6.1, II 6.4 and II 6.6 above are considered to have been met. However, the petition fails to comply with conditions II 5.2, II 6.2-6.3 and II 6.5 above. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirement of MPEP § 708.02(a)(I.)(H) and item II.5.2 above, the preexamination search does not encompass all of the features of the claims, and does not appear to have given the claims the broadest reasonable interpretation.

Specifically, the text search strategy should be added to supplement the classified search performed. Here is an example search strategy that would complete this requirement.

1) (smart near card OR card OR trust$3 near platform near module) with (activat$3 OR start$3 OR power$3 near on) with (lap$1top OR personal near computer OR PC OR computer OR PDA portable near digital near assistant OR (cell mobile) near phone)

2) (smart near card OR card OR trust$3 near platform near module) near3 (activat$3 OR start$3 OR power$3 near on) near3 (lap$1top OR personal near computer OR PC OR computer OR PDA OR portable near digital near assistant OR (cell mobile) near phone)

3) (smart near card OR card OR trust$3 near platform near module) near3 (activat$3 OR start$3 OR power$3 near on) adj (lap$1top OR personal near computer OR PC OR computer OR PDA OR portable near digital near assistant OR (cell mobile) near phone)

This strategy should or rough equivalent should be performed on a database that includes US Patents, US PG Pubs, Foreign Patents and Non Patent Literature.

Or is the default operator. Petitioner should review all claim limitations, especially those asserted as patentable distinctions from the cited references to ensure that the search covers these concepts, and update the search and/or provide any clarifications if deemed necessary.

The search document states that the classes and subclasses list in the classified search where searched by an extensive keyword search. What search strategy was used? It should be noted that it is rare that a text search by itself would be considered a complete search strategy. MPEP 904.02 A recommended search strategy is a couple of the most relevant subclasses are searched by themselves

viewing each document or combined in a text search with a few relevant terms. A larger subset of subclasses can be combined with more search terms.

Finally, based upon the claimed subject matter of the instant application, a search in the following class and subclasses is recommended in order to provide full coverage of where the most pertinent references are most likely to be found: Class 726 Information Security Subclasses 9 (Access Control using Tokens e.g. smart cards) and Class 235 Registers Subclass 375 (Systems Controlled by Data Bearing Records) for subject matter dealing with access control of portable computers. This additional search area was confirmed with an examiner in the pertinent art area.

With regard to the requirement of MPEP § 708.02(a)(I)(2) and item 6.2 above, Petitioners identification of limitations in the independent claims is proper however none of the dependent claims have been discussed. Petitioner must provide a detailed discussion of each of the identified references, identifying subject matter by way of figure, page, column and line numbers, as appropriate, as they pertain to ALL of the claim limitations of the instant application.

With regard to the requirement of MPEP § 708.02(a)(I)(2-3) and item 6.3 above, Petitioners statement of how certain features are not taught or rendered obvious by each individual reference alone is proper however the support document fails to discuss how the combination of references fails to render the claims obvious. Nor does the support document discuss whether any of the features not taught by the references one could take official notice of and thus be obvious.

Regarding the requirement of MPEP § 708.02(a)(I.)(5) and item II.6.5 above, the preexamination support document fails to provide a proper showing of the 112 1st support for each and every claim feature for the applications that this application claims priority on and this application. A single set of paragraph numbers are referenced for each claim feature but the record is not clear as to whether these paragraphs refer to this application's specification, the provisional application's specification or both specifications. Clarification is required.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Tod Swann, Quality Assurance Specialist, at (571) 272-3612. A second point of contact is QAS Kim Huynh whose number is (571)-272-4147.

/Tod R Swann/

Tod R Swann, Quality Assurance Specialist
Technology Center 2400

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DEC 19 2008

TECHNOLOGY CENTER 2100

IP GROUP OF DLA PIPER US LLP
ONE LIBERTY PLACE
1650 MARKET ST, SUITE 4900
PHILADELPHIA PA 19103

In re Application of:
Arnouse, Michael
Serial No.: 12/099,032
Filed: April 07, 2008
Docket: ARN-08-1059R
For: **Reader Adapted for a Portable Computer**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the renew petition filed on December 17, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The original petition to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d), submitted on April 07, 2008 was dismissed in the decision mailed on November 07, 2008.

Renew petition filed December 17, 2008 in response to the dismissed decision mailed November 07, 2008, has been considered and found deficient with respect to Condition II. 6.5.

Applicant (Cruz, Richard Reg. No. 52,783) was contacted on December 16, 2008 and requested a supplemental/renew petition to correct noted deficiency with respect to above mentioned condition for showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification for the parent application. Condition states that if instant application claims the benefit of one or more applications under title 35, United States Code, the showing where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists is required.

The renew petition to make the application special is **GRANTED** as the Supplemental Accelerated Support Document filed December 17, 2008 meets the requirements of conditions II 6.2 that were noted deficient in the renew petition.

The application is eligible for accelerated examination and the renewed petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323) as

the original identified deficiencies for failing to comply with the requirements for the pre-examination search encompassing all of the features of the claims, and giving the claims the broadest reasonable interpretation, the statement of patentability must provide a detailed explanation of how each of the claims are patentable and the concise statement of the utility must be of the invention as defined in each of the independent claims (reference must be made to independent claims 1, 14 and 20) have been corrected.

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent

claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:

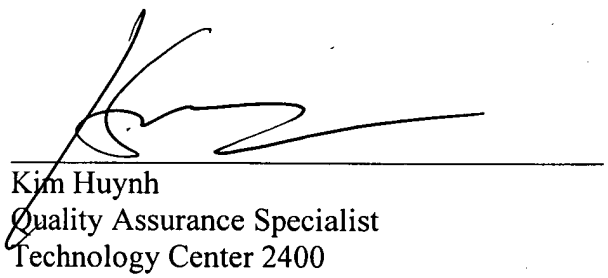
If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Tod Swann, Quality Assurance Specialist, at (571) 272-3612. A second point of contact is WQAS Kim Huynh at (571) 272-4147.

/bp/



Kim Huynh
Quality Assurance Specialist
Technology Center 2400

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,032 | 04/07/2008 | Michael Arnouse | ARN-08-1059R | 3500 |

35811 7590 12/19/2008

IP GROUP OF DLA PIPER US LLP
ONE LIBERTY PLACE
1650 MARKET ST, SUITE 4900
PHILADELPHIA, PA 19103

| EXAMINER | |
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| LOUIE, OSCAR A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2436 | |

| MAIL DATE | DELIVERY MODE |
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| 12/19/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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BLACK LOWE & GRAHAM, PLLC
SUITE 4800
701 FIFTH AVENUE
SEATTLE WA 98104

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JUL 1 8 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| David C. Pollock | : | |
| Application No. 12/099,033 | : | ON PETITION |
| Deposited: April 7, 2008 | : | |
| Attorney Docket No. VOET-1-0208 | : | |

This is in response to the "PETITION TO ADD INADVERTENTLY OMITTED MATERIAL UNDER 37 CFR 1.57", filed June 27, 2008, requesting that the above-referenced application be accorded a filing date of April 7, 2008. This petition is being treated pursuant to 37 CFR 1.53(e)(2)[1].

Application papers in the above-identified application were deposited on April 7, 2008. However, on April 28, 2008, the Office of Patent Application Processing mailed applicants a "Notice of Incomplete Nonprovisional Application," notifying applicants that the application papers had not been accorded a filing date because the application was deposited without drawings. In response, applicants timely filed this petition. Applicants request that the application be amended to include the inadvertently omitted drawings on the basis that the application as filed contained a prior benefit claim under 37 CFR 1.78.

Petitioner's arguments and evidence have been considered. However, a review of the application confirms that, as filed, the application contained at least one method claim. MPEP 601.01(f) provides that:

> It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

[1] Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f). In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

Thus, pursuant to § 601.01(f), a drawing is not considered essential for a filing date. The instant application is entitled to a filing date without drawings present in the application.

Accordingly, the Office should have granted the application a filing date and mailed a Notice of Omitted Items instead of a Notice of Incomplete Nonprovisional Application. As stated in MPEP 601.01(g) under the section entitled, "Application Entitled to a Filing Date," applicant may submit an amendment to include the inadvertently omitted portion of the drawing(s) pursuant to 37 CFR 1.57(a):

> [i]f an application was filed on or after September 21, 2004, and contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application that was present on the filing date of the application, and the omitted portion of the drawing(s) was inadvertently omitted from the application and is completely contained in the prior-filed application[.]

Receipt of the amendment, submitted with the instant petition, is acknowledged. The amendment will be considered by the examiner in due course.

To the extent the instant petition requests a filing date of April 7, 2008 with no drawings present in the application on filing, the petition is **GRANTED**.

Given the basis for granting this petition, the petition fee is being refunded to petitioner under separate cover.

Pursuant to this decision, the application will be referred to Office of Patent Application Processing for:

- **correction of the filing date to April 7, 2008**;
- **for indication in Office records, as appropriate, that "0" sheets of drawings were present on filing** and
- **for issuance of a filing receipt.**

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

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**MORRISON & FOERSTER LLP**
**12531 HIGH BLUFF DRIVE**
**SUITE 100**
**SAN DIEGO, CA 92130-2040**

MAILED

JUN 25 2010

OFFICE OF PETITIONS

In re Application of :
Stephen Harrison :
Application No. 12/099,074 : DECISION ON PETITION
Filed: April 7, 2008 : TO WITHDRAW
Attorney Docket No. 578422002300 : 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 21, 210.

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

A review of the file record indicates that the power of attorney to Morrison & Foerster LLP has been revoked by the assignee of the patent application on June 17, 2010. 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 Johnson at 571-272-2991.

Terri Johnson
Petitions Examiner
Office of Petitions

cc: **KING & SPALDING LLP**
**P.O. BOX 889**
**BELMONT, CA 94002-0889**

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,094 | 04/07/2008 | Nils HAUSTEIN | DE920080034US1 | 3610 |

48150 7590 06/19/2008

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

| EXAMINER | |
|---|---|
| PERVEEN, REHANA | |
| ART UNIT | PAPER NUMBER |
| 2116 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/19/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA VA 22182-3817

In re Application of: Haustein, et al.
Serial No.: 12/099,094
Filed: April 07, 2008
Docket: DE920080034US1
Title: SERVER-MANAGED POWER SAVING POLICIES FOR AUTOMATED TAPE LIBRARIES AND DRIVES

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 07, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees that the dependent claims will be grouped together with and not to separately argue the patentability of any independent claim from which they depend during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

REVIEW OF FACTS

The conditions I. 1-4 & II. 1-5, 5.1, 6.1, 6.4 & 6.6 above are considered to have been met. However, the petition fails to comply with conditions II. 5.2 - 5.3, 6.2, 6.3, & 6.5 above. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirement of MPEP § 708.02(a)(I.)(H)[1] and items 5.2 - 5.3 above, the pre-exam search must be directed to the (instant) claimed invention and encompass all of the disclosed features of the (instant) claims. The search logic does not seem to include the inventive concept or features included in the claim language and identified by Petitioner in the detailed explanation of patentability of the claims over the cited references. The search should consider individual features, combination of features as well as synonyms. The search should also cover the broadest scope encompassed by the claims. Based upon the claimed subject matter of the instant application, the following supplemental suggested search is presented:

Additional Class(es)/Subclass(es) should be searched:

713/320, 323; and additional text searches as below:

request$3 near5 ((restor$3 or backup) near2 data)

(required or necessary) near5 ((number of quantity or amount) near2 (drive or tape or disk or disc))

available near5 ((number of quantity or amount) near2 (drive or tape or disk or disc))

((select$3 or choos$3) near5 ((number of quantity or amount) near2 (drive or tape or disk or disc))

(power$3 near2 (up or on or start)) near2 (command or instruction)

(determin$3 or calculat$3) near3 (operation near2 (time or period))

(determin$3 or calculat$3) near3 (idle near2 (time or period))

(update$3 near3 power$3 near2 (state or mode))

power$3 near2 (off or shut$4 or stop$3 or halt$3)

The additional search recommendations were confirmed with and recommended by a (primary) examiner in the pertinent art area.

[1] MPEP 8th ed. rev 5 August 2006

With regard to the requirement of MPEP § 708.02(a)(I.)(I)(5) and item 6.2 above, Petitioner fails to identify where each limitation of the claim is disclosed by any of the references specifying where the limitation is disclosed in the cited reference. The petition briefly identifies subject matter disclosed in each of the references. The petition fails to correlate this to any of the claim limitations, as is required. Further, the petition fails to address any portion by figure or column/lines where any of the limitations are disclosed in any of the cited prior art references.

With regard to the requirement of MPEP § 708.02(a)(I.)(I)(5) and item 6.3 above, Petitioner fails to provide a detailed explanation of how the claim is patentable over any of the references cited with particularly required by 37 CFR 1.111(b) and (c). Specifically, the detailed explanation referred to, in the petition, only states that the entire claim (recites the entire claim) including each and every step is patentable over any of the cited references. However, the claim includes several generic steps that are well known in the art and admitted prior art in the specification, for example, "determining a required number of tape drives for an operation; determining an available number of powered tape drives; commanding a power control module to power selected tape drives; and performing a requested operation and repeating until the requested operation is completed". The petition fails to indicate specific steps that are taken by the applicants which are patentable over the prior art methods steps.

In addition, Petitioner should ensure that the above discussion is directed to how the language of (each of) the claim(s is) **specifically** distinguishable and patentable from each of the references provided in requirement (6.1) above, ***rather than to repeat essentially the entirety of the claim(s)***. The office cannot infer or guess what Petitioner believes the differences between the claim(s) and the teaching of the prior art to be. Furthermore, it would be difficult to conclude that the pre-examination search was directed to the claimed invention if essentially none of the claimed limitations were found in the prior art deemed "most closely related" by Petitioner. Clarification is required.

With regard to the requirement of MPEP § 708.02(a)(I.)(I)(5) and item 6.5 above, Petitioner fails to identify where each limitation of the instant claims finds support under 35 USC 112, first paragraph, in the written description of the specification. Support for each limitation of each pending claim must be properly identified (by page, line or paragraph and/or figure). Specifically, reference is made to Petitioner's ***general*** allegation that support in the disclosure under 35 USC 112, first paragraph, is found in following sections of specification middle, bottom, or top of pages 6 or 7. MPEP 2162 is reproduced below:

> **2162 Policy Underlying 35 U.S.C. 112, First Paragraph**
> To obtain a valid patent, a patent application must be filed that contains a full and clear disclosure of the invention in the manner prescribed by 35 U.S.C. 112, first paragraph. The requirement for an adequate disclosure ensures that the public receives something in return for the exclusionary rights that are granted to the inventor by a patent. The grant of a patent helps to foster and enhance the development and disclosure of new ideas and the advancement of scientific knowledge. Upon the grant of a patent in the U.S., information contained in the patent becomes a part of the information available to the public for further research and development, subject only to the patentee's right to exclude others during the life of the patent.
> In exchange for the patent rights granted, 35 U.S.C. 112, first paragraph, sets forth the minimum requirements for the quality and quantity of information that must be contained

> in the patent to justify the grant. As discussed in more detail below, the patentee must disclose in the patent sufficient information to put the public in possession of the invention and to enable those skilled in the art to make and use the invention. The applicant must not conceal from the public the best way of practicing the invention that was known to the patentee at the time of filing the patent application. Failure to fully comply with the disclosure requirements could result in the denial of a patent, or in a holding of invalidity of an issued patent.

The requirement of MPEP § 708.02(a)(I.)(I)(5) and item II. 6.5 above clearly states that the petitioner is required to **specifically identify corresponding elements in the figures** and **specifically identify where the corresponding written description in the cited portions of the instant specification** can find support under 35 U.S.C. § 112, first paragraph **for each limitation of claim 1**. A review of the pages 5-6 of the instant specification indicates that the description on this page is identical to the claimed language of claim 1, except of the legal phraseology used in patent claim (e.g. "said" and "wherein"). It is pointed out that the written description requirement has several policy objectives. The essential goal of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed. Another objective is to put the examiner in possession of what the applicant claims as the invention – the written description requirement implements the principle that a patent application must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the application is based and to demonstrate that the applicants were in possession of the invention that is claimed. Further, the written description requirement promotes the progress of expedite examination by ensuring that applicants adequately describe their inventions in sufficient detail in their applications in exchange for the right to take-up out of order of examination. Thus, a general statement that all limitations of claim(s) can be found by pointing to the specification having a verbatim of the claim language cannot be accepted to satisfy such a requirement of MPEP § 708.02(a)(I.)(I)(5) and item II. 6.5 above.

Clarification and identification of support for each limitation in the claim is required. Thus, the petition does not meet the conditions II. 5.2 - 5.3 and 6.2, 6.3, & 6.5 above.

## DECISION

For the above-stated reasons, the petition is **DISMISSED**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given ***a single opportunity*** to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a) is permitted) from the date of this decision in order to be considered timely. Any request for reconsideration ***must fully address all of the deficiencies indicated above***. [emphasis added]

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Brian Johnson, Quality Assurance Specialist, at (571) 272-3595. If attempts to reach the undersigned by telephone are unsuccessful, Kakali Chaki, Quality Assurance Specialist, can be reached at (571) 272-3719.

REHANA PERVEEN
SUPERVISORY PATENT EXAMINER
for

Brian L. Johnson
Quality Assurance Specialist, WG 2110
Technology Center 2100

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,094 | 04/07/2008 | Nils HAUSTEIN | DE920080034US1 | 3610 |

48150 7590 08/06/2008

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

| EXAMINER | |
|---|---|
| CHEN, TSE W | |
| **ART UNIT** | **PAPER NUMBER** |
| 2116 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/06/2008 | PAPER |

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07/23/2008

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA VA 22182-3817

In re Application of: Haustein, et al.
Serial No.: 12/099,094
Filed: April 07, 2008
Docket: DE920080034US1

Title: SERVER-MANAGED POWER SAVING POLICIES FOR AUTOMATED TAPE LIBRARIES AND DRIVES

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the renewed petition filed on June 26, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d). The original petition, submitted on April 07, 2008 was dismissed in the decision mailed on June 19, 2008.

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the

examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not

file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve-month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application. In addition, Applicant is reminded that due to the dismissal of the previous petition submission, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Brian Johnson, Quality Assurance Specialist, at (571) 272-3595. If attempts to reach the undersigned by telephone are unsuccessful, Kakali Chaki, Quality Assurance Specialist, can be reached at (571) 272-3719.

___/Rehana Perveen/ For_____

Brian Johnson, WQAS 2110
Technology Center 2100
Computer Architecture, Software and Information Security

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,116 | 04/07/2008 | Ralf Altrichter | DE920080036US1 | 3653 |

48150 7590 05/02/2008

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

| EXAMINER | |
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| ART UNIT | PAPER NUMBER |
| 3664 | |

| MAIL DATE | DELIVERY MODE |
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| 05/02/2008 | PAPER |

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MAY 0 2 2008

TECHNOLOGY CENTER 3600

McGinn Intellectual Property Law Group, PLLC
8321 Old Courthouse Road
Suite 200
Vienna, VA 22182-3817

In re application of :
Ralf Altrichter et al. :
Application No. 12/099,116 :
Filed: April 7, 2008 :
For: METHOD OF CALCULATING A ROUTE BASED ON ESTIMATED ENERGY CONSUMPTION :

**DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 CFR 1.102**

This is a decision on the petition filed on April 7, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED.**

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner;

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document.

An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; if the application claims the benefit of one or more applications

under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The petition fails to comply with conditions II.6.2 and II.6.5 above.

As to condition II.6.2, there currently is not an adequate listing of all the limitations (or portions thereof) in each of the claims that are disclosed in each of the cited references, specifying where each of the limitations (or portions thereof) are disclosed in each of the references. It is noted that there are explanations of the disclosures of the references, but it is not clear if the limitations (or a portion thereof) of each claim are clearly taught by the reference or not. That must be made clear.

As to condition to II.6.5, the showing of where each limitation of the claim finds support under 35 USC 112 in the written description of the application is insufficient. For each claimed limitation the petition needs to identify specific passages, or at least a single paragraph where each limitation is supported. Listing broadly paragraphs, without specifically pointing out which limitation is supported in a particular paragraph, does not comply with what is required.

Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

## DECISION

For the above-stated reasons, the petition is **DISMISSED**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Teri P. Luu, Quality Assurance Specialist, at (571) 272-7045.

Teri P. Luu
Quality Assurance Specialist
Technology Center 3600

TL/tl: 4/29/08

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,116 | 04/07/2008 | Ralf Altrichter | DE920080036US1 | 3653 |

48150 7590 08/18/2008

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

| EXAMINER | |
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| TRAN, DALENA | |

| ART UNIT | PAPER NUMBER |
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| 3664 | |

| MAIL DATE | DELIVERY MODE |
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| 08/18/2008 | PAPER |

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McGinn Intellectual Property Law Group, PLLC
8321 Old Courthouse Road
Suite 200
Vienna, VA 22182-3817

In re application of
Ralf Altrichter et al.
Application No. 12/099,116
Filed: April 7, 2008
For: METHOD OF CALCULATING A ROUTE BASED ON ESTIMATED ENERGY CONSUMPTION

**DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 CFR 1.102**

This is a decision on the renewed petition filed on May 29, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed to a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Quality Assurance Specialist Teri P. Luu, at (571) 272-7045.

Teri P. Luu
Quality Assurance Specialist
Technology Center 3600

TL/tl: 08/13/08

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,151 | 04/08/2008 | James Edward Bostick | AUS920071000US1 | 3714 |

56351 7590 07/17/2008

CHRISTINA M. EAKMAN
5304 20TH ST. N.
ARLINGTON, VA 22205

| EXAMINER | |
|---|---|
| CALDWELL, ANDREW T | |

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CHRISTINA M. EAKMAN
5304 20TH ST. N.
ARLINGTON VA 22205

In re Application of:
James E.BOSTICK, et al.
Serial No.: 12/099,151
Filed: April 08, 2008
Docket: AUS920071000US1
Title: SYSTEM FOR RECALLING DECLINED MEETINGS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 08, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims is patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions I.1 to II.4 above are considered to have been met. However, the petition fails to comply with conditions II.5 and II.6 above. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding item II.5.1 above, for classification searches, MPEP 719.05 states that a *classification search* is defined as a complete search of all the documents in a particular subclass, and it is not limited by any text query or other means. Petitioner is requested to **clarify whether the text search logic used was utilized in combination with the identified field of search** (i.e. class 705/8, 9; 715/963; and 708/112) or **separate therefrom** (i.e. the identified classes and subclasses were searched in their entirety); and if they were combined, **how the combination of searches were performed.**

Based upon the claimed subject matter of the instant application, a search in the following classes and subclasses is recommended in order to provide full coverage of where the most pertinent references are most likely to be found: **class 709 subclass 204** (computer conferencing) under which the application is classified.

Regarding the requirement of MPEP § 708.02(a)(I.)(I)(3) and item 6.3 above, the Accelerated Examination Support Document (AESD) requires a detailed explanation of how each of the claims are patentable with the particularity required by 37 CFR 1.111(b) and (c). The petitioner's "Statement of Patentability" is **not clear and consistent** as to how claim 1 is patentable over the references cited.

In the discussion of claim 1, petitioner's statement in section 9(C) of the Accelerated Examination Support Document (AESD), petitioner states that the claim is seen to patentably distinguish over each of these references alone or in combination since the identified references fail to at least teach or suggest:

1) differentiating the format of "displayed declined events" from accepted events on the calendar as required in displaying the declined invitations clause of claim 1

2) recalling a previously declined event for acceptance "by opening the declined event displayed on the calendar" required in the recalling clause of claim 1.

As for feature 1), applicant indicates in section 9(B) of the AESD that Kaminsky teaches "***displaying the declined invitations on the calendar as declined events*** in corresponding event time slots (figure 2, box 170; figure 6, box $4)"; and Boland teaches "displaying the declined invitations as declined events in corresponding event time slots (paragraphs [0047], [0048]), where the ***displayed declined events differentiate in format by displaying a different icon*** (declined icon 311, paragraph [0046] in front of the event when the event has been declined". Note that claim 1 requires the displayed declined events differentiate in format from a format of the accepted events ***by one or more of*** ... *displaying a different icon in front of the calendar event time slot when the event has been declined.* As such, it appears that the references do teach and suggest in combination the feature of "differentiating the format of displayed declined events from accepted events on the calendar as required in displaying the declined invitations clause of claim 1.

As for feature 2), applicant indicates in section 9(B) of the AESD that Kaminsky teaches "***displaying the declined invitations on the calendar as declined events*** in corresponding event time slots (figure 2, box 170; figure 6, box $4); and "***recalling a previously declined event for acceptance*** (receiving rejected event reminder, figure 3, box 190; figure 6, boxes $5 and $6), changing the status of the declined event from declined to accepted (scheduling button, figure 3, box 194; figure 6, box $7), and sending an updated status message to the sender indicating that a previously declined event has now been accepted (figure 6, box $8) (paragraph [0028])". As such, it appears the Kaminsky teaches the feature of recalling a previously declined event for acceptance "by opening the declined event displayed on the calendar" required in the recalling clause of claim 1.

Contrary to the applicant's statement regarding the patentability, all the claim features appear to be taught and/or suggested by the Kaminsky and Boland references. Petitioner is requested to clearly point out claim limitations not taught by any of the references and how the limitations are patentably distinguished over the references cited alone or in combination.

Regarding the requirement of MPEP § 708.02(a)(I.)(I)(5) and items 6.5-6.6 above, the Accelerated Examination Support Document is required to provide a showing of where ***each limitation of each claim*** finds support under 35 USC 112, first paragraph, in the written description of the specification. Petitioner identifies the support for the claimed features by referring to the entire figure 5 and blocks 110-180 of the specification rather than by page, line and corresponding element in the figures. As such each claim feature is not separately identified with its corresponding support element. Petitioner is required to identify each claim limitations and the corresponding support in the cited portions **(page, line, and corresponding element in the figures)** where the instant claim language finds corresponding support.

## DECISION

For the above-stated reasons, the petition is **DISMISSED**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed the undersigned whose telephone number is (571) 272-4147.

If attempts to reach the undersigned by telephone are unsuccessful, Tod Swann, Quality Assurance Specialist, can be reached at (571) 272-3612.

Kim Huynh,
Quality Assurance Specialist
Technology Center 2100
Computer Architecture, Software and Information Security

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,151 | 04/08/2008 | James Edward Bostick | AUS920071000US1 | 3714 |

56351 7590 10/01/2008

CHRISTINA M. EAKMAN
5304 20TH ST. N.
ARLINGTON, VA 22205

| EXAMINER | |
|---|---|
| CALDWELL, ANDREW T | |
| ART UNIT | PAPER NUMBER |
| 2142 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 10/01/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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CHRISTINA M. EAKMAN
5304 20TH ST. N.
ARLINGTON VA 22205

In re Application of:
James E.BOSTICK, et al.
Serial No.: 12/099,151
Filed: April 08, 2008
Docket: AUS920071000US1
Title: SYSTEM FOR RECALLING DECLINED MEETINGS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the renewed petition filed on Aug 12, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d). The original petition, submitted on April 8, 2008 was dismissed in the decision mailed on July 17, 2008.

In the transmittal letter the, petitioner states that a search in that class/subclass **709/204** (suggested in the July 17, 2008 dismissal) was conducted. However, the Updated Pre-Examination Search Document indicates that class/subclass **709/4** (rather than 709/204) was searched. It is of the understanding that a search in class/subclass 709/204 was performed; and the indication of class/subclass 709/4 was a typographical error since class/subclass 709/4 does not exist.

The renewed petition adequately addresses all the concerns raised in the dismissal, the petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the

amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
The twelve-month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application. In addition, Applicant is reminded that due to the dismissal of the previous petition submission, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed the undersigned whose telephone number is (571) 272-4147.

If attempts to reach the undersigned by telephone are unsuccessful, Tod Swann, Quality Assurance Specialist, can be reached at (571) 272-3612.

/Kim Huynh/

Kim Huynh,
Quality Assurance Specialist
Technology Center 2100
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DILLON & YUDELL LLP
8911 NORTH CAPITAL OF TEXAS HWY
SUITE 2110
AUSTIN TX 78759

JUL 29 2008

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| In re Application of: Blum Daniel, et al. | : | |
| Application No.: 12/099,188 | : | DECISION ON PETITION TO |
| Filed: April 8, 2008 | : | MAKE SPECIAL FOR NEW |
| Title: METHOD OF AND SYSTEM FOR ENFORCING AUTHENTICATION STRENGTH FOR REMOTE PORTLETS | : | APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02 |

This is a decision on the petition filed on April 8, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 U.S.C. 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 U.S.C. 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 U.S.C. 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 U.S.C. 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 U.S.C. 103(c).

## REVIEW OF FACTS

The conditions I: 1-4, II: 1-4, 5, 5.1, 5.3, 6, 6.1, and 6.6 above are considered to have been met. However, the petition fails to comply with conditions II: 5.2, 6.2, 6.3, 6.4 and 6.5 above.

Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

**Discussion**

When referring to "the petition" herein below, the received papers under consideration include the four page PTO/SB/28 form "Petition to Make Special Under Accelerated Examination Program", the "pre-examination search document" including pages 3-6; the "accelerated examination support document" comprising pages 7-8, and an Information Disclosure Statement.

Regarding the requirements of section II element 5.2 outlined above, it appears the search outlined in the petition omitted a critical search area by not searching in the following class/subclasses combinations:

709/203, 217-219, 227-229
726/4-5, 26-27
713/155-156, 168, 170, 176
715/741-742, 744.

In addition:

Applicants must search the following:

- All references that discuss the protocol on which this invention is based - Web Services for Remote Portlets.

- The concept of "authentication strength" or "authentication strength level" alone and without being linked to the concept of a portlet. The applicants have also not included searches for this concept using alternate terminology. For example, as IBM knows (see http://publib.boulder.ibm.com/infocenter/tivihelp/v2r1/index.jsp?topic=/com.ibm.itame.doc/am61_webseal_admin271.htm) alternate terminology for this concept is known as "step up authentication". As demonstrated in the aforementioned reference, a more general concept that needs to be searched for is the concept of "changing the authentication method." It would also be reasonably expected that references that describe the use of step up authentication might discuss the concepts of a user, person, or process being "challenged again" or "rechallenged." When searching for these concepts, the applicants are reminded that the order in which the terms appear may not, in some relevant references, be the same as given above. For example, on page 42 of the following IBM reference (http://www-05.ibm.com/de/events/websphere-portal61/pdf/WP61_WebSpherePortal_TechnicalOverview.pdf) the word level appears before "authentication strength." A reasonable search would recognize this fact and modify the search strategy accordingly.

- The concept of "portal or portlet" within some proximity of "security."

- An inventor name search in all of the databases.

- Regarding the text search of patent documents, the following in noted:

In the PATBASE search, applicants must include in L1 and L2 the term portal as an alternative to the concept of portlet; and include password as an alternative to the concept of authentication.

In the PATBASE search, the applicants only performed a full text search of the entire database in query L2. This query is incomplete. The applicants only searched for the term portlet. The applicants did not search the full text database for the alternatives to portlet identified in query L1. If too many results were obtained in the full text database, the applicants should have used a different proximity operator than the "and" used in query L1.

The text search of Google Scholar appears to be improperly recorded. Google does not allow use of the * as a truncation operator for words. In Google, the * is a wildcard operator that is used in phrases. What is listed as the search strategy would not appear to reflect what was actually entered into Google.

Regarding the requirements of section II element 6.2 outlined above, the petition fails to identify all of the limitations in the application claims that are disclosed in each of the reference(s) and where the limitation is disclosed in each of the cited reference. As stated in the policy published in the Federal Register on June 26, 2006 (71 Fed. Reg. 36323), for each reference cited, the examination support document must include an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference. The policy statement does not caveat "the independent claims", nor does it allow for grouping and general discussions. A grantable petition must delineate every limitation of every claim and identify where the equivalent limitation is disclosed in each piece of prior art cited on the IDS. As is published on www.uspto.gov/web/patents/accelerated/ in "Guidelines for Applicants under the new accelerated examination procedures"):

> *For each reference cited, the accelerated examination support document must include an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference. Applicants should specify where in each of the cited references the particular claim limitations are found. This process is intended to be analogous to the analysis an examiner uses when locating a relevant prior art reference and then determining whether the reference contains the claimed limitation. For each claimed limitation, the examiner would consider the disclosure of the reference and all reasonable portions in the reference where the limitation is shown. When preparing an Office Action, the examiner would correlate the limitation to the portion of reference which best characterizes the limitation. This part of the AESD is not intended to be an exhaustive listing of every conceivable subjective interpretation of how a claim limitation may read on the reference. Applicants should point out what are considered to be the relevant representations of the limitation in the reference. A limitation may be found in more than one portion of the reference and should be pointed out, yet the intention is not to have applicants point out every conceivable interpretation. The USPTO will adopt a rule of reason when evaluating this portion of the AESD. Unless the representation is so deficient that it would materially effect examination of the application (e.g., numerous instances where the limitations are*

*not shown where applicant states they are), the representation will be deemed to be sufficient for this part of the AESD.*

Petitioner's submission is not specific enough. Petitioner points out some limitations of the claim and provides direction to areas of the prior art where the corresponding limitation may be found. Petitioner does not address each limitation (i.e., each single limitation, NOT multiple limitations bundled together) and state where it is (or state that it is not) found in each one of the most closely related prior art. In particular, the present mapping fails to indicate which discrete limitation is not taught by the prior art. The requirement of section II element 6.2 can be satisfied by listing verbatim ("copy and paste") the presently filed claim (i.e., the claim of the instant application) and by indicating where each discrete limitation of said presently filed claim is taught (or is not taught) in each one of the cited most closely related references, by specifically indicating the element number and/or the relevant page/paragraph and line number(s), or by indicating "(not disclosed)" where appropriate - in order to ensure that no limitation was left out inadvertently. This one-to-one mapping should be performed individually, with regard to each one of the most closely related prior art that has been cited, one reference at a time. Applicant's attention is drawn to the fact that the requirement of this element calls for a straight mapping of each single limitation unto the prior art. Section II element 6.2 is not the place to make patentability arguments by bundling together multiple limitations and concluding that the combination is not disclosed. Patentability arguments should be made only in response to the requirement of section II element 6.3.

With respect to the requirements of section II element 6.3 outlined above, the petition fails to provide a detailed explanation of how the claim is patentable over (each of) the reference(s) with particularity required by 37 CFR 1.111(b) and (c). Petitioners should be specific in their explanation and include the identification of specific claim limitations that support their position, where appropriate. Petitioners must distinguish the claim from each piece of prior art cited. The Office cannot infer or guess what petitioner believes the differences between the claims and the teachings of the prior art to be. Petitioner's statements must also be consistent and must be related to the claim language. In the instant petition, it appears that the Petitioner failed to be specific in his arguments. For example while Petitioner argues for patentability that:

"The reference cited above fails to at least teach or suggest method of enforcing authentication strength for remote portlets, which includes the step of authenticating said consumer portal to said producer portal, said consumer portal having an authentication strength assertion level; a required feature of independent claim 1."

on p. 7, in response to the requirement of section II element 6.2, Petitioner states that

"authenticating a user (105,110) to a consumer portal (115), said user having an authentication strength level;"

Therefore, if authenticating a user to a consumer portal was known in the prior art, and if said user having an authentication strength level was also known in the prior art, it is not clear which particular limitation defines the present claim over the prior art, because as understood the consumer portal stands locally for the producer portal (specification, paragraph 0002).

Applicant is therefore required to review the patentability argument for specificity. The requirement of section II element 6.3 can be satisfied by indicating for the presently filed claim (i.e., the claim of the instant application) which specific i.e., discrete limitation(s) in said presently filed claim define(s) over each one of the most closely related references that has been, or will be cited. This patentability showing should be performed individually, with regard to each one of the most closely related prior art that has been or will be cited, one reference at a time.

Regarding the requirements of section II element 6.4 outlined above, the petition fails to identify a concise statement of the utility of the invention as defined in the independent claim. A general statement directed to the overall concept of the invention is not specifically relating the utility to each of the independent claims as is required by the policy. Petitioner should reference the independent claim language specifically when discussing the utility of the invention.

Regarding the requirements of section II element 6.5 outlined above, the requirements of this section are not met because lack of specificity. A grantable petition requires petitioner to provide a showing of where each limitation of the claim finds support under 35 U.S.C. 112, first paragraph, in the written description of the specification. The instant petition only identifies portions of text with respect to the claim as opposed to the disclosure of the required claim limitations. The requirement of section II element 6.5 can be satisfied by listing verbatim the presently filed claim (by "copy and paste") and by indicating where the instant application teaches each discrete limitation (without bundling limitations together to the extent possible), by indicating the element number and/or the relevant page and line numbers. Applicant's attention is also drawn to the requirements relevant under 35 U.S.C 112, 6$^{th}$ paragraph, listed above. Should this requirement not apply to the present application, Applicant should make a statement in this regard.

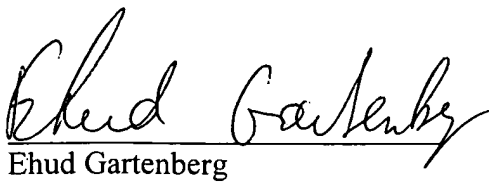
## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address all of the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Ehud Gartenberg, TC 3700 Special Programs Examiner, at (571) 272-4828. In his absence, an inquiry can be directed to J. Harrison, Special Program Examiner, at 571 272-4449.



Ehud Gartenberg
Special Programs Examiner
Technology Center 3700

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

DILLON & YUDELL LLP
8911 NORTH CAPITAL OF TEXAS HWY
SUITE 2110
AUSTIN TX 78759

SEP 04 2008

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| In re Application of: BLUM, DANIEL et al. | : | |
| Serial No.: 12/099,188 | : | DECISION ON PETITION TO |
| Filed: April 8, 2008 | : | MAKE SPECIAL FOR NEW |
| Title: METHOD OF AND SYSTEM FOR ENFORCING | : | APPLICATION UNDER 37 |
| AUTHENTICATION STRENGTH FOR REMOTE | : | C.F.R. § 1.102 & M.P.E.P. § |
| PORTLETS | : | 708.02 |

This is a decision on the request for reconsideration filed on August 22, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d). The request has been treated as a renewed petition to make the above-identified application special and has been viewed as a supplement to and in combination with the original petition which was filed on April 8, 2008 and dismissed in the Office letter of July 29, 2008.

The petition to make the application special is **DENIED.**

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the conditions as outlined in the prior petition decision. The conditions are not repeated herein.

## REVIEW OF FACTS

As stated in the decision of July 29, 2008, conditions I: 1-4, II: 1-5, 5.1 5.3, 6, 6.1 and 6.6 were considered to have been met. However, the petition failed to comply with conditions II: 5.2, 6.2, 6.3, 6.4 and 6.5. Upon reconsideration, the petition is considered to additionally meet II: 5.2, 6.4, and 6.5. However, the petition still fails to meet the requirement of section II: 6.2 and 6.3. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

## DISCUSSION

With regard to the requirement of section II element 6.2, Petitioner's mapping of the claimed limitations unto the prior art is not specific as required. For example, on p. 11 of the accelerated

examination support document (AESD) with respect to the mapping of the claimed limitations unto Cheng 2007/0240063, Petitioner states *inter alia*,

> authenticating a user to a consumer portal, said user having an authentication strength level (see paragraphs 31, 37 and 39);

Pointing to three paragraphs without identifying the location of discrete limitations in terms of step/element numerals and/or line numbers does not meet the specificity requirement. In addition, the mapping does not indicate which limitations are not disclosed by the prior art. The requirement of section II element 6.2 can be satisfied by listing verbatim ("copy and paste") the presently filed claim (i.e., the claim of the instant application) and by indicating where each discrete limitation of said presently filed claim is taught (or is not taught) in each one of the cited most closely related references, by specifically indicating the element number and/or the relevant page/paragraph and line number(s), or by indicating "(not disclosed)" where appropriate - in order to ensure that no limitation was left out inadvertently. Claim recitations must be complete. Statements such as "Limitation II(b) – (not disclosed)", i.e., recitations that do not spell out the relevant limitations should be avoided. This one-to-one mapping should be performed individually, with regard to each one of the most closely related prior art that has been cited, one reference at a time. Applicant's attention is drawn to the fact that the requirement of this element calls for a straight mapping of each single limitation unto the prior art. Section II element 6.2 is not the place to make patentability arguments by bundling together multiple limitations and concluding that the combination is not disclosed. Patentability arguments should be made only in response to the requirement of section II element 6.3.

With regard to the requirement of section II element 6.3, Petitioner argument for patentability over the prior art is not detailed with the particularity required. For example, on p. 12 of the AESD, Petitioner states *inter alia*, that the following limitations define over the all the prior art of record:

> The reference cited above fails to at least teach or suggest method of enforcing authentication strength for remote portlets, which comprises: authenticating said consumer portal to said producer portal said consumer portal having an authentication strength assertion level;

However, it appears that on p. 11 of the AESD, with respect to e.g., Cheng 2007/0240063, Petitioner stated that Cheng does disclose

> authenticating said consumer portal to said producer portal said consumer portal having an authentication strength level;

and consequently the only limitation that defines said recitation over Cheng is "assertion" (level). For this reason, the Petition fails to argue the patentability with the particularity required. The requirement of section II element 6.3 can be satisfied by indicating for the presently filed claim (i.e., the claim of the instant application) which specific i.e., discrete limitation(s) in said presently filed claim define(s) over each one of the most closely related references that has been cited. This patentability showing should be performed individually, with regard to each one of the most closely related prior art that has been cited, one reference at a time. Patentability

arguments must specifically spell out the relevant limitation(s); prior art patents can be referred to by the last name of the first inventor. Statements such as "Reference A does not teach limitation II(b)" should be avoided.

## DECISION

For at least the above-stated reason (for failing to meet the requirement of section II: elements 6.2 and 6.3), the petition is **DENIED**. The application will remain in its regular status and will be taken up by the examiner for action in its regular turn.

Petitioner is reminded that a single opportunity to perfect the petition is given. Therefore, further petitions for accelerated examination in this application will not be entertained.

Any inquiry regarding this decision should be directed to Ehud Gartenberg, TC 3700 Special Program Examiner, at (571) 272-4828. In his absence, an inquiry can be directed to J. Harrison, Special Program Examiner, at 571 272-4449.

Ehud Gartenberg
Special Program Examiner
Technology Center 3700

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United States Patent and Trademark Office
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Alexandria, Virginia 22313-1450
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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** | : Yutaka IKEDA | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7649438 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/19/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/099,206 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/08/2008 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **16** 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. |
|---|---|---|---|---|
| 12/099,217 | 04/08/2008 | Wolfgang G. Schadeberg | GB920080077US1 | 3829 |

45046 7590 09/30/2008

IBM CORPORATION (SWP)
C/O SUITER SWANTZ PC LLO
14301 FNB PARKWAY, SUITE 220
OMAHA, NE 68154-5299

| EXAMINER | |
|---|---|
| TESLOVICH, TAMARA | |
| ART UNIT | PAPER NUMBER |
| 2137 | |
| MAIL DATE | DELIVERY MODE |
| 09/30/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, DC 20231
www.uspto.gov

Sean Patrick Suiter
IBM Corporation (SWP)
C/O Suiter Swantz PC LLO
14301 FNB Parkway, Suite 220
Omaha NE 68154-5299

In re Application of:
Wolfgang Schadeberg
Serial No.: 12/099217
Filed: April 8, 2008
Docket: GB920080077US1
For: **Method of Securing Typed Conversation using Encryption Keys in a Virtual World**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 8, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document.

An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include

where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions I 1-4, II 1-4 and II 5.1, 5.3, II 6.1, and 6.4-6.6 above are considered to have been met. However, the petition fails to comply with conditions II 5.2, II and 6.2-6.3 above. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirement of MPEP § 708.02(a)(I.)(H)[1] and items II.5.2 above, the preexamination search does not encompass all of the features of the claims, and does not appear to have given the claims the broadest reasonable interpretation.

Specifically, the text search strategy should be modified to include the terms chat and instant messaging. Here is an example of 2 queries that would complete this requirement. (encrypt$ encod$ crypto$) near8 (chat$ instan$ near4 messag$) and a second query of key near4 password near4 encrypt$ near8 (based derived deriving created creating generated generating) where or is the default operator. Petitioner should review all claim limitations, especially those asserted as patentable distinctions from the cited references to ensure that the search covers these concepts, and update the search and/or provide any clarifications if deemed necessary.

Finally, based upon the claimed subject matter of the instant application, a search in the following class and subclasses is recommended in order to provide full coverage of where the most pertinent references are most likely to be found: Class 380 Cryptography Subclasses 30, 283-285 & 44 (Public Key Cryptograph & Key Management/Generation ), for subject matter related to secure communications involving cryptography. This additional search area was confirmed with an examiner in the pertinent art area.

With regard to the requirement of MPEP § 708.02(a)(I)(2-3) and items II 6.2-6.3 above, Petitioners identification of limitations of the claims is improper as not all claim limitations have been discussed and the language used to discuss patentability isn't detailed enough. Petitioner must provide a detailed discussion of each of the identified references, identifying subject matter by way of figure, page, column and line numbers, as appropriate, as they pertain to ALL of the claim limitations of the instant application. The discussion of the references fails to follow the wording/format of the claims making the comparison to the action

[1] MPEP 8th ed. rev 5 August 2006

claims difficult. The support document must discuss in detail each of the references cited as being most relevant as only the '127 has been discussed. The statement for patentability needs to be clarified to include what are the closest features taught by the cited references and how they are different.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Tod Swann, Quality Assurance Specialist, at (571) 272-3612. A second point of contact is QAS Kim Huynh whose number is (571)-272-4147.

Tod R Swann
Quality Assurance Specialist
Technology Center 2100

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,217 | 04/08/2008 | Wolfgang G. Schadeberg | GB920080077US1 | 3829 |

82294 7590 12/17/2008

IBM CORPORATION (ACCSP)
c/o Suiter Swantz pc llo
14301 FNB Parkway, Suite 220
Omaha, NE 68154

| EXAMINER | |
|---|---|
| TESLOVICH, TAMARA | |
| ART UNIT | PAPER NUMBER |
| 2437 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 12/17/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Sean Patrick Suiter
IBM Corporation (ACCSP)
C/O Suiter Swantz PC LLO
14301 FNB Parkway, Suite 220
Omaha NE 68154-5299

MAILED

DEC 17 2008

TECHNOLOGY CENTER 2100

In re Application of:
Wolfgang Schadeberg
Serial No.: 12/099217
Filed: April 8, 2008
Docket: GB920080077US1
For: **Method of Securing Typed Conversation using Encryption Keys in a Virtual World**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the renewed petition filed on October 30, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d). The original petition, submitted on April 4, 2008 was dismissed in the decision mailed on September 30, 2008.

The renew petition to make the application special is **GRANTED** as the new Support Document meets the requirements of conditions II 6.2- 6.3 and the new Search Document meets the requirements of conditions II 5.2 that were deficient in the original petition. It should be noted that the 3 references deemed most closely in the first petition have been replaced by 2 new references in the second petition. The replacement of references is being taken as an admission that the original 3 references are no longer most closely related.

The application is eligible for accelerated examination and the renewed petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323) as the original identified deficiencies for failing to comply with the requirements for the pre-examination search encompassing all of the features of the claims, and giving the claims the broadest reasonable interpretation, the statement of patentability must provide a detailed explanation of how each of the claims are patentable and the concise statement of the utility must be of the invention as defined in each of the independent claims (reference must be made to independent claims 1, 14 and 20) have been corrected.

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

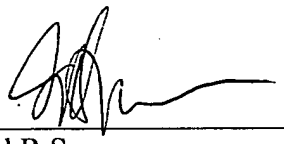
9. Proceedings Outside the Normal Examination Process:
If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:

The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Tod Swann, Quality Assurance Specialist, at (571) 272-3612. A second point of contact is WQAS Kim Huynh at (571) 272-4147.



Tod R Swann
Quality Assurance Specialist
Technology Center 2400

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INTELLECTUAL PROPERTY
GROUP - PATENTS
70 WEST MADISON STREET
SUITE 3500
CHICAGO IL 60602-4224

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OCT 0 1 2008

OFFICE OF PETITIONS

In re Application of
Wielgat, et al.
Application No. 12/099,247
Filed/Deposited: 8 April, 2008
Attorney Docket No. 54021-7004

DECISION ON PETITION

This is in response to the petition filed on 27 June, 2008, and properly considered under 37 C.F.R. §1.47(a).

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.

The petition as considered under 37 C.F.R. §1.47(a) is **GRANTED**.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) petition and fee; (2) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification: description, claims and drawings); (3) an acceptable oath or declaration in compliance with 35 U.S.C. §115 and §116; and (4) a statement of the last known address of the non-signing inventor(s)—with diligence in the effort to ascertain the validity of the address set forth as the reasonably believed to be last known/current/valid address.

## BACKGROUND

The record indicates:

The instant application was filed on 8 April, 2008, without, *inter alia*, a fully executed oath/declaration.

On 29 April, 2008, the Office mailed a Notice of Missing Parts indicating, *inter alia*, that a fully executed oath/declaration (signed and dated) was required.

On 27 June, Petitioner Peter M. Klobouchar (Reg. No. 43,722), filed, *inter alia*, an oath/declaration signed by co-inventor Mr. Wielgat on behalf of themselves and non-signing co-inventor Daniel J. Kegg (Mr. Keggi) and the petition and statement, which detail the transmittal of the entire application (description, claims, abstract, drawings) to Mr. Kegg at his last known address, and following delivery thereof a conversation between Mr. Kloboucher and Mr. Keeg, wherein Mr. Kloboucher reports that Mr. Kegg refused to sign/join in the oath/declaration—thus constituting actual refusal to sign.

The record reflects that: Petitioner demonstrates statement of the last known address of the non-signing inventor; that the entire application—description, claims, abstract and drawings—was sent to and received at the last known residence address of the non-signing inventor, and that the non-signing inventor has since failed and refused to join in the filing of the above-identified application.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

## CONCLUSION

The instant petition under 37 C.F.R. §1.47 is **granted**.

As provided in 37 C.F.R. §1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

The instant application is released to the Office of Patent Application Processing (OPAP) (formerly the Office of Initial Patent Examination (OIPE)) for further processing in due course.

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[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[2]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[2] The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DANIEL J. KEGG
18089 West Pond Ridge Circle
Gurnee IL 60031

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OCT 0 1 2008

**OFFICE OF PETITIONS**

In re Application of
Wielgat, et al.
Application No. 12/099,247
Filed/Deposited: 8 April, 2008
Attorney Docket No. 54021-7004

COMMUNICATION

Dear Daniel J. Kegg:

You are named as an 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, Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein 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 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 the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Should you elect to join in the application, the contact information for Counsel of Record is set forth at the end of this Communication.

Should you seek to identify independent Counsel, you may find the Patent Attorneys/Agents Search engine of assistance (https://oedci.uspto.gov/OEDCI/ ).

Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (571) 272-3150 or 1 (800) 972-6382 (outside the Washington, DC area).

While telephone inquiries regarding this communication may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[1])

[1] The regulations at 37 C.F.R. §1.2 provide:

and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s). Moreover, the Office cannot neither advise you nor recommend Counsel in this matter.

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

Counsel of Record:
UNGARETTI & HARRIS LLP
INTELLECTUAL PROPERTY
GROUP - PATENTS
70 WEST MADISON STREET
SUITE 3500
CHICAGO IL 60602-4224

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**§1.2 Business to be transacted in writing.**
All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Levenfeld Pearlstein, LLC (ILLINOIS TOOL WORKS)
2 North LaSalle Street
Suite 1300
Chicago, IL 60602

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Jeffrey J. Patrick | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7607236 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/27/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/099,274 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/08/2008 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **15** 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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P.O. Box 1450
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Date : September 11, 2009

Patent No. :7507919
Inventor(s) :Jun Sugahara et al.
Issue :March 24, 2009
Title :MULTI-DIRECTIONAL INPUT DEVICE

Review of the application file has revealed the omission of the Foreign Priority data on the printed Patent as a result of applicant's failure to fully comply with 35 U.S.C. 119, in that requirements were not met according to the records in the U.S. Patent and Trademark Office. Applicant's attention is directed to MPEP 201.14(a), 37 CFR 1.17(i).

In view of the forgoing, applicant's request in this matter is hereby denied.

Any inquiry concerning this communication should be directed to Ms. A. Green at (703) 756-1541.

Ms. Mary Diggs, Supervisor
Decisions & Certificates
of Correction Branch
(703) 756-1580 or (703) 756-

RatnerPrestia
P.O. Box 980
Valley Forge, PA 19482

/arg

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 09-30-09

**TO SPE OF** : ART UNIT 2832

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 12/099336 Patent No.: 7507919

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**

**Angela Green**
**Certificates of Correction Branch**
**703-756-1814**

**Thank You For Your Assistance**

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

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

**Comments:** the Foreign Priority documents are in the file - see PD.FILED.E, filed 9/5/08

/renee s luebke/
Renee Luebke
SPE - AU 2833

**SPE** **Art Unit**

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 | 12099338 | Confirmation Number | 4039 | Filing Date | 2008-04-08 |
| Attorney Docket Number (optional) | 10106-1450 | Art Unit | 2875 | Examiner | |
| First Named Inventor | Robert J. Alderman | | | | |
| Title of Invention | Reflective Insulation Tiles | | | | |

**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 |
|---|---|---|---|
| Robert | J. | Alderman | |

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 | /George M. Thomas/ | Date (YYYY-MM-DD) | 2008-05-20 |
| Name | George M. Thomas | Registration Number | 22260 |

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.

# UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of
Robert J. Alderman

Application No. 12099338
Filed: April 8,2008

Attorney Docket No. 10106-1450

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

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1) ,filed 20-MAY-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.

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UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,343 | 04/08/2008 | Yu Cao | 101618.0002US3 | 4046 |

24392 7590 08/30/2008

FISH & ASSOCIATES, PC
ROBERT D. FISH
2603 Main Street
Suite 1050
Irvine, CA 92614-6232

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 3622 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/30/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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FROM DIRECTORS OFFICE

AUG 3 0 2008

TECHNOLOGY CENTER 3600

FISH & ASSOCIATES, PC.
ROBERT D. FISH
2603 Main Street
Suite 1050
Irvine CA 92614-6232

In re application of : **DECISION ON PETITION**
Yu Cao : **TO MAKE SPECIAL FOR**
Application 12/099,343 : **NEW APPLICATION**
Filed: April 8, 2008 : **UNDER 37 CFR 1.102**
For: **METHODS AND APPARATUS FOR FRESHNESS AND COMPLETENESS OF INFORMATION**

This is a decision on the petition filed on April 8, 2008, to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document.

An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims is patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

REVIEW OF FACTS

The petition in this case fails to comply with conditions II.5.1 and II.5.2

Condition II.5.1 requires that the search involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement. Applicant has not searched many of the NPL (Non-Patent Literature) Dialog databases identified for applications in U.S. class/subclass 705/14, where the invention is classified. NPL searches in Dialog databases such as Business & Industry, ABI/Inform, Prompt, Gale Group, Gale Group Newsletter, are particularly relevant to the claimed invention. Below is the link to the USPTO's specific search template associated with the application's classification http://www.uspto.gov/web/patents/searchtemplates/class705-002.htm.

As to condition II.5.2, the petition lacks an indication of a preexamination search that encompasses all of the features of the claims. Specifically, while the classification search is acceptable, with respect to the text search of the US Patents database, the petition lacks sufficiently specific search logic. The USPTO website has an example of the proper manner of performing and documenting a preexamination search for Accelerated Examination petitions at: http://www.uspto.gov/web/patents/accelerated/. Furthermore, a sample of search logic in West to be used in this application is provided below:

L1: ((first or primary) near5 second$) near5 (data or information)

L2: ((time near5 (sensible$ or sensitivit$ or critic$)) near5 (data or information)) near7 (updat$ or amend$ or chang$3 or revis$3 or alter$ or modif$6) and (fee$1 or price$1 or charg$3 or cost$1)

L3: L1 and L2

Please keep in mind that these are non-limiting search suggestions and they are only meant to serve as a possible starting point for Applicant's preexamination search. Additional guidance regarding the proper manner of performing and documenting a preexamination search may be found on the following web site: http://www.uspto.gov/web/patents/accelerated/

The petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

DECISION

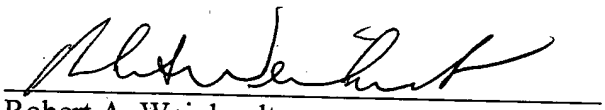
For the above stated reasons, the petition is **DISMISSED**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within one (1) month or thirty (30)

days, whichever is longer, from the date of this decision. No extensions of time will be granted under 37 CFR 1.136(a) if the request is to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Robert Weinhardt, Business Practice Specialist, at (571) 272-6633, or Romain Jeanty, Primary Examiner, at (571) 272-6732.



Robert A. Weinhardt,
Business Practice Specialist
Technology Center 3600

RW/RJ/ 8/27/08

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. |
|---|---|---|---|---|
| 12/099,343 | 04/08/2008 | Yu Cao | 101618.0002US3 | 4046 |

24392 7590 10/23/2008

FISH & ASSOCIATES, PC
ROBERT D. FISH
2603 Main Street
Suite 1050
Irvine, CA 92614-6232

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 3622 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 10/23/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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ROBERT D. FISH
2603 Main Street
Suite 1050
Irvine CA 92614-6232

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OCT 23 2008

TECHNOLOGY CENTER

In re application of: : **DECISION ON PETITION**
Yu Cao : **TO MAKE SPECIAL FOR**
Application No. 12/099,343 : **NEW APPLICATION**
Filed: April 8, 2008 : **UNDER 37 CFR 1.102**
For: METHODS AND APPARATUS FOR FRESHNESS AND COMPLETENESS OF INFORMATION

This is a decision on the petition filed on April 8, 2008 and the supplemental petition documents filed September 30, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to

make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed to a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

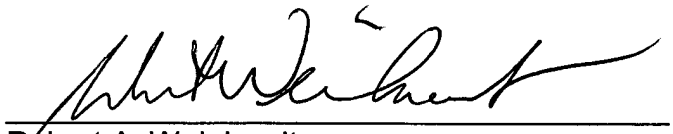
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Robert Weinhardt, Business Practice Specialist, at (571) 272-6633, C. Michelle Tarae, Business Practice Specialist at (571) 272-6727, or Primary Examiner Jamisue Plucinski, at (571) 272-6811.



Robert A. Weinhardt,
Business Practice Specialist
Technology Center 3600

RW/10/22/08

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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. |
|---|---|---|---|---|
| 12/099,355 | 04/08/2008 | Christian Richter | GB920080112US1 | 4066 |

45046 7590 07/23/2008

IBM CORPORATION (SWP)
C/O SUITER SWANTZ PC LLO
14301 FNB PARKWAY, SUITE 220
OMAHA, NE 68154-5299

| EXAMINER | |
|---|---|
| AN, MENG AI T | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2195 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 07/23/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

July 16, 2008

Chad W. Swantz
Suiter Swantz pc llo
14301 FNB Parkway, Suite 220
Omaha, NE 68154

In re Application of:
Richter, Christian
Serial No.: 12/099355
Filed: April 4, 2008
Docket: GB920080112US1
Title: SYSTEM AND METHOD FOR ENHANCING THE SHARING OF APPLICATION LIBRARIES BETWEEN DIFFERENT JVM'S AND SYSTEMS WITH A DYNAMIC RELOCATION BASED ON USAGE PATTERNS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 4, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions I1-I4, II1-II4, II5.1,II5.3, II6.1, II6.3-II6.4 and II6.6 above are met. However, the petition fails to comply with conditions II5.2, II6.2, and II6.5 above. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Deleted: ¶

Regarding the requirement of MPEP § 708.02(a)(I.)(H)[1] and items II.5.2 above, the pre-examination search must be directed to the (instant) claimed invention and encompass all of the features of the claims as well as encompass the disclosed features that may be claimed. Text searches of section (A) of the Pre-examination Search Document should cover individual features of the claims themselves as well as a combination of features. The text search for US and foreign documents as well as for non-patent literature should include appropriate terms, Boolean operators, truncations, and proximities if applicable.

The class and subclass search should be expanded to include class 718 subclasses 1, 100 and 104 as the invention includes aspects of resource management.

In addition, the following problems are noted with the current text search:

1. The text search should be expanded to include virtual machines in general and should not be limited to java virtual machines as the references disclosing the claimed method in an alternative virtual machine would be relevant to the claimed invention.

2. The NPL text search performed on Google fails to include any synonyms. Thus references which might be highly relevant but which did not use the exact terminology included in this search would not be retrieved.

3. The current text search of US and foreign patent documents would retrieve references relating to allocation or reallocation of shared libraries or classes in a java virtual machine. However, references relating to determining the effectiveness of libraries or classes based on usage statistics or including a criteria or threshold used to determine if a class or library should be transferred would not retrieved by this search. This omission is particularly relevant given the reasons provided in section 9(D) that the claimed invention patentably distiquish over the closest prior art.

The following text search strategies are suggested but are clearly not exhaustive of the strategies that should be included to solve the issues identified above.

a. (Virtual near machine or any other relevant synonym) with (usage near2 (pattern or statistic)

b. (Relocat$3 or move$3 or transfer$3) near2 (class or library) same (usage near2 (pattern or statistic)

[1] MPEP 8th ed. rev 6 September 2007

c. (Relocat$3 or move$3) adj (data near5 location) with (usage patterns or usage statistics)

Clarification and/or correction are required.

Examples of various search strategies can be found on USPTO website, using the link http://www.uspto.gov/web/patents/accelerated/ and clicking on "Sample Accelerated Examination Support Document".

Regarding the requirement of MPEP § 708.02(a)(I.)(I)(3) and item II.6.2 above, the accelerated examination support document must include an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference. In section 9B, Petitioner discusses disclosures of references deemed most closely related to the claimed invention. However, this section fails to specify which element of claim 1 is disclosed by the references and where disclosures for these features can be found in the references. Correction is required.

Finally, with respect to the requirement of MPEP § 708.02(a)(I.)(I)(5) and item II.6.5 above, the Accelerated Examination Support Document must provide a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. On section 9(E) of the Examination Support Document, Petitioner cites paragraphs 10-12 and Figures 2 and 4 as support for all elements listed in claim 1. However, it is unclear if each element is discussed in paragraph 10, in paragraph 11 and in paragraph 12 or is shown in both Figures 2 and 4. Petitioner is requested to identify the specific location of support for each claimed location. Clarification and identification of support for each claim limitation is required.

## DECISION

For the above-stated reasons, the petition is **Dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed Gail Hayes, Quality Assurance Specialist, at (571) 272-3591.

**Deleted:** include: 1) a statement that if the Office determines that all the claims presented are not directed to a single invention, applicant will make an election without traverse as a prerequisite to the grant of special status; 2) a detailed discussion with the particularity required by 37 CFR § 1.111(b) and (c) of how the claims distinguish over each cited reference.¶

/Gail Hayes/

Gail Hayes, Quality Assurance Specialist
Technology Center 2100

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,355 | 04/08/2008 | Christian Richter | GB920080112US1 | 4066 |

45046 7590 09/30/2008

IBM CORPORATION (SWP)
C/O SUITER SWANTZ PC LLO
14301 FNB PARKWAY, SUITE 220
OMAHA, NE 68154-5299

| EXAMINER | |
|---|---|
| KAWSAR, ABDULLAH AL | |
| **ART UNIT** | **PAPER NUMBER** |
| 2195 | |
| **MAIL DATE** | **DELIVERY MODE** |
| 09/30/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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September 25, 2008

Chad W. Swantz
Suiter Swantz pc llo
14301 FNB Parkway, Suite 220
Omaha, NE 68154-5299

In re Application of:
Christian Richter
Serial No.: 12/099,355
Filed: April 8, 2008
Docket: GB920080112US1
Title: SYSTEM AND METHOD FOR ENHANCING THE SHARING OF APPLICATION LIBRARIES BETWEEN DIFFERENT JVM'S AND SYSTEMS WITH A DYNAMIC RELOCATION BASED ON USAGE PATTERNS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on August ~~12~~ 21, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions I1-I4, II1-II4, II5.1-II5.3, II.6.1-II6.6 above are met. Therefore, the petition meets the required conditions to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

## DECISION

For the above-stated reasons, the petition is **Granted**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply

within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

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**WARF/BHGL**
**P.O. BOX 10395**
**CHICAGO IL 60610**

**MAILED**

APR 2 0 2010

**OFFICE OF PETITIONS**

In re Application of :
Luigi PUGLIELLI :
Application No. 12/099,378 : DECISION ON PETITION
Filed: April 8, 2008 : TO WITHDRAW
Attorney Docket No. 12854-65 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 2, 2010.

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).

Any request to withdraw the attorneys from record should include the same designation used to appoint the attorneys of record. Accordingly, the Request cannot be approved because the attorneys of record were not appointed through the use of a Customer Number, as indicated.

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.

/DCG/
/Diane C. Goodwyn/
Petitions Examiner
Office of Petitions

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THOMPSON COBURN, LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS MO 63101

JAN 09 2009

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|---|---|---|
| In re Application of: LYONS, LESLIE A.<br>Serial No.: 12/099384<br>Filed: April 08, 2008<br>Title: EXTENDED LENGTH CUTOFF BLOWER | : | DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02 |

This is a decision on the petition filed on December 15, 2008 to make the above-identified application special for accelerated examination procedure 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), applications and petitions must be filed 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), effective August 25, 2006. The filing is missing, *inter alia*, a pre-examination search document, an Accelerated Examination Support Document, and form PTO/SB/28.

The petition appears on its face to have been filed without recognition of the August 25, 2006 policy change to the petition to make special program. The changes to the program are substantial; a copy of Federal Register of June 26, 2006 (71 Fed. Reg. 36323) can be reviewed at the following USPTO website:

http://www.uspto.gov/web/offices/com/sol/notices/71fr36323.pdf

Notably, special status based upon categories such as manufacture, infringement, environmental quality, conservation of energy resources, recombinant DNA, superconductivity materials, HIV/AIDS and cancer, countering terrorism, and biotechnology applications filed by small entities are no longer available (see in above cited notice, p. 36324, col. 1, l. 47 to col. 2, l. 5). Further guidance may be found at www.USPTO.gov under the accelerated examination link.

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 Ehud Gartenberg, TC 3700 Special Program Examiner, at (571) 272-4828.

Ehud Gartenberg
Special Program Examiner
Technology Center 3700

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www.uspto.gov

THOMPSON COBURN LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS MO 63101

May 12, 2009

| | |
|---|---|
| In re Application of: LYONS, LESLIE A.<br>Serial No.: 12/099384<br>Filed: 04/08/2008<br>Title: EXTENDED LENGTH CUTOFF BLOWER | DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02 |

This is a decision on the petition filed on February 9, 2009 to make the above-identified application special for accelerated examination procedure 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.
5. The petition must be filed with the application.

The application as filed is not eligible for the accelerated examination under 37 C.F.R. § 1.102(d) because the petition was not filed with the application. As noted in the policy statement referenced above, any petition to make special filed on or after the effective date must meet the new requirements set forth in the 71 Fed. Reg. 36323 notice. Applications filed before the effective date will not be eligible for the revised accelerated examination program. The

effective date of the change in practice was August 25, 2006. Thus the instant petition must be reviewed under the revised practice and the instant application is ineligible.

The petition appears on its face to have been filed without recognition of the August 25, 2006 policy change to the petition to make special program. The changes to the program are substantial. The Notice of Federal Register on June 26, 2006 (71 Fed. Reg. 36323) can be accessed on the internet at
http://www.uspto.gov/web/offices/com/sol/notices/71fr36323.pdf

Further guidance may be found website of the USPTO at
http://www.uspto.gov/web/patents/accelerated

under the accelerated examination link.

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 Ehud Gartenberg, TC 3700 Special Program Examiner, at (571) 272-4828.

Ehud Gartenberg
Special Program Examiner
Technology Center 3700

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P.O. Box 1450
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**Darby & Darby, P.C.**
**P.O. Box 770**
**Church Street Station**
**New York, NY 10008-0770**

MAILED

MAR 13 2009

OFFICE OF PETITIONS

In re Application of :
David Court :
Application No. 12/099,403 : DECISION ON PETITION
Filed: April 8, 2008 : TO WITHDRAW
Attorney Docket No. 20410/1206869-US1 : FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed 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. 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 John W. Branch 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 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 address of the first signing inventor at the first copied address below, 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. If this person(s) desire to receive future correspondence regarding this application, the proper power of attorney documents and/or a statement under 37 CFR 3.73(b) must be submitted.

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

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: David Court
58 Taunton Road
Bridgwater
Somerset, United Kingdom TA6 6AE

cc: Saint-Gobain Performance Plastics
Rencol Limited
Unit 16 Concorde Road
Patchway
Bristol, United Kingdom BS34 5TB

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United States Patent and Trademark Office
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IBM CORPORATION, T.J. WATSON RESEARCH CENTER
P.O. BOX 218
YORKTOWN HEIGHTS, NY 10598

MAILED

JUN 22 2010

OFFICE OF PETITIONS

In re Application of :
Herbert L. Ho, et al. :
Application No. 12/099,437 : DECISION ON PETITION
Filed: April 8, 2008 :
Attorney Docket No. YOR920030635US3 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 6, 2010, to revive the above-identified application.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. In accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts. However, if petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. A courtesy copy of this decision is being mailed to petitioner. Nevertheless, all future correspondence regarding this application file will be directed solely to the address of record until otherwise instructed.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must so notify the Office.

This application became abandoned for failure to timely pay the issue and publication fees on or before April 8, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed January 8, 2010. Accordingly, the date of abandonment of this application is April 9, 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 $1510 and the publication fee of $300, (2) the petition fee of $1620; and (3) a proper statement of unintentional delay.

In view of the above, the petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning this application should be directed to the Office of Data Management at their hotline 571-272-4200.

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

April M. Wise
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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GIBSON & DERNIER L.L.P.
900 ROUTE 9 NORTH
SUITE 504
WOODBRIDGE, NJ 07095

COPY MAILED

JAN 04 2010

| | | |
|---|---|---|
| In re Application of | : | |
| Jeff Wagner | : | DECISION ON PETITION |
| Application No. 12/099,453 | : | TO WITHDRAW |
| Filed: April 8, 2008 | : | FROM RECORD |
| Attorney Docket No. 337-7X2 | : | |

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 2, 2009.

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

A review of the file record indicates that on December 3, 2009 the power of attorney to Gibson & Dernier L.L.P. was revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to the undersigned at 571-272- 7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Kaplan Gilman & Pergament LLP
1480 Route 9 North
Woodbridge NJ 07095

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LEXICON PHARMACEUTICALS, INC.
8800 TECHNOLOGY FOREST PLACE
THE WOODLANDS TX 77381-1160

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FEB 17 2009

OFFICE OF PETITIONS

In re Application of
Abuin, et al.
Application No. 12/099,459
Filed: April 8, 2008
Attorney Docket No. LEX-1128-US-CNT(2)
For: GENETICALLY ENGINEERED AND PHENOTYPED MICE AND STEM CELL CLONES FOR PRODUCING THE SAME

ON PETITION

This is a decision on the petition under 37 CFR 1.181, filed January 15, 2009, to withdraw the holding of abandonment.

The petition under 37 CFR 1.181 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. This is **not** final agency action within the meaning of 5 U.S.C. § 704.

This application was held abandoned for failure to timely submit replacement drawings. A Notice to File Missing Parts of Nonprovisional Application, mailed May 1, 2008, required applicants to submit a basic filing fee, replacement drawings, a surcharge, a search fee, and an examination fee within two months of the mailing of the Notice. Extensions of time under 37 CFR 1.136(a) were available. On December 1, 2008, applicants submitted a petition for a five month extension of time, a declaration, a preliminary amendment, a request to rescind a nonpublication request, an $82.00 electronic filing fee, a $270.00 search fee, a $110.00 examination fee, and a $65.00 surcharge. On December 15, 2008, the Office mailed a Notice of Incomplete Reply (Nonprovisional) requesting that applicants submit replacement drawings, as was required in the May 1, 2008 Notice. This application became abandoned on December 2, 2008 because applicants did not timely file replacement drawings. A Notice of Abandonment was mailed on January 7, 2009.

Petitioners request withdrawal of the holding of abandonment because applicants purportedly e-filed a complete reply, along with petition for a five month extension of time, on December 1, 2008.

The Office has no record of receiving replacement drawings until January 15, 2009. It appears that the response filed on December 1, 2008 did **not** include replacement drawings, as shown be the "RESPONSE TO NOTICE TO FILE MISSING PARTS" of December 1, 2008 and the Office's Acknowledgement Receipt. The rules of practice are clear that prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. As a response to a Notice to File Missing Parts of Nonprovisional Application can only be extended up to five months, the application became abandoned on December 2, 2008 because applicants did not file replacement drawings in time.

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is **dismissed**.

Petitioners are encouraged to file a petition to revive under the unintentional delay provisions of 37 CFR 1.137(b).

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

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

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

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

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

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

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United States Patent and Trademark Office
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LEXICON PHARMACEUTICALS, INC.
8800 TECHNOLOGY FOREST PLACE
THE WOODLANDS TX 77381-1160

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APR 07 2009

**OFFICE OF PETITIONS**

In re Application of :
Abuin, et al. :
Application No. 12/099,459 : ON PETITION
Filed: April 8, 2008 :
Attorney Docket No. LEX-1128-US-CNT(2) :
For: GENETICALLY ENGINEERED AND PHENOTYPED MICE AND STEM CELL CLONES FOR PRODUCING THE SAME

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

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

This application was held abandoned for failure to timely submit replacement drawings. A Notice to File Missing Parts of Nonprovisional Application, mailed May 1, 2008, required applicants to submit a basic filing fee, replacement drawings, a surcharge, a search fee, and an examination fee within two months of the mailing of the Notice. Extensions of time under 37 CFR 1.136(a) were available. On December 1, 2008, applicants submitted a petition for a five month extension of time, a declaration, a preliminary amendment, a request to rescind a nonpublication request, an $82.00 electronic filing fee, a $270.00 search fee, a $110.00 examination fee, and a $65.00 surcharge. On December 15, 2008, the Office mailed a Notice of Incomplete Reply (Nonprovisional) requesting that applicants submit replacement drawings, as was required in the May 1, 2008 Notice. This application became abandoned on December 2, 2008 because applicants did not timely file replacement drawings. A Notice of Abandonment was mailed on January 7, 2009.

Petitioners have submitted a proper reply to the May 1, 2008 Notice in the form of the basic filing fee, replacement drawings, the surcharge, the search fee, and the examination fee, an acceptable statement of the unintentional nature of the delay in responding to the May 1, 2008 Notice, and the $1,620.00 petition fee.

The statement of unintentional delay presented in the petition does not comply with the current rule. 37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR

1.137(b) was unintentional" be submitted. However, the statement presented will be accepted and construed as meaning that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." If this is an incorrect interpretation in view of the rules, petitioners are required to provide a statement to that effect.

All requirements under 37 CFR 1.137(b) being met, the petition is granted.

After the mailing of this decision, the file will be returned to the Office of Patent Application Processing for further pre-examination processing.

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

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

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2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

MAIL

NOV 25 2008

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of: Gene FEIN, et. al.
Serial No.: 12/099,498
Filed: April 8, 2008
Docket: KM2056.003A
Title: DATA FILE FORWARDING STORAGE AND SEARCH

DECISION ON REQUEST TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the request filed on April 8, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. 1.102(d).

The request 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:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The **petition must**:

1. **be filed with the application**;

2. include **a statement** that applicant agrees **not to separately argue** the patentability of any independent claim during any appeal in the application;

3. include a **statement** that applicant agrees **to make an election without traverse** in a telephone interview.

4. include a **statement** that applicant agrees **to conduct such an interview** when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

MPEP §708.02(a) I states:

> (A) The **application must be filed with a petition** to make special under the accelerated examination program accompanied by either the fee set forth in 37 CFR 1.17(h) or a statement that the claimed subject matter is directed to environmental quality, the development or conservation of energy resources, or countering terrorism. See 37 CFR 1.102(c)(2). Applicant should use form **PTO/SB/28 for filing the petition.**
> (C) The application, petition, and required fees must be filed electronically using the USPTO's electronic filing system (EFS), or EFS-Web.
> The petition must include
> (E) ... The petition must include a statement that applicant will agree not to separately argue the patentability of any dependent claim during any appeal in the application. See form PTO/SB/28.
> (F) .... The petition must include a statement that applicant will agree to make an election without traverse in a telephonic interview. See form PTO/SB/28.
> (G) ...The petition must include a statement that applicant will agree to have such an interview when requested by the examiner. See form PTO/SB/28.

## REVIEW OF FACTS

The application filed on April 08, 2008 is not eligible for the accelerated examination under 37 C.F.R. 1.102(d) because, **at the time of filing**, the application does not comply with the requirements of MPEP §708.02(a) subsection I above; namely the application fails to include the following:

1) A statement that applicant agrees not to separately argue the patentability of any independent claim

2) A statement include a statement that applicant agrees to make an election without traverse in a telephone interview

3) A statement that applicant agrees to conduct such an interview when requested by the examiner

4) A petition or form PTO/SB28 at time of filing. Though the pre-examination search and support document refer to a petition, no such paper is found at the time of filing.

For the above-mentioned reasons, the request to grant special status under 37 C.F.R. 1.102(d) is **DENIED.** The application will therefore be taken up by the examiner for action in its regular turn. The petition fee ($130.00) paid on April 8, 2008 will be credited to Deposit Account No. **50-2678**

Any inquiry regarding this decision should be directed to the undersigned whose telephone number is (571) 272-4147. If attempts to reach the undersigned by telephone are unsuccessful, Tod Swann, Quality Assurance Specialist, can be reached at (571) 272-3612.

/bp/

/Kim Huynh/

Kim Huynh
Quality Assurance Specialist
Technology Center 2400

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IRVINE CA 92614

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NOV 25 2008

TECHNOLOGY CENTER 2100

In re Application of: Gene FEIN, et. al.
Serial No.: 12/099,498
Filed: April 8, 2008
Docket: KM2056.003A
Title: DATA FILE FORWARDING STORAGE AND SEARCH

DECISION ON REQUEST TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the request filed on April 8, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. 1.102(d).

The request 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:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The **petition must**:

1. **be filed with the application**;

2. include **a statement** that applicant agrees **not to separately argue** the patentability of any independent claim during any appeal in the application;

3. include a **statement** that applicant agrees **to make an election without traverse** in a telephone interview.

4. include a **statement** that applicant agrees **to conduct such an interview** when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

MPEP §708.02(a) I states:

> (A) The **application must be filed with a petition** to make special under the accelerated examination program accompanied by either the fee set forth in 37 CFR 1.17(h) or a statement that the claimed subject matter is directed to environmental quality, the development or conservation of energy resources, or countering terrorism. See 37 CFR 1.102(c)(2). Applicant should use form **PTO/SB/28 for filing the petition.**
> (C) The application, petition, and required fees must be filed electronically using the USPTO's electronic filing system (EFS), or EFS-Web.
> The petition must include
> (E) ... The petition must include a statement that applicant will agree not to separately argue the patentability of any dependent claim during any appeal in the application. See form PTO/SB/28.
> (F) .... The petition must include a statement that applicant will agree to make an election without traverse in a telephonic interview. See form PTO/SB/28.
> (G) ...The petition must include a statement that applicant will agree to have such an interview when requested by the examiner. See form PTO/SB/28.

## REVIEW OF FACTS

The application filed on April 08, 2008 is not eligible for the accelerated examination under 37 C.F.R. 1.102(d) because, **at the time of filing**, the application does not comply with the requirements of MPEP §708.02(a) subsection I above; namely the application fails to include the following:

1) A statement that applicant agrees not to separately argue the patentability of any independent claim

2) A statement include a statement that applicant agrees to make an election without traverse in a telephone interview

3) A statement that applicant agrees to conduct such an interview when requested by the examiner

4) A petition or form PTO/SB28 at time of filing. Though the pre-examination search and support document refer to a petition, no such paper is found at the time of filing.

For the above-mentioned reasons, the request to grant special status under 37 C.F.R. 1.102(d) is **DENIED.** The application will therefore be taken up by the examiner for action in its regular turn. The petition fee ($130.00) paid on April 8, 2008 will be credited to Deposit Account No. **50-2678**

Any inquiry regarding this decision should be directed to the undersigned whose telephone number is (571) 272-4147. If attempts to reach the undersigned by telephone are unsuccessful, Tod Swann, Quality Assurance Specialist, can be reached at (571) 272-3612.

/bp/

/Kim Huynh/

Kim Huynh
Quality Assurance Specialist
Technology Center 2400

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BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

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SEP 14 2009

**OFFICE OF PETITIONS**

In re Application of Kim et al. :
Application No. 12/099,502 : Decision on Petition
Filing Date: April 8, 2008 :
Attorney Docket No. P26911 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 27, 2009, to revive the above-identified application.

The petition is **granted**.

The Office mailed a Notice to File Corrected Application Papers on May 1, 2008. The Notice set a period for reply of two (2) months. The Office did not receive a reply or a request for an extension of time in response to the Notice. As a result, the application became abandoned as of July 2, 2008. The Office mailed a Notice of Abandonment on January 7, 2009.

The instant petition requests revival of the application.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed,
(2) The petition fee,
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
(4) A terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

As to item (1), the petition is accompanied by a reply to the May 1, 2008 Notice.

As to item (2), the petition fee of $1,620 has been submitted.

As to item (3), the petition states the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. However, the petition is signed by Attorney Erick Metzger who was not an attorney or agent of record at the time the application became abandoned Therefore, it appears Attorney Metzger may not have been in a position to have firsthand or direct knowledge of the facts and

circumstances of the delay. Nevertheless, the statement by Metzger that the entire delay was unintentional is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay.[1] In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that a portion of the delay from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was intentional, petitioner must notify the Office.

As to item (4), a terminal disclaimer is unnecessary because the application is a nonprovisional application filed after June 8, 1995.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Therefore, the petition is granted and the application is revived.

The petition is accompanied by payment of $2,350 for a five-month extension of time. However, payment for an extension of time is unnecessary when reviving an application. Therefore, the Office has credited the $2,350 back to deposit account no. 50-0221.

There is no indication that Attorney Metzger has been given a power of attorney or authorization of agent to prosecute the above-identified application and a request to change the correspondence address has not been filed. If Attorney Metzger wishes to receive future correspondence regarding this application, a proper request to change the address of record must be filed. If the request is signed by Metzger, then a power of attorney to Metzger should be filed with the request to change the addressWhile a courtesy copy of this decision is being mailed to Attorney Metzger, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

The Office of Patent Application Processing will be informed of the instant decision and will prepare the application for examination in due course.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

cc: ERIK M. METZGER
C/O CPA GLOBAL
PO BOX 52050
MINNEAPOLIS, MN 55402

[1] See Changes to Patent Practice and Procedure, 62 *Fed. Reg.* at 53160 and 53178; 1203 *Off. Gaz. Pat. Office* at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,527 | 04/08/2008 | Kiyohiro Kimura | 112857-1372 | 4350 |

29175 7590 04/23/2008

BELL, BOYD & LLOYD, LLP
P. O. BOX 1135
CHICAGO, IL 60690

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2871 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 04/23/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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**BELL, BOYD & LLOYD, LLP**
**P. O. BOX 1135**
**CHICAGO IL 60690**
**UNITED STATES**

**In re Application of**
**Kiyohiro KIMURA et al.**
**Application No.: 12/099,527**
**Filed: April 08, 2008**
**Attorney Docket No.: 112857-1372**
**For: AN OPTICAL SHEET**

**: DECISION ON REQUEST TO**
**: PARTICIPATE IN THE PATENT**
**: PROSECUTION HIGHWAY**
**: PILOT 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) pilot program and the petition under 37 CFR 1.102(d), filed April 08, 2008, to make the above-identified application special.

The request and petition are **GRANTED**.

## Discussion

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, note where the JPO 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 JPO application with similar claims and the JPO priority 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 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 Brian Sircus at 571 272 2058.

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.

This application is being forwarded to the examiner for action on the merits commensurate with this decision.

Brian Sircus
TQAS
Technology Center 2800 – Semiconductors
Electrical & Optical Systems & Components

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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HAMRE, SCHUMANN, MUELEER & LARSON, P.C.
P.O. Box 2902
Minneapolis, MN 55402

APR 16 2008

| | | |
|---|---|---|
| In re Application of | : | DECISION ON REQUEST TO |
| Shozo OSHIO | : | PARTICIPATE IN PATENT |
| Application No. 12/099555 | : | PROSECUTION HIGHWAY |
| Filed: April 8, 2008 | : | PILOT PROGRAM AND PETITION |
| Attorney Docket No. 10873. 1696USC2 | : | 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 April 8, 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 pilot program and petition fails to include:

(1) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s).

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.

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

HAMRE, SCHUMANN, MUELEER & LARSON, P.C.
P.O. Box 2902
Minneapolis, MN 55402

UNITED STATES PATENT AND TRADEMARK OFFICE

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HAMRE, SCHUMANN, MUELEER & LARSON, P.C.
P.O. Box 2902
Minneapolis, MN 55402

APR 2 4 2008

| | | |
|---|---|---|
| In re Application of | : | DECISION ON REQUEST TO |
| Shozo OSHIO | : | PARTICIPATE IN PATENT |
| Application No. 12/099555 | : | PROSECUTION HIGHWAY |
| Filed: April 8, 2008 | : | PILOT PROGRAM AND PETITION |
| Attorney Docket No. 10873. 1696USC2 | : | 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 April 8, 2008, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH pilot program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation is accurate;
(3) All the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the JPO application(s);
(4) Examination of the U.S. application has not begun;
(5) Applicant must submit a copy of all the office actions from each of the JPO application(s) containing the allowable/patentable claim(s) along with an English translation thereof and a statement that the English translation is accurate;
(6) Applicant must submit an IDS listing the documents cited by the JPO examiner in the JPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Kathryn Gorgos at 571 272-1012.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://www.uspto.gov/ebc/index.html.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Kathryn Gorgos
TQAS TC 1700

SUGHRUE MION, PLLC
2100 Pennsylvania Ave, NW
Washington, DC 20037-3213

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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**GIFFORD, KRASS, SPRINKLE,ANDERSON & CITKOWSKI, P.C**
**PO BOX 7021**
**TROY MI 48007-7021**

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SEP 02 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Charles Joseph Skinner | : | |
| Application No. 12/099,573 | : | DECISION ON PETITION |
| Filed: June 24, 2008 | : | TO MAKE SPECIAL UNDER |
| Attorney Docket No. SCW-10202/01 | : | 37 CFR 1.102(c)(1) |
| | : | |

This is a decision on the petition under 37 CFR 1.102(c)(1), filed June 24, 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 from the applicant declaring that he is 65 years of age or older. Accordingly, the above-identified application has been accorded "special" status.

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

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

The application is being forwarded to the Technology Center Art Unit 3744 for action on the merits commensurate with this decision.

Terri Williams
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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JUN 0 8 2009

OFFICE OF PETITIONS

**FISH & RICHARDSON, PC**
**P.O. Box 1022**
**Minneapolis, MN 55440-1022**

| | | |
|---|---|---|
| In re Application of | : | |
| Loki Jorgenson | : | |
| Application No. 12/099,595 | : | DECISION ON PETITION |
| Filed: April 8, 2008 | : | TO WITHDRAW |
| Attorney Docket No. 8897-002002/1150-110CON | : | FROM RECORD |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 24, 2009.

The request is **APPROVED**.

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

The request was signed by Bing Ai 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 correspondence address has been changed and listed below.

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Apparent Networks, Inc.**
**10 Cedar Street, Suite 100**
**Wellesley Hills, MA 02481**

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 |
|---|---|---|---|
| 12/099,595 | 04/08/2008 | Loki Jorgenson | 18897-002002/1150-110CON |

**CONFIRMATION NO. 4461**

20985
FISH & RICHARDSON, PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

**POWER OF ATTORNEY NOTICE**

*OC000000036350851*

Date Mailed: 06/08/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 04/24/2009.

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

/tswilliams/

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

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. |
|---|---|---|---|---|
| 12/099,623 | 04/08/2008 | Kiyohiro Kimura | 112857-1373 | 4515 |

29175 7590 04/23/2008

BELL, BOYD & LLOYD, LLP
P. O. BOX 1135
CHICAGO, IL 60690

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2871 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 04/23/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Alexandria, VA 22313-1450
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**BELL, BOYD & LLOYD, LLP**
**P. O. BOX 1135**
**CHICAGO IL 60690**
**UNITED STATES**

**In re Application of**
**Kiyohiro KIMURA et al.**
**Application No.: 12/099,623**
**Filed: April 08, 2008**
**Attorney Docket No.: 112857-1373**
**For: METHOD FOR PRODUCING AN OPTICAL SHEET**

**: DECISION ON REQUEST TO**
**: PARTICIPATE IN THE PATENT**
**: PROSECUTION HIGHWAY**
**: PILOT 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) pilot program and the petition under 37 CFR 1.102(d), filed April 08, 2008, to make the above-identified application special.

The request and petition are **GRANTED**.

## Discussion

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, note where the JPO 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 JPO application with similar claims and the JPO priority 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;

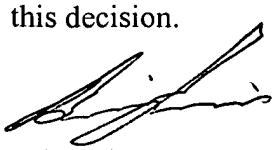
    Further, if a copy of the documents from a or b above is available via the Dossier Access System (DAS) applicant may request the USPTO obtain a copy from the DAS, however if the USPTO is unable to obtain a copy from the DAS the applicant will be required to submit a copy;
    b. An English language translation 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 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 Brian Sircus at 571 272 2058.

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.

This application is being forwarded to the examiner for action on the merits commensurate with this decision.



Brian Sircus
TQAS
Technology Center 2800 – Semiconductors
Electrical & Optical Systems & Components

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JUN 20 2008

OFFICE OF PETITIONS

HOVEY WILLIAMS LLP
10801 Mastin Blvd., Suite 1000
Overland Park KS 66210

| | | |
|---|---|---|
| In re Application of | : | |
| Mark J Lacour and Max W. Thompson | : | DECISION GRANTING STATUS |
| Application No. 12/099,651 | : | UNDER 37 CFR 1.47(a) |
| Filed: April 8, 2008 | : | |
| Attorney Docket No. 38814 | : | |

This is in response to the petition under 37 CFR 1.47(a), filed May 30, 2008.

The petition is **GRANTED.**

Petitioner has shown that the non-signing inventor Thompson has refused to join in the filing of the above-identified application.

The application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in 37 CFR 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

Pursuant to petitioner's request deposit account no. 19-0522 will be charged the $200.00 petition fee.

This application is being referred to the Office of Patent Application Processing for pre-examination processing.

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

Charlema Grant
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

Max W. Thompson
7935 Chianti Ct.
Sugar Land, Texas 77479

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JUN 2 0 2008

**OFFICE OF PETITIONS**

In re Application of
Mark J Lacour and Max W. Thompson
Application No. 12/099,651
Filed: April 8, 2008
Attorney Docket No. 38814
For: Agglomerate Removal System

Dear Mr. Thompson:

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 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 Charlema Grant at (571) 272-3215. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (571) 272-3150 or 1 (800) 972-6382 (outside the Washington, DC area).

Charlema Grant
Petitions Attorney
Office of Petitions

cc: HOVEY WILLIAMS LLP
10801 Mastin Blvd., Suite 1000
Overland Park KS 66210

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APR 13 2009

OFFICE OF PETITIONS

**WILSON SONSINI GOODRICH & ROSATI**
**650 PAGE MILL ROAD**
**PALO ALTO CA 94304-1050**

In re Application of :
**KURN,** Nurith et al. :
Application No. 12/099,670 : DECISION ON PETITION
Filed: April 08, 2008 : TO MAKE SPECIAL UNDER
Attorney Docket No. **25115-711.301** : 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed March 30, 2009, 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 attesting that Nurith Kurn is over 65 years of age. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Michelle R. Eason at 571-272-4231.

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 1637 for action on the merits commensurate with this decision.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**SHEPPARD, MULLIN, RICHTER & HAMPTON LLP**
**333 SOUTH HOPE STREET**
**48TH FLOOR**
**LOS ANGELES CA 90071-1448**

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JUL 31 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Roderick B. Wideman | : | DECISION ON PETITION |
| Application No. 12/099,698 | : | TO WITHDRAW |
| Filed: April 8, 2008 | : | FROM RECORD |
| Attorney Docket No. 16HC-134322 | : | |

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 26, 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 Daniel N. Yannuzzi on behalf of all attorneys of record who are associated with customer No. 30764.

All attorneys/agents associated with the Customer Number 30764 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record remains unchanged.

Currently, there is no outstanding Office action that requires a reply.

Telephone inquires concerning this decision should be directed to Petitions Examiner Joan Olszewski at (571) 272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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**SHEPPARD, MULLIN, RICHTER & HAMPTON LLP**
**333 SOUTH HOPE STREET**
**48TH FLOOR**
**LOS ANGELES CA 90071-1448**

**MAILED**

AUG 03 2009

**OFFICE OF PETITIONS**

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|---|---|---|
| In re Application of | : | |
| Joe Kent Jurneke | : | DECISION ON PETITION |
| Application No. 12/099,707 | : | TO WITHDRAW |
| Filed: April 8, 2008 | : | FROM RECORD |
| Attorney Docket No. 16HC-134316 | : | |

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 26, 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 Daniel N. Yannuzzi on behalf of all attorneys of record who are associated with customer No. 30764.

All attorneys/agents associated with the Customer Number 30764 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The correspondence address of record remains unchanged.

Currently, there is no outstanding Office action that requires a reply.

Telephone inquires concerning this decision should be directed to Petitions Examiner Joan Olszewski at (571) 272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**TRELLIS INTELLECTUAL PROPERTY LAW GROUP, PC**
**1900 EMBARCADERO ROAD**
**SUITE 109**
**PALO ALTO CA 94303**

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JAN 16 2009

In re Application of :

**GUHA**, Aloke :
Application No. 12/099,714 : DECISION ON PETITION
Filed: April 08, 2008 : TO WITHDRAW
Attorney Docket No. **100112-000240US** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 12, 2008.

The request is **NOT APPROVED**.

The Office has revised its change in procedure for request to withdraw from representation applies to requests filed on or after May 12, 2008.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request cannot be approved because there is no indication that acts (1) thru (3) noted in the above-identified certifications have been performed. See PTO/SB/83 (04-08).

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

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272- 2783.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

cc: **COPAN SYSTEMS INC.**
**1900 PIKE ROAD, UNIT A**
**LONGMONT CO 80501**

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

**TRELLIS INTELLECTUAL PROPERTY LAW GROUP, PC**
**1900 EMBARCADERO ROAD**
**SUITE 109**
**PALO ALTO CA 94303**

COPY MAILED

FEB 17 2009

OFFICE OF PETITIONS

In re Application of :

**GUHA**, Aloke :
Application No. 12/099,714 : DECISION ON PETITION
Filed: April 08, 2008 : TO WITHDRAW
Attorney Docket No. **100112-000240US** : 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 28, 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 Charles Kulas on behalf of all attorneys of record who are associated with customer No. 37490. All attorneys/agents associated with the Customer Number 37490 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence address of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

cc: **ALOKE GUHA**
**814 W. MULBERRY STREET**
**LOUISVILLE CO 80027**

cc: **COPAN SYSTEMS INC.**
**1900 PIKE ROAD, UNIT A**
**LONGMONT CO 80501**

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

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

MAILED

APR 20 2009

OFFICE OF PETITIONS

In re Application of :
HETZEL et al. : DECISION ACCORDING STATUS
Application No. 12/099,740 : UNDER 37 CFR 1.47(a)
Filed: 04/08/2008 :
Attorney Docket No. SENS0002C :
Title: METHOD OF SCREENING FOR :
DISORDERS OF GLUCOSE METABOLISM :

This is in response to the petition under 37 CFR 1.47(a), filed October 24, 2008. Petitioner obtained an extension of time for response within the fourth month. Accordingly, the petition is filed timely.

The petition is **GRANTED.**

Petitioner has shown that the non-signing inventor cannot be located to join in the filing of the above-identified application after diligent efforts. Petitioner mailed a copy of the application papers to the non-signing inventor for his review and signature on the declaration. However, the package was returned without a forwarding address. A copy of the FedEx Track Shipment accompanies the petition. Petitioners state that they performed an internet search which confirmed that his last known address was the same address to which the package was mailed. A copy of the results of the internet search was provided on petition.

The application and papers have been reviewed and are found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status. As provided in 37 CFR 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

This application is being referred to Technology Center AU 1631 for examination in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3211.

Christina L. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ANDREW CONE
14031 S. 8th Street,
Phoenix, AZ 85048

MAILED

APR 20 2009

OFFICE OF PETITIONS

In re Application of :
HETZEL et al. :
Application No. 12/099,740 : LETTER
Filed: 04/08/2008 :
Attorney Docket No. SENS0002C :
Title: METHOD OF SCREENING FOR :
DISORDERS OF GLUCOSE METABOLISM :

Dear Mr. Cone:

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. Requests for information regarding your application should be directed to the File Information Unit at 571- 272-3150. 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 571-272-3150 or 1-800-972-6382 (outside the Washington D.C. area).

Christina T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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

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

MAIL

MAR 03 2010

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

MARK D. SARALINO (GENERAL)
RENNER, OTTO, BOISSELLE & SKLAR, LLP
1621 EUCLID AVENUE, NINETEENTH FLOOR
CLEVELAND OH 44115-2191

In re Application of
TACHIMORI, NOBUYA
Application No. 12/099,802
Filed: April 9, 2008
Attorney Docket No. **ONKYP0136US**

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 20, 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:

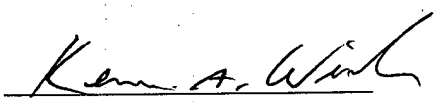
(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the JPO application(s) along with an English translation thereof and a statement that the English translation 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 Kenneth Wieder at 571-272-2986.

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.



Kenneth Wieder
Quality Assurance Specialist
Technology Center 2600
Communications

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. |
|---|---|---|---|---|
| 12/099,848 | 04/09/2008 | Koji YAMAOKA | P/4723-32 | 4973 |

2352 7590 05/18/2010
OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

| EXAMINER | |
|---|---|
| CARPENTER, WILLIAM R | |
| ART UNIT | PAPER NUMBER |
| 3767 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/18/2010 | 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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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:
YAMAOKA, KOJI et al
Serial No.: 12/099,848
Filed: April 9, 2008
Docket: P/4723-32
Title: OVER TUBE

DECISION ON PETITION

This is a decision on the Petition for Suspension of Action received on April 30, 2010, seeking to suspend action on the above-identified application for a period of one month. This petition is being considered pursuant to 37 CFR § 1.103(a)[1].

The petition is dismissed.

In the petition, petitioner alleged that the petition to suspend further action on the current application is for good and sufficient cause, namely, the applicant is likely to further amend the claims in view of the interview held on April 30, 2010. Petitioner requests suspension of action on the present application for one month.

The reason for a one-month suspension of action is not convincing and could not justify a month delay in prosecution. Petitioner did not provide any reasons as to why a one-month suspension of Office action is necessary. The Office must balance the burden of timely examinations and needs of the public to know which claims it faces with the needs of applicants in pursuing claims which reflect the scope to which they are entitled. Therefore, any suspension of Office action will not be granted without a good and sufficient cause. Accordingly, the request for suspension of action is denied.

[1] 37 CFR 1.103. Suspension of action by the Office. (a) Suspension for cause . On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include: (1) A showing of good and sufficient cause for suspension of action; and (2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office

The application remains in active status and is being forwarded to the examiner via the Supervisory Patent Examiner of Art Unit 3767 for consideration of the amendment filed on April 26, 2010 and preparation of an Office action in response to the amendment. As stated in 37CFR § 1.181(f): 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.

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" and directed to the Office of the Deputy Commissioner for Patent Examination Policy at Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. See MPEP 1002.02(b).

Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DISMISSED.

Robert Olszewski, Director
Technology Center 3700

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

IBM CORPORATION (JSS)
C/O SCHUBERT OSTERRIEDER & NICKELSON PLLC
6013 CANNON MOUNTAIN DRIVE, S14
AUSTIN, TX 78749

MAILED

MAY 13 2010

OFFICE OF PETITIONS

In re Application of :
Jente B. Kuang, et al. :
Application No. 12/099,913 : DECISION ON PETITION
Filed: April 9, 2008 :
Attorney Docket No. ASU920050912US2 :

This is a decision on the petition, filed March 22, 2010, which is being treated as a petition under 37 CFR 1.8(b), requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to timely respond to the Office action of August 31, 2009, which set a three (3) month shortened statutory period for reply. Accordingly, a reply was due on or before November 30, 2010.

Petitioner states that a timely reply was mailed via certificate of mailing on March 1, 2010, which included the following papers: an amendment, request for a three (3) month extension of time, two sheets of formal replacement drawings and credit card payment form. Petitioner has submitted a copy of the previously mailed correspondence, which bears a certificate of mailing dated March 1, 2010, which would have rendered the reply timely if received. The original papers are in the file.

The petition satisfies the above requirements of 37 CFR 1.8(b). Accordingly, the holding of abandonment for failure to timely file a reply to the Office action of August 31, 2009 is hereby **withdrawn** and the **application restored to pending status**.

Telephone inquiries concerning this decision should be directed to April M. Wise at 571-272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2824 for appropriate action in the normal course of business on the reply received with petition.

/Carl Friedman/
Carl Friedman
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LATTICE SEMICONDUCTOR CORPORATION
5555 NE MOORE COURT
HILLSBORO, OR 97124-6421

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Ravindar M. Lall | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7661878 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/099,933 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/09/2008 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **8** 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

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,943 | 04/09/2008 | Koichi NIIDA | 22590 | 5142 |

7590 04/26/2010

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 3739 | |
| MAIL DATE | DELIVERY MODE |
| 04/26/2010 | PAPER |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Patent Publication Branch
Office of Data Management

Adjustment date: 04/26/2010 NFARMEN
04/09/2008 INTEFSW 00007638 191013 12099943
02 FC:1111 510.00 CR

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
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,947 | 04/09/2008 | Scott Thomas Brady | UIC0017US | 5149 |

7590 12/28/2009

Jane Massey Licata
Licata & Tyrrell P.C.
66 E. Main Street
Marlton, NJ 08053

| EXAMINER | |
|---|---|
| KOLKER, DANIEL E | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1649 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 12/28/2009 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Jane Massey Licata
Licata & Tyrrell P.C.
66 E. Main Street
Marlton NJ 08053

Applicant: Brady et al.
Appl. No.: 12/099,947
Filing Date: April 9, 2008
Title: METHOD FOR TREATING A SYNUCLEINOPATHY
Attorney Docket No.: UIC0017US
Pub. No.: US 2009/0258814 A1
Pub. Date: October 15, 2009

This is a decision on the request for republication of patent application publication under 37 CFR 1.221(a), filed on December 18, 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

The applicant is also reminded that any amendments must be incorporated into the submission to be included in the publication.

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: 12/29/2009 KKING1
12/18/2009 INTEFSW 00010052 12099947
01 FC:1504 -300.00 DP

Refund Ref:
12/29/2009 0030078156

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Credit Card Refund Total: $300.00

Am Exp..: XXXXXXXXXXX2000

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/099,960 | 04/09/2008 | Jun-Ho CHOI | AB-2550 US | 5170 |

7590 04/10/2009

Haynes and Boone, LLP
IP Section
2323 Victory Avenue
SUITE 700
Dallas, TX 75219

| EXAMINER | |
|---|---|
| LOUIE, WAI SING | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2814 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 04/10/2009 | PAPER |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Patent Publication Branch
Office of Data Management

Adjustment date: 04/10/2009 NFARMER
04/09/2008 INTEFSW 00007896 502257 12099960
02 FC:1111 510.00 CR

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. |
|---|---|---|---|---|
| 12/099,994 | 04/09/2008 | Chester Wayne Sink | 80340 US05 | 5233 |

7590 02/18/2009

MICHAEL K. CARRIER
EASTMAN CHEMICAL COMPANY
100 NORTH EASTMAN ROAD
KINGSPORT, TN 37660-5075

| EXAMINER | |
|---|---|
| HEINCER, LIAM J | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1796 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 02/18/2009 | PAPER |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Betty Powell

Patent Publication Branch
Office of Data Management

Adjustment Date: 02/18/2009 BPOWELL
04/09/2008 INTEFSW 00008303 050221 12099994
02 FC:1111 510.00 CR
04 FC:1202 500.00 CR

Adjustment date: 02/18/2009 BPOWELL
04/09/2008 INTEFSW 00008303 050221 12099994
02 FC:1111 510.00 CR
04 FC:1202 500.00 CR

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

**FLEIT GIBBONS GUTMAN BONGINI & BIANCO P.L.**
**ONE BOCA COMMERCE CENTER**
**551 NORTHWEST 77TH STREET,**
**SUITE 111**
**BOCA RATON FL 33487**

COPY MAILED
MAR 01 2010

In re Application of :
Steven W. GOLDSTEIN :
Application No. 12/100,002 : DECISION ON PETITION
Filed: April 9, 2008 : TO WITHDRAW
Attorney Docket No. 537-P0002-D1 : 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 17, 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 request cannot be approved because there is no indication that the acts noted above have been performed.

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

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-6735.

/DCG/
Diane C. Goodwyn
Petitions Examiner
Office of Petitions

cc: STEVEN M. GOLDSTEIN
16390 MADDALENA PLACE
DELRAY BEACH, FL 33446

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LOZA & LOZA LLP
305 N. Second Avenue
#127
Upland CA 91786-6064

MAIL

JUN 03 2008

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Michael G. MARTINEZ, et al.
Serial No.: 12/100,081
Filed: April 9, 2008

Title: **SYSTEM AND METHOD FOR INSERTING BREAK-IN SIGNALS IN COMMUNICATION SYSTEMS**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 9, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions set forth under section I. above are considered to have been met. However, the petition fails to comply with conditions set forth under section II. , items 5 through 5.3, 6.1 through 6.3 and 6.5.

Regarding the requirement in item 5. through 5.3 above, the preexamination search document provided with the instant petition is deficient as follows: The US field of search and database searches which are to be provided under section 8(A) are not sufficient. In addition to the search areas provided, applicant would also need to search in the following class/subclasses: 455/ 403, 521, and 527. Also, applicant should also search Google Scholar database.

Please note that any request for reconsideration must include an Information Disclosure Statement citing any newly found relevant prior art and an updated Accelerated Examination Support Document (AESD) meeting all of requirements 6.1 – 6.6 for any documents uncovered by the new search(es) as required above.

In regard to item 6.1, a review of the file finds that applicant failed to provide copies of the cited foreign documents and the non-patent literature documents listed on the Information Disclosure Statement as required by 37 CFR 1.98(a)(2).

In regard to items 6.2 and 6.3, sections 9(B) and 9(C) of the Accelerated Examination Support Document are deficient inasmuch as they only include an analysis with respect to the "six closest references". However, each reference cited on the IDS filed in support of the petition must be discussed in detail as per items 6.2 and 6.3 above. *In other words, applicant must discuss each of the claims in regard to each of the references as required.* Correction is therefore required in regard to the discussion of each claim with respect to each cited reference.

In regard to item 6.5, although applicant mentions that this application claims the benefit of parent application, the Accelerated Examination Support Document fails to include the showing of where each limitation finds support in the parent application as required. While applicant states that parent application has an identical specification and figures, the numbering of the paragraphs of the specifications is not identical because the instant application has one more paragraph and therefore the paragraph numbering is not identical.

For the reason cited above, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Krista Zele, Quality Assurance Specialist, at (571) 272-7288.

/Krista Zele/

Krista Zele
Quality Assurance Specialist
Technology Center 2600
Communications

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SLATER & MATSIL, L.L.P.
17950 PRESTON ROAD
SUITE 1000
DALLAS, TX 75252

MAILED

JUL 22 2010

OFFICE OF PETITIONS

In re Application of :
Andrei Josiek :
Application No. 12/100,120 :
Filed: April 9, 2008 :
Attorney Docket No. QIM 2007 P 50234 US :

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 16, 2010.

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.

In the instant application, the practitioner(s) were appointed via Customer Number however the request does not designate a Customer Number to be withdrawn by. Therefore, the current request cannot be approved at this time. Any subsequent request must withdraw all associated practitioner(s) in the same manner as appointed.

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.*

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

There are no outstanding Office actions that require a reply.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-6059.

Alicia Kelley
Petitions Examiner
Office of Petitions

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. |
|---|---|---|---|---|
| 12/100,125 | 04/09/2008 | Elisabetta Flamini | GB920080072US1 (3026) | 5497 |

78290 7590 06/23/2008

Oppenheimer Wolff & Donnelly LLP
Plaza VII, Suite 3300
45 South Seventh Street
Minneapolis, MN 55402-1609

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2837 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/23/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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Minneapolis, MN 55402-1609

| | |
|---|---|
| In re Application of:<br>FLAMINI *et al.*<br>Serial No.: 12/100,125<br>Filed: April 09, 2008<br>Title: **SELF-ADJUSTING MUSIC SCROLLING SYSTEM** | DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02 |

This is a decision on the petition filed on April 09, 2008, to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any dependent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions I.1-4; II.5, 5.1-5.3, 6, 6.1-6.4 and 6.6, above are considered to have been met. However, the petition fails to comply with conditions II 6.5, above. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirements of II.6.5, the examination support document must include a showing of where **each limitation** of the application claims finds support under 35 USC 112, first paragraph, in the written description of the specification. The examination support document includes a broad statement of the support being found between a range of paragraphs. As such, the examination support document neither clearly shows support for each limitation, nor is it pointed out in the written description of the specification. A more specific description of where each limitation finds support is required. For these reasons, the petition does not meet the requirements of II. 6.5, as set forth above.

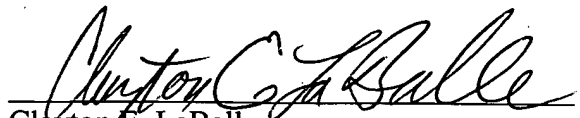
## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Clayton E. LaBalle, Special Program Examiner, at (571) 272-1594.



Clayton E. LaBalle
Special Program Examiner
Technology Center 2800

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/100,125 | 04/09/2008 | Elisabetta Flamini | GB920080072US1 (3026) | 5497 |

78290 7590 07/31/2008

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| EXAMINER | |
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| ART UNIT | PAPER NUMBER |
| 2837 | |

| MAIL DATE | DELIVERY MODE |
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| 07/31/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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In re Application of:
FLAMINI *et al.*
Serial No.: 12/100,125
Filed: April 09, 2008
Title: **SELF-ADJUSTING MUSIC SCROLLING SYSTEM**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 CFR 1.102

This decision is a reply to the communication filed July 09, 2008. The communication is being treated as a petition requesting reconsideration of the previous decision of June 28, 2008, dismissing the petition to make special under 37 C.F.R. §1.102(d) filed April 09, 2008.

The petition to make the application special is GRANTED.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:

If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 C.F.R. §1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 C.F.R. §1.97 and §1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

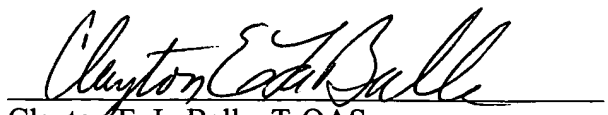
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 C.F.R. §1.181, §1.182 or §1.183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve-month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to the undersigned at (571) 272-1594.



Clayton E. LaBalle, T-QAS
Technology Center 2800 - Semiconductors,
Electrical & Optical Systems & Components

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JUN 15 2009

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

| | | |
|---|---|---|
| In re application of | : | **DECISION ON REQUEST TO** |
| Yoshito Tanaka et al. | : | **PARTICIPATE IN PATENT** |
| Application No. 12/100,152 | : | **PROSECUTION HIGHWAY** |
| Filed: April 9, 2008 | : | **PROGRAM AND PETITION** |
| For: BRAKE CONTROL APPARATUS AND | : | **TO MAKE SPECIAL UNDER** |
| BRAKE CONTROL METHOD | : | **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 10, 2009, to make the above-identified application special.

The request and petition are **DISMISSED**.

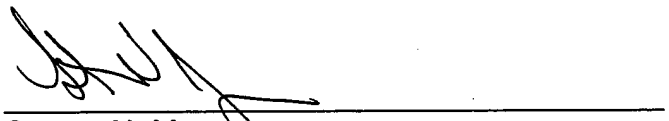
A grantable request to participate in the PPH pilot program and petition to make special require:

(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 the latest Office action 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:
(3) Claims of the U.S. Application that sufficiently correspond to the allowable claims of the JPO application. Specifically, claim 1 lacks the limitation, "...performed by a driver..." that is present in the corresponding claim of the JPO application. This limitation is a material limitation, and unlike the other differences in claim language identified by the applicant in the petition, is not a difference which obviates indefinite claim language.

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. All replies to a decision to dismiss must be submitted by EFS-Web using the document description "Petition to make special under Patent Prosecution Highway."

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: 6/14/09

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JUL 15 2009

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1940 Duke Street
Alexandria, VA 22314

| | | |
|---|---|---|
| In re application of<br>Yoshito Tanaka et al.<br>Application No. 12/100,152<br>Filed: April 9, 2008<br>For: BRAKE CONTROL APPARATUS AND BRAKE CONTROL 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 renewed request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed July 13, 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 the latest Office action 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).

In light of renewed petition, which included a second preliminary amendment, the request to participate in the PPH program complies with the above requirements. Therefore, the above-identified application has been accorded "special" status.

All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

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: 7/14/09

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. |
|---|---|---|---|---|
| 12/100,152 | 04/09/2008 | Yoshito Tanaka | 325032US26 | 5555 |

22850 7590 07/28/2009

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

| EXAMINER | |
|---|---|
| KISWANTO, NICHOLAS | |
| **ART UNIT** | **PAPER NUMBER** |
| 3664 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 07/28/2009 | 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):

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JUL 15 2009

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

| | | |
|---|---|---|
| In re application of<br>Yoshito Tanaka et al.<br>Application No. 12/100,152<br>Filed: April 9, 2008<br>For: BRAKE CONTROL APPARATUS AND BRAKE CONTROL 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 renewed request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed July 13, 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 the latest Office action 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).

In light of renewed petition, which included a second preliminary amendment, the request to participate in the PPH program complies with the above requirements. Therefore, the above-identified application has been accorded "special" status.

All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

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: 7/14/09

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/100,164 | 04/09/2008 | Takeshi Kubota | 325034US2 | 5580 |

7590 08/21/2009

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

| EXAMINER | |
|---|---|
| YAN, REN LUO | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2854 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 08/21/2009 | ELECTRONIC |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Nomi Farmer

Patent Publication Branch
Office of Data Management

Refund Ref:
08/21/2009 0030073552

Credit Card Refund Total: $510.00

Acct Exp..: XXXXXXXXXXX1000

Adjustment date: 08/21/2009 NFARMER
04/10/2008 INTEFSW 00001896 12100164
02 FC:1111 -510.00 OP

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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. |
|---|---|---|---|---|
| 12/100,178 | 04/09/2008 | Qiao Li | HW702824 | 5611 |

7590 08/21/2009

Leydig, Voit & Mayer, Ltd
(for Huawei Technologies Co., Ltd)
Two Prudential Plaza Suite 4900
180 North Stetson Avenue
Chicago, IL 60601

| EXAMINER | |
|---|---|
| PATEL, JAYANTI K | |
| **ART UNIT** | **PAPER NUMBER** |
| 2419 | |
| **NOTIFICATION DATE** | **DELIVERY MODE** |
| 08/21/2009 | ELECTRONIC |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Patent Publication Branch
Office of Data Management

Adjustment date: 08/21/2009 NFARMER
04/10/2008 INTEFSW 00002078 121216 12100178
02 FC:1111 510.00 CR

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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GORDON & JACOBSON
SUITE 407
60 LONG RIDGE ROAD
STAMFORD, CT 06902

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AUG 14 2009

OFFICE OF PETITIONS

In re Application of :
Sundaram Ravikumar :
Application No. 12/100,185 : DECISION ON PETITION
Filed: April 9, 2008 : TO WITHDRAW
Attorney Docket No. RAV-029 : 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 25, 2009.

The request is **APPROVED**.

The request was signed by David P. Gordon on behalf of the practitioners of record associated with Customer Number 36822.

Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to inventor Sundaram Ravikumar at the address indicated below.

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

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Sundaram Ravikumar
265 Hardscrabble Road
Briarcliff Manor, NY 10510

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**DYKAS, SHAVER & NIPPER, LLP**
**P.O. Box 877**
**Boise, ID 83701-0877**

**COPY MAILED**

OCT 0 1 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Marcus Ritter | : | |
| Application No. 12/100,204 | : | DECISION ON PETITION |
| Filed: April 9, 2008 | : | TO WITHDRAW |
| Attorney Docket No. RITM101CON | : | FROM RECORD |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 20, 2009.

The request is **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 Stephen M. Nipper 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 Marcus Ritter at the address indicated below.

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

Terri Johnson
Petitions Examiner
Office of Petitions

cc: **Marcus Ritter**
**PO Box 13402**
**Salem, OR 97309**

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/100,204 | 04/09/2008 | MARCUS RITTER | RITM101CON |

**CONFIRMATION NO. 5673**

21658
DYKAS, SHAVER & NIPPER, LLP
P.O. BOX 877
BOISE, ID 83701-0877

**POWER OF ATTORNEY NOTICE**

OC000000038014927

Date Mailed: 09/28/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/20/2009.

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

/tsjohnson/

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/100,215 | 04/09/2008 | Girish Sundaram | IN920080018US1 (105077) | 5696 |

78148 7590 11/04/2008

KING & SPALDING
1180 PEACHTREE ST.
ATLANTA, GA 30309

| EXAMINER | |
|---|---|
| CALDWELL, ANDREW T | |
| **ART UNIT** | **PAPER NUMBER** |
| 2442 | |
| **MAIL DATE** | **DELIVERY MODE** |
| 11/04/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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KING & SPALDING
1180 PEACHTREE ST.
ATLANTA GA 30309

In re Application of:
Girish Sundaram
Serial No.: 12/100215
Filed: April 9, 2008
Docket: IN920080018US1 (105077)

Title: METHOD AND SYSTEM FOR PREVIEWING OF FORWARDING FILE ATTACHMENTS RECEIVED DURING A CHAT SESSION

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 9, 2008 to make the above-identified application special for accelerated examination procedure 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;
5. The petition must be filed with the application.

The application as filed is not eligible for the accelerated examination under 37 C.F.R. § 1.102(d) because it is a utility application filed under 37 CFR 1.111(a) and was not complete. The Notice to File Corrected Application papers mailed on April 14, 2008 is evidence that the application was not complete and in condition for examination at the time of filing.

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 the undersigned at (571) 272-3719. If attempts to reach the undersigned are unsuccessful, Mano Padmanabhan., Quality Assurance Specialist can be reached at (571)272-4210.

/Kakali Chaki/

Kakali Chaki, Quality Assurance Specialist

Technology Center 2100

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P.O. Box 1450
Alexandria, VA 22313-1450
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Michael L. Leetzow, Esq.
Michael L. Leetzow, P.A.
5213 SHORELINE CIRCLE
SANFORD FL 32771

MAILED

JUL 20 2009

OFFICE OF PETITIONS

In re Application of :
Violett :
Application No. 12/100,216 : ON PETITION
Filed: April 9, 2008 :
Attorney Docket No. BVMI-004 :
For: ELECTRIC PROPULSION SYSTEM
USEFUL IN JET-TYPE MODEL
AIRPLANES AND UAVS

This is a decision on the petition under 37 CFR 1.137(b), filed June 4, 2009, to revive the above-identified application.

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

This application became abandoned for failure to timely reply to the Notice to File Corrected Application Papers, mailed April 29, 2008, which set a two month shortened statutory period for reply. No extensions of time having been obtained pursuant to 37 CFR 1.136(a) and no reply being received in the Office, this application became abandoned on June 30, 2008. A Notice of Abandonment was mailed on January 5, 2009.

Applicant has submitted a proper reply to the April 29, 2008 Notice in the form of replacement drawings, an acceptable statement of the unintentional nature of the delay in responding to the April 29, 2008 Notice, and the $810.00 petition fee. Accordingly, the petition under 37 CFR 1.137(b) is granted.

After the mailing of this decision, the file will be returned to the Office of Patent Application Processing for further pre-examination processing.

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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STERNE, KESSLER, GOLDSTEIN & FOX, P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005-3934

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DEC 19 2008

OFFICE OF PETITIONS

In re Application of :
Murthy, et al. : REQUEST FOR INFORMATION
Application No. 12/100,225 :
Filed: April 9, 2008 :
Attorney Docket No. 2348.1180000 :

This is in response to the petition under 37 CFR 1.47(a), filed December 1, 2008.

Prior to a decision on the merits of the petition, clarification is requested. While the petition makes reference to five inventors, the declaration submitted therewith is executed by five out of six inventors. Clarification as to the inventive entity is requested as the petition conflicts with the information contained in the declaration.

Petitioners are given TWO MONTHS from the mailing date of this letter to reply with the information requested herein. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted herein. The reply under 37 CFR 1.47(a) may include an oath or declaration executed by the non-signing inventors. Any extensions of time will be governed by 37 CFR 1.136(a).

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

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

By facsimile: (571) 273-8300

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

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

Alesia M. Brown
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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STERNE, KESSLER, GOLDSTEIN & FOX, P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005-3934

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JUN 19 2009

OFFICE OF PETITIONS

In re Application of
Agrawal, et al.
Application No. 12/100,225
Filed: April 9, 2008
Atty. Dkt. No.: 2348.1170000

: DECISION NOTING JOINDER OF
: INVENTOR AND PETITION

Papers filed on February 19, 2009 in response to a "Decision Refusing Status Under 37 CFR 1.47(a)," mailed December 19, 2008, included a Declaration signed by a previously non-signing inventor in compliance with 37 CFR 1.63.

The petition is **DISMISSED AS MOOT**.

In view of the joinder of the inventor, further consideration under § 1.47(a) is not necessary. This application does not have any Rule 1.47 status and no such status should appear on the record for this file. This application need not be returned to this Office for any further consideration under 37 CFR 1.47(a).

This application is being referred to the Office of Patent Application Processing for further processing.

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**FOLEY & LARDNER LLP**
**P.O. BOX 80278**
**SAN DIEGO, CA 92138-0278**

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OCT 0 1 2009

OFFICE OF PETITIONS

In re Application of
Sankar et al
Application No. 12/100,339
Filed: April 9, 2008
Attorney Docket No. 090699-0301

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 on September 11, 2009.

The request is **NOT APPROVED**.

The request cannot be approved because no reasons for withdrawal have been provided. The Office cannot, at this time, determine whether practitioner's request is one of the mandatory or permissive reasons enumerated in 37 CFR 10.40. 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.

Further, 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 Office no longer accepts address changes to a new practitioner or law firm filed with requests under 37 C.F.R. § 1.36(b) and 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.*

Any subsequent requests must include reasons for withdrawal, and proper certifications pursuant to 37 CFR 10.40.

All future communications from the Office will be directed to above-listed address until otherwise properly notified by the applicant or a proper change of correspondence address have been submitted.

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

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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MAIL

MAY 19 2008

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

CARPENTER & ASSOCIATES
5 PIPESTEM COURT
ROCKVILLE MD 20854

In re Application of:
CANNARA, RACHEL, et al
Serial No.: 12/100,347
Filed: April 9, 2008

Title: **SILICON CARBIDE INDENTS FOR PROBE STORAGE UTILIZING THERMOMECHANICALLY ACTIVATED POLYMER MEDIA**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 9, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions set forth under section I. above are considered to have been met. However, the petition fails to comply with conditions set forth under section II. items 5.2 and 5.3.

For these reasons cited above, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirement in item 5.2 and 5.3 above, the preexamination search document provided with the instant petition is deficient as follows: Regarding the database search, the search is inadequate.

The search includes only the terms in bold below, but should include a lot more synonyms/equivalents (note the "preceramic" equivalents are taken from just the applicant's disclosure itself). See L1 and L2.
The search also "ANDs" the 2 search terms, which is not restrictive enough to provide useful results when correcting for use of proper synonyms. See use of "near10" in L3 below.
The search would then need to be narrowed more specifically to the environment (L4, L6) to provide viewable results. See L5 and L7.

L1 "**indent or indents** or pit or pits or dent or dents or indent or indents or indentation or indentations or hole or holes"

L2 "**preceramic or (pre adj ceramic) or polymethylsilyne** or ceramic or ((phase chang$4) near2 (chemical$7 or hard$9)) or (polymer$4 adj ((thin adj film) or precursor or soft or hard)) or (silicon adj carbide) or sic or methylene or acetylene or silane"

L3 L1 near10 L2

L4 (stor$6 or writ$6 or record$5)

L5 L3 same L4

L6 probe

L7 L3 same L6

If any request for reconsideration is filed, an updated preexamination search must be conducted as per items 5.2 and 5.3 above, and the Preexamination Search Document must be amended to indicate such; a new Information Disclosure Statement should be filed to cite any newly found prior art, and the Accelerated Examination Support Document must also be amended to include the necessary reference and discussion of any newly found and cited prior art in accordance with all of items 6 through 6.6 above.

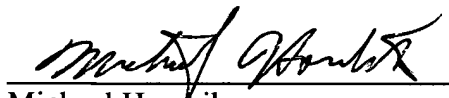
## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Michael Horabik, Quality Assurance Specialist, at (571) 272-3068.



Michael Horabik
Quality Assurance Specialist
Technology Center 2600
Communications

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TECHNOLOGY CENTER 2600

CARPENTER & ASSOCIATES
5 PIPESTEM COURT
ROCKVILLE MD 20854

In re Application of:
CANNARA, RACHEL et al,
Serial No.: 12/100,347
Filed: April 09, 2008

Title: **SILICON CARBIDE INDENTS FOR PROBE STORAGE UTILIZING THERMOMECHANICALLY ACTIVATED POLYMER MEDIA**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on June 19, 2008 requesting reconsideration to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

All of the requirements to correct the deficiencies outlined in the petition decision mailed May 19, 2008 have been met.

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral

election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Michael Horabik, Quality Assurance Specialist, at (571) 272-3068.

Michael Horabik
Quality Assurance Specialist
Technology Center 2600
Communications

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/100,354 | 04/09/2008 | Rachel Cannara | CH920070092US1/RKC100020 | 5975 |

76089 7590 05/02/2008
CARPENTER & ASSOCIATES
5 PIPESTEM COURT
ROCKVILLE, MD 20854

| EXAMINER | |
|---|---|
| PARKER, FREDERICK JOHN | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1792 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/02/2008 | PAPER |

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5-2-08

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|---|---|---|
| In re application of<br>Cannara et al.<br>Serial No. 12/100,354<br>Filed: April 9, 2008<br>For: PROBE-BASED LITHOGRAPHY<br>UTILIZING THERMOMECHANICALLY<br>ACTIVATED POLYMERS | :<br>:<br>:<br>:<br>:<br>:<br>:<br>: | DECISION ON PETITION<br>TO MAKE SPECIAL |

This is a decision on the petition filed on April 9, 2008 to make the above-identified application special under the accelerated examination program.

The petition to make the application special is **DISMISSED.**

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any dependent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner;

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document.

An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## DECISION

The conditions regarding the application (section I, subsections 1-4) discussed above are considered to have been met. Additionally, the conditions regarding the petition (section II, subsections 1-4 and 6) are considered to have been met. However, the petition fails to comply with section II, subsection 5.

It appears that the search is incomplete. A search in Class 427, Subclasses 256, 264, 271, 336, 376.1, 403, 419.1, and 419.7 is required. Note that the application is classified in Class 427, Subclass 256 for examination.

Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

For the above-stated reasons, the petition is dismissed. The application will therefore be taken up by the examiner in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Gregory Mills, Quality Assurance Specialist, at (571) 272-1439.

/Gregory Mills/

Gregory Mills
Quality Assurance Specialist
Technology Center 1700

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ROCKVILLE MD 20854

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/100,354 | 04/09/2008 | Rachel Cannara | CH920070092US1/RKC100020 | 5975 |

76089 7590 06/20/2008

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ROCKVILLE, MD 20854

| EXAMINER | |
|---|---|
| PARKER, FREDERICK JOHN | |
| **ART UNIT** | **PAPER NUMBER** |
| 1792 | |
| **MAIL DATE** | **DELIVERY MODE** |
| 06/20/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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6-20-08

In re application of
Cannara et al.
Serial No. 12/100,354
Filed: April 9, 2008
For: PROBE-BASED LITHOGRAPHY UTILIZING THERMOMECHANICALLY ACTIVATED POLYMERS

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the REQUEST FOR RECONSIDERATION OF DECISION DISMISSING PETITION TO MAKE SPECIAL FOR ACCELERATED EXAMINATION OF NEW APPLICATION, filed on June 1, 2008 to make the above-identified application special under 37 C.F.R. § 1.102(d).

As the previously noted defects have been corrected by the request for reconsideration and accompanying documents, the petition to make the application special is **GRANTED.**

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

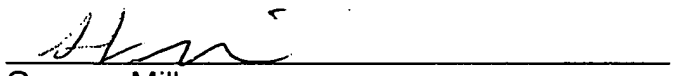
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Gregory Mills, Quality Assurance Specialist, at (571) 272-1439.



Gregory Mills
Quality Assurance Specialist
Technology Center 1700

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/100,364 | 04/09/2008 | Rachel Cannara | CH920070091US1/RKC100021 | 5990 |

76089 7590 05/02/2008

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5 PIPESTEM COURT
ROCKVILLE, MD 20854

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 1793 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/02/2008 | PAPER |

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The time period for reply, if any, is set in the attached communication.

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5-2-08

In re application of
Cannara et al.
Serial No. 12/100,364
Filed: April 9, 2008
For: THERMOMECHANICALLY-ACTIVATED TIP SHAPE AND REGISTRY RESTORATION FOR PROBE ARRAY DEVICES UTILIZING THERMOMECHANICALLY-ACTIVATED POLYMERS

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition filed on April 9, 2008 to make the above-identified application special under the accelerated examination program.

The petition to make the application special is **DISMISSED.**

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any dependent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner;

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document.

An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## DECISION

The conditions regarding the application (section I, subsections 1-4) discussed above are considered to have been met. Additionally, the conditions regarding the petition (section II, subsections 1-4 and 6) are considered to have been met. However, the petition fails to comply with section II, subsection 5.

It appears that the search is incomplete. A search in the following classes and subclasses is required:

264/36.1, 36.18, 259, 271.1, 279, 319, 332, 338
156/89.11, 94, 245
427/140, 222, 376.1, 376.2

Note that the application will be classified in Class 156, Subclass 89.11 for examination.

Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

For the above-stated reasons, the petition is dismissed. The application will therefore be taken up by the examiner in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Gregory Mills, Quality Assurance Specialist, at (571) 272-1439.

/Gregory Mills/

Gregory Mills
Quality Assurance Specialist
Technology Center 1700

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/100,364 | 04/09/2008 | Rachel Cannara | CH920070091US1/RKC100021 | 5990 |

76089 7590 06/20/2008

CARPENTER & ASSOCIATES
5 PIPESTEM COURT
ROCKVILLE, MD 20854

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 1793 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/20/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

glm

6-20-08

In re application of
Cannara et al.
Serial No. 12/100,364
Filed: April 9, 2008
For: THERMOMECHANICALLY-ACTIVATED TIP SHAPE AND REGISTRY RESTORATION FOR PROBE ARRAY DEVICES UTILIZING THERMOMECHANICALLY-ACTIVATED POLYMERS

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the REQUEST FOR RECONSIDERATION OF DECISION DISMISSING PETITION TO MAKE SPECIAL FOR ACCELERATED EXAMINATION OF NEW APPLICATION, filed on June 1, 2008 to make the above-identified application special under 37 C.F.R. § 1.102(d).

As the previously noted defects have been corrected by the request for reconsideration and accompanying documents, the petition to make the application special is **GRANTED.**

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention

(invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Gregory Mills, Quality Assurance Specialist, at (571) 272-1439.

Gregory Mills
Quality Assurance Specialist
Technology Center 1700

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/100,400 | 04/09/2008 | Zhimin Ding | 351913-993800 | 6082 |

26379 7590 05/26/2010

DLA PIPER LLP (US )
2000 UNIVERSITY AVENUE
EAST PALO ALTO, CA 94303-2248

| EXAMINER | |
|---|---|
| BARRON JR, GILBERTO | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2432 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 05/26/2010 | 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):

PatentDocketingUS-PaloAlto@dlapiper.com

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Alexandria, VA 22313-1450
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Ron Yin
ATTN: Patent Department
DLA PIPER LLP US
2000 University Avenue
East Palo Alto, CA 94303

*In re* Application of:
Ding
Appl. No.: 12/100,400
Filed: April 9, 2008
For: Secure Removable Card Having a Plurality of Integrated Circuit Dies

DECISION ON PETITION
UNDER 37 CFR § 1.59

This is a decision on the petition under 37 CFR § 1.59(b), filed on 14 October 2008, to expunge information submitted pursuant to MPEP § 724.02.

The petition is **DISMISSED**.

Petitioner requests that the information submitted on 14 October 2008 be expunged from the record as the information was identified as being under a protective order after it was filed. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

The petition is premature because the application is not currently allowed or abandoned. Accordingly, it is not appropriate to make a final determination of whether or not the material requested to be expunged is "material," with "materiality" being defined as any information which the examiner considers as being important to a determination of patentability of the claims.

During prosecution on the merits, the examiner will determine whether or not the information submitted on 14 October 2008 is considered to be "material." Once prosecution on the merits is closed, applicant may re-submit a petition to expunge the information. No further fee is required for such a second submission of a petition under 37 CFR § 1.59 to expunge information. If the information is not considered by the examiner to be material, the information will be removed from the file.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3612. A second point of contact is Kim Huynh at (571) 272-4147.

Tod Swann, QAS
Technology Center 200

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ASHOK TANKHA
36 GREENLEIGH DRIVE
SEWELL, NJ 08080

MAILED

MAY 05 2010

OFFICE OF PETITIONS

In re Application of
Greg Melvin
Application No. 12/100,416
Filed: April 10, 2008
Attorney Docket No. Joneswine_01

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 25, 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 Ashok Tankha on behalf of all attorneys of record who are associated with this application. All attorneys/agents associated with this application have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The 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: GREG MELVIN
58 CHESTER WAY
SAN MATEO, CA 94402

UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/100,416 | 04/10/2008 | Greg Melvin | Joneswine_01 |

**CONFIRMATION NO. 6100**

**POWER OF ATTORNEY NOTICE**

Ashok Tankha
36 Greenleigh Drive
Sewell, NJ 08080

Date Mailed: 05/03/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 02/25/2010.

- 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.

/amwise/

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

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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** | : Takanori UEJIMA | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7653360 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/100,474 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/10/2008 | : 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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**WARD AND SMITH, P.A.**
**1001 COLLEGE COURT**
**P.O. BOX 867**
**NEW BERN, NC 28563-0867**

**COPY MAILED**

MAR 0 4 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Derick G. BEHRENDS, et al | : | |
| Application No. 12/100,481 | : | DECISION ON PETITION |
| Filed: April 10, 2008 | : | TO WITHDRAW |
| Attorney Docket No. ROC920080016US1 (IBM 25) | : | 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 23, 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 E. Eric Mills on behalf of the attorneys of record associated with Customer No. 74342.

The attorneys of record associated with Customer No. 74342 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 first signing inventor at the 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: DERICK G. BEHRENDS
6184 GRANITE DR. NW
ROCHESTER, MN 55901

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**TIM COOK**
**P.O. BOX 10107**
**LIBERTY, TX 77575**

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MAY 2 2 2008

OFFICE OF PETITIONS

In re Application of :
**CHASE**, Russell :
Application No. 12/100,496 : DECISION ON PETITION
Filed: April 10, 2008 : TO MAKE SPECIAL UNDER
Attorney Docket No. **CHAS.02** : 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed April 10, 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 copy of the inventor's driver's license as evidence that Russell Chase is over 65 years of age. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Michelle R. Eason at 571-272-4231.

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

This application is being referred to the Office of Initial Patent Examination for processing. This application will be accorded "special" status when pre-examination processing is done.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

PTO/SB/130 (03-08)
Approved for use through 04/30/2008. 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 | 12100562 | Confirmation Number | 6459 | Filing Date | 2008-04-10 |
| Attorney Docket Number (optional) | DUN-34981-A | Art Unit | | Examiner | |
| First Named Inventor | RIchard L. Dunn | | | | |
| Title of Invention | Low Viscosity Liquid Polymeric Delivery System | | | | |

**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 |
|---|---|---|---|
| Richard | L. | Dunn | |

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 | /kms/ | Date (YYYY-MM-DD) | 2008-04-11 |
| Name | Kristine M. Strodthoff | Registration Number | 34259 |

PTO/SB/130 (03-08)
Approved for use through 04/30/2008. 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.

# UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of
Richard L. Dunn

Application No. 12100562

Filed:

Attorney Docket No. DUN-34981-A

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

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1) ,filed 11-APR-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.

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United States Patent and Trademark Office
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GENERAL MOTORS LLC
LEGAL STAFF
MAIL CODE 482-C23-B21
P O BOX 300
DETROIT, MI 48265-3000

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Halim G. Santoso | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7561957 | : RECALCULATION of PATENT |
| **Issue Date** | : 07/14/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/100,580 | : OF WYETH |
| **Filed** | : 04/10/2008 | : |
| | | : |

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

Commissioner for Patents
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COPY MAILED

JUN 23 2008

OFFICE OF PETITIONS

CANTOR COLBURN, LLP
20 CHURCH STREET
22ND FLOOR
HARTFORD CT 06103

In re Application of
Scott D. Kennedy
Application No. 12/100,705
Filed: April 10, 2008
Attorney Docket No. RGP-0345

: DECISION GRANTING
: PETITION

This is a decision on the filing date petition filed May 29, 2008, under 37 CFR 1.57 requesting that the above referenced application be accorded a filing date of April 10, 2008. The petition is being treated under 37 CFR 1.53 (e)(2)[1]

The application was filed on April 10, 2008. However, on May 1, 2008 the Office of Initial Patent Examination mailed a Notice of Incomplete Application stating that the application had not been filed with drawings and thus, the application could not be accorded a filing date.

In response, the present petition was filed. Petitioner admits that the drawings were inadvertently omitted but argues that the instant application claimed priority to a prior filed application which contained the drawings.

Petitioner's arguments and evidence have been considered. However, it is controlling that a review of the application confirms that as filed, the application contained at least one method claim. MPEP 601.01(f) provides that:

> It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

Thus, pursuant to § 601.01(f), a drawing is not considered essential for a filing date. Thus, the application is entitled to a filing date without drawings present in the application.

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[1] Any request for review of a notification pursuant to paragraph (e)(1) of this section, or a notification that the original application papers lack a portion of the specification or drawing(s), must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f). In the absence of a timely (§ 1.181(f)) petition pursuant to this paragraph, the filing date of an application in which the applicant was notified of a filing error pursuant to paragraph (e)(1) of this section will be the date the filing error is corrected.

Accordingly, the Office should have mailed a Notice of Omitted Items and not a Notice of Incomplete Nonprovisional Application. As stated in MPEP 601.01(g), if an application is entitled to a filing date, the mailing of a Notice of Omitted Items will permit *inter alia*:

> If an application was filed on or after September 21, 2004, and contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application that was present on the filing date of the application, and the omitted portion of the drawing(s) was inadvertently omitted from the application and is completely contained in the prior-filed application, applicant may submit an amendment to include the inadvertently omitted portion of the drawing(s) pursuant to 37 CFR 1.57(a). The amendment should be submitted in response to the Office action and must comply with 37 CFR 1.57(a) and 37 CFR 1.121. See MPEP § 201.17.

No petition is required. The amendment to include the inadvertently omitted drawings will be considered by the examiner.

To the extent the instant petition requests a filing date of April 10, 2008 with no drawings present in the application, the petition is **GRANTED**.

Given the basis for granting this petition, the petition fee is being credit back to deposit account no. 06-1130.

The Office of Patent Application Processing (OPAP) has been advised of this decision. Pursuant to this decision, the application has been referred to OPAP for:

- correction of the filing date to April 10, 2008
- for indication in Office records, as appropriate, that "0" sheets of drawings were present on filing and
- for issuance of a filing receipt.

Entry of the amendment filed May 29, 2008 will be determined by the examiner.

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

Anthony Knight
Supervisory Petitions Examiner
Office of Petitions

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AUG 04 2009

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

| | | |
|---|---|---|
| In re application of | : | DECISION ON REQUEST TO |
| Takashi Shimizu | : | PARTICIPATE IN PATENT |
| Application No. 12/100,717 | : | PROSECUTION HIGHWAY |
| Filed: April 10, 2008 | : | PROGRAM AND PETITION |
| For: VEHICULAR POWER | : | TO MAKE SPECIAL UNDER |
| TRANSMITTING APPARATUS | : | 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 July 30, 2009, to make the above-identified application special.

The request and petition are **DISMSSED**.

A grantable request to participate in the PPH program and petition to make special require:

(1) The U.S. application must validly claim priority 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 because:

(3) all the claims in the U.S. application do not sufficiently correspond or have been amended to sufficiently correspond to the allowable/patentable claims in the JPO application;

Specifically, the JPO allowable/patentable claims recite a "motor-type" drive means. However, the corresponding U.S. claims only require a "drive unit". The U.S. claims need to recite a "motor-type drive unit".

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.

Response must submitted by EFS-Web using the document description "Petition to make special under Pat Pros Hwy".

Telephone inquires concerning this decision should be directed to Teri P. Luu, Quality Assurance Specialist, at 571-272-7045. All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

/Teri Luu/
Teri P. Luu
Quality Assurance Specialist
Technology Center 3600

tpl: 08/03/09

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AUG 25 2009

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

| | | |
|---|---|---|
| In re application of | : | DECISION ON REQUEST TO |
| Takashi Shimizu | : | PARTICIPATE IN PATENT |
| Application No. 12/100,717 | : | PROSECUTION HIGHWAY |
| Filed: April 10, 2008 | : | PROGRAM AND PETITION |
| For: VEHICULAR POWER | : | TO MAKE SPECIAL UNDER |
| TRANSMITTING APPARATUS | : | 37 CFR 1.102(d) |

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 August 13, 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 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).

light of the preliminary amendment filed currently with the instant request and petition, all claims in the U.S. application sufficiently correspond or have been amended to sufficiently correspond to the allowable/patentable claims in the JPO application. The request to participate in the PPH program and petition now comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquires concerning this decision should be directed to Teri P. Luu, Quality Assurance Specialist, at 571-272-7045.

All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

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

/Teri Luu/

Teri P. Luu
Quality Assurance Specialist
Technology Center 3600

tpl: 08/24/09

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/100,726 | 04/10/2008 | Eric C. Johnson | SKY1P001 | 6784 |

58766 7590 02/16/2010

Beyer Law Group LLP
P.O. BOX 1687
Cupertino, CA 95015-1687

| EXAMINER | |
|---|---|
| BARTON, JEFFREY THOMAS | |
| ART UNIT | PAPER NUMBER |
| 1795 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 02/16/2010 | 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):

USPTOmail@beyerlaw.com

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Beyer Law Group LLP
P.O. BOX 1687
Cupertino CA 95015-1687

FEB 16 2010

| | | |
|---|---|---|
| In re Application of | : | |
| Johnson et al. | : | DECISION ON PETITION |
| Application No. 12/100,726 | : | TO MAKE SPECIAL UNDER |
| Filed: 4/10/2008 | : | THE GREEN TECHNOLOGY |
| Attorney Docket No. **SKY1P001** | : | PILOT PROGRAM |

This is a decision on the petition under 37 CFR 1.102, filed 1/13/2010, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth 74 Federal Register Notice 64666 (December 8, 2009).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications and be filed prior to the date of the notice, December 8, 2009.

In order to qualify for special status, the following requirements must be met. 1) The application must be classified in one of the eligible US classifications listed in section VI of the notice. 2) The application must have no more than 3 independent claims and no more than 20 total claims. 3) The application must not contain any multiple dependent claims. 4) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 5) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 6) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 7) The petition to make special must be filed electronically. 8) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 9) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

As set forth at numeral 7 in the Requirements section of the Notice, the petition to make special must be accompanied by a request for early publication and the publication fee set forth in 37 CFR 1.18(d). Petitioner's deposit account has been charged the $300 early publication fee in accordance with this notice.

The instant petition complies with items 1 – 9 above. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquires concerning this decision should be directed to Tom Dunn at 571-272-1171.

The application is being forwarded to the Technology Center Art Unit 1795 for action on the merits commensurate with this decision.

/Tom Dunn/

Tom Dunn
Quality Assurance Specialist
Technology Center 1700

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JUN 22 2009

OFFICE OF PETITIONS

GIBBONS, PC
ONE GATEWAY CENTER
NEWARK, NJ 07102

In re Application of :
Kerrie P Waldis :
Application No. 12/100,759 : DECISION ON PETITION
Filed: April 10, 2008 : TO WITHDRAW
Attorney Docket No. 107570-59877 : 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 6, 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 Vincent E. McGeary on behalf of all attorneys of record who are associated with customer No. 26345. All attorneys/agents associated with the Customer Number 26345 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 is an outstanding Office action mailed April 20, 2009 that requires a reply from the applicant.

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: KERRIE P. WALDIS
28 ROCKLAND TERRACE
LUMBERTON, NJ 08048

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/100,759 | 04/10/2008 | Kerrie P. Waldis | 107570-59877 |

**CONFIRMATION NO. 6855**

**POWER OF ATTORNEY NOTICE**

26345
GIBBONS P.C.
ONE GATEWAY CENTER
NEWARK, NJ 07102

Date Mailed: 06/16/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 05/06/2009.

- 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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BLANK ROME LLP
WATERGATE
600 NEW HAMPSHIRE AVENUE, N.W.
WASHINGTON DC 20037

MAILED

JUL 16 2009

OFFICE OF PETITIONS

Applicant: Koivunen
Appl. No.: 12/100,788
Filing Date: April 10, 2008
Title: JOINT FOR REINFORCED CONCRETE PILE SECTIONS
Attorney Docket No.: 128574.0102
Pub. No.: 2008/0022545 A1
Pub. Date: January 22, 2009

This is a decision on the request for corrected of patent application publication under 37 CFR 1.221(b), received on February 19, 2009 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 is noted that applicant filed multiple copies of the translation of the provisional application into the above identified application, which were not required to be filed in this application. The rule (37 CFR 1.78) was amended to require that the translation be filed in the provisional application to prevent it from being improperly be scanned and coded in the nonprovisional application and published.

It would greatly benefit the Office if applicant did not provide copies of papers, which were previously submitted or a complete copy of the pre-grant publication, as it unnecessarily increases the cost to the Office. See 37 CFR 1.4(b).

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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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/100,801 | 04/10/2008 | Andrew David Baglino | 2635.010US1 | 6929 |

21186 7590 02/24/2010
SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

| EXAMINER | |
|---|---|
| BENSON, WALTER | |
| **ART UNIT** | **PAPER NUMBER** |
| 2837 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 02/24/2010 | 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):

uspto@slwip.com
request@slwip.com

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

| | | |
|---|---|---|
| In re Application of | : | |
| BAGLINO et al. | : | DECISION ON PETITION |
| Application No. 12/100,801 | : | TO MAKE SPECIAL UNDER |
| Filed: 10 April 2008 | : | THE GREEN TECHNOLOGY |
| Attorney Docket No. 2635.010US1 | : | PILOT PROGRAM |

This is a decision on the petition under 37 CFR 1.102, filed 23 December 2009, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth 74 Federal Register Notice 64666 (December 8, 2009).

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within ONE (1) MONTH OR THIRTY (30) DAYS from the mail date of this decision, whichever is longer. No extension of this time limit can be granted under 37 CFR 1.136(a) or (b). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications and be filed prior to the date of the notice, December 8, 2009.

In order to qualify for special status, the following requirements must be met. 1) The application must be classified in one of the eligible US classifications listed in section VI of the notice. 2) The application must have no more than 3 independent claims and no more than 20 total claims. 3) The application must not contain any multiple dependent claims. 4) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 5) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 6) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction

requirement is made by the examiner. 7) The petition to make special must be filed electronically. 8) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 9) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The petition lacks items 1 and 4 above.

In regard to item 1, petitioner should note that this application has been classified in USPC 318/432 which is not one of the eligible US classifications listed in section VI of the notice. Therefore, this application is not eligible for the Pilot Program. The classification limitations are purposefully made to be narrow for the Pilot Program; however, these may be expanded based upon the success of the Pilot Program. Petitioner may file a preliminary amendment that would cause this application to be classified elsewhere. However, while petitioner may suggest a classification (see, e.g., MPEP 708.02(a)(VII)(C)), the application will be assigned to the most appropriate classification based upon current U.S. classification guidelines. Furthermore, a petition for the Pilot Program should not be filed until and unless all of the requirements set forth in the Notice are met; i.e., a petition should not be filed for an application that is currently classified outside the eligible classifications set forth in the Notice.

In regard to item 4, petitioner should note that the instant petition fails to state the basis for the special status (i.e., whether the instant invention (1) materially enhances the quality of the environment or materially contributes to (2) development of renewable energy resources or energy conservation, or (3) greenhouse gas reduction) as required by sections II and III of the notice.

Any reconsideration of this decision should be submitted through the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen.

Telephone inquires concerning this decision should be directed to Lee W. Young at 571-272-4549.

The application is being forwarded to the Technology Center Art Unit 2837 for action on the merits commensurate with this decision.

Lee W. Young
Quality Assurance Specialist
Technology Center 2800

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CST

May 27, 2009

| | | |
|---|---|---|
| In re application of<br>Yuuki Tauchi et al<br>Serial No. 12/100,823<br>Filed: 10 April 2008<br>For: AG BASE ALLOY THIN FILM AND SPUTTERING TARGET FOR FORMING AG BASE ALLOY THIN FILM | :<br>:<br>:<br>:<br>:<br>:<br>: | 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) to make the above-identified application special filed March 29, 2009.

The request and petition are **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, note where the JPO 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 JPO application with similar claims and the JPO priority 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 to obtain a copy from 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), 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 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 claims(s) or
ii. if the allowable/patentable claim(s) are from "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 (i) or (ii) is available via the Dossier Access System (DAS), applicant may request the USPO obtain a copy from the DAS; however, if the USPTO is unable to obtain a copy of 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 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 JPO examiner in the JPO 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:

(3) All of 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).

Claim 42 of the present application specifies the Ag base alloy sputtering target for an optical information recording medium, the alloy comprising Ag, 0.05 to 4.5 atomic percent Bi, and impurities. Claim 1 in the translated JPO application, which appears to be the closest to claim 42 as noted in the claim correspondence table, specifies the Ag base alloy sputtering target having the same amount of Bi with the remainder being Ag and impurities. This excludes any other components even if part of the alloy because the "remainder" (i.e., that other than the Bi) is limited to Ag and impurities. Claim 42 places no limitation on additional, non-recited components.

Dependent claims 43-45 similarly do not individually correspond to a claim in the JPO application because the "remainder" of the components is limited in each claim (e.g., JPO claims 2 and 3), but claims 43-45 are not so limited.

Claim 46 specifies the Ag base alloy sputtering target for an optical information recording medium, the alloy comprising Ag, 0.005 to 0.40 atomic percent Sb, 0.1 to 2 atomic percent Nd and/or Y, and impurities. Claim 4 in the translated JPO application (see claim correspondence table) specifies the Ag base alloy sputtering target having the same amount of Sb, Nd, and Y, with the remainder being Ag and impurities. This excludes any other components even if part of the alloy because the "remainder" (i.e., that other than the Sb, Nd, and Y) is limited to Ag and impurities. Claim 46 places no limitation on additional, non-recited components.

Dependent claim 47 similarly does not correspond to a claim in the JPO application because the "remainder" of the components is limited in JPO claim 5, but claim 47 is not so limited.

(6) An IDS listing all the documents cited by the JPO examiner in the JPO office action and copies thereof except U.S. patents or U.S. patent application publications must be submitted.

Applicant is required to submit all the reference patent documents cited by the JPO examiner in the JPO office action. JP-A 2001-357559 cited in the JPO communication has not been cited on an IDS and no copy has been provided.

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 within the time period given, the application with await action in its regular turn.

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

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

August 3, 2009 CST

| | | |
|---|---|---|
| In re application of | : | DECISION ON REQUEST TO |
| Yuuki Tauchi et al | : | PARTICIPATE IN PATENT |
| Serial No. 12/100,823 | : | PROSECUTION HIGHWAY |
| Filed: 10 April 2008 | : | PROGRAM AND |
| For: AG BASE ALLOY THIN FILM AND SPUTTERING TARGET FOR FORMING AG BASE ALLOY THIN FILM | : | PETITION TO MAKE SPECIAL UNDER 37 CFR 1.102(d) |

This is a decision on the supplemental request to participate in the Patent Prosecution Highway (PPH) program filed June 29, 2009.

The request and petition are **GRANTED**.

It is noted that the initial request to participate in the Patent Prosecution Highway (PPH) program filed March 26, 2009 was dismissed on May 27, 2009 because the claims of the present application and the claims of the JPO application did not sufficiently correspond, and that all of the documents cited by the JPO examiner were not provided in the present application. However, a non-final office action was mailed in this application on June 29, 2009, the same day that applicant filed a timely response to the petition decision of May 27, 2009.

Accordingly, the office action of June 29, 2009 is vacated for consideration of the amendment and IDS provided in response to the initial petition decision dismissing the petition.

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, note where the JPO 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 JPO application with similar claims and the JPO priority 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 to obtain a copy from 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), 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 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 claims(s) or
      ii. if the allowable/patentable claim(s) are from "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 is available via the Dossier Access System (DAS), applicant may request the USPO obtain a copy from the DAS; however, if the USPTO is unable to obtain a copy of 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 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 JPO examiner in the JPO 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 comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

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

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NIXON PEABODY, LLP
401 9TH STREET, NW
SUITE 900
WASHINGTON, DC 20004-2128

**MAILED**

**JUL 22 2010**

**OFFICE OF PETITIONS**

In re Application of :
Yoshiharu Hirakata, et al. :
Application No.: 12/100,873 : ON PETITION
Filed: April 10, 2008 :
Attorney Docket No.: 740756-3186 :

This is a decision on the petition, filed July 21, 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 June 8, 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 2814 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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SHUMAKER & SIEFFERT, P. A.
1625 RADIO DRIVE
SUITE 300
WOODBURY, MN 55125

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Lori E. Lucke | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7611478 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/03/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/100,876 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/10/2008 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **18** 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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MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO IL 60606

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DEC 0 5 2008

OFFICE OF PETITIONS

In re Application of :
Wallace A. Pratt Jr. et al. :
Application No. 12/101,005 : DECISION ACCORDING STATUS
Filed: April 10, 2008 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 31244/42873 :

This is in response to the petition filed November 3, 2008 under 37 CFR 1.47(a).

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

The above-identified application was filed on April 10, 2008, without an oath or declaration. On April 29, 2008, a "Notice To File Missing Parts of Application" was mailed which set a two month period for reply.

In response, the requirements of the Notice, the instant petition under 37 CFR 1.47(a), a four month extension of time request, and an oath or declaration signed by all joint inventors except Yuri Zats was filed. The petition argues that joint inventor Zats has failed to return executed copies of the oath or declaration and thus by his actions, to cooperate with the filing of the instant application.

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

The petition bears proof that the application papers were forwarded to joint inventor Zats and that to date, he has not returned an executed copy of the oath or declaration.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). In view thereof, this application is hereby accorded Rule 1.47(a) status.

Thus, as provided in Rule 1.47c, this Office will forward notice of this application's filing

to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

This matter is being referred to the Office of Patent Application Processing for further pre-examination processing.

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO IL 60606

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DEC 16 2008

In re Application of
Pratt, et al.
Application No. 12/101,021
Filed: April 10, 2008
Attorney Docket No. 31244/42875

: DECISION NOTING JOINDER OF
: INVENTOR AND PETITION
: UNDER 37 CFR 1.47(a)

This decision is in response to the petition under 37 CFR 1.47(a) filed November 3, 2008 and supplemented November 6, 2008. The supplemental communication included a declaration signed by the previously non-signing inventor, Y. Zats, in compliance with 37 CFR 1.63.

In view thereof, the petition under 37 CFR 1.47(a) is **DISMISSED AS MOOT**.

In view of the joinder of the inventor, further consideration under § 1.47(a) is not necessary. This application does not have any Rule 1.47 status and no such status should appear on the record for this file. This application need not be returned to this Office for any further consideration under 37 CFR 1.47(a).

This application is being referred to the Office of Patent Application Processing for further action.

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

Alesia M. Brown
Petitions Attorney
Office of Petitions

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TRASKBRITT, P.C.
P.O. BOX 2550
SALT LAKE CITY, UT 84110

Mail Date: 05/03/2010

| | | |
|---|---|---|
| **Applicant** | : Glenn N. Waterman | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7650657 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 12/101,070 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/10/2008 | : 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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MARTINE PENILLA & GENCARELLA, LLP
710 LAKEWAY DRIVE
SUITE 200
SUNNYVALE, CA 94085

Mail Date: 05/17/2010

| | | |
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| **Applicant** | : Przemek Guzy | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7657857 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 12/101,088 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/10/2008 | : 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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**VEDDER PRICE, PC**
**875 15TH STREET, NW**
**SUITE 725**
**WASHINGTON DC 20005**

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**JAN 27 2010**

| | | |
|---|---|---|
| In re Application of | : | |
| Earhart et al. | : | DECISION ON PETITION |
| Application No. 12/101,186 | : | TO WITHDRAW |
| Filed: April 11, 2008 | : | FROM RECORD |
| Attorney Docket No. 00765.02.0008 | : | |

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 10, 2008.

The request is **NOT APPROVED as involving a moot issue.**

The request to withdraw indicated that the petitioner, Steven B. Kelber, was withdrawing due to being suspended from practice before the USPTO for sixty (60) days pursuant to the provisions of 37 CFR 1.158. However, on February 27, 2009, a Power of Attorney was received, along with a copy of the granted Decision on Petition for Reinstatement for Steven B. Kelber.

In view of the letter from the Office of Enrollment and Discipline, the Request to Withdraw is moot.

The Power of Attorney received on February 27, 2009 asks to recognize Steven B. Kelber as an attorney of record in the instant application. However, the attorneys associated with the instant application were appointed via Customer Number. As set forth in MPEP 403(I), the addition or deletion of a practitioner from the list of persons associated with a Customer Number should be done by way of a Request for Customer Number Data Change (PTO/SB/124).

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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NOV 16 2009

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

| | | |
|---|---|---|
| In re application of<br>Hiroya Fujiwara et al.<br>Application No. 12/101,217<br>Filed: April 11, 2008<br>For: CONTROL APPARATUS AND METHOD FOR CONTINUOUSLY VARIABLE TRANSMISSION | :<br>:<br>:<br>:<br>:<br>: | 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 November 12, 2009, 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 the Office action from the JPO application just prior to the "Decision to Grant a Patent" (e.g., the latest "Notification of Reasons for Refusal") from each of the JPO application(s) containing the allowable/patentable claims that are the basis for the request 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 fails to comply with requirement 3 above.

Specifically, the claims correspondence table only address claims 15-19. The PPH program guidelines require that all claims need to be addressed in the claims correspondence table. Accordingly, the PPH petition and request fail to meet the guidelines of the PPH program.

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.

Response must submitted by EFS-Web using the document description "Petition to make special under Pat Pros Hwy".

Telephone inquires concerning this decision should be directed to Teri P. Luu at 571-272-7045. All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

/Teri P. Luu/

Teri P. Luu
Quality Assurance Specialist
Technology Center 3600

tpl: 11/13/09

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DEC 15 2009

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

| | | |
|---|---|---|
| In re application of<br>Hiroya Fujiwara et al.<br>Application No. 12/101,217<br>Filed: April 11, 2008<br>For: CONTROL APPARATUS AND METHOD FOR CONTINUOUSLY VARIABLE TRANSMISSION | :<br>:<br>:<br>:<br>:<br>: | 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 renewed request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d), filed December 8, 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 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 the Office action from the JPO application just prior to the "Decision to Grant a Patent" (e.g., the latest "Notification of Reasons for Refusal") from each of the JPO application(s) containing the allowable/patentable claims that are the basis for the request 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).

Applicant has submitted a complete claims correspondence table. The renewed request and petition now complies with the above requirements. Accordingly, the above identified application has been accorded "special" status.

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

Telephone inquires concerning this decision should be directed to Teri P. Luu at 571-272-7045. All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

/Teri P. Luu/
Teri P. Luu
Quality Assurance Specialist
Technology Center 3600

tpl: 12/11/09

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**WARD AND SMITH, P.A.**
**1001 College Court**
**P.O. Box 867**
**New Bern, NC 28563-0867**

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APR 0 3 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Jinmei Shen, et al. | : | |
| Application No. 12/101,225 | : | DECISION ON PETITION |
| Filed: April 11, 2008 | : | TO WITHDRAW |
| Attorney Docket No. 1342-0021 | : | 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 23, 2009.

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

A review of the file record indicates that the power of attorney to Ward and Smith, P.A. has been revoked by the assignee of the patent application on March 24, 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 Terri Williams at 571-272-2991.

Terri Williams
Petitions Examiner
Office of Petitions

cc: **IBM-Rochester**
**c/o Toler Law Group**
**8500 Bluffstone Cove, Suite A201**
**Austin, TX 78759**

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Paper No.

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JAN 0 8 2009

OFFICE OF PETITIONS

PRAXAIR, INC.
LAW DEPARTMENT - M1 557
39 OLD RIDGEBURY ROAD
DANBURY CT 06810-5113

| | | |
|---|---|---|
| In re Application of | : | |
| Randy D. Golding, David Rabb, | : | |
| and Ken Huey | : | |
| Application No. 12/101,272 | : | DECISION ON PETITION |
| Filed: April 11, 2008 | : | PURSUANT TO 37 C.F.R. |
| Attorney Docket Number: 21698 | : | § 1.47(A) |
| Title: METHOD AND APPARATUS FOR | : | |
| LEAK DETECTION | : | |

This is in response to the petition pursuant to 37 C.F.R. § 1.47(a), filed November 21, 2008.

This petition pursuant to 37 C.F.R. § 1.47(a) is **GRANTED**.

On April 11, 2008, the application was filed, identifying Randy D. Golding, David Rabb, and Ken Huey as joint inventors. The application was not deposited with an executed declaration. On July 25, 2008, a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (notice) was mailed, requiring a fully executed oath or declaration and the surcharge associated with the late submission of the same. The notice set a two-month period for response.

A grantable petition pursuant to 37 C.F.R. § 1.47(a) requires:

(1) the petition fee of $200;
(2) a surcharge of either $65 or $130 if the

petition is not filed at the time of filing the application, as set forth in 37 C.F.R. § 1.16(e);

(3) a statement of the last known address of the non-signing inventor;

(4) either

a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or

b) proof that the non-signing inventor cannot be found or reached after diligent effort, and;

(5) a declaration which complies with 37 C.F.R. § 1.63.

With this petition, Petitioner has submitted the petition fee,[1] an acceptable declaration that has been executed by Mr. Golding along with the fee that is associated with the late submission of the same, the last known addresses of the two non-signing inventors, and proof that each was provided with a complete copy of the application and that executed copies of the declaration have not been obtained. Petitioner has further included a two-month extension of time so as to make this response timely.

Each of the requirements of 37 C.F.R. § 1.47(a) has been satisfied.

This application is hereby accorded Rule 1.47(a) status. As provided in Rule 1.47, this Office will forward notice of this application's filing to the non-signing inventor at the addresses given in the declaration. Notice of the filing of this application will also be published in the Official Gazette.

The Office of Patent Application Processing (OPAP) will be notified of this decision so that the application may receive further processing.

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1 A portion of the petition fee has been included. The remaining $70 will be charged to Petitioner's Deposit Account, as authorized in the petition.

The general phone number for OPAP is 571-272-4000. Telephone inquiries **regarding this decision** should be directed to the undersigned at (571) 272-3225.[2]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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The Law Firm of Andrea Hence Evans, LLC
14625 Baltimore Ave., #853
Laurel, MD 20707

MAY 22 2008

In re Application of:
Paul Samaniego et al.
Serial No.: 12/101,284
Filed: April 11, 2008
Docket Number: POU920070374US1
Title: COLD PLATE STRUCTURE AND METHOD FOR COOLING PLANAR ARRAYS OF PROCESSORS DURING ASSEMBLY AND TEST ALLOWING FOR SINGLE MODULE SITE REWORKABILITY

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.2

This is a decision on the petition filed on April 11, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner; and

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation; and

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims is patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists; and

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions set forth in items I. 1-4 and II. 1-4 and 6 are considered to have been met. However, the petition fails to comply with the requirements for a preexamination search as discussed in item II. 5 above. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirements for a preexamination search, as stated in the Federal Register of June 26, 2006 (71 Fed. Reg. 36323), "applicant must provide a statement that a preexamination search was conducted, including an identification of the field of search by United States class and subclass . . . and for database searches . . ." As stated in the Guidelines for Applicants Under the New Accelerated Examination Procedure (hereinafter the Guidelines), "(a) search submitted in support of a petition for accelerated examination will be considered sufficient . . . if the search includes: 1. A classified search of the US patents and published patent applications in the Class and subclass where the claimed invention is most likely to be classified in the current United States Patent Classification system (USPC)." The Guidelines then goes on to add that a sufficient search also includes a text search.

To summarize the Guidelines, a sufficient search includes a classified search and a text search. The Federal Register of June 26, 2006, specifically states that preexamination search must include an identification of the field of search by United States class and subclass (i.e., a classified search) and then indicates the requirements of a text/database search. In other words, a sufficient preexamination search in most cases must include both a classified search and a text search.

The statement of preexamination search in the present application indicates that Classes/Subclasses Searched were 165/all and 361/all. While it is possible that applicant performed a classified search of 165/all and 361/all (i.e., reviewing every patent in all the subclasses of two different classes), it is more likely that such a statement indicates that just a text search was performed which included all the patents of both classes. If applicant did perform a classified search of all the subclasses of classes 165 and 361, applicant should so state. However, if not, a sufficient search for the present application would include a classified search of at least 361/716; 361/715 and 165/104.33.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer,

from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petition is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to the undersigned at (571) 272-1638.

Edward Westin

Edward Westin, Quality Assurance Specialist
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/101,284 | 04/11/2008 | Paul Samaniego | POU920070374US1 | 7905 |

77062 7590 08/28/2008

The Law Firm of Andrea Hence Evans, LLC
14625 Baltimore Ave., #853
Laurel, MD 20707

| EXAMINER |
|---|
| HOFFBERG, ROBERT JOSEPH |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2835 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/28/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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The Law Firm of Andrea Hence Evans, LLC
14625 Baltimore Ave., #853
Laurel, MD 20707

In re Application of:
Paul Samaniego et al.
Serial No.: 12/101,284
Filed: April 11, 2008
Docket Number: POU920070374US1
Title: COLD PLATE STRUCTURE AND METHOD FOR COOLING PLANAR ARRAYS OF PROCESSORS DURING ASSMEBLY AND TEST ALLOWING FOR SINGLE MODULE SITE REWORKABILITY

DECISION ON RENEWED PETITION TO MAKE SPECIAL UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.2

This is a decision on the renewed petition filed on June 17, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. §1.102(d).

In a telephone conversation with the petitioner, Andrea H. Evans, on August 21, 2008, it was agreed that (1) a classified search means that all documents within the class/subclass were reviewed; (2) a text search means a computerized key word search; and (3) a database search as used in the Federal Register on June 26, 2006 (71 Fed. Reg. 36323) is referring to a text search. The petitioner confirmed that a classified search was performed of all the subclasses in both class 165 and class 361.

The renewed petition to make the application special is GRANTED.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election

without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 C.F.R. §1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 C.F.R. §1.97 and §1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 C.F.R. §1.181, §1.182 or §1.183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve-month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to the undersigned at (571) 272-1638.

Edward Westin

Edward Westin, Quality Assurance Specialist
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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WHIRLPOOL PATENTS COMPANY - MD 0750
500 RENAISSANCE DRIVE - SUITE 102
ST. JOSEPH, MI 49085

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Chad T. VanderRoest | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7594513 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/29/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/101,302 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/11/2008 | : 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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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/101,338 | 04/11/2008 | Tomofumi Mishima | PRM0206US | 8030 |

23413 7590 03/10/2010

CANTOR COLBURN, LLP
20 Church Street
22nd Floor
Hartford, CT 06103

| EXAMINER |
|---|
| LEYKIN, RITA |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2837 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 03/10/2010 | 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):

usptopatentmail@cantorcolburn.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**CANTOR COLBURN, LLP**
**20 Church Street**
**22nd Floor**
**Hartford CT 06103**

**In re Application of**
**Tomofumi HISHIMA**
**Application No.: 12/101,338**
**Filed: 11 April 2008**
**Attorney Docket No.: PRM0206US**
**For: MOTOR DRIVE DEVICE WITH LOCK PROTECTION FUNCTION**

**: DECISION ON REQUEST TO**
**: PARTICIPATE IN THE 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 09 February 2010, to make the above-identified application special.

The request and petition are **GRANTED**.

**Discussion**

A grantable request to participate in the PPH pilot 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;

2. Applicant must submit a copy of:
   a. The allowable/patentable claim(s) from the JPO application(s);
   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;
   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 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.

Inquiries concerning this decision should be directed to Lee W. Young at 571-272-4549.

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.

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

Lee W. Young
TQAS
Technology Center 2800

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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FISH & ASSOCIATES, PC
ROBERT D. FISH
2603 MAIN STREET
SUITE 1000
IRVINE, CA 92614-6232

COPY MAILED

DEC 14 2009

OFFICE OF PETITIONS

In re Application of :
Barry Edward Rothenberg :
Application No. 12/101,367 : DECISION ON PETITION
Filed: April 11, 2008 : TO WITHDRAW
Attorney Docket No. 101193.0003US9 : 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 9, 2009.

The request is **APPROVED**.

The request was signed by Robert D. Fish on behalf of the practitioners of record associated with Customer Number 24392.

Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to inventor Barry Edward Rothenberg at the address indicated below.

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

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Barry Edward Rothenberg
P.O. Box 977
Del Mar, CA 92014-0977

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/101,367 | 04/11/2008 | Barry Edward Rothenberg | 101193.0003US9 |

**CONFIRMATION NO. 8079**

Barry Edward Rothenberg
P.O. Box 977
Del Mar, CA 92014-0977

**POA ACCEPTANCE LETTER**

*OC00000003914973 7*

Date Mailed: 12/14/2009

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/09/2009.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

/idingle/

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

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United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/101,367 | 04/11/2008 | Barry Edward Rothenberg | 101193.0003US9 |

**CONFIRMATION NO. 8079**

**POWER OF ATTORNEY NOTICE**

24392
FISH & ASSOCIATES, PC
ROBERT D. FISH
2603 Main Street
Suite 1000
Irvine, CA 92614-6232

*OC000000039149669*

Date Mailed: 12/14/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/09/2009.

- 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.

/idingle/

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/101,402 | 04/11/2008 | Donald Gary Eichler | EIC-P2008-001 | 8161 |

37753 7590 06/29/2010

MARTIN A. WEEKS
1909 ALADDIN
NORMAN, OK 73072

| EXAMINER | |
|---|---|
| HEPPERLE, STEPHEN M | |
| ART UNIT | PAPER NUMBER |
| 3753 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/29/2010 | 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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MARTIN A. WEEKS
1909 ALADDIN
NORMAN OK 73072

| | | |
|---|---|---|
| In re Application of | : | |
| EICHLER, DONALD GARY | : | DECISION ON PETITION |
| Application No. 12/101402 | : | TO MAKE SPECIAL UNDER |
| Filed: Apr. 11, 2008 | : | THE GREEN TECHNOLOGY |
| Attorney Docket No. EIC-P2008-001 | : | PILOT PROGRAM |

This is a decision on the petition under 37 CFR 1.102, filed June 16, 2010, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth in 74 Federal Register Notice 64666 (December 8, 2009) and amended by 75 Federal Register Notice 28554 (May 21, 2010).

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within ONE (1) MONTH OR THIRTY (30) DAYS from the mail date of this decision, whichever is longer. No extension of this time limit can be granted under 37 CFR 1.136(a) or (b). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications and be filed prior to the date of the notice, December 8, 2009.

In order to qualify for special status, the following requirements must be met. 1) The application must have no more than 3 independent claims and no more than 20 total claims. 2) The application must not contain any multiple dependent claims. 3) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 4) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 5) A statement that applicant will agree to

make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 6) The petition to make special must be filed electronically. 7) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 8) The petition must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The petition lacks items 4 and 8.

In regard to item 4, petitioner should note that the instant petition includes a statement identifying the basis for the special status (i.e., whether the instant invention (1) materially enhances the quality of the environment or materially contributes to (2) development of renewable energy resources or energy conservation, or (3) greenhouse gas reduction) as required by sections II and III of the notice. However, as stated in the notice, applicant must also provide a statement pertaining to the materiality standard if the application disclosure is not clear on its face as to the materiality of the basis for the special status of the invention. This petition lacks such a statement and it is not agreed that the application on its face meets that materiality standard. In the petition, the applicant states that claimed would reduce an explosion hazard from a build-up of natural gas vapors; and control the amount of gas flowing to an appliance. The valve results in a substantial reduction of the use of natural gas. This is not sufficient to establish the claimed invention is based o green technology. The applicant fails to explain why and how the claimed cartridge insert valve will materially enhance the quality of the environment or materially contributes to development of renewable energy resources or energy conservation, or greenhouse gas reduction.

In regard to item 8, petitioner should note that since no request in compliance with 37 CFR 1.219 has been made for the early publication of the present application and the publication fee as set forth in 37 CFR 1.18(d) has not been received, the petition is dismissed.

Any reconsideration of this decision should be submitted through the USPTO electronic filing system, EFS-Web, and selecting the document description of "Petition for Green Tech Pilot" on the EFS-Web screen.

Telephone inquiries concerning this decision should be directed to Henry C. Yuen at 571-272-4856.

The application is being forwarded to the Technology Center Art Unit 3753 for action in its regular turn.

/Henry C. Yuen/

Henry C. Yuen
Quality Assurance Specialist
Technology Center 3700

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OFFICE OF PETITIONS

**MCCARTER & ENGLISH, LLP NEWARK**
**FOUR GATEWAY CENTER.**
**100 MULBERRY STREET**
**NEWARK, NJ 07102**

In re Application of :
**Christopher L. GROPP, et al.** :
Application No. 12/101,408 : DECISION ON PETITION TO
Filed: April 11, 2008 : WITHDRAW FROM RECORD
Attorney Docket No. **114777-00004** :

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 7, 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 Mark E. Nikolsky 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 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: **CHRISTOPHER L. GROPP**
**65 IVY ROAD**
**WILMINGTON, DE 19806**

cc: **JAMES MOWBRAY**
**67 IVY ROAD**
**WILMINGTON, DE 19806**

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**CARLSON, GASKEY & OLDS/PRATT & WHITNEY**
**400 WEST MAPLE ROAD**
**SUITE 350**
**BIRMINGHAM, MI 48009**

**COPY MAILED**

MAY 2 2 2008

**OFFICE OF PETITIONS**

In re Application of :
**JOSLIN**, Frederick :
Application No. 12/101,478 : DECISION ON PETITION
Filed: April 11, 2008 : TO MAKE SPECIAL UNDER
Attorney Docket No. **PA-0005440-U** : 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed April 11, 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 attesting that Frederick Joslin is over 65 years of age. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Michelle R. Eason at 571-272-4231.

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

This application is being referred to the Office of Initial Patent Examination for processing. This application will be accorded "special" status when pre-examination processing is done.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

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CANTOR COLBURN LLP-IBM YORKTOWN
20 Church Street
22nd Floor
Hartford CT 06103

JUN 26 2008

| | | |
|---|---|---|
| In re Application of: Bergman, Lawrence, et al. | : | |
| Application No.: 12/101,483 | : | DECISION ON PETITION TO |
| Filed: April 11, 2008 | : | MAKE SPECIAL FOR NEW |
| Title: METHOD, SYSTEM AND COMPUTER | : | APPLICATION UNDER 37 |
| PROGRAM FOR IDENTIFYING AND REUSING | : | C.F.R. § 1.102 & M.P.E.P. § |
| COMPONENT AGGREGATES | : | 708.02 |

This is a decision on the petition filed on April 11, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 U.S.C. 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 U.S.C. 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 U.S.C. 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 U.S.C. 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 U.S.C. 103(c).

## REVIEW OF FACTS

The conditions I: 1-4, II: 1-5, 5.1, 5.3, 6, 6.1, 6.3 and 6.6 above are considered to have been met. However, the petition fails to comply with conditions II: 5.2, 6.2, 6.4 and 6.5 above. Therefore,

the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

**Discussion**

When referring to "the petition" herein below, the received papers under consideration include the four page PTO/SB/28 form "Petition to Make Special Under Accelerated Examination Program", the "pre-examination search document" including pages 1-4; the "accelerated examination support document" comprising pages 1-9, and an Information Disclosure Statement.

Regarding the requirements of section II element 5.2 outlined above, it appears the search outlined in the petition omitted a critical search area by not searching in class 717 subclasses 100, 102-104, 106, 121-123, 142, 143, 162, 164-167 and class 719 subclasses 311, 328, 330-332. Applicant should also run the following term(s) and logic search:

mashup
aggregator
(composite adj (component or module or code or segement))
(combine or compound or integrate or aggregate)
librar$4 near3 (aggregat$4 or integrat$4 or build$4 or creat$4 or produc$4 or generat$4)
(compar$4 near3 ((component or service or module))
((identif$4 or determin$4 or generat$4 or produc$4) near3 (similar or same or comparable or like or possible) near3 (component or service or module)))
(reusable near3 (component or service or module)
(reusable near3 (component or service or module)) with librar$4
((scor$4 or normal$6 or rank$4) near3 (component or service or module or code or segment or function))
(similarity or similar or normal or comparison) near3 (metric or measure or value or pattern or usage)
((scor$4 or normal$6 or rank$4) near3 ((module or application or service or component))).
(similarity or similar or normal or comparison) near3 (usage adj pattern)
(component or service) near3 (usage adj (pattern or metric))
((build$4 or generat$4 or compound$4 or compil$4 or aggregat$4 or integrat$4 or composit$4) near3(componet or module or code or service))
((scor$4 or normal$6 or rank$4) near3 ((application or service or component)) near3 (usage adj (metric or pattern)))
((build$4 or generat$4 or compound$4 or compil$4 or aggregat$4 or integrat$4 or composit$4) near3(componet or module or code or service)) with librar$4

The above phrases should be combined or adjusted for search NPL, IEEE, and ACM databases.

Regarding the requirements of section II element 6.2 outlined above, the petition fails to identify all of the limitations in the application claims that are disclosed in each of the reference(s) and where the limitation is disclosed in each of the cited reference. As stated in the policy published in the Federal Register on June 26, 2006 (71 Fed. Reg. 36323), for each reference cited, the

examination support document must include an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference. The policy statement does not caveat "the independent claims", nor does it allow for grouping and general discussions. A grantable petition must delineate every limitation of every claim and identify where the equivalent limitation is disclosed in each piece of prior art cited on the IDS. As is published on www.uspto.gov/web/patents/accelerated/ in "Guidelines for Applicants under the new accelerated examination procedures"):

> *For each reference cited, the accelerated examination support document must include an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference. Applicants should specify where in each of the cited references the particular claim limitations are found. This process is intended to be analogous to the analysis an examiner uses when locating a relevant prior art reference and then determining whether the reference contains the claimed limitation. For each claimed limitation, the examiner would consider the disclosure of the reference and all reasonable portions in the reference where the limitation is shown. When preparing an Office Action, the examiner would correlate the limitation to the portion of reference which best characterizes the limitation. This part of the AESD is not intended to be an exhaustive listing of every conceivable subjective interpretation of how a claim limitation may read on the reference. Applicants should point out what are considered to be the relevant representations of the limitation in the reference. A limitation may be found in more than one portion of the reference and should be pointed out, yet the intention is not to have applicants point out every conceivable interpretation. The USPTO will adopt a rule of reason when evaluating this portion of the AESD. Unless the representation is so deficient that it would materially effect examination of the application (e.g., numerous instances where the limitations are not shown where applicant states they are), the representation will be deemed to be sufficient for this part of the AESD.*

Petitioner's submission is not specific enough. Petitioner points out some limitations of some of the claims and provides direction to areas of the prior art where the corresponding limitation may be found. Petitioner does not address each limitation and where it is (or state that it is not) found in each one of the most closely related prior art, in other words the mapping lacks specificity. The requirement of section II element 6.2 can be satisfied by listing verbatim ("copy and paste") all the presently filed claims (i.e., the claims of the instant application) and by indicating where each limitation of each one of said presently filed claims is taught (or is not taught) in each one of the cited most closely related references, by specifically indicating the element number and/or the relevant page/paragraph and line number(s); or by indicating "(not disclosed)" where appropriate - in order to ensure that no limitation was left out inadvertently. This one-to-one mapping should be performed individually, with regard to each one of the most closely related prior art that has been cited, one reference at a time. Applicant's attention is drawn to the fact that the requirement of this element calls for a straight mapping of each single limitation unto the prior art. This is not the place to make patentability arguments by bundling together multiple limitations and concluding that the combination is not disclosed. Patentability arguments should be made only in response to the requirement of section II element 6.3.

Regarding the requirements of section II element 6.4 outlined above, the petition fails to identify a concise statement of the utility of the invention as defined in the independent claim. A general statement directed to the overall concept of the invention is not specifically relating the utility to each of the independent claims as is required by the policy. Petitioner should reference the independent claim language specifically when discussing the utility of the invention.

Regarding the requirements of section II element 6.5 outlined above, the requirements of this section are not met because lack of specificity. A grantable petition requires petitioner to provide a showing of where each limitation of the claims finds support under 35 U.S.C. 112, first paragraph, in the written description of the specification. The instant petition only identifies full paragraphs with respect to claim numbers as opposed to the disclosure of the required claim limitations, addressed individually for each limitation in each claim. The requirement of section II element 6.5 can be satisfied by listing verbatim all the presently filed claims (by "copy and paste") and by indicating where the instant application teaches each limitation in each one of said presently filed claims, by indicating the element number and/or the relevant page and line numbers. Applicant's attention is also drawn to the requirements relevant under 35 U.S.C 112, 6th paragraph, listed above. Should this requirement not apply to the present application, Applicant should make a statement in this regard.

DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address all of the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Ehud Gartenberg, TC 3700 Special Programs Examiner, at (571) 272-4828. In his absence, an inquiry can be directed to J. Harrison, Special Program Examiner, at 571 272-4449.

Ehud Gartenberg
Special Programs Examiner
Technology Center 3700

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20 Church Street
22nd Floor
Hartford CT 06103

SEP 15 2008

In re Application of: BERGMAN, LAWRENCE et al.
Application No.: 12/101,483
Filed: April 11, 2008
Title: METHOD, SYSTEM AND COMPUTER PROGRAM FOR IDENTIFYING AND REUSING COMPONENT AGGREGATES

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the renewed petition filed on July 25, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is GRANTED.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Ehud Gartenberg, TC 3700 Special Program Examiner, at (571) 272-4828. In his absence, an inquiry can be directed to J. Harrison, Special Program Examiner, at (571) 272-4449.

Ehud Gartenberg

Ehud Gartenberg, Special Programs Examiner
Technology Center 3700

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20 Church Street
22nd Floor
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JUN 27 2008

In re Application of: Bergman, Lawrence, et al.
Application No.: 12/101,493
Filed: April 11, 2008
Title: METHOD, SYSTEM AND COMPUTER PROGRAM PRODUCT FOR RECOMMENDING COMPONENTS BASED ON COMMON USAGE PATTERNS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 11, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 U.S.C. 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 U.S.C. 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 U.S.C. 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 U.S.C. 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 U.S.C. 103(c).

REVIEW OF FACTS

The conditions I: 1-4, II: 1-5, 5.1, 5.3, 6, 6.1, 6.3 and 6.6 above are considered to have been met. However, the petition fails to comply with conditions II: 5.2, 6.2, 6.4 and 6.5 above. Therefore,

the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

**Discussion**

When referring to "the petition" herein below, the received papers under consideration include the four page PTO/SB/28 form "Petition to Make Special Under Accelerated Examination Program", the "pre-examination search document" including pages 1-4; the "accelerated examination support document" comprising pages 1-8, and an Information Disclosure Statement.

Regarding the requirements of section II element 5.2 outlined above, it appears the search outlined in the petition omitted a critical search area by not searching in class 717 subclasses 100, 102-104, 106, 108, 110-111, 121-123, 142-143, 162-167, class 709 subclass 202, and class 719 subclasses 311, 328, 330-332. In addition, the following terms search and logic in NPL, IEEE, and ACM should be performed:

mashup
aggregator
(composite adj component)
(composite adj (web adj service)
(composite adj (web adj application))
(combine or compound or integrate or aggregate)
(integrat$4 adj (web adj service))
(integrat$4 adj (web adj application))
(compar$4 near3 (web adj (component or service))
((identif$4 or determin$4 or generat$4 or produc$4) near3 (similar or same or comparable or like or possible) near3 (web adj (component or service)))
(reusable near3 (web adj (component or service)))
((scor$4 or normal$6 or rank$4) near3 (component or service or module or code or segment or function))
(similarity or similar or normal or comparison) near3 (metric or measure or value or pattern or usage)
((scor$4 or normal$6 or rank$4) near3 (web adj (application or service or component)))
(similarity or similar or normal or comparison) near3 (usage adj pattern)
(component or service or (web adj application)) near3 (usage adj (pattern or metric))

The above phrases should be combined or adjusted for search. Search both limiting to web applications and not limited to web applications.

Regarding the requirements of section II element 6.2 outlined above, the petition fails to identify all of the limitations in the application claims that are disclosed in each of the reference(s) and where the limitation is disclosed in each of the cited reference. As stated in the policy published in the Federal Register on June 26, 2006 (71 Fed. Reg. 36323), for each reference cited, the examination support document must include an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference. The policy statement does not caveat "the independent claims", nor does it allow for grouping and general discussions. A grantable petition must delineate every limitation of every

claim and identify where the equivalent limitation is disclosed in each piece of prior art cited on the IDS. As is published on www.uspto.gov/web/patents/accelerated/ in "Guidelines for Applicants under the new accelerated examination procedures"):

> *For each reference cited, the accelerated examination support document must include an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference. Applicants should specify where in each of the cited references the particular claim limitations are found. This process is intended to be analogous to the analysis an examiner uses when locating a relevant prior art reference and then determining whether the reference contains the claimed limitation. For each claimed limitation, the examiner would consider the disclosure of the reference and all reasonable portions in the reference where the limitation is shown. When preparing an Office Action, the examiner would correlate the limitation to the portion of reference which best characterizes the limitation. This part of the AESD is not intended to be an exhaustive listing of every conceivable subjective interpretation of how a claim limitation may read on the reference. Applicants should point out what are considered to be the relevant representations of the limitation in the reference. A limitation may be found in more than one portion of the reference and should be pointed out, yet the intention is not to have applicants point out every conceivable interpretation. The USPTO will adopt a rule of reason when evaluating this portion of the AESD. Unless the representation is so deficient that it would materially effect examination of the application (e.g., numerous instances where the limitations are not shown where applicant states they are), the representation will be deemed to be sufficient for this part of the AESD.*

Petitioner's submission is not specific enough. Petitioner points out some limitations of some of the claims and provides direction to areas of the prior art where the corresponding limitation may be found. Petitioner does not address each limitation and where it is (or state that it is not) found in each one of the most closely related prior art. The requirement of section II element 6.2 can be satisfied by listing verbatim ("copy and paste") all the presently filed claims (i.e., the claims of the instant application) and by indicating where each limitation of each one of said presently filed claims is taught (or is not taught) in each one of the cited most closely related references, by specifically indicating the element number and/or the relevant page/paragraph and line number(s), or by indicating "(not disclosed)" where appropriate - in order to ensure that no limitation was left out inadvertently. This one-to-one mapping should be performed individually, with regard to each one of the most closely related prior art that has been cited, one reference at a time. Applicant's attention is drawn to the fact that the requirement of this element calls for a straight mapping of each single limitation unto the prior art. This is not the place to make patentability arguments by bundling together multiple limitations and concluding that the combination is not disclosed. Patentability arguments should be made only in response to the requirement of section II element 6.3.

Regarding the requirements of section II element 6.4 outlined above, the petition fails to identify a concise statement of the utility of the invention as defined in the independent claim. A general statement directed to the overall concept of the invention is not specifically relating the utility to

each of the independent claim as is required by the policy. Petitioner should reference the independent claim specifically when discussing the utility of the invention.

Regarding the requirements of section II element 6.5 outlined above, the requirements of this section are not met because lack of specificity. A grantable petition requires petitioner to provide a showing of where each limitation of the claims (no bundling of limitations!) finds support under 35 U.S.C. 112, first paragraph, in the written description of the specification. The instant petition only identifies figures and portions of text with respect to claim numbers as opposed to the disclosure of the required claim limitations, addressed individually for each limitation in each claim. The requirement of section II element 6.5 can be satisfied by listing verbatim all the presently filed claims (by "copy and paste") and by indicating where the instant application (and separately each one of the priority documents – if applicable) teaches each limitation in each one of said presently filed claims, by indicating the element number and/or the relevant page and line numbers. Applicant's attention is also drawn to the requirements relevant under 35 U.S.C 112, 6th paragraph, listed above. Should this requirement not apply to the present application, Applicant should make a statement in this regard. As an example of the deficient mapping in the present case the following example is addressed: in the accelerated examination support document, on p. 6, last paragraph, the following mapping is made:

"generating a recommendation based on the scores of each of the one or more candidate components. (Paragraph [0028], Figure 5, Paragraphs [0035] and [0036], Figure 6)"

In the specification, paragraphs [0028] and [0035], read:

[0028] The accumulator 164 generates the recommendation 144 based on the scores 166. In one example, the accumulator 164 computes a normalized score 168 for each component type in the component set 142 based on the associated scores 166. The normalized score 168 is set equal to the sum of all scores 166 for the similar or the same components divided by the total number of different components. The accumulator 164 then ranks the components based on the normalized score 168 and generates the recommendation 144 based on the ranking. The recommendation 144 includes the predicted next component 170 and the normalized score 168.

[0035] Once all entries in the next component set have been processed at block 414, the cumulative scores are normalized for each entry in the accumulation set at block 420. Normalization is performed by dividing the cumulative score for an entry by the frequency count for that entry. Once normalized at block 420, the normalized scores can be used as a sort key, to sort or rank the entries in the accumulation set at block 422. Finally, the components in the accumulation set or a subset of the components are presented in sort order (e.g., high to low) as recommendations at block 424. Thereafter, the method may end at block 426.

First, it is noted that the following specific location citation could have been made: generating a recommendation (144 [0028] ll. 6-7, 424 [0035] l. 7). Second, the limitation "based on the scores" could not be found. It is believed that a normalization is performed before the recommendation is made – and this is the reason why a limitation by limitation (rather than bundling of limitations) is essential to be made in response to this requirement.

DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address all of the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Ehud Gartenberg, TC 3700 Special Programs Examiner, at (571) 272-4828. In his absence, an inquiry can be directed to J. Harrison, Special Program Examiner, at 571 272-4449.

Ehud Gartenberg
Special Programs Examiner
Technology Center 3700

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Alexandria, VA 22313-1450
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CANTOR COLBURN LLP-IBM YORKTOWN
20 Church Street
22nd Floor
Hartford CT 061031

JUL 29 2008

In re Application of: Bergman Lawrence, et al.
Serial No.:12/101,493
Filed: April 11, 2008
Title: METHOD, SYSTEM AND COMPUTER PROGRAM PRODUCT FOR RECOMMENDING COMPONENTS BASED ON COMMON USAGE PATTERNS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the request for reconsideration filed on July 25, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d). The request has been treated as a renewed petition to make the above-identified application special and has been viewed as a supplement to and in combination with the original petition which was filed on April 11, 2008 and dismissed in the Office letter of June 27, 2008.

The petition to make the application special is **DENIED.**

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the conditions as outlined in the prior petition decision. The conditions are not repeated herein.

## REVIEW OF FACTS

As stated in the decision of June 27, 2008 conditions I: 1-4, II: 1-5, 5.1 5.3, 6, 6.1, 6.3 and 6.6 were considered to have been met. However, the petition failed to comply with conditions II: 5.2, 6.2, 6.4 and 6.5. Upon reconsideration, the petition is considered to additionally meet II: 5.2 and 6.5. However, the petition still fails to meet the requirement of section II: 6.2 and 6.4. However, because of the deficiency in meeting the requirements section II condition 6.2, the statement regarding section II condition 6.3 should be reviewed too. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

## DISCUSSION

Applicant failed to satisfy the requirement of section II condition 6.2 because of lack of specificity. For example, Applicant states on p. 3 of the AESD:

"Ohsugi teaches the following limitations of the pending claims.

Claim 1

A method of recommending a next component **(Abstract, lines** 12-14), identifying one or more candidate software applications based on a first similarity metric, wherein the one or more candidate software applications include one or more reusable software components; **(limitations not** found) "

And further:

estimating a score (3.3 collaborative Filtering Procedure, "ratings," FIG. 3, "frequency") for each of the one or more candidate software components (FIG. **3, functions A-D in** summarized usage history) based on a composition of the one or more candidate software applications **(limitation not** found);

However, it appears that Ohsugi in section 4.1.3 teaches the limitations that Applicant states that are not found:

**4.1.3. User Similarity Computation Algorithm**

The *User Similarity Computation Algorithm* was proposed by Resnick et al. [11] in GroupLens research,

which is one of the basic algorithms in collaborative filtering researches. For example, Sarwar et al. [12] proposed faster algorithm based on this algorithm, to apply to their commodity recommendation system in e-commerce.

Here the situation is that system computes rating of item $k$ for user $a$. At first, if $I_i$ is the set of item on which user $i$ has voted, then the mean vote for user $i$ is calculated as:

$$\bar{v}_i = \frac{1}{|I_i|}\sum_{j \in I_i} v_{ij} \qquad (4)$$

Next, the similarity $c(a, i)$ between each user $i$ and the user $a$ is calculated as:

$$c_{(a,i)} = \frac{\sum_{j \in I_a \cap I_i}\left(v_{aj} - \bar{v}_a\right)\left(v_{ij} - \bar{v}_i\right)}{\sqrt{\sum_{j \in I_a \cap I_i}\left(v_{aj} - \bar{v}_a\right)^2 \sum_{j \in I_a \cap I_i}\left(v_{ij} - \bar{v}_i\right)^2}} \qquad (5)$$

At last, rating $r_{ak}$ of item $k$ for user $a$ is calculated as:

$$r_{ak} = \bar{v}_a + \sum_{i \neq a} c(a, i)\left(v_{ik} - \bar{v}_i\right) \qquad (6)$$

The equation (5) is a correlation coefficient between user $a$ and $i$. And its range of value is [-1, 1]. The first term of the equation (6) is an average voting of user $a$ and the second term is a weighted sum of the votes of all users except user $a$. Results of the equation (6) depend on the votes of other users who are similar to user $a$, so that high voted items by similar other users get high rating.

Note that Ohsugi teaches at least identifying one candidate software application in the form of a commodity recommendation system (4.1.3 first paragraph, l. 6), based on a similarity metric (4.1.3 title and first line, wherein said commodity recommendation system reads on the claimed reusable software component. Note that the result of equation (6) "the rating of item k for user a" in Ohsugi reads on the claimed "estimated score" in the present application.

For the same lack of specificity, the patentability explanation under the requirements of section II condition 6.3 is found deficient as well. Note that the claimed limitation:

"estimating a score for each of the one or more candidate software components **based on a composition of the one or more candidate software applications.**";

reads on the substance and content (the software code) of the prior art software itself. In fact, all software evaluations are based on their compositions, i.e., their software code.

Petitioner also failed to satisfy the requirement of section II, condition 6.4. In response to said requirement, Petitioner states on p. 8 of the AESD:

"Concise Statement of Utility:
The invention as claimed has utility in that it provides a developer a set of specific

recommendations that are more likely to be useful. "The developer can be confident in the recommendation because it is based on a similarity between the application being assembled and already-built applications." (Paragraph [0006])"

The statement "The invention as claimed has utility in that it provides a developer a set of specific recommendations that are more likely to be useful.", is general, non-specific, and hardly illuminates the reader on the utility of the claimed invention.

As a courtesy to Applicant and for future use, the examiner provides the following guidelines to satisfying certain requirements of the Accelerated Examination program.

The requirement of section II element 6.2 can be satisfied by listing verbatim ("copy and paste") all the filed claims (i.e., the claims of the application) and by indicating where each discrete limitation of each one of said filed claims is taught (or is not taught) in each one of the cited most closely related references, by specifically indicating the element number and/or the relevant page/paragraph and line number(s), or by indicating "(not disclosed)" where appropriate - in order to ensure that no limitation was left out inadvertently. This one-to-one mapping should be performed individually, with regard to each one of the most closely related prior art that is cited, one reference at a time. Applicant's attention is drawn to the fact that the requirement of this element calls for a straight mapping of each single limitation unto the prior art. Section II element 6.2 is not the place to make patentability arguments by bundling together multiple limitations and concluding that the combination is not disclosed. Patentability arguments should be made only in response to the requirement of section II element 6.3.

The requirement of section II element 6.3 can be satisfied by indicating for each one of the filed claims (i.e., the claims of the instant application) which specific i.e., discrete limitation(s) in each one of said filed claims define(s) over each one of the most closely related references that has been cited. With regard to each dependent claim, there should be an unequivocal statement whether the patentability of each dependent claim is predicated solely on that of the claim from which it depends, or Applicant should provide a detailed explanation of patentability specific to that particular claim. This patentability showing should be performed individually, with regard to each one of the most closely related prior art that is cited, one reference at a time.

## DECISION

For at least the above-stated reason (for failing to meet the requirement of section II: element 6.2, 6.3, and 6.4), the petition is **DENIED**. The application will remain in its regular status and will be taken up by the examiner for action in its regular turn.

Petitioner is reminded that a single opportunity to perfect the petition is given. Therefore, further petitions for accelerated examination in this application will not be entertained.

Any inquiry regarding this decision should be directed to Ehud Gartenberg, TC 3700 Special Program Examiner, at (571) 272-4828. In his absence, an inquiry can be directed to J. Harrison, Special Program Examiner, at 571 272-4449.

Ehud Gartenberg
Special Program Examiner
Technology Center 3700

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

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Anthony John Hart | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7610744 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/03/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/101,507 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/11/2008 | : 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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FELDMANGALE, P.A.
1700 Market Street
Suite # 3130
Philadelphia, PA 19103

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MAR 13 2009

**OFFICE OF PETITIONS**

In re Application of Gonzalez-Hernandez :
Application No. 12/101,508 : Decision on Petition
Filing Date: April 11, 2008 :
Attorney Docket No. 1114.694U :

This is a decision in response to the petition filed July 9, 2008, which is being treated as a petition under 37 CFR 1.53(e) and the petition under 37 CFR 1.181 filed October 10, 2008.

The petition under 37 CFR 1.53(e) will be treated as **withdrawn**.

The petition under 37 CFR 1.181 is **dismissed as moot**.

The application was filed April 11, 2008.

The Office of Initial Patent Examination mailed a "Notice of Omitted Item(s) in a Nonprovisional Application." on May 21, 2008. The Notice stated Figures 1 to 6 of the drawings did not appear to be part of the application as filed.

In response, petitioner filed a "Petitioner for Date of Deposit 37 C.F.R. §1.17(F)," which is being treated as a petition under 37 CFR 1.53(e). The petition stated, "Applicant(s) respectfully petition the Commissioner for the date of deposit of drawing Figures 1-6 in the above-identified application."

On October 10, 2008, petitioner filed a petition under 37 CFR 1.181 requesting the withdrawal of the petition filed July 9, 2008.

In view of the October 10, 2008 communication from petitioner, and the fact the merits of the petition under 37 CFR 1.53(e) petition had not been considered as of October 10, 2008, the petition under 37 CFR 1.53(e) is withdrawn. The $400 petition fee submitted July 9, 2008, has been credited back to petitioner's deposit account.

A petition under 37 CFR 1.181 is not necessary in order to withdraw a petition. Therefore, the petition is dismissed as moot. Office records indicate the petition under 37 CFR 1.181 included a fee of $400. However, a fee is unnecessary for a petition under 37 CFR 1.181 and the fee has been credited back to petitioner's deposit account.

As a courtesy, the Office notes the preliminary amendment filed October 10, 2008, was combined with the petition. However, an amendment must be filed as a separate paper. In order to avoid a possible objection to the preliminary amendment by the examiner, petitioner may wish to file a supplemental amendment.

Technology Center Art Unit 3775 will be informed the pending petitions have now been addressed and that the application is in condition to be docketed to an examiner and examined in due course.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/101,541 | 04/11/2008 | Nils Haustein | DE920070196US1 | 8430 |

42640 7590 08/13/2008

DILLON & YUDELL LLP
8911 NORTH CAPITAL OF TEXAS HWY
SUITE 2110
AUSTIN, TX 78759

| EXAMINER | |
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| ALAM, HOSAIN T | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2166 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/13/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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Jonathan E. Jobe
DILLON & YUDELL LLP
8911 N. Capital of Texas Highway
Austin, Texas 78759

In re Application of:
Nils HAUSTEIN et al.
Serial No.: 12/101,541
Filed: April 11, 2008
Attorney Docket: DE920070196US1
Title: METHOD OF AND SYSTEM FOR DEDUPLICATING BACKED UP DATA IN A CLIENT-SERVER ENVIRONMENT

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 11, 2008 and the supplemental petition filed on July 16, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

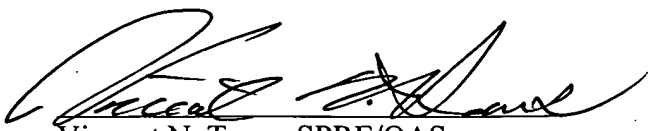
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3613.



Vincent N. Trans, SPRE/QAS
Technology Center 2100
Computer Architecture, Software, and
Information Security

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. |
|---|---|---|---|---|
| 12/101,544 | 04/11/2008 | Markus SCHULTHEIS | 920-35US (P10464 WOUS) | 8443 |

7590 10/09/2008

PANITCH SCHWARZE BELISARIO & NADEL LLP
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

| EXAMINER | |
|---|---|
| MAI, NGOCLAN THI | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1793 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 10/09/2008 | PAPER |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Patent Publication Branch
Office of Data Management

Adjustment date: 10/10/2008 BPOWELL
04/14/2008 INTEFSW 00000953 501017 12101544
02 FC:1111 510.00 CR

Refund Ref:
10/10/2008 0030062168

Credit Card Refund Total: $500.00

Am Exp..: XXXXXXXXXXX1007

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PATENTTM.US
P. O. BOX 82788
PORTLAND OR 97282-0788

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DEC 0 7 2009

OFFICE OF PETITIONS

In re Application of :
Chen, et al. :
Application No. 12/101,549 : DECISION
Filed: 11 April, 2008 :
Attorney Docket No. T-1706 :

This is a decision on the petition filed on 24 August, 2009, pursuant to 37 C.F.R. §1.137(b) for revival of an application abandoned due to unintentional delay .

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

**Petitioners' attentions always are directed to the guidance in the Commentary at MPEP §711.03(c )(II).**

## BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the Notice of Allowance/Allowability and Fees Due mailed on 31 March, 2009, with reply due under a non-extendable deadline on or before 30 June, 2009.

The application went abandoned by operation of law after midnight 30 June, 2009.

The Office mailed the Notice of Abandonment on 24 July, 2009.

On 24 August, 2009, Petitioner filed, *inter alia*, a petition (with fee) pursuant to 37 C.F.R. §1.137(b), with a reply in the form of fees due and made the statement of unintentional delay.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]
The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[3]))

### As to Allegations of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that the requirements under the rule have been satisfied.

---

[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

[2] 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[3] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

## CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to the Publications Branch to be processed into a patent in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the Publications Branch in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the Publications Branch where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[4]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[4] The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

UNITED STATES PATENT AND TRADEMARK OFFICE

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**FOLEY & LARDNER LLP**
**975 PAGE MILL ROAD**
**PALO ALTO CA 94304**

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AUG 3 1 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Sinha et al. | : | DECISION ON PETITION |
| Application No. 12/101,644 | : | TO WITHDRAW |
| Filed: April 11, 2008 | : | FROM RECORD |
| Attorney Docket No. 070545-1401 | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 14, 2009.

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

A review of the file record indicates that on August 14, 2009 the power of attorney to Foley and Lardner LLP was revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to the undersigned at 571-272- 7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Swiss Tanner, P.C.
P.O. Box 1749
Four Main Street, Suite 100
Los Altos CA 94022

UNITED STATES PATENT AND TRADEMARK OFFICE

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**Thelen LLP**
**P.O. Box 640640**
**San Jose, CA 65164-0640**

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SEP 2 4 2008

**OFFICE OF PETITIONS**

In re Application of :
Tetsuo Sato, et al. :
Application No. 12/101,665 : DECISION ON PETITION
Filed: April 11, 2008 : TO WITHDRAW
Attorney Docket No. 650007-007 : 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 8, 2008.

The request is **APPROVED**.

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

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

There is no outstanding Office action at this time.

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Tetsuo Sato**
**2101 Leon Drive**
**San Jose, CA 95128**

cc: **Renesas Technology America, Inc**
**c/o Song Zhu, Squire, Sanders & Dempsey LLP**
**One Maritime Plaza, Suite 300**
**San Francisco, CA 94111**

UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/101,665 | 04/11/2008 | Tetsuo Sato | 650007-007 |

**CONFIRMATION NO. 8684**

**POWER OF ATTORNEY NOTICE**

46188
THELEN LLP
P. O. BOX 640640
SAN JOSE, CA 95164-0640

Date Mailed: 09/23/2008

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/08/2008.

- 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

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MARSHALL, GERSTEIN & BORUN LLP
233 S. WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO IL 60606

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SEP 23 2008

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of | : DECISION REFUSING STATUS |
| Amanullah, Islam, Chami, and Ienco | : UNDER 37 CFR 1.47(a) |
| Application Number: 12/101677 | : |
| Filing Date: 04/11/2008 | : |
| Attorney Docket Number: 28594/43876 | : |

This is in response to the petition under 37 CFR 1.47(a) filed on August 1, 2008.

The petition is **DISMISSED**.

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

The above-identified application was filed on April 11, 2008, without an executed oath or declaration. Accordingly, on May 1, 2008, the Office of Patent Application Processing mailed a Notice to File Missing Parts of Nonprovisional Application requiring, *inter alia*, an executed oath or declaration and a surcharge for its late filing.

In response, on August 1, 2008, the present petition was filed, accompanied by a one (1) month extension of time, and *inter alia*, declaration naming Mohammed Amanullah, Syed Mofizul Islam, Samer Chami, and Gary Ienco as joint inventors, signed by all inventors except non-signing inventor Chami on behalf of themselves and non-signing inventor Chami.

Petitioners assert, via the statement of registered patent practitioner Joseph A. Williams, Jr., that a letter was sent to the non-signing inventor requesting that he execute an assignment

of an international application, but that no response was received.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of $130 or $65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventors.

The petition lacks item (1).

In regards to item (1), petitioners have not shown that a copy of the application as filed (specification, including claims, drawings, if any, and the declaration) was sent to each of the non-signing inventors.[1]

Petitioners may show proof that a copy of the application was sent or given to the non-signing inventors for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners **must** show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

It is noted that a petition fee of $130.00 was filed with the petition. The fee for a petition under 37 CFR 1.47(a), however, is $200.00. The balance of $70.00 will be charged to counsel's deposit account as authorized in the extension of time filed on August 1, 2008.

---

[1] MPEP 409.03(d).

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

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

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

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

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DRW Feb-09

MARSHALL, GERSTEIN & BORUN LLP
233 SOUTH WACKER DRIVE
6300 SEARS TOWER
CHICAGO IL 60606-6357

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FEB 04 2009

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of | : |
| Amanullah et al. | : DECISION NOTING JOINDER |
| Application Number: 12/101677 | : OF INVENTOR AND PETITION |
| Filing Date: 04/11/2008 | : UNDER 37 CFR 1.47(a) MOOT |
| Attorney Docket Number: | : |
| 28594/43876 | : |

This is a decision in response to the renewed petition under 37 CFR 1.47(a) filed on December 23, 2008.

Papers filed on January 12, 2009, subsequent to the filing of the renewed petition filed on December 23, 2008, included a Declaration signed by the previously non-signing inventor, in compliance with 37 CFR 1.63.

The petition is **dismissed as moot**.

In view of the joinder of the inventor, further consideration under 37 CFR 1.47(a) is moot; this application does not have any rule 1.47(a) status and no such status should appear on the file wrapper. This application need not be returned to this office for any further consideration under 37 CFR 1.47(a).

This application will be referred to the Office of Patent Application Processing for further processing.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 12/1/09 **Paper No.:** —

**TO SPE OF** : ART UNIT 1656

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 12/101689 Patent No.: 7608692B2

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:** —

[signature] (SPE) AU 1656

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/101,704 | 04/11/2008 | John Alcario VALENCIA | 2008_0541A | 8772 |

513 7590 12/08/2008

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

| EXAMINER | |
|---|---|
| DECADY, ALBERT | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2121 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 12/08/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON DC 20006-1021

| | |
|---|---|
| In re Application of:<br>John Alcario Valencia<br>Serial No.: 12/101,704<br>Filed: April 11, 2008<br>Docket: 2008_0541A<br>Title: BLUETOOTH VOLUME TRACKER | DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02 |

This is a decision on the petition filed on April 11, 2008 to make the above- identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is GRANTED.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:

To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Kakali Chaki, Quality Assurance Specialist, at (571) 272-3719.

/Kakali Chaki/

---

Kakali Chaki, Quality Assurance Specialist
Technology Center 2100

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**SAIDMAN DESIGNLAW GROUP**
**8601 GEORGIA AVENUE**
**SUITE 603**
**SILVER SPRING MD 20910**

MAILED

MAY 18 2009

OFFICE OF PETITIONS

In re Application of :
**VALENCIA,** John A. :
Application No. 12/101,704 : DECISION ON PETITION
Filed: April 11, 2008 : TO WITHDRAW
Attorney Docket No. **1773.002** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 21, 2009.

The request is **NOT APPROVED**.

The Office has revised its change in procedure for request to withdraw from representation applies to requests filed on or after May 12, 2008.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request cannot be approved because there is no indication that acts (1) thru (3) noted in the above-identified certifications have been performed. See PTO/SB/83 (11-08).

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

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272- 2783.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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JUN 23 2008

OFFICE OF PETITIONS

CHARLES C MCCLOSKEY
763 S NEW BALLAS ROAD STE 170
ST LOUIS MO 63141

In re Application of :
Virginia E. Foster :
Application No. 12/101,730 : DECISION GRANTING PETITION
Filed: April 11, 2008 :
Attorney Docket No. 188

This is a decision on the "RESPONSE TO NOTICE of INCOMPLETE NONPROVISIONAL APPLICATION AND PETITION", filed May 29, 2008, which is being tread as a petition under 37 CFR 1.53 to accord the above-identified application a filing date of April 11, 2008.

The application was deposited on April 11, 2008. However, on May 1, 2008, the Office of Initial Patent Examination mailed a "Notice of Incomplete Nonprovisional Application", stating that the application had not been accorded a filing date because the application was deposited without drawings. In response, applicant timely filed this petition.

As stated in MPEP § 601.01(f), it is the practice of the PTO to treat an application that contains at least one process or method

claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

MPEP § 601.01(f) also states that:

> A nonprovisional application having at least one claim, or a provisional application having at least some disclosure, directed to the subject matter discussed above for which a drawing is usually not considered essential for a filing date, describing drawing figure(s) in the specification, but filed without drawings will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g), so long as the application contains something that can be construed as a written description.

This instant application contains a method claim, namely claim 15.

Therefore, the application should have been treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP § 601.01(g). The Office should have granted the application a filing date and mailed a Notice of Omitted Items instead of a Notice of Incomplete Nonprovisional Application. As stated in § 601.01(g), applicant may submit an amendment to include the inadvertently omitted portion of the drawing(s) pursuant to 37 CFR 1.57(a):

> [i]f an application was filed on or after September 21, 2004, and contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application that was present on the filing date of the application, and the omitted portion of the drawing[s] was inadvertently omitted from the application and is completely contained in the prior-filed application[.]

Please note that no petition is required and that the amendment must comply with 37 CFR 1.57(a) and 37 CFR 1.121. See MPEP 201.17. Any amendment to include the inadvertently omitted drawing(s) will be considered by the examiner.

To the extent the instant petition requests a filing date of April 11, 2008, with no drawings present in the application, the petition is **GRANTED**.

Given the basis for granting this petition, the petition fee is being refunded to petitioner under separate cover.

Pursuant to this decision, the application will be referred to the Office of Patent Application Processing for:

- **correction of the filing date to April 11, 2008**;
- **for indication in Office records, as appropriate, that "0" sheets of drawings were present on filing**, and
- **for issuance of a filing receipt**.

Telephone inquiries specific to this decision may be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

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JUL 15 2010

OFFICE OF PETITIONS

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

In re Application of
Gunnar Hanson, et. al.
Application No. 12/101,733
Filed: April 11, 2008
Attorney Docket No. 606922000700

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), or 10.40 filed June 4, 2010.

The request is **APPROVED**.

The request was signed by Leslie A. Robinson on behalf of himself and the attorneys/agents associated with Customer Number 25225. Therefore, Leslie A. Robinson and the attorney/agents associated with Customer Number 25225 have been withdrawn.

Applicant is reminded that there are no attorneys/agents of record at this time.

The request to change the correspondence address cannot be accepted since it is not of the sole inventor or the intervening assignee that complied with the requirements of 37 CFR 3.73(b)[1]. Since 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 CFR 3.71, all future communications from the Office will continue to be directed to the above listed address until otherwise properly notified by the applicant[2].

This application file is being referred to Technology Center Art Unit 1654 for examination in due course.

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

Andrea Smith
Petitions Examiner
Office of Petitions

cc: Joyant Pharmaceuticals, Inc.
2620 N. Stemmons Freeway
Dallas, TX 75207

[1] 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).

[2] The Office will no longer change the correspondence address to that of a new practitioner unless the Request is accompanied by a power of attorney to a new practitioner (e.g., Form PTO/SB/82).

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United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/101,733 | 04/11/2008 | Gunnar HANSON | 606922000700 |

**CONFIRMATION NO. 8837**

**POWER OF ATTORNEY NOTICE**

25225
MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO, CA 92130-2040

Date Mailed: 07/08/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 06/04/2010.

- 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.

/amsmith/

---

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

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

MAILED

MAY 22 2009

OFFICE OF PETITIONS

In re Application of
Sharma and Chu
Application No. 12/101,739
Filed: April 11, 2008
Attorney Docket No. 3510.64US02
For: **MODULAR BLADE FOR PROVIDING SCALABLE MECHANICAL, ELECTRICAL AND ENVIRONMENTAL FUNCTIONALITY IN THE ENTERPRISE USING ADVANCEDTCA BOARDS**

: DECISION ACCORDING STATUS
: UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed December 1, 2008

The petition is **GRANTED**.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

The above-identified application was filed on April 11, 2008, without a proper oath or declaration. Accordingly, a "Notice to File Missing Parts of Nonprovisional Application" was mailed on May 1, 2008, requiring an executed oath or declaration and a surcharge for the late filing of the oath or declaration. The instant petition was filed on December 1, 2008, with a request for an extension of time within the fifth month.

Petitioner has shown that inventor Sharma has refused to join the prosecution of the application. The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

This application will be forwarded to the Office of Patent Application Processing for further processing.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Paper No.

PILLSBURY WINTHROP SHAW
PITTMAN, LLP
P.O. BOX 10500
MCLEAN VA 22102

MAILED

MAR 25 2009

OFFICE OF PETITIONS

In re Application of :
Murillo Filho, :
Isabelle Schaarschmidt : DECISION ACCORDING STATUS
Bernd Wahl, Elmar Rother : UNDER 37 C.F.R. § 1.47(a)
Hartmut Zimmermann and :
Andreas Karau :
Application No. 12/101,759 :
Filed: April 11, 2008 :
Atty Docket No. 021123-0367944:

This is a decision on the PETITION UNDER 37 C.F.R. §1.47(a) filed October 2, 2008.

The petition is **GRANTED**.

The above-identified application was filed on April 11, 2008, with an application data sheet but without an executed oath or declaration. Accordingly, on May 2, 2008, the Office sent a "Notice to File Missing Parts of Application," requiring an executed oath or declaration and the surcharge for its late filing. This Notice set a two-month time limit for reply with extensions of time obtainable under § 1.136(a).

In response, applicants filed the instant petition (and late surcharge). This petition was made timely by an accompanying petition and extension of time for response within the three months. The petition includes five declarations executed, in combination, by joint inventors Filho, Schaarschmidt, Wahl, Rother, and Karau on behalf of themselves and on behalf of non-signing joint inventor Zimmermann. Applicant asserts that status under 1.47(a) is proper because joint inventor Zimmermann refuses to join in the application. By statements on petition

of patent practitioner Thomas Cawley, Jr, with supporting documentary evidence in German (with English translation), applicant shows that after having been presented with the application papers inventor Zimmermann has expressly refused to join in the application. The evidence includes an E-mail communication from inventor Zimmermann acknowledging receipt of the application papers and expressing his unwillingness to sign the declaration in response to the presentation made. The present refusal shown is sufficient for purposes of showing unavailability within the meaning of 37 CFR 1.47(a). In view thereof, it is concluded that applicants have made an adequate showing of inventor Zimmermann's refusal to join in the application.

The declarations filed October 2, 2008, have been reviewed and found in compliance with § 1.63. The $200 petition fee has been charged to the Deposit Account, as authorized. The petition includes the last known address of non-signing inventor Zimmermann.

In view thereof, this application is hereby accorded Rule 1.47(a) status.

As provided in new Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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Dr. Hartmut Zimmermann
Weberberggasse 49
88400 Biberach
GERMANY

MAILED

MAR 25 2009

OFFICE OF PETITIONS

In re Application of :
Murillo Filho, :
Isabelle Schaarschmidt :
Bernd Wahl, Elmar Rother :
Hartmut Zimmermann and : LETTER
Andreas Karau :
Application No. 12/101,759 :
Filed: April 11, 2008 :
Atty Docket No. 021123-0367944:

Dear Dr. Zimmermann:

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. However, no action on your part is required for this patent to issue with you as a named inventor.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Nancy Johnson at (571) 272-3219. Requests for information regarding your application should be

directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (571) 272-3150 or 1-800-972-6382 (outside the Washington D.C. area).

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Thomas A. Cawley
PILLSBURY WINTHROP SHAW
PITTMAN, LLP
P.O. BOX 10500
MCLEAN VA 22102

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Paper No.

TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111

MAILED

JUL 06 2010

OFFICE OF PETITIONS

In re Application of :
Drachman et al. :
Application No. 12/101,785 :
Patent No.: 7,695,716 : DECISION ON PETITION
Filed: April 11, 2008 : PURSUANT TO
Issued: April 13, 2010 : 37 C.F.R. § 1.28(c)
Attorney Docket No.: 018891-002340US :
Title: METHODS OF TREATING NEOPLASTIC, AUTOIMMUNE AND INFLAMMATORY DISEASES :

This is a notice regarding your request for acceptance of a fee deficiency submission pursuant to 37 C.F.R. § 1.28, received on February 10, 2010. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 C.F.R. § 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

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

Petitioner has identified the particular type of fees that were erroneously paid as a small entity, when the small entity fees were actually paid, the small entity fees that were actually paid, the deficiency owed amounts, and the total deficiency payment owed.

The deficiency payment of $1533 will be charged to Deposit Account No. 20-1430 in due course, as authorized on the second page of this petition.

Your fee deficiency submission pursuant to 37 C.F.R. § 1.28(c) is hereby accepted. The petition is **GRANTED** accordingly.

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

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[1]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MITCHELL P. BROOK
LUCE, FORWARD, HAMILTON & SCRIPPS, LLP
11988 EL CAMINO REAL, SUITE 200
SAN DIEGO, CA 92130

**COPY MAILED**

**OCT 28 2008**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Donald E. Friese, et. al. | : | |
| Application No. 12/101,787 | : | DECISION ON PETITION |
| Filed: April 11, 2008 | : | |
| Attorney Docket No. 27458-1090 | : | |

This is a decision on the petition filed on April 22, 2008, which is being treated as a petition under 37 CFR 1.182, to change the order of the names of the inventors.

The petition is not signed by an attorney of record. However, in accordance with 37 CFR 1.34(a), the signature of Eric Lane appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts

The petition is **granted**.

The order of the names of the inventors will be changed as follows:

1. Donald E. Friese

2. Ray Bowie

Office records have been corrected to reflect the change in the order of the named inventors. A corrected Filing Receipt, which sets forth the desired order of the named inventors, accompanies this decision on petition.

As authorized, the $400 fee for the petition under 37 CFR 1.182 has been assessed to petitioner's deposit account.

This application is being referred to Technology Center Art Unit 3679, for examination, in due course.

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

Andrea Smith
Petitions Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 12/101,787 | 04/11/2008 | 3679 | 1030 | 27458-1090 | 20 | 3 |

**CONFIRMATION NO. 8923**

**CORRECTED FILING RECEIPT**

45263
MITCHELL P. BROOK
LUCE, FORWARD, HAMILTON & SCRIPPS LLP
11988 EL CAMINO REAL, SUITE 200
SAN DIEGO, CA 92130

Date Mailed: 10/23/2008

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

Donald E. Friese, Los Angeles, CA;
Ray Bowie, Los Angeles, CA;

**Assignment For Published Patent Application**

C.R. LAURENCE COMPANY, INC., Los Angeles, CA

**Power of Attorney:** None

**Domestic Priority data as claimed by applicant**

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 04/30/2008

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 12/101,787**

**Projected Publication Date:** 10/15/2009

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

CORNER ASSEMBLY

**Preliminary Class**

256

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

## LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

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

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

**NOT GRANTED**

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

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INTELLECTUAL PROPERTY DEPARTMENT
AMYLIN PHARMACEUTICALS, INC.
9360 TOWNE CENTRE DRIVE
SAN DIEGO, CA 92121

MAILED

MAY 15 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kathryn S. Prickett, et al. | : | |
| Application No. 12/101,818 | : | DECISION GRANTING PETITION |
| Filed: April 11, 2008 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 253/204-CON4 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed May 14, 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 April 2, 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 regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries regarding the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 1656 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAIL

MAY 14 2008

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

MORGAN LEWIS & BOCKIUS LLP/ APPLE INC.
2 PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO CA 94306

In re Application of:
JOBS, STEVEN P., et al.
Serial No.: 12/101,832
Filed: April 11, 2008

Title: **TOUCH SCREEN DEVICE, METHOD, AND GRAPHICAL USER INTERFACE FOR DETERMINING COMMANDS BY APPLYING HEURISTICS**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 11, 2008 requesting that the above-identified application be made special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election

without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

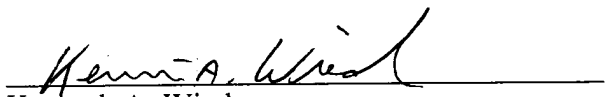
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Ken Wieder, Quality Assurance Specialist, at (571) 272-2986.



Kenneth A. Wieder
Quality Assurance Specialist
Technology Center 2600
Communications

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Alexandria, VA 22313-1450
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**MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C**
**ONE FINANCIAL CENTER**
**BOSTON MA 02111**

| | | |
|---|---|---|
| In re Application of | : | |
| **MARSH,** Gene | : | |
| Application No. 12/101,845 | : | DECISION ON PETITION |
| Filed: April 11, 2008 | : | TO WITHDRAW |
| Attorney Docket No. **37143-507F01US** | : | 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 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 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 Pedro F. Suarez on behalf of all attorneys of record who are associated with customer No. 64046. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence address of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor.

There 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: **GENE MARSH**
**12670 HIGH BLUFF DRIVE**
**SUITE 100**
**SAN DIEGO, CA 92130**

cc: **WI-LAN, INC.**
**11 HOLLAND AVENUE, SUITE 608**
**OTTAWA, ONTARIO K1Y 4S1**
**CANADA**

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**MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C**
**ONE FINANCIAL CENTER**
**BOSTON, MA 02111**

**MAILED**

OCT 23 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Bourlas et al. | : | DECISION ON PETITION |
| Application No. 12/101,852 | : | TO WITHDRAW |
| Filed: April 11, 2008 | : | FROM RECORD |
| Attorney Docket No. 37143-502F01US | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed on September 21, 2009.

The request is **NOT APPROVED**.

The Request for Withdrawal as Attorney or Agent and Change of Correspondence Address submitted herein cannot be approved at this time.

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.*

All future communications from the Office will be directed to above-listed address until otherwise properly notified by the applicant or a proper change of correspondence address have been submitted.

There are no 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.

A. Kelley

Alicia Kelley
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
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MAIL

SEP 17 2009

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, JIN WOO et al :
Application No. 12/101,861 :
Filed: April 11, 2008 :
Attorney Docket No.: 2080-3606 :

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 July 10, 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:

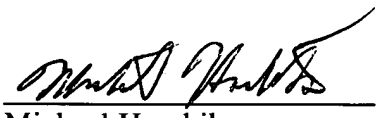
(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the KIPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the KIPO application(s) along with an English translation thereof and a statement that the English translation 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
Quality Assurance Specialist
Technology Center 2600
Communications

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Paper No.

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1021 MAIN CAMPUS DRIVE
CENTENNIAL CAMPUS
RALEIGH NC 27606

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SEP 15 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| John W. Cash III | : | DECISION ON PETITION |
| Application No. 12/101,870 | : | PURSUANT TO |
| Filed: April 11, 2008 | : | 37 C.F.R. § 1.182 |
| Attorney Docket No. D20746-1 | : | |
| Title: PACKAGING MACHINE WITH GLUING STATION AND FOLDING STATION | : | |

This is a decision on the "PETITION PURSUANT TO 37 CFR 1.57(a)," filed July 23, 2008, requesting that the above-identified application, including eight pages of drawings containing Figures 1-9, be accorded a filing date of April 11, 2008, as part of the original disclosure. This submission is being treated as a petition pursuant to 37 C.F.R. § 1.182.[1]

The petition is **GRANTED**.

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1 See MPEP § 201.06(c)(IV)(A), which sets forth, in *pertinent part*: "[I]n an application containing an explicit incorporation by reference statement in the specification or in a transmittal letter (if the transmittal letter was filed prior to September 21, 2004), a petition for the granting of a filing date may be made under 37 CFR 1.182."

Application papers in the above-identified application were deposited on April 11, 2008. However, on June 13, 2008, the Office of Initial Patent Examination Division mailed Applicant a "Notice of Incomplete Nonprovisional Application," notifying Applicant that the application papers had not been accorded a filing date because the application had been deposited without drawings, and that a filing date would be accorded upon the deposit of the same.

In response, Applicant timely filed this petition. Petitioner has acknowledged the inadvertent omission of drawings, and has set forth that this application incorporates a prior-filed provisional application by reference.

It is noted that this application claims priority to prior-filed provisional application number 60/911,215, and the contents of the same have been incorporated by reference.

Petitioner's arguments and evidence have been considered. However, it is controlling that a review of the application confirms that as filed, the application contained at least one method claim. MPEP. § 601.01(f) provides that:

> It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

Thus, pursuant to 37 C.F.R. § 601.01(f), a drawing is not considered essential for a filing date. Thus, the application is entitled to a filing date without drawings present in the application.

Accordingly, the Office should have mailed a Notice of Omitted Items and not a Notice of Incomplete Nonprovisional Application. As stated in MPEP § 601.01(g), if an application is entitled to a filing date, the mailing of a Notice of Omitted Items will permit *inter alia*:

> If an application was filed on or after September 21, 2004, and contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application that was present on the filing date of the application, and the omitted portion of the drawing(s) was inadvertently omitted from the application and is completely contained in the prior-filed application,

> applicant may submit an amendment to include the inadvertently omitted portion of the drawing(s) pursuant to 37 CFR 1.57(a). The amendment should be submitted in response to the Office action and must comply with 37 CFR 1.57(a) and 37 CFR 1.121. See MPEP § 201.17.

Although Petitioner has submitted eight pages of drawings, it does not appear that Petitioner has submitted an amendment directing the entry of the same. Petitioner may wish to submit this amendment. Any such amendment will, of course, be reviewed by the Examiner for new matter,[2] where the Examiner will compare the drawings to those contained in prior-filed provisional application number 60/911,215, in order to verify that they are an accurate copy of the figures contained therein and that they contain no new matter. The amendment is not new matter if the substance was a part of the disclosure of prior-filed provisional application number 60/911,215.

To the extent the present petition requests a filing date of April 11, 2008 with no drawings present in the application, the petition is **GRANTED**.

Given the basis for granting this petition, no petition fee is required, and the petition fee will be refunded to Petitioner's Deposit Account in due course.

The Office of Patent Application Processing (OPAP) will be advised of this decision. Pursuant to this decision, the application will be referred to OPAP for:

- **correction of the filing date to April 11, 2008**;
- **for indication in Office records, as appropriate, that "0" sheets of drawings were present on filing,** and;
- **for issuance of a filing receipt.**

Receipt of the concurrently submitted eight pages of drawings containing Figures 1-9 is acknowledged. Entry of the same will be determined by the Examiner.

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2 See MPEP §§ 608.02(h) and 608.04.

The general phone number for OPAP is 571-272-4000. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.[3]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/101,884 | 04/11/2008 | Philip L. BOYER | SVL920030035US2 | 9105 |

| EXAMINER |
|---|
| |

7590 08/01/2008

KONRAD RAYNES & VICTOR, LLP
ATTN: IBM54
315 SOUTH BEVERLY DRIVE, SUITE 210
BEVERLY HILLS, CA 90212

| ART UNIT | PAPER NUMBER |
|---|---|
| 2176 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/01/2008 | PAPER |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Betty Powell

Patent Publication Branch
Office of Data Management

Refund Ref:
08/04/2008 0030059331

Credit Card Refund Total: $700.00

Am Exp..: XXXXXXXXXXX1008

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/101,902 | 04/11/2008 | Nobuhiro Hanafusa | NOG-0306 | 9139 |

| EXAMINER |
|---|
| |

7590 10/26/2009

Cheng Law Group, PLLC
1100 17th Street, N.W.
Suite 503
Washington, DC 20036

| ART UNIT | PAPER NUMBER |
|---|---|
| 1635 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 10/26/2009 | PAPER |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Patent Publication Branch
Office of Data Management

Adjustment date: 10/26/2009 NFARMER
04/14/2038 INTEFSW 00003427 504422 12101902
02 FC:1111 510.00 CR
04 FC:1202 50.00 CR

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APR 06 2010

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**Weaver Austin Villeneuve & Sampson LLP - IGT**
**Attn: IGT**
**P.O. Box 70250**
**Oakland CA 94612-0250**

| | | |
|---|---|---|
| In re Application of | : | |
| Anthony ESCALERA et al. | : | |
| Application No. 12/101,921 | : | DECISION ON PETITION |
| Filed: April 11, 2008 | : | |
| Attorney Docket No. IGT1P086C1/P000557-029 | : | |

This is a decision on the petition, filed September 30, 2009, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to reply to the non-final Office action mailed December 22, 2008, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed on August 3, 2009.

Petitioner asserts that the Office action dated December 22, 2008 was not received.

A review of the written record indicates no irregularity in the mailing of the Office action, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

1. a statement from practitioner stating that the Office action was not received by the practitioner;

2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and

3. a copy of the docket record where the nonreceived Office action would have been entered had it been received and docketed must be attached to and referenced in the practitioner's statement.

*See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The petition satisfies the above-stated requirements. Accordingly, the application was not abandoned in fact.

In view of the above, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

This application is being referred to the Technology Center technical support staff of Art Unit 3714 for re-mailing the Office action of December 22, 2008. The period for reply will run from the mailing date of the Office action.

Telephone inquiries concerning this decision should be directed to Olisa Anwah at (571) 272-6051 or in his absence, the undersigned at (571) 272-7099.

David A. Bucci
Petitions Examiner
Office of Petitions

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/101,939 | 04/11/2008 | Anil Pothireddy | IN920070025US1/RKC100030 | 9220 |

76089 7590 06/26/2008
CARPENTER & ASSOCIATES
5 PIPESTEM COURT
ROCKVILLE, MD 20854

| EXAMINER | |
|---|---|
| LEE, THOMAS C | |
| ART UNIT | PAPER NUMBER |
| 2115 | |
| MAIL DATE | DELIVERY MODE |
| 06/26/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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CARPENTER & ASSOCIATES
5 PIPESTEM COURT
ROCKVILLE MD 20854

In re Application of: Pothireddy, et al.
Serial No.: 12/101,939
Filed: April 11, 2008
Docket: IN920070025US1/RKC100030
Title: METHOD AND SYSTEM FOR REDUCING LATENCY IN DATA TRANSFER BETWEEN ASHYNCHRONOUS CLOCK DOMAINS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 11, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees that the dependent claims will be grouped together with and not to separately argue the patentability of any independent claim from which they depend during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions I. 1-4 & II. 1-5, 5.1, 6.1, 6.4 & 6.6 above are considered to have been met. However, the petition fails to comply with conditions II. 5.2 - 5.3, 6.2, 6.3 & 6.5 above. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirement of MPEP § 708.02(a)(I.)(H)[1] and items 5.2 - 5.3 above, the pre-exam search must be directed to the (instant) claimed invention and encompass all of the disclosed features of the (instant) claims. The search logic does not seem to include the inventive concept or features included in the claim language and identified by Petitioner in the detailed explanation of patentability of the claims over the cited references. The search should consider individual features, combination of features as well as synonyms. The search should also cover the broadest scope encompassed by the claims. Based upon the claimed subject matter of the instant application, the following supplemental suggested search is presented:

Additional Class(es)/Subclass(es) should be searched:

713/500; and additional text searches as below:

(transfer$3 or send$3 ) near3 data

(first adj clock adj domain) and (second adj clock adj domain)

(two or dual) near3 (time or clock or frequency) near3 domains

(multiple or several or plurality) near3 registers

(first near2 (frequency or speed)) and (second near2 (frequency or speed)) and (third near2 (frequency or speed))

The search conducted is extremely broad and directed to the general area which does not reflect being directed to the claimed feature. For example, see L10 on page 2 of the AE Pre-Examination Search Document. There are 995 hits made by that search. There was no other search conducted using L10 to reasonably narrow the scope to reflect the claimed limitations. It is recommended that the conducted search considers both a broad coverage and a narrow coverage addressing the gist of the invention as claimed.

The additional search recommendations were confirmed with and recommended by a (primary) examiner in the pertinent art area.

With regard to the requirement of MPEP § 708.02(a)(I.)(I)(5) and item 6.2 above, Petitioner fails to identify where each limitation of the claim is disclosed by any of the references specifying where the limitation is disclosed in the cited reference. The petition briefly identifies where the

[1] MPEP 8th ed. rev 5 August 2006

preamble of the claim is disclosed in each of the references. The petition fails to address any of the claim limitations in the body of the claims, as is required. Further, the petition fails to address any portion by figure or column/lines where any of the limitations are disclosed in any of the cited prior art references.

With regard to the requirement of MPEP § 708.02(a)(I.)(I)(5) and item 6.3 above, Petitioner fails to provide a detailed explanation of how the claim is patentable over any of the references cited with particularly required by 37 CFR 1.111(b) and (c). Specifically, the detailed explanation referred to, in the petition, only states that the entire claim (recites the entire claim except the preamble) including each and every step is patentable over any of the cited references. However, the claim includes several generic steps that are well known in the art and admitted prior art in the specification, for example, "transmitting data from a first clock domain to a second clock domain"; "storing data in a register", "first clock domain operates at a first frequency"; and "second clock domain operates at a second frequency". The petition fails to indicate specific steps that are taken by the applicants which are patentable over the prior art methods steps.

In addition, Petitioner should ensure that the above discussion is directed to how the language of (each of) the claim(s is) **specifically** distinguishable and patentable from each of the references provided in requirement (6.1) above, ***rather than to repeat essentially the entirety of the claim(s)***. The office cannot infer or guess what Petitioner believes the differences between the claim(s) and the teaching of the prior art to be. Furthermore, it would be difficult to conclude that the pre-examination search was directed to the claimed invention if essentially none of the claimed limitations were found in the prior art deemed "most closely related" by Petitioner. Clarification is required.

Regarding to the requirement of MPEP § 708.02(a)(I.)(I)(5) and item II.6.5 above, the Accelerated Examination Support Document only identifies para. [0017 - Summary of the Invention] of the instant specification providing support for the claims. However, the requirement of MPEP § 708.02(a)(I.)(I)(5) and item II.6.5 above clearly states that the petitioner is required to **specifically identify what corresponding elements in the figures** and **specifically identify where the corresponding written description in the cited portions of the instant specification** can find support under 35 U.S.C. § 112, first paragraph **for each limitation of the claims**. A review of the para. [0017] indicates that the description on this page is essentially identical to the claimed language set forth in the claims. It is pointed out that the written description requirement has several policy objectives. The essential goal of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed. Another objective is to put the examiner in possession of what the applicant claims as the invention – the written description requirement implements the principle that a patent application must describe the technology that is sought to be patented; the requirement serves both to satisfy the inventor's obligation to disclose the technologic knowledge upon which the application is based and to demonstrate that the applicants were in possession of the invention that is claimed. Further, the written description requirement promotes the progress of expedite examination by ensuring that applicants adequately describe their inventions in sufficient detail in their applications in exchange for the right to take-up out of order of examination. Thus, a general statement that all limitations of

claim(s) can be found in all of the figures and pointing to the specification having a verbatim of the claim language cannot be accepted to satisfy such a requirement of MPEP § 708.02(a)(I.)(I)(5) and item II.6.5 above. A clarification and identification of support is required.

Clarification and identification of support for each limitation in the claim is required. Thus, the petition does not meet the conditions II. 5.2 - 5.3, 6.2, 6.3 & 6.5 above.

## DECISION

For the above-stated reasons, the petition is **DISMISSED**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given ***a single opportunity*** to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a) is permitted) from the date of this decision in order to be considered timely. Any request for reconsideration ***must fully address all of the deficiencies indicated above***. [emphasis added]

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Brian Johnson, Quality Assurance Specialist, at (571) 272-3595. If attempts to reach the undersigned by telephone are unsuccessful, Kakali Chaki, Quality Assurance Specialist, can be reached at (571) 272-3719.

Brian L. Johnson
Quality Assurance Specialist, WG 2110
Technology Center 2100

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. |
|---|---|---|---|---|
| 12/101,939 | 04/11/2008 | Anil Pothireddy | IN920070025US1/RKC100030 | 9220 |

76089 7590 10/03/2008
CARPENTER & ASSOCIATES
5 PIPESTEM COURT
ROCKVILLE, MD 20854

| EXAMINER | |
|---|---|
| LEE, THOMAS C | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2115 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 10/03/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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10/01/2008

CARPENTER & ASSOCIATES
5 PIPESTEM COURT
ROCKVILLE, MD 20854

In re Application of: POTHIREDDY, et al.
Serial No.: 12/101,939
Filed: April 11, 2008
Docket: IN920070025US1/RKC100030

Title: METHOD AND SYSTEM FOR REDUCING LATENCY IN DATA TRANSFER BETWEEN ASYNCHRONOUS CLOCK DOMAINS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the renewed petition filed on July 28, 2008 to make the above- identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d). The original petition, submitted on April 11, 2008 was dismissed in the decision mailed on June 26, 2008.

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the

examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not

file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

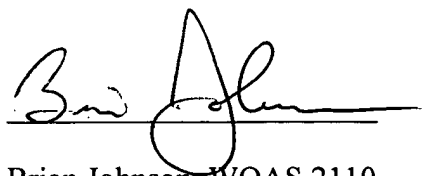
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
The twelve-month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application. In addition, Applicant is reminded that due to the dismissal of the previous petition submission, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Brian Johnson, Quality Assurance Specialist, at (571) 272-3595. If attempts to reach the undersigned by telephone are unsuccessful, Kakali Chaki, Quality Assurance Specialist, can be reached at (571) 272-3719.



Brian Johnson, WQAS 2110
Technology Center 2100
Computer Architecture, Software and Information Security

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PO BOX 435
JERUSALEM 91003
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DEC 03 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Yakov BAR-OR, et al | : | |
| Application No. 12/101,991 | : | DECISION ON PETITION |
| Filed: April 13, 2008 | : | TO WITHDRAW |
| Attorney Docket No. 415/49 | : | 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 3, 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 Bruce E. Lilling on behalf of the attorneys of record associated with Customer No. 24101.

The attorneys of record associated with Customer No. 24101 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: YAKOV BAR-OR
10 TIDHAR STREET
HAIFA
ISRAEL

cc: STRYKER GI LTD.
8 HAESHEL ST., BUSINESS AND
INDUSTRIAL PARK, P.O. BOX 3534
CAESAREA 38900
ISRAEL

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

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AUG 14 2008

In re Application of
Payne et al.
Application No. 12/101,999
Filed: N/A
Attorney Docket No. A9922

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed April 13, 2008.

The petition is dismissed.

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

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

The petition does not clearly indicate if Philip Chun cannot be reached or if he expressly refuses to sign the declaration after having been presented with the application papers (specification, claims and drawings). However, the petition does suggest both.

In regard to the inability to reach Mr. Chun, the applicable statute (35 U.S.C.§ 116) requires that a "diligent effort" have been expended in attempting to find or reach the non-signing inventor. *See* MPEP 409.03(a). The showing currently fails to demonstrate, with a documented showing, that a diligent effort was made to find or locate non-signing inventor Philip Chun, such that the declaration can be accepted under 37 CFR 1.47(a). Where inability to find or locate a named inventor(s) is alleged, 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 to locate the inventor.

Petitioner has not demonstrated that all efforts were expended in trying to locate inventor non-signing Chun. In this regard, petitioner should, at the very least, conduct a search of the regional or national registry(s). The results of such search should be made in any future petition for reconsideration. *See* MPEP 409.03(d). Additionally, petitioner should indicate what an inspection of Mr. Chun's personnel records reveal as to a current address, forwarding address, or an address of the nearest living relative? What does inspection of the phone directories for those address locations reveal? Further, petitioner should mail correspondence to the inventor's last known address, return receipt and/or forwarding address requested. If a forwarding address is provided, petitioner should then mail a complete copy of the application papers (specification, claims, drawings, oath, etc.) to Mr. Chun's address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. Moreover, petitioner should utilize search resources available on the internet. If the papers are returned and all other attempts to locate or reach the inventor, e.g., through personnel records, co-workers, or the Internet, etc., continue to fail, then applicant will have established that the inventor cannot be reached after diligent effort or has refused to join in the application. **The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein and should be accompanied by documentary evidence in support of the statement of facts.** It is important that the forthcoming communication contain statements of fact as opposed to conclusions.

In regard to a refusal by Mr. Chun to sign the declaration after having been presented with the application papers (specification, claims and drawings), where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration by the party to whom the refusal was made. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The declaration of Walter A. Blättler indicates that several unsuccessful telephone calls were made and letters were mailed. Some of these attempts did not reach Mr. Chun, such as the telephone calls of the Human Resources Department of ImmunoGen, Inc. and the mailings by registered mail by the U.S. Postal Service, which suggests that Mr. Chun could not be reached. Other communications merely did not receive a response, such as the telephone call by Dr. Thomas Chittenden that concluded in a voicemail message and the letter mailed by Mr. Bret Cohen, which suggests that Mr. Chun can be reached but chose not to sign. There is no indication on record that these communications involved presenting Mr. Chun with the application papers (specification, claims and drawings) so that he may make an informed decision before signing or refusing to sign. Any renewed petition should clearly state whether Mr. Chun cannot be found or expressly refuses to sign and should include facts in accordance with the standards presented in the preceding paragraphs.

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

| | |
|---|---|
| By mail: | Mail Stop PETITIONS<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Service Window<br>Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (571) 273-8300<br>ATTN: Office of Petitions |

Telephone inquiries should be directed to Christopher Bottorff at (571) 272-6692.

David Bucci
Petitions Examiner
Office of Petitions

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**2100 PENNSYLVANIA AVENUE, N.W.**
**SUITE 800**
**WASHINGTON DC 20037**

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DEC 15 2008

| | | |
|---|---|---|
| In re Application of | : | DECISION GRANTING STATUS |
| Payne et al. | : | UNDER 37 CFR 1.47(a) |
| Application No. 12/101,999 | : | |
| Deposited: April 13, 2008 | : | |
| Attorney Docket No. A9922 | : | |

This is in response to the renewed petition under 37 CFR 1.47(a), filed October 14, 2008.

The petition is **GRANTED.**

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application.

The application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in 37 CFR 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

This application is being referred to the Office of Patent Application Processing for pre-examination processing.

Telephone inquiries regarding this decision should be directed to Christopher Bottorff at (571) 272-6692.

Christopher Bottorff
Petitions Examiner
Office of Petitions

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Philip Chun
181 Pleasant Street, #25
Malden Massachusetts 02148

COPY MAILED
DEC 15 2008

In re Application of
Payne et al.
Application No. 12/101,999
Deposited: April 13, 2008
For: A CA6 ANTIGEN-SPECIFIC CYTOTOXIC CONJUGATE AND METHODS OF USING THE SAME

Dear Mr. Chun:

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 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 Christopher Bottorff at (571) 272-6692. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (571) 272-3150 or 1 (800) 972-6382 (outside the Washington, DC area).

/ /

Christopher Bottorff
Petitions Examiner
Office of Petitions

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

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INTELLECTUAL PROPERTY LAW DEPARTMENT
PO BOX 1895 MS 641
NEW HOLLAND PA 17557

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OFFICE OF PETITIONS

In re Application of
Benassi, et al.
Application No. 12/102,009
Filed: April 13, 2008
Attorney Docket No. 18952

: DECISION GRANTING PETITION
: AND WITHDRAWING THE
: HOLDING OF ABANDONMENT

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, or in the alternative to revive under 37 CFR 1.137(b), filed January 23, 2009.

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

The petition under 37 CFR 1.137(b) is **DISMISSED** as moot.

The above-identified application became abandoned for failure to timely file an executed oath or declaration in response to the Notice to File Missing Parts, mailed April 23, 2008. This Office action set an extendable period of two (2) months. No reply having been received, the application became abandoned on June 24, 2008. A Notice of Abandonment was mailed on December 29, 2008.

Petitioner states that he did not receive the Notice. To establish nonreceipt of an Office action, a petitioner must: 1) include a statement that the Office action was not received; 2) attest to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and 3) include a copy of the docket record where the nonreceived Office action would have been entered had it been received and docketed.[1] A proper docket report consists of a "docket record where the nonreceived Office action would have been entered had it been received and docketed."[2]

Here, petitioner has submitted a satisfactory master docket record showing all replies docketed for a due date of June 23, 2008. An entry for the instant application is absent, supporting the conclusion that the Notice was not received.

Accordingly, the holding of abandonment is **WITHDRAWN**.

Given the basis for granting this petition, consideration of the petition under 37 CFR 1.137(b) was not necessary. Accordingly, the $1,620 petition fee will be refunded to petitioner under separate cover.

The application is being forwarded to the Office of Patent Application Processing for pre-examination processing, using the executed declaration filed on January 23, 2009.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

---

[1] See MPEP 711.03(c)(II).

[2] Id.

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MARK YOUNG, P.A.
12086 FORT CAROLINE ROAD
UNIT 202
JACKSONVILLE, FL 32225

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APR 30 2009

**OFFICE OF PETITIONS**

In re Application of :
Fadi Kalaouze, Jr. :
Application No. 12/102,028 : ON PETITION
Filed: April 4, 2008 :
Attorney Docket No. FK08001 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 20, 2009, to revive the above-identified application.

The petition is **DISMISSED**.

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

The application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Nonprovisional Application (Notice), mailed May 2, 2008. The Notice set a period for reply of two (2) months and required additional claim fees. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned July 3, 2008. A Notice of Abandonment was mailed on January 8, 2009. On February 20, 2009, the present petition was filed.

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).

It is noted that petitioner submitted $105 for the additional claim fee. However, effective October 2, 2008, the small entity fee for independent claims in excess of three was increased to $110. Therefore, any fee amount paid on or after October 2, 2008 must be paid in the revised amount. There is no authorization to charge any fee deficiency to a deposit account found of record. Accordingly, the petition cannot be granted until the $5 balance of the additional claim fee is submitted.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

| | |
|---|---|
| By mail: | Mail Stop PETITIONS<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Service Window<br>Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (571) 273-8300<br>ATTN: Office of Petitions |
| By internet: | EFS-Web[1] |

Any questions concerning this matter may be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

1 www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)

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MARK YOUNG, P.A.
12086 FORT CAROLINE ROAD
UNIT 202
JACKSONVILLE, FL 32225

MAILED

JUL 15 2009

OFFICE OF PETITIONS

In re Application of
Fadi Kalaouze, Jr.
Application No. 12/102,028
Filed: April 14, 2008
Attorney Docket No. FK08001

ON PETITION

This is a decision in response to a communication filed May 12, 2009, which is being treated as a renewed petition under 37 CFR 1.137(b) to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely respond to a Notice to File Missing Parts mailed May 2, 2008. A Notice of Abandonment was mailed on July 3, 2008. On February 20, 2009, a petition under 37 CFR 1.137(b) was filed; however, the petition was dismissed in a decision mailed April 30, 2009. On May 12, 2009, the present petition was filed.

The present petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of the requisite additional claim fees; (2) the petition fee of $810; and (3) an adequate statement of unintentional delay.

The application is being referred to the Office of Patent Application Processing (OPAP) for further pre-examination processing.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to processing at OPAP should be directed to their hotline at (571) 272-4000.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

**MICHAEL A. ERVIN**
**8202 TALBOT COVE**
**AUSTIN TX 78746**

**MAILED**

MAR 29 2010

**OFFICE OF PETITIONS**

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| In re Application of | : | |
| Dale E. Polk, Jr., et al. | : | |
| Application No. 12/102,040 | : | DECISION ON PETITION |
| Filed: April 14, 2008 | : | |
| Attorney Docket No. 2007 022 USA-NONP | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 15, 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 November 30, 2009, as required by the Notice of Allowance and Fee(s) Due, mailed August 28, 2009. Accordingly, the date of abandonment of this application is December 1, 2009.

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.

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

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

Terri Johnson
Petitions Examiner
Office of Petitions

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18 JUN 2008

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SUITE 110
ORANGEBURG NY 10962-2100

| | | |
|---|---|---|
| In re Application of | : | |
| POMYTKIN et al. | : | DECISION ON |
| Application No.: 12/102,143 | : | |
| Filing Date: 14 April 2008 | : | PETITION |
| Attorney's Docket No.: J662-030 US | : | |
| For: SUBSTANCE AND METHOD FOR TREATING NEOPLASMS | : | 37 CFR 1. 137(b) |

This is a decision 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 in the United States Patent and Trademark Office (USPTO) on 14 April 2008.

## BACKGROUND

On 30 December 2005, applicant filed international application PCT/RU05/00688 and claims a priority date of 01 April 2005. Thus, the deadline for filing the basic national fee was thirty months from the international filing date or 01 October 2007.

On 14 April 2008, applicant filed the international application in United States as a utility application along with a petition to revive the international application. No transmittal letter accompanied the filing; however, the Electronic Acknowledgement Receipt indicated under "Application Type" that the application papers were filed as a "Utility under 35 U.S.C. 111(a)".

## 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 "the entire delay in filing the required reply from the due date for the

required reply until the filing of a grantable petition pursuant to this paragraph was unintentional"; and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(b).

With respect to Item (1), as set forth in MPEP section 711.03(c)(II)(A), the required reply is generally "the reply sufficient to have avoided abandonment, had such reply been timely filed." The MPEP notes that the filing of a continuation application under 35 U.S.C. 111(a) is considered an appropriate "required reply" under 37 CFR 1.137(b).

In the present circumstances, the "required reply" needed to revive international application PCT/RU03/00688 would be the filing of a U.S. national stage application of this international application under 35 U.S.C.371 (accompanied by, at least, the basic national fee) or a proper continuation of the international application filed under 35 U.S.C. 111(a).

Applicant identified the present application as a utility application under 35 U.S.C. 111(a) rather than a U.S. national stage filed under 35 U.S.C. 371(c). However, the present application is not a proper continuation of the international application in that the application does not include the proper continuity reference required for the application to be considered a continuation of the international application. Specifically, applicant did not file an ADS including a domestic priority claim. Nor did applicant make a reference in the form required by 37 CFR 1.78(a)(2)(i).[1] Accordingly, the present application is not, at this time, a proper continuation of the international application, and the filing of this application, therefore, cannot be treated as the "required reply" necessary to revive the international application.

Based upon the above, applicants have not satisfied Item (1) of a grantable petition, that is, applicants have not provided the "required reply".

Applicants paid the required petition fee, satisfying Item (2). Item (3) above is satisfied because the present 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 pursuant to this paragraph was unintentional".

In light of the above, Item (1) is not satisfied and the petition to revive is dismissed.

## CONCLUSION

For the reasons set forth above, the "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally under 37 CFR 1.137(b)" is

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[1] Specifically, the reference in the amendment to the specification must state the relationship of the present application to the international application, for example, "the present application is a continuation of the international application PCT/RU05/00688, filed December 30, 2005".

**DISMISSED without prejudice**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) months from the mail date of this decision. Any reconsideration request should be entitled "Renewed Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally under 37 CFR 1.137(b)" and must include the materials required to satisfy the outstanding requirements for a grantable petition, as discussed above and in the MPEP.

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

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|---|---|---|
| In re Application of | : | |
| POMYTKIN et al. | : | DECISION ON |
| Application No.: 12/102,143 | : | |
| Filing Date: 14 April 2008 | : | RENEWED PETITION |
| Attorney's Docket No.: J662-030 US | : | |
| For: SUBSTANCE AND METHOD FOR TREATING NEOPLASMS | : | Under 37 CFR 1. 137(b) |

This is a decision in response to applicant's "Renewed 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 26 June 2008.

## BACKGROUND

On 30 December 2005, applicant filed international application PCT/RU05/00688 and claims a priority date of 01 April 2005. Thus, the deadline for filing the basic national fee was thirty months from the international filing date or 01 October 2007.

On 14 April 2008, applicant filed the international application in United States as a utility application along with a petition to revive the international application. No transmittal letter accompanied the filing; however, the Electronic Acknowledgement Receipt indicated under "Application Type" that the application papers were filed as a "Utility under 35 U.S.C. 111(a)".

On 18 June 2008, a decision dismissing the petition was mailed to applicant, indicating that the proper reply as required by 37 CFR 1.137(b) had not been filed.

On 26 June 2008, applicant filed a response along with a "Request For Filing a Continuation or Division of an International Application" (Form PTO/SB13/PCT).

## DISCUSSION

Applicant was advised in the 18 June 2008 decision that: "In the present circumstances, the "required reply" needed to revive international application PCT/RU03/00688 would be the filing of a U.S. national stage application of this international application under 35 U.S.C.371 (accompanied by, at least, the basic national fee) or a proper continuation of the international application filed under 35 U.S.C. 111(a)." Applicant was further advised that:

> Applicant identified the present application as a utility application under 35 U.S.C. 111(a) rather than a U.S. national stage filed under 35 U.S.C. 371(c). However, the present application is not a proper continuation of the international application in that the application does not include the proper continuity reference required for the application to be considered a continuation of the international application. Specifically, applicant did not file an ADS including a domestic priority claim. Nor did applicant make a reference in the form required by 37 CFR 1.78(a)(2)(i). Accordingly, the present application is not, at this time, a proper continuation of the international application, and the filing of this application, therefore, cannot be treated as the "required reply" necessary to revive the international application.

(Emphasis added.)

Applicant has not filed the proper response based upon the above. The filing of "Request For Filing a Continuation or Division of an International Application" (Form PTO/SB13/PCT) is not responsive and does not satisfy the requirements. Specifically, the reference in the amendment to the specification must state the relationship of the present application to the international application, for example, "the present application is a continuation of the international application PCT/RU05/00688, filed December 30, 2005". Thus, applicant has not satisfied Item (1) of a grantable petition, that is, applicants have not provided the "required reply".

In light of the above, Item (1) is not satisfied and the petition to revive is dismissed.

## CONCLUSION

For the reasons set forth above, the "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally under 37 CFR 1.137(b)" is **DISMISSED without prejudice**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) months from the mail date of this decision. Any reconsideration request should be entitled "Renewed Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally under 37 CFR 1.137(b)" and must include the materials

required to satisfy the outstanding requirements for a grantable petition, as discussed above and in the MPEP.

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

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| In re Application of | : | |
| POMYTKIN et al. | : | DECISION ON |
| Application No.: 12/102,143 | : | |
| Receipt Date: 23 July 2008 | : | RENEWED PETITION |
| Attorney's Docket No.: J662-030 US | : | |
| For: SUBSTANCE AND METHOD FOR TREATING NEOPLASMS | : | UNDER 37 CFR 1. 137(b) |

This is a decision in response to applicant's "Renewed 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 23 July 2008.

## BACKGROUND

In a decision mailed on 01 July 2008, applicant's petition for revival of international application PCT/RU2005/000688 was dismissed without prejudice for failure to include all the requirements of a grantable petition. Specifically, applicant had not filed the "required reply" in the form of a proper continuation application filed under 35 U.S.C. 111(a).

On 23 July 2008, applicant filed the present renewed petition, accompanied by a preliminary amendment that included an amended first paragraph of the specification identifying the present application as a continuation of PCT/RU2005/000688, filed 30 December 2005.

## DISCUSSION

As noted above, applicant's 23 July 2008 renewed petition included an amendment adding to the specification the continuity reference required under 37 CFR 1.78(a)(2)(i) with respect to PCT/RU2005/000688.

Based on the above, the present application has now been properly identified as a continuation of the international application. As noted in the previous decision, a continuation application under 35 U.S.C. 111(a) is considered an appropriate "required reply" under 37 CFR

1.137(b). Accordingly, applicant has now submitted the "required reply," satisfying the final element of a grantable petition under 37 CFR 1.137(b). Revival of international application PCT/RU2005/000688 pursuant to 37 CFR 1.137(b) is therefore appropriate.

## CONCLUSION

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

International application PCT/RU2005/000688 is being revived for purposes of continuity only, and since continuity has been established by this decision reviving the international application, the international application is again abandoned in favor of the present continuing application number 12/102,143.

Cynthia M. Kratz
Attorney Advisor
Office of PCT Legal Administration

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

PTO/SB/130 (03-08)
Approved for use through 04/30/2008. OMB 0651- 0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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# PETITION TO MAKE SPECIAL BASED ON AGE FOR ADVANCEMENT OF EXAMINATION UNDER 37 CFR 1.102(c)(1)

## Application Information

| | | | | | |
|---|---|---|---|---|---|
| Application Number | 12102147 | Confirmation Number | 9607 | Filing Date | 2008-04-14 |
| Attorney Docket Number (optional) | TRANSMageSPECIAL | Art Unit | | Examiner | |
| First Named Inventor | Kamilo Feher | | | | |
| Title of Invention | Transmission of Signals in Cellular Systems and in Mobile Networks | | | | |

**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 |
|---|---|---|---|
| Kamilo | | Feher | |

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 | /Name/ | Date (YYYY-MM-DD) | 2008-04-13 |
| Name | Kamilo Feher | | |

PTO/SB/130 (03-08)
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# 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.

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In re Application of
Kamilo Feher

Application No. 12102147

Filed:

Attorney Docket No. TRANSMads14Apr08

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

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1) ,filed 14-APR-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.

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KAMILO FEHER
44685 COUNTRY CLUB DRIVE
EL MACERO CA 95618

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MAR 12 2009

OFFICE OF PETITIONS

In re Application of :
Kamilo Feher :
Application No. 12/102,147 : DECISION ON PETITION
Filed: 14 April 2008 : TO MAKE SPECIAL UNDER
Attorney Docket No. TRNSM 04set : 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed initially on 15 November 2008 and again on 18 November 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 the inventor that his age is over 65 years. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Zohreh Fay at 571-272-6051 or in her absence to the undersigned at 571-272-7099.

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 2611for action on the merits commensurate with this decision.

for David Bucci
Petitions Examiner
Office of Petitions

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**P O BOX 655474, M/S 3999**
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OFFICE OF PETITIONS

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| In re Application of | : | |
| Ido et al. | : | |
| Application No. 12/102,163 | : | DECISION ON PETITION |
| Filed: April 14, 2008 | : | |
| Attorney Docket No. TI-61001 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 8, 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 Notice to File Missing Parts of Nonprovisional Application (Notice), mailed May 12, 2008. The Notice set a period for reply of two (2) months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on July 13, 2008. A Notice of Abandonment was mailed January 15, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Oath or Declaration, the $130.00 surcharge fee, the Basic filing fee of $330.00; the Search fee of $540.00, and the Examination fee of $220.00, (2) the petition fee of $1,620.00, and (3) a proper statement of unintentional delay.

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

This application is being referred to the Office of Patent Application Processing for further processing in accordance with this decision on petition.

Joan Olszewski
Petitioner Examiner
Office of Petitions

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Paper No.

ALSTON & BIRD LLP
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101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE NC 28280-4000

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SEP 0 8 2009

OFFICE OF PETITIONS

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| In re Application of | : | |
| Schilling et al. | : | DECISION ON PETITION |
| Application No. 12/102,172 | : | PURSUANT TO |
| Filed: April 14, 2008 | : | 37 C.F.R. § 1.181(A) |
| Attorney Docket No.: | : | |
| 51375.342911 | : | |
| Title: INDUCTION HEATING DEVICE | : | |
| AND ASSOCIATED OPERATING AND | : | |
| SAUCEPAN DETECTION METHOD | : | |

This is a decision on the petition filed January 22, 2009, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

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

Receipt of a fully executed declaration is acknowledged. It is noted that the fee that is associated with the late submission of the same has not been received.

## BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Missing Parts (notice), mailed May 2, 2008, which set a shortened statutory period for reply of two months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on July 3, 2008. A notice of abandonment was mailed on January 7, 2009.

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

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

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

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

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

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

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

docket number, the mail date of the Office action and the due date for the response.

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

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

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

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

(Emphases added).

## ANALYSIS

Petitioner has indicated that the Office action was not received at the correspondence address of record[1] and that a search of the "file jacket and docket records" indicates the same.[2] The Office will construe this statement to mean that both the file jacket *and its contents* were reviewed, and Petitioner must notify the Office if this is not a correct interpretation of the statement contained in this petition.

1 Petition, page 2.
2 Id.

Petitioner has further included a copy of the file jacket and the master docket.

Petitioner's assertion of non-receipt has not been adequately supported, as will be now pointed out.

First, Petitioner has not provided a statement describing the system used for recording an Office communication received at the correspondence address of record with the USPTO, other than to indicate that Office correspondence is entered into both the file jacket and into an electronic docketing system by the name of "IP Master" upon receipt.[3] Second, Petitioner has not established that the docketing system is sufficiently reliable.

More specifically, Petitioner has indicated that IP Master generates a "Docket Control Sheet,"[4] which serves as the master docket. However, the record is silent as to whether this master docket is distributed to the responsible attorneys. **Is the master docket distributed to the responsible attorneys for their review, and if so, at what frequency**?

CONCLUSION

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

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,[5] hand-delivery,[6] or facsimile.[7] Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.[8]

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that

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3 Id.
4 Id. at 1.
5 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
6 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
7 (571) 273-8300- please note this is a central facsimile number.
8 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[9] All other inquiries concerning examination procedures should be directed to the Technology Center.

Paul Shanoski
Senior Attorney
Office of Petitions

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

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SEP 22 2009

OFFICE OF PETITIONS

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE NC 28280-4000

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|---|---|---|
| In re Application of | : | |
| Schilling et al. | : | DECISION ON RENEWED PETITION |
| Application No. 12/102,172 | : | PURSUANT TO |
| Filed: April 14, 2008 | : | 37 C.F.R. § 1.181(A) |
| Attorney Docket No.: | : | |
| 51375.342911 | : | |
| Title: INDUCTION HEATING DEVICE | : | |
| AND ASSOCIATED OPERATING AND | : | |
| SAUCEPAN DETECTION METHOD | : | |

This is a decision on the renewed petition filed September 17, 2009, pursuant to 37 C.F.R. § 1.181(a), requesting that the holding of abandonment in the above-identified application be withdrawn.

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

## BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Missing Parts (notice), mailed May 2, 2008, which set a shortened statutory period for reply of two months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on July 3, 2008. A notice of abandonment was mailed on January 7, 2009.

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

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

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

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

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

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

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

docket number, the mail date of the Office action and the due date for the response.

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

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

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

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

(Emphases added).

## ANALYSIS

An original petition pursuant to 37 C.F.R. § 1.181(a) was filed January 22, 2009, and included an indication that the Office action was not received at the correspondence address of record, and a statement that is being construed to mean that a search of both the file jacket and its contents indicates the same. Petitioner further included a copy of the file jacket and the master docket.

The original petition was dismissed via the mailing of a decision on September 8, 2009, for failure to sufficiently describe the system used for recording an Office communication received at the correspondence address of record with the USPTO, so as to establish that the docketing system is sufficiently reliable.

With this renewed petition, Petitioner has indicated that during the relevant time period, the docket control sheets that were generated by the electronic docketing system were distributed to the secretary of the responsible attorney on a weekly and monthly basis.[1] Moreover, the system generated an e-mail containing the due date for the response, which was sent directly to the responsible attorney.[2]

## CONCLUSION

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that the Office communication of May 2, 2008, was not received.

The fee that is associated with the late submission of an oath or declaration will be charged to Petitioner's Deposit account in due course, as authorized on the second page of this renewed petition.

The Office of Patent Application Processing (OPAP) will be notified of this decision, and jurisdiction over the application is transferred to OPAP, so that the application may receive further processing.

Petitioner will receive appropriate notifications regarding the fees owed, if any, and other information in due course from OPAP.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the withdrawal of the holding of abandonment has been acknowledged by OPAP in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to OPAP where that change of status must be effected - **the Office of Petitions cannot effectuate a change of status.**

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1 Renewed petition, pages 1-2.
2 Id.

The general phone number for OPAP is 571-272-4000. Telephone inquiries **regarding this decision** should be directed to the undersigned at (571) 272-3225.[3]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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

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BELL, BOYD & LLOYD LLP
P.O. Box 1135
CHICAGO, IL 60690

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JAN 22 2009

**OFFICE OF PETITIONS**

In re Application of Baerlocher :
Application No. 12/102,308 : Decision on Petition
Filing Date: April 14, 2008 :
Attorney Docket No. 112300-4595 :

This is a decision in response to the petition filed August 27, 2008, which requests the application be accorded a filing date of April 14, 2008, and requests entry of the drawings filed August 27, 2008. As will be discussed in this decision, the petition has been treated as a petition under 37 CFR 1.53(e).

The petition is **granted** to the extent indicated herein.

Procedural History:

On April 14, 2008, the application was inadvertently filed without drawings.

On August 1, 2008, the Office of Patent Application Processing mailed a "Notice of Incomplete Nonprovisional Application." The Notice stated drawings did not appear to be part of the application as filed and that a filing date would be accorded upon the submission of drawings.

On August 27, 2008, petitioner filed the instant petition and a petition fee of $400. Petitioner requests the application include the inadvertently omitted drawings on the basis that the application as filed contained a proper priority claim under 37 CFR 1.55 or 1.78.

Petitioner has not filed an amendment pursuant to 37 CFR 1.57(a) to add the drawings.

Discussion:

In order to add material pursuant to 37 CFR 1.57(a), one must always file an amendment. However, a petition under 37 CFR 1.57 and the $400 fee is only necessary if the application is not entitled to a filing date absent the missing material.

As a courtesy, the Office has chosen to initially treat the petition as a petition under 37 CFR 1.53(e) in order to determine if the application should have been accorded a filing date without the drawings. If the application should have been accorded a filing date without the drawings, then a petition under 37 CFR 1.57 is unnecessary and the $400 fee is refundable.

A review of the application papers filed April 14, 2008, indicates the papers included eight method claims. MPEP 601.01(f) states,

> It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

Pursuant to MPEP 601.01(f), drawings should not have been required in order to accord the application a filing date. In other words, the Office should have accorded the application a filing date without the drawings.

The Office should have granted the application a filing date of April 14, 2008, and mailed a Notice of Omitted Items instead of a Notice of Incomplete Nonprovisional Application. As stated in MPEP 601.01(g) under the section entitled, "Application Entitled to a Filing Date," applicant may submit an *amendment* to include the inadvertently omitted portion of the drawing(s) pursuant to 37 CFR 1.57(a):

> [If the] application was filed on or after September 21, 2004, and contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application that was present on the filing date of the application, and the omitted portion of the drawing(s) was inadvertently omitted from the application and is completely contained in the prior-filed application.

Since the application is entitled to a filing date without the drawings, an amendment pursuant to 37 CFR 1.57(a) does not need to be accompanied by a petition under 37 CFR 1.57 and the petition fee of $400 has been refunded to petitioner's deposit account.

The original application papers will include only those application papers present on the date of deposit.

The drawings filed August 27, 2008, will not be entered. If petitioner wishes for drawings to be entered, a formal amendment must be filed pursuant to 37 CFR 1.57(a). An amendment adding the drawings will be reviewed for new matter by the examiner in due course.

Please note an amendment pursuant to 37 CFR 1.57(a) must comply with the requirements of 37 CFR 1.121. For example, per 37 CFR 1.121(d), any new drawings added to an application must include in the top margin the label "New Sheet." Petitioner may wish to file a preliminary amendment to ensure the addition of the new drawings complies with the requirements of 37 CFR 1.121.

Pursuant to this decision, the application will be referred to the Office of Patent Application Processing for:

- **correction of the filing date to April 14, 2008**;

- **for indication in Office records, as appropriate, that "0" sheets of drawings were present on filing** and
- **for issuance of a filing receipt**.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Anthony Knight
Supervisory Petitions Examiner
Office of Petitions

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20 CHURCH STREET
22ND FLOOR
HARTFORD CT 06103

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SEP 23 2008

**OFFICE OF PETITIONS**

In re Application of :
Chen, et al. :
Application No. 12/102,333 : DECISION ACCORDING STATUS
Filed: April 14, 2008 : UNDER 37 CFR 1.47(a)
Attorney Docket No. FIS920070368US1:

This is in response to the petition under 37 CFR 1.47(a), filed August 19, 2008.

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

On petition, petitioner has established that inventor Wann has refused to sign the application papers. Specifically, petitioner has attested that a copy of the application paper were e-mailed to Wann, but a signed declaration was not returned. Furthermore, petitioner attested that multiple phone conversations were held with Wann, in which Wann was not cooperative.

The above-identified application and papers have been reviewed and found to be in compliance with 37 CFR 1.47(a). Accordingly, the above-identified application is hereby accorded Rule 1.47(a) status. As provided in 37 CFR 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the last known address provided on the declaration. Notice of the filing of this application will also be published in the Official Gazette.

The $200 petition fee has been charged to Deposit Account No. 06-1130, as authorized.

The matter is being forwarded to the Office of Patent Application Processing for pre-examination.

Telephone inquiries related to this decision may be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

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Alexandria, VA 22313-1450
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CLEMENT WANN
1170 BARRETT CIRCLE WEST
CARMEL NY 10512

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SEP 2 3 2008

**OFFICE OF PETITIONS**

In re Application of
Chen, et al.
Application No. 12/102,333
Filed: April 14, 2008
Title: Finfet Devices from Bulk Semiconductor and Methods for Manufacturing the Same

LETTER

Dear Mr. Wann:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 USC 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 joint 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, agent of record 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 Petitions Attorney Cliff Congo at (571)272-3207. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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JUL 15 2009

REINHART BOERNER VAN DEUREN P.C.
2215 PERRYGREEN WAY
ROCKFORD IL 61107

In re Application of
Scott Seville
Application No. 12/102,342
Filed: April 14, 2008
Attorney Docket No. 506789

DECISION ON REQUEST TO PARTICIPATE IN PATENT PROSECUTION HIGHWAY PILOT 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) pilot program and the petition under 37 CFR 1.102(d), filed April 1, 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 UKIPO;
(2) 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 UKIPO application(s);
(3) Examination of the U.S. application has not begun;
(4) Applicant must submit a copy of all the office actions from each of the UKIPO application(s) containing the allowable/patentable claim(s) that are the basis for the request.
(5) Applicant must submit an IDS listing the documents cited by the UKIPO examiner in the UKIPO office action along with copies of documents except U.S. patents or U.S. patent application publications; and
(6) 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 Ram R. Shukla at 571-272-0735.

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.

Ram R. Shukla, Ph.D.
Supervisory Patent Examiner
TC 1600

RAM R. SHUKLA, PH.D.
SUPERVISORY PATENT EXAMINER

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. |
|---|---|---|---|---|
| 12/102,350 | 04/14/2008 | Masahiro Sugiura | MNL-2018-1972 | 9994 |

7590 08/06/2009

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

| EXAMINER | |
|---|---|

| ART UNIT | PAPER NUMBER |
|---|---|
| 2612 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/06/2009 | PAPER |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Mimi Farmer

Patent Publication Branch
Office of Data Management

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Credit Card Refund Total: $510.00

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Adjustment date: 08/07/2009 NFARMER
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# PETITION TO MAKE SPECIAL BASED ON AGE FOR ADVANCEMENT OF EXAMINATION UNDER 37 CFR 1.102(c)(1)

## Application Information

| | | | | | |
|---|---|---|---|---|---|
| Application Number | 12/102,388 | Confirmation Number | 1056 | Filing Date | 2008-04-14 |
| Attorney Docket Number (optional) | 080111 | Art Unit | | Examiner | |
| First Named Inventor | William Morris Harvey | | | | |
| Title of Invention | ANALYZING RETURN ON INVESTMENT OF ADVERTISING CAMPAIGNS USING CROSS-CORRELATION OF MULTIPLE DATA SOURCES | | | | |

**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 |
|---|---|---|---|
| William | Morris | Harvey | |

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 | /Michael D. Lazzara/ | Date (YYYY-MM-DD) | 2008-04-15 |
| Name | Michael D. Lazzara | Registration Number | 41142 |

PTO/SB/130 (03-08)
Approved for use through 04/30/2008. OMB 0651- 0031
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# 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.

# UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Application of
William Morris Harvey

Application No. 12102388

Filed:

Attorney Docket No. 080111

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

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1) ,filed 15-APR-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.

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**PATENT DOCKET CLERK**
**COWAN, LIEBOWITZ & LATMAN, P.C.**
**1133 AVENUE OF THE AMERICAS**
**NEW YORK NY 10036**

MAILED

JUL 26 2010

OFFICE OF PETITIONS

In re Application of :
Charles H. BOXENBAUM, et al :
Application No. 12/102,393 : DECISION ON PETITION
Filed: April 14, 2008 : TO WITHDRAW
Attorney Docket No. 26913-000-CONT : 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 14, 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 37 CFR 10.40(c).

The request was signed by Mark Montague on behalf of the attorneys of record associated with Customer No. 32137.

The attorneys of record associated with Customer No. 32137 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The correspondence address for future communications from the Office has been changed and the new correspondence address is indicated below.

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

/dcg/
Diane C. Goodwyn
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/102,393 | 04/14/2008 | Charles H. Boxenbaum | 26913-000-CONT |

**CONFIRMATION NO. 1072**

**POWER OF ATTORNEY NOTICE**

32137
PATENT DOCKET CLERK
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 AVENUE OF THE AMERICAS
NEW YORK, NY 10036

Date Mailed: 07/22/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 06/14/2010.

- 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.

/dcgoodwyn/

---

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

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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS MN 55402-0903

In re Application of:
HJULBERG, LISA MARIE
Serial No.: 12/102,424
Filed: April 14, 2008

Title: **METHOD AND APPARATUS FOR IMPLEMENTING DISTINCTIVE ALERTS**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on November 23, 2009 to make the above-identified application special for accelerated examination procedure 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 application as filed is not eligible for accelerated examination under 37 C.F.R. § 1.102(d) because the application, at the time of filing, was not complete. A "Notice to File Missing Parts of Nonprovisional Application" was mailed on May 1, 2008. Additionally, the petition and

supporting documentation were submitted on November 23, 2009, not upon filing of the application papers.

Any inquiry regarding this decision should be directed to Ken Wieder, Quality Assurance Specialist, at (571) 272-2986.

Kenneth A. Wieder
Quality Assurance Specialist
Technology Center 2600
Communications

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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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WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI OH 45202

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MAR 19 2009

OFFICE OF PETITIONS

In re Application of
Charles C. Keil et al.
Application No. 12/102,425
Filed: April 14, 2008
Attorney Docket No. MIDTF-440P2

: DECISION ACCORDING STATUS
: UNDER 37 CFR 1.47(a)

This is in response to the petition filed under 37 CFR 1.47(b) on November 5, 2008, which is being treated under 37 CFR 1.47(a).

The petition is **GRANTED**.

The above-identified application was filed on April 14, 2008 with an unsigned Oath or Declaration. Accordingly, on May 21, 2008, a Notice to File Missing Parts was mailed requiring, *inter alia*, a properly signed oath or declaration in compliance with 37 CFR 1.63.

In response thereof, a declaration signed by joint inventor John A. Owczarczak and the instant petition seeking status under 37 CFR 1.47(b) was filed claiming that Charles C. Keil refuses to sign the oath or declaration and thus to join in the application.

At the outset, petitioner is advised that if none of the named inventor(s) will sign the oath or declaration, a petition under 37 CFR 1.47(b) must be filed. If some of the named inventors signed the oath or declaration and one or more of the named inventors have not signed the declaration, a petition under 37 CFR 1.47(a) must be filed. In the instant case, two inventors have been named but the oath or declaration is missing the signature of only one of the named inventors, thus, this petition will be treated under 37 CFR 1.47(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The petition bears proof that the application papers were sent to Mr. Keil and that he

has verbally refused, in a telephone conversation with David W. Dorton, Registration No. 51,625, Attorney of Record, to execute the oath or declaration and thus, to cooperate with the filing of the instant application. The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). In view thereof, this application is hereby accorded Rule 1.47(a) status.

Thus, as provided in Rule 1.47c, this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

The petition fee, four month extension of time fee and surcharge for late filing have been applied.

This matter is being referred to the Office of Patent Application Processing for further pre-examination processing.

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, NY 10112-3801

| | |
|---|---|
| In re Application of | : DECISION ON REQUEST TO |
| Hideo KIYOTA | : PARTICIPATE IN PATENT |
| Application No. 12/102431 | : PROSECUTION HIGHWAY |
| Filed: April 14, 2008 | : PILOT PROGRAM AND PETITION |
| Attorney Docket No. 03504.000400 | : 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 July 10, 2008 and the preliminary amendment, filed April 14, 2008, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH pilot program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the JPO, note where the JPO 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 JPO application with similar claims and the JPO priority 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 to obtain a copy from 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), 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 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 claims(s) or

ii. if the allowable/patentable claims(s) are from "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 SAD; however, if the USPTO is unable to obtain a copy of 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, 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 JPO examiner in the JPO 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 pilot program and petition comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Kathryn Gorgos at 571 272-1012.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://www.uspto.gov/ebc/index.html.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Kathryn Gorgos
TQAS TC 1700

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**K&L GATES LLP**
**P.O. BOX 1135**
**CHICAGO, IL 60690**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application | : | |
| Riley et al. | : | DECISION ON PETITION |
| Application No. 12/102,456 | : | TO WITHDRAW |
| Filed: April 14, 2008 | : | FROM RECORD |
| Attorney Docket No. 3716069-00006 | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b) filed April 19, 2010, which is being treated as a request to withdraw from employment in a proceeding before the Office under 37 C.F.R. § 10.40.

The request is **DISMISSED**.

A review of the file record indicates that K & L LLP was not appointed power of attorney in this patent application and was only designated as the correspondence address of record. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

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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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

Oppenheimer Wolff & Donnelly LLP
Plaza VII, Suite 3300
45 South Seventh Street
Minneapolis MN 55402-1609

In re Application of:
BICHENO, RICHARD M., et al.
Serial No.: 12/102,533
Filed: April 14, 2008

Title: **USING AUDIO TO DETECT CHANGES TO THE PERFORMANCE OF AN APPLICATION**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 14, 2008, to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions set forth under section I. above are considered to have been met. However, the petition fails to comply with conditions set forth under section II. items 5.2, 5.3 and 6.1.

For these reasons cited above, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirement in items 5.2 and 5.3 above, the preexamination search document provided with the instant petition is deficient as follows: The US field of search and database searches which are to be provided under section 8(A) are not sufficient. In addition to the search areas provided, applicant would also need to search in the following class/ subclasses: 340/384.7, 691.1, 691.3; 702/182.

Regarding the requirement in item 6.1 above, the accelerated examination support document only discuses four references deemed most closely related to the subject matter of the claims. However, the IDS lists several additional references. All references deemed most closely related to the subject matter of the claims must be discussed in the accelerated examination support document.

If any request for reconsideration is filed, an updated preexamination search must be conducted as per items 5.2 and 5.3 above, and the Preexamination Search Document must be amended to indicate such; and the Accelerated Examination Support Document must also be amended to include the necessary reference and discussion of any newly found and cited prior art in accordance with all of items 6 through 6.6 above.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Ken Wieder, Quality Assurance Specialist, at (571) 272-2986.

Kenneth A. Wieder
Quality Assurance Specialist
Technology Center 2600
Communications

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Oppenheimer Wolff & Donnelly LLP
Plaza VII, Suite 3300
45 South Seventh Street
Minneapolis MN 55402-1609

In re Application of:
BICHENO, RICHARD M., et al.
Serial No.: 12/102,533
Filed: April 14, 2008

Title: **USING AUDIO TO DETECT CHANGES TO THE PERFORMANCE OF AN APPLICATION**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on August 4, 2008 requesting reconsideration that the above-identified application be made special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the

examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

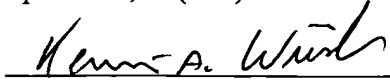
   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.
Any inquiry regarding this decision should be directed to Ken Wieder, Quality Assurance Specialist, at (571) 272-2986.



Kenneth A. Wieder
Quality Assurance Specialist
Technology Center 2600
Communications

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P.O. Box 1450
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**MUNCY, GEISSLER, OLDS & LOWE, PLLC**
**4000 LEGATO ROAD**
**SUITE 310**
**FAIRFAX VA 22033**

MAILED

JUN 01 2010

OFFICE OF PETITIONS

In re Application of :
Tung-Tsai LIAO, et al :
Application No. 12/102,553 : NOTICE
Filed: April 14, 2008 :
Attorney Docket No. 3722/0507PUS1 :

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

cc: JOE MCKINNEY MUNCY
MUNCY, GEISSLER, OLDS
LOWE, PLLC
PO BOX 1364
FAIRFAX, VA 22038-7140

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**SHEPPARD, MULLIN, RICHTER & HAMPTON LLP**
**333 SOUTH HOPE STREET**
**48TH FLOOR**
**LOS ANGELES CA 90071-1448**

**COPY MAILED**

JUL 31 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Wideman et al. | : | DECISION ON PETITION |
| Application No. 12/102,590 | : | TO WITHDRAW |
| Filed: April 14, 2008 | : | FROM RECORD |
| Attorney Docket No. 16HC-134320 | : | |

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 26, 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 Daniel N. Yannuzzi on behalf of all attorneys of record who are associated with customer No. 30764.

All attorneys/agents associated with the Customer Number 30764 have been withdrawn. Applicants are reminded that there is no attorney of record at this time.

The correspondence address of record remains unchanged.

Currently, there is no outstanding Office action that requires a reply.

Telephone inquires concerning this decision should be directed to Petitions Examiner Joan Olszewski at (571) 272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
www.uspto.gov

SJM/AFD-WILEY
14901 DEVEAU PLACE
MINNETONKA MN 55345-2126

APR 24 2008

In re Application of: Cox, James L., et al.
Application No.: 12/102,592
Filed: April 14, 2008
Title: SURGICAL SYSTEM AND PROCEDURE FOR TREATMENT OF MEDICALLY REFRACTORY ATRIAL FIBRILLATION

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 14, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is GRANTED.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

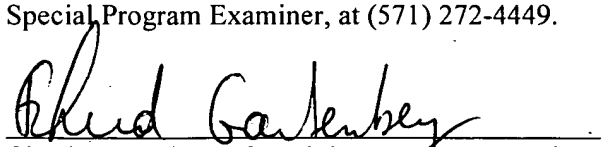
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Ehud Gartenberg, TC 3700 Special Program Examiner, at (571) 272-4828. In his absence, an inquiry can be directed to Jessica Harrison, Special Program Examiner, at (571) 272-4449.



Ehud Gartenberg, Special Programs Examiner
Technology Center 3700

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# BIB DATA SHEET

**CONFIRMATION NO. 1550**

| SERIAL NUMBER | FILING or 371(c) DATE<br>RULE | CLASS | GROUP ART UNIT | ATTORNEY DOCKET NO. |
|---|---|---|---|---|
| 12/102,654 | 04/14/2008 | 600 | 3735 | DEXCOM.016DV1 |

**APPLICANTS**

Paul V. Goode JR., Cherry Hill, NJ;
James H. Brauker, Cement City, MI;
Apurv U. Kamath, San Diego, CA;
Victoria Carr-Brendel, San Diego, CA;

**** CONTINUING DATA ***************************

This application is a DIV of 10/633,367 08/01/2003

**** FOREIGN APPLICATIONS ***************************

**** IF REQUIRED, FOREIGN FILING LICENSE GRANTED **** ** SMALL ENTITY **

05/01/2008

| Foreign Priority claimed ☐ Yes ☑ No<br>35 USC 119(a-d) conditions met ☐ Yes ☑ No<br>Verified and Acknowledged /ROBERT L NASSER/ Examiner's Signature | ☐ Met after Allowance<br>Initials | STATE OR COUNTRY | SHEETS DRAWINGS | TOTAL CLAIMS | INDEPENDENT CLAIMS |
|---|---|---|---|---|---|
| | | NJ | 14 | 32 | 2 |

**ADDRESS**

KNOBBE, MARTENS, OLSEN & BEAR, LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614
UNITED STATES

**TITLE**

SYSTEM AND METHODS FOR PROCESSING ANALYTE SENSOR DATA

| FILING FEE RECEIVED | | |
|---|---|---|
| 1085 | FEES: Authority has been given in Paper No._____ to charge/credit DEPOSIT ACCOUNT No._____ for following: | ☐ All Fees<br>☐ 1.16 Fees (Filing)<br>☐ 1.17 Fees (Processing Ext. of time)<br>☐ 1.18 Fees (Issue)<br>☐ Other _____<br>☐ Credit |

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**P.O. BOX 997**
**ROCKWALL, TX 75087**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Peter C. Salaverry | : | DECISION ON PETITION |
| Application No. 12/102,668 | : | TO WITHDRAW |
| Filed: April 14, 2008 | : | FROM RECORD |
| Attorney Docket No. SKZW-1 | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 1, 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 Marlin R. Smith, on behalf of all practitioners of record who are associated with Customer Number 20558.

All attorneys/agents associated with the Customer Number 20558 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 outstanding Office actions that require a reply from the applicant.

Telephone inquires concerning this decision should be directed to Alicia Kelley at (571) 272-6059. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

cc: PETER C. SALAVERRY
3401 MAIN STREET SUITE B
DALLAS, TX 75226

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/102,668 | 04/14/2008 | Peter C. SALAVERRY | SKZW-1 |

**CONFIRMATION NO. 1574**

**POWER OF ATTORNEY NOTICE**

20558
SMITH IP SERVICES, P.C.
P.O. Box 997
Rockwall, TX 75087

*OC00000037186720*

Date Mailed: 08/03/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 05/01/2009.

- 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.

/atkelley/

---

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/102,690 | 04/14/2008 | Chibwe Chungu | 2971-8314.1US (64636A) | 1632 |

7590 01/12/2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |
| ART UNIT | PAPER NUMBER |
| 1638 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 01/12/2010 | 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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TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

JAN 1 2 2010

In re Application of:
Chungu et al.
Serial No.: 12/102,690
Filed: April 14, 2008
Attorney Docket No.: **2971-8314.1US**
**(64636A)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed December 29, 2009, to expunge information from the above identified application. This application has not been allowed.

Petitioner requests that the Declaration under CFR 1.132 submitted to the Patent Office on December 29, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

This is an examined application which is currently under non-final rejection. As such the information provided has been reviewed, in part, but proceedings in the application have not been terminated. As stated in M.P.E.P. 724, upon allowance or other action closing prosecution in an application, petition may be made for return of Proprietary information. The information cannot be expunged at this time.

The petition is **DISMISSED**. Petitioner may resubmit the petition subsequent to a Notice of Allowability or *ex parte Quayle* action being mailed in the application. No additional petition fee will be required at that time.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/102,690 | 04/14/2008 | Chibwe Chungu | 2971-8314.1US (64636A) | 1632 |

7590 03/31/2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1638 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/31/2010 | 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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Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

MAR 3 1 2010

In re Application of:
Chungu et al.
Serial No.: 12/102,690
Filed: April 14, 2008
Attorney Docket No.: **2971-8314.1US**
**(64636A)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed March 17, 2010, to expunge information from the above identified application. This application has been allowed.

Petitioner requests that the Declaration under 37 CFR 1.132 submitted to the Patent Office on November 3, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

The reasons set forth in this petition establishes to the satisfaction of the Director that expungement of the information is appropriate. The file entry for this document has been closed and as such the document is no longer publicly available, which is the IFW equivalent to removal of a paper document from a paper file wrapper.

Therefore, petitioner's petition is GRANTED.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/102,694 | 04/14/2008 | Eric Ameres | 1087.268.001 | 1639 |

4617 7590 06/02/2008

LEVISOHN, BERGER , LLP
61 BROADWAY , 32ND FLOOR
NEW YORK, NY 10022

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2621 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/02/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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LEVISOHN, BERGER , LLP
61 BROADWAY , 32ND FLOOR
NEW YORK NY 10022

In re Application of:
Eric AMERES, et al.
Serial No.: 12/102,694
Filed: April 14, 2008

Title: **CONTEXT-BASED SYNCHRONIZATION FOR TERMINAL DEVICES**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 14, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions set forth under section I. above are considered to have been met. However, the petition fails to comply with conditions set forth under section II. , items 6.2 and 6.3.

Under the section "Identification of Limitations Disclosed By References", there is no discussion of any of the cited references disclosing any of the claimed limitations of claims 3, 6, or 10. However, under the section "Detailed Explanation of Patentability", each of claims 3, 6 and 10 are stated as having no patentable features if the independent claim it depends from is found unpatentable. This appears inconsistent and is confusing. If there are no patentable features in claims 3, 6, and 10, then there should be a clear identification where those claimed limitations are disclosed by at least one of the cited references. Clarification is required.

For the reason cited above, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Krista Zele, Quality Assurance Specialist, at (571) 272-7288.

/Krista Zele/

Krista Zele
Quality Assurance Specialist
Technology Center 2600
Communications

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Alexandria, VA 22313-1450
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MAIL

SEP 17 2008

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

LEVISOHN, BERGER , LLP
61 BROADWAY , 32ND FLOOR
NEW YORK NY 10022

In re Application of:
AMERES, ERIC et al,
Serial No.: 12/102,694
Filed: April 14, 2008

Title: **VIDEO COMPRESSION AND ENCODING METHOD**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on July 01, 2008 requesting reconsideration to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

All of the requirements to correct the deficiencies outlined in the petition decision mailed June 02, 2008 have been met.

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the

examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:

To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

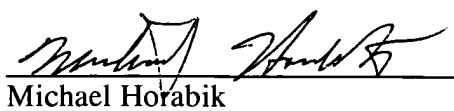
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Michael Horabik, Quality Assurance Specialist, at (571) 272-3068.



Michael Horabik
Quality Assurance Specialist
Technology Center 2600
Communications

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P.O. Box 1450
Alexandria, VA 22313-1450
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**DUNLAP CODDING, P.C.**
**PO BOX 16370**
**OKLAHOMA CITY, OK 73113**

MAILED

JUL 30 2009

OFFICE OF PETITIONS

In re Application of :
Rodney K. Tweten :
Application No. 12/102,696 : ON PETITION
Filed: April 14, 2008 :
Attorney Docket No. 5864.067 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 4, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to file a complete reply to the Notice to File Missing Parts of Nonprovisional Application (Notice), May 2, 2008. A Notice of Abandonment was mailed February 3, 2009. On May 4, 2009, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of the surcharge of $65 as set forth in 37 CFR 1.16(f); (2) the petition fee of $810; and (3) an adequate statement of unintentional delay.

This application file is being referred to the Office of Patent Application Processing (OPAP) for further pre-examination processing.

Telephone inquiries concerning this decision should be directed to Alicia Kelley at (571) 272-6059. Telephone inquiries related to OPAP processing should be directed to their hotline at (271) 272-4000.

/SDB/

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/102,704 | 04/14/2008 | Chibwe Chungu | 2971-8308.1US (64628A) | 1657 |

7590 01/12/2010

Edgar R. Cataxinos,
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1638 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 01/12/2010 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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JAN 12 2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

In re Application of:
Chungu et al.
Serial No.: 12/102,704
Filed: April 14, 2008
Attorney Docket No.: **2971-8310.1US**
**(64628 A)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed December 29, 2009, to expunge information from the above identified application. This application has not been allowed.

Petitioner requests that the Declaration under CFR 1.132 submitted to the Patent Office on December 29, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

This is an examined application which is currently under non-final rejection. As such the information provided has been reviewed, in part, but proceedings in the application have not been terminated. As stated in M.P.E.P. 724, upon allowance or other action closing prosecution in an application, petition may be made for return of Proprietary information. The information cannot be expunged at this time.

The petition is **DISMISSED**. Petitioner may resubmit the petition subsequent to a Notice of Allowability or *ex parte Quayle* action being mailed in the application. No additional petition fee will be required at that time.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/102,704 | 04/14/2008 | Chibwe Chungu | 2971-8308.1US (64628A) | 1657 |

7590 03/31/2010

Edgar R. Cataxinos,
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

| ART UNIT | PAPER NUMBER |
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Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

In re Application of:
Chungu et al.
Serial No.: 12/102,704
Filed: April 14, 2008
Attorney Docket No.: **2971-8308.1US**
**(64628A)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed March 17, 2010, to expunge information from the above identified application. This application has been allowed.

Petitioner requests that the Declaration under 37 CFR 1.132 submitted to the Patent Office on December 29, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

The reasons set forth in this petition establishes to the satisfaction of the Director that expungement of the information is appropriate. The file entry for this document has been closed and as such the document is no longer publicly available, which is the IFW equivalent to removal of a paper document from a paper file wrapper.

Therefore, petitioner's petition is GRANTED.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/102,716 | 04/14/2008 | Chibwe Chungu | 2971-8309.1US (64629A) | 1683 |

7590 01/12/2010

Edgar R. Cataxinos,
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
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| MCELWAIN, ELIZABETH F | |
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| 1638 | |

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Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

JAN 1 2 2010

In re Application of:
Chungu et al.
Serial No.: 12/102,716
Filed: April 14, 2008
Attorney Docket No.: **2971-8309.1US (64629A)**

: PETITION DECISION

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The petition is **DISMISSED**. Petitioner may resubmit the petition subsequent to a Notice of Allowability or *ex parte Quayle* action being mailed in the application. No additional petition fee will be required at that time.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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| 12/102,716 | 04/14/2008 | Chibwe Chungu | 2971-8309.1US (64629A) | 1683 |

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Edgar R. Cataxinos,
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |
| **ART UNIT** | **PAPER NUMBER** |
| 1638 | |

| MAIL DATE | DELIVERY MODE |
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Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

In re Application of:
Chungu et al.
Serial No.: 12/102,716
Filed: April 14, 2008
Attorney Docket No.: **2971-8309.1US**
**(64629A)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed March 17, 2010, to expunge information from the above identified application. This application has been allowed.

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The reasons set forth in this petition establishes to the satisfaction of the Director that expungement of the information is appropriate. The file entry for this document has been closed and as such the document is no longer publicly available, which is the IFW equivalent to removal of a paper document from a paper file wrapper.

Therefore, petitioner's petition is GRANTED.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/102,726 | 04/14/2008 | Chibwe Chungu | 2971-8312.1US (64633A) | 1700 |

7590 01/12/2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

| ART UNIT | PAPER NUMBER |
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Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

In re Application of:
Chungu et al.
Serial No.: 12/102,726
Filed: April 14, 2008
Attorney Docket No.: **2971-8312.1US (64633A)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed December 29, 2009, to expunge information from the above identified application. This application has not been allowed.

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Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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|---|---|---|---|---|
| 12/102,726 | 04/14/2008 | Chibwe Chungu | 2971-8312.1US (64633A) | 1700 |

7590 03/22/2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
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| MCELWAIN, ELIZABETH F | |
| **ART UNIT** | **PAPER NUMBER** |
| 1638 | |

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P.O. Box 1450
Alexandria, VA 22313-1450
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Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

In re Application of:
Chungu et al.
Serial No.: 12/102,726
Filed: April 14, 2008
Attorney Docket No.: **2971-8312.1US (64633A)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed March 17, 2010, to expunge information from the above identified application. This application has not been allowed.

Petitioner requests that the Declaration under CFR 1.132 submitted to the Patent Office on December 29, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

The reasons set forth in this petition establishes to the satisfaction of the Director that expungement of the information is appropriate. The file entry for this document has been closed and as such the document is no longer publicly available, which is the IFW equivalent to removal of a paper document from a paper file wrapper.

Therefore, petitioner's petition is GRANTED.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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. |
|---|---|---|---|---|
| 12/102,747 | 04/14/2008 | Chibwe Chungu | 2971-8310.1US (64630A) | 1750 |

7590 01/12/2010

Edgar R. Cataxinos,
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1638 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 01/12/2010 | 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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Alexandria, VA 22313-1450
www.uspto.gov

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

JAN 1 2 2010

In re Application of:
Chungu et al.
Serial No.: 12/102,747
Filed: April 14, 2008
Attorney Docket No.: **2971-8310.1US (64630A)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed December 29, 2009, to expunge information from the above identified application. This application has not been allowed.

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The petition is **DISMISSED**. Petitioner may resubmit the petition subsequent to a Notice of Allowability or *ex parte Quayle* action being mailed in the application. No additional petition fee will be required at that time.

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Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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|---|---|---|---|---|
| 12/102,747 | 04/14/2008 | Chibwe Chungu | 2971-8310.1US (64630A) | 1750 |

7590 03/31/2010

Edgar R. Cataxinos,
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |
| **ART UNIT** | **PAPER NUMBER** |
| 1638 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/31/2010 | PAPER |

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Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

MAR 3 1 2010

In re Application of:
Chungu et al.
Serial No.: 12/102,747
Filed: April 14, 2008
Attorney Docket No.: **2971-8310.1US (64630A)**

: PETITION DECISION

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Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/102,750 | 04/14/2008 | Chibwe Chungu | 2971-8313.1US (64635A) | 1753 |

7590 01/12/2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1638 | |

| MAIL DATE | DELIVERY MODE |
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| 01/12/2010 | PAPER |

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JAN 1 2 2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

In re Application of:
Chungu et al.
Serial No.: 12/102,750
Filed: April 14, 2008
Attorney Docket No.: **2971-8313.1US**
**(64635 A)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed December 29, 2009, to expunge information from the above identified application. This application has not been allowed.

Petitioner requests that the Declaration under CFR 1.132 submitted to the Patent Office on December 29, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

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The petition is **DISMISSED**. Petitioner may resubmit the petition subsequent to a Notice of Allowability or *ex parte Quayle* action being mailed in the application. No additional petition fee will be required at that time.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/102,750 | 04/14/2008 | Chibwe Chungu | 2971-8313.1US (64635A) | 1753 |

7590 04/14/2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1638 | |

| MAIL DATE | DELIVERY MODE |
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| 04/14/2010 | PAPER |

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APR 14 2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

In re Application of:
Chungu et al.
Serial No.: 12/102,750
Filed: April 14, 2008
Attorney Docket No.: **2971-8313.1US (64635A)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed April 1, 2010, to expunge information from the above identified application. This application has been allowed.

Petitioner requests that the Declaration under 37 CFR 1.132 submitted to the Patent Office on December 29, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

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Therefore, petitioner's petition is GRANTED.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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**STOEL RIVES LLP - SLC**
**201 SOUTH MAIN STREET, SUITE 1100**
**ONE UTAH CENTER**
**SALT LAKE CITY UT 84111**

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DEC 0 3 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Bookman et al. | : | DECISION ON PETITION |
| Application No. 12/102,756 | : | TO WITHDRAW |
| Filed: April 14, 2008 | : | FROM RECORD |
| Attorney Docket No. 38115/3 | : | |

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 9, 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 Kory D. Christensen on behalf of all attorneys/agents of record who are associated with Customer Number 32642.

All attorneys/agents associated with Customer Number 32642 have been withdrawn. Applicant(s) is/are reminded that there is no attorney of record at this time.

All future correspondence will be directed to the assignee, Inauara Incorporated, at the address indicated below.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Liana Walsh
Petitions Examiner
Office of Petitions

cc: INAUARA INCORPORATED
4525 S. WASATCH BLVD., SUITE 150
SALT LAKE CITY UT 84124

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. |
|---|---|---|---|---|
| 12/102,761 | 04/14/2008 | Chibwe Chungu | 2971-8311.1US (64632) | 1777 |

24247 7590 01/13/2010

TRASKBRITT, P.C.
P.O. BOX 2550
SALT LAKE CITY, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1638 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 01/13/2010 | 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):

USPTOMail@traskbritt.com

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JAN 13 2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

In re Application of:
Chungu et al.
Serial No.: 12/102,761
Filed: April 14, 2008
Attorney Docket No.: **2971-8311.1US**
**(64632 A)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed December 29, 2009, to expunge information from the above identified application. This application has not been allowed.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/102,761 | 04/14/2008 | Chibwe Chungu | 2971-8311.1US (64632) | 1777 |

24247 7590 02/22/2010

TRASKBRITT, P.C.
P.O. BOX 2550
SALT LAKE CITY, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |
| **ART UNIT** | **PAPER NUMBER** |
| 1638 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 02/22/2010 | ELECTRONIC |

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USPTOMail@traskbritt.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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FEB 22 2010

TRASKBRITT, P.C.
P.O. BOX 2550
SALT LAKE CITY UT 84110

In re Application of:
Chungu et al.
Serial No.: 12/102,761
Filed: April 14, 2008
Attorney Docket No.: **2971-8311.1US**
**(64632)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed February 18, 2010, to expunge information from the above identified application. This application has been allowed.

Petitioner requests that the Declaration under CFR 1.132 submitted to the Patent Office on December 29, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

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Therefore, petitioner's petition is GRANTED.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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www.uspto.gov

**QUALCOMM INCORPORATED**
**5775 MOREHOUSE DR.**
**SAN DIEGO CA 92121**

**MAILED**

JUL 29 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Gang Zhang, et al. | : | |
| Application No. 12/102,768 | : | DECISION ON PETITION |
| Filed: April 14, 2008 | : | |
| Attorney Docket No. 071795 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 9, 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, November 20, 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 February 21, 2010.

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

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

This application is being referred to Technology Center AU 2819 for appropriate action by the Examiner in the normal course of business on the reply received.

Terri Johnson
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/102,769 | 04/14/2008 | Chibwe Chungu | 2971-8277.1US (64634A) | 1792 |

7590 01/12/2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City, UT 84110

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1638 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 01/12/2010 | PAPER |

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JAN 1 2 2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

In re Application of:
Chungu et al.
Serial No.: 12/102,769
Filed: April 14, 2008
Attorney Docket No.: **2971-8277.1US**
**(64634 A)**

: PETITION DECISION

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Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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| 12/102,769 | 04/14/2008 | Chibwe Chungu | 2971-8277.1US (64634A) | 1792 |

7590 03/31/2010

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| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

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MAR 3 1 2010

Edgar R. Cataxinos
TRASKBRITT
P.O. Box 2550
Salt Lake City UT 84110

In re Application of:
Chungu et al.
Serial No.: 12/102,769
Filed: April 14, 2008
Attorney Docket No.: **2971-8277.1US**
**(64634A)**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed March 17, 2010, to expunge information from the above identified application. This application has been allowed.

Petitioner requests that the Declaration under 37 CFR 1.132 submitted to the Patent Office on December 29, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

The reasons set forth in this petition establishes to the satisfaction of the Director that expungement of the information is appropriate. The file entry for this document has been closed and as such the document is no longer publicly available, which is the IFW equivalent to removal of a paper document from a paper file wrapper.

Therefore, petitioner's petition is GRANTED.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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DAVIS WRIGHT TREMAINE LLP - San Francisco
505 MONTGOMERY STREET
SUITE 800
SAN FRANCISCO CA 94111

**MAILED**

MAY 24 2010

**OFFICE OF PETITIONS**

In re Application of :
Shing Man Lee :
Application No. 12/102,775 : DECISION ON PETITION
Filed: April 14, 2008 : TO WITHDRAW
Attorney Docket No. **SOLN.003US0** : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR § 1.36(b), filed April 7, 2010.

The request is **NOT APPROVED**.

A review of the file record indicates that James S. Hsue or any attorneys/agents associated with Customer Number 36257 does not have power of attorney or was ever given power of attorney in the above-identified application. Accordingly, the request to withdraw under 37 CFR § 1.36(b) is not applicable.

According to our records the Customer Number has been listed as the Representative Information in the application data sheet. However, providing the information in the application data sheet does not constitute as a power of attorney in the application. ***See 37 CFR § 1.76(b)(4)***.

All future communications from the Office will continue to be directed to the address of record until otherwise properly notified by the applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-4584.

/JoAnne Burke/
JoAnne Burke
Petitions Examiner
Office of Petitions

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DON D. CHA
547 BUENA VISTA ROAD
GOLDEN CO 80401

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SEP 14 2009

OFFICE OF PETITIONS

In re Application of :
Park, et al. :
Application No. 12/102,794 : DECISION
Filed: 14 April, 2008 :
Attorney Docket No. NSB-000110US :

This is a decision on the petition filed on 1 June, 2009, for revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b).

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

**Petitioners attentions always are directed to the guidance in the Commentary at MPEP §711.03(c )(II). )**

## BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the Notice to File Corrected Application Papers mailed on 15 July, 2008, with reply due absent extension of time on or before 15 September, 2008.

The application went abandoned by operation of law after midnight 15 September, 2008.

The Office mailed the Notice of Abandonment on 17 March, 2009.

On 1 June, 2009, Petitioner filed, *inter alia*, a petition (with fee) pursuant to 37 C.F.R. §1.137(b), with a reply in the form of, *inter alia*, drawings and sequence listing.

**Again, Petitioners attentions always are directed to the guidance in the Commentary at MPEP §711.03(c )(II).**

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]
The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[3]))

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[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

[2] 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[3] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

It appears that the requirements under 37 C.F.R. §1.137(b) have been satisfied.

## CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to the Office of Patent Application Processing (OPAP) for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the OPAP in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the OPAP where that change of status must be effected—that does not occur in the Office of Petitions.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[4]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[4] The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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MCDERMOTT, WILL & EMERY
11682 EL CAMINO REAL
SUITE 400
SAN DIEGO, CA 92130-2047

Mail Date: 05/14/2010

| | | |
|---|---|---|
| **Applicant** | : William D. Huse | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7667007 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/23/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 12/102,818 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/14/2008 | : 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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**MICROSOFT CORPORATION**
**ONE MICROSOFT WAY**
**REDMOND WA 98052**

MAILED

MAR 25 2009

OFFICE OF PETITIONS

In re Application of :
Yunbo CAO et al. :
Application No. 12/102,866 : DECISION ON PETITION
Filed: April 15, 2008 :
Attorney Docket No. **322768.01** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 10, 2009, to revive the above-identified application.

The petition is **DISMISSED**.

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

The application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Nonprovisional Application (Notice), mailed May 22, 2008. The Notice set a period for reply of two (2) months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on July 23, 2008.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item(s) (1) in that it does not include a statement under 37 CFR 1.125(b), required by the Notice that the substitute specification includes no new matter.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

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

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

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

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

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at (571) 272-2783.

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

cc: **JOSEPH R. KELLY**
**900 SECOND AVENUE SOUTH**
**SUITE 1400**
**MINNEAPOLIS MN 55402-3319**

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APR 28 2009

OFFICE OF PETITIONS

**MICROSOFT CORPORATION**
**ONE MICROSOFT WAY**
**REDMOND WA 98052**

In re Application of :
Yunbo CAO et al. :
Application No. 12/102,866 : DECISION ON PETITION
Effective Date: April 15, 2008 :
Attorney Docket No. **322768.01** :

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed April 02, 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 Notice to File Missing Parts of Nonprovisional Application (Notice), mailed May 22, 2008. The Notice set a period for reply of two (2) months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on July 23, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a substitute specification and statement, (2) the petition fee of $1620, and (3) a proper statement of unintentional delay. Accordingly, the reply to the Notice to File Missing Parts of Nonprovisional Application of May 22, 2008 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

This application is being referred to the Office Patent Application Processing.

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

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SEP 17 2009

PIONEER HI-BRED INTERNATIONAL, INC.
7250 N.W. 62ND AVENUE
P.O. BOX 552
JOHNSTON IA 50131-0552

In re Application of:
Michael J. OLeary
Serial No.: 12/102,915
Filed: April 15, 2008
Attorney Docket No.: **2800**

: PETITION DECISION

This is in response to the petition under 37 CFR § 1.59(b), filed August 8, 2009, to expunge information from the above identified application. This application has not been allowed.

Petitioner requests that the Reply to Request for Information under 37 CFR 1.105, and attachment thereto, submitted to the Patent Office on August 8, 2009, be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

This is an examined application which is currently under non-final rejection. As such the information provided has been reviewed, in part, but proceedings in the application have not been terminated. As stated in M.P.E.P. 724, upon allowance or other action closing prosecution in an application, petition may be made for return of Proprietary information. The information cannot be expunged at this time.

The petition is **DISMISSED**. Petitioner may resubmit the petition subsequent to a Notice of Allowability or *ex parte Quayle* action being mailed in the application. No additional petition fee will be required at that time.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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7250 NW 62ND AVENUE
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JOHNSTON, IA 50131-0552

Mail Date: 04/27/2010

| | | |
|---|---|---|
| **Applicant** | : Mark David Hoffbeck | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7576269 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/18/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 12/102,919 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : 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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Mail Date: 04/21/2010

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|---|---|---|
| **Applicant** | : Thomas Craig Kevern | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7589264 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/102,920 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : 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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Mail Date: 04/21/2010

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|---|---|---|
| **Applicant** | : Thomas Craig Kevern | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7586027 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/102,922 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : 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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Mail Date: 04/27/2010

| | | |
|---|---|---|
| **Applicant** | : Mark David Hoffbeck | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7572963 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/11/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 12/102,923 | : OF WYETH |
| **Filed** | : 04/15/2008 | : |
| | | : |

The Patentee's Request for Recalculation is **DISMISSED.**

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

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

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

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7250 NW 62ND AVENUE
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JOHNSTON, IA 50131-0552

Mail Date: 05/18/2010

**Applicant** : Mark David Hoffbeck
**Patent Number** : 7572963
**Issue Date** : 08/11/2009
**Application No**: 12/102,923
**Filed** : 04/15/2008

: NOTICE CONCERNING IMPROPER
: DISMISSAL OF THE REQUEST
: FOR RECALCULATION OF
: PATENT TERM ADJUSTMENT
: IN VIEW OF WYETH

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 mistakenly dismissed a small number of requests as ineligible. The dismissals involve requests that were filed on February 9-12, 2010, for patents that were granted on August 11, 2009. Any request that was filed on February 8, 2010 was properly deemed eligible for patent term adjustment (PTA) and was recalculated.

Patents meeting the above criteria were eligible because the USPTO was closed February 8-11, 2010, due to a snowstorm. See Closing of the United States Patent and Trademark Office from Monday February, 8, 2010, through Thursday, February 11, 2010, 1352 *Off. Gaz. Pat. Office* 146 (March 16, 2010). The Office considered each day from Monday, February 8, 2010, through Thursday, February 11, 2010, to be a "Federal holiday within the District of Columbia" under 35 U.S.C. § 21(b) and 37 CFR 1.6, 1.7, 1.9, 2.2(d), 2.195 and 2.196. Any actions that were due from Monday, February, 8, 2010, through Thursday, February 11, 2010, (or the preceding Saturday (February 6, 2010) or Sunday (February 7, 2010)) will be considered timely if the action was taken on the next succeeding business day on which the USPTO was open, which was February 12, 2010.

This notice **VACATES** the previous mailed decision in the patented file that deemed patentee ineligible for the request for recalculation. Patentee's request for recalculation is GRANTED.

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** 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 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 deterimation 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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7250 NW 62ND AVENUE
P.O. BOX 552
JOHNSTON, IA 50131-0552

Mail Date: 04/27/2010

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|---|---|---|
| **Applicant** | : Todd Elliott Piper | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7576270 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/18/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 12/102,924 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : 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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Mail Date: 04/20/2010

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| **Applicant** | : Mark David Hoffbeck | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7632993 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/102,925 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : 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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OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Thomas Charles Barker et al. | : | |
| Application No. 12/102,927 | : | DECISION ON PETITION |
| Filed: April 15, 2008 | : | |
| Attorney Docket No. 2889+ | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 24, 2009, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue fee on or before September 16, 2009, as required by the Notice of Allowance and Fee(s) Due, mailed June 16, 2009. Accordingly, the date of abandonment of this application is September 17, 2009. A Notice of Abandonment was mailed on October 9, 2009.

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 $1,510 (2) the petition fee of $1,620, and (3) a proper statement of unintentional delay. Accordingly, the issue fee is accepted as being unintentionally delayed.

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

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

Carl Friedman
Petitions Examiner
Office of Petitions

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|---|---|---|
| **Applicant** | : Thomas Charles Barker | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7655842 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/102,927 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : 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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Mail Date: 04/20/2010

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| **Applicant** | : Lori Lisa Carrigan | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7612263 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/03/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/102,928 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : ISSUE CERTIFICATE OF CORRECTION |
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The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **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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MCKEE, VOORHEES & SEASE, P.L.C.
ATTN: PIONEER HI-BRED
801 GRAND AVENUE, SUITE 3200
DES MOINES, IA 50309-2721

Mail Date: 04/26/2010

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|---|---|---|
| **Applicant** | : Edwin Michael Grote | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7582816 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/01/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 12/102,956 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : ISSUE CERTIFICATE OF CORRECTION |
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The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **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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Mail Date: 04/21/2010

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| **Applicant** | : Edwin Michael Grote | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7586028 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/102,958 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : ISSUE CERTIFICATE OF CORRECTION |
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The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **126** 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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7250 NW 62ND AVENUE
JOHNSTON, IA 50131-0552

Mail Date: 05/18/2010

**Applicant** : Edwin Michael Grote
**Patent Number** : 7586028
**Issue Date** : 09/08/2009
**Application No**: 12/102,958
**Filed** : 04/15/2008

: 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 **172** 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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Mail Date: 04/21/2010

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|---|---|---|
| **Applicant** | : David Bernard Fischer | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7592523 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/102,960 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : 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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Mail Date: 04/21/2010

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| **Applicant** | : Gary Edward Henke | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7592524 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/102,961 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : ISSUE CERTIFICATE OF CORRECTION |
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The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **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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Mail Date: 04/27/2010

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| **Applicant** | : Stephen William Noble JR. | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7576271 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/18/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 12/102,963 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : ISSUE CERTIFICATE OF CORRECTION |
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The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **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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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/102,976 | 04/15/2008 | Claus Felby | 132212 | 1127 |

62691 7590 06/05/2008

BUDDE, SCHOU & OSTENFELD, A/S
VESTER SOEGADE 10, 5TH FLOOR
COPENHAGEN, DK-1601
DENMARK

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 1797 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/05/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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62691
Budde, Schou & Ostenfeld, A/S
Vester Soegade 10, 5th floor
Copenhagen, DK-1601
Denmark

JUN 0 5 2008

In re Application of
Vekso et al.
Serial No.: 12/102,976
Filed: April 15, 2008
Attorney Docket No.: 132212

: DECISION ON PETITION TO MAKE
: SPECIAL FOR NEW APPLICATION
: UNDER 37 C.F.R. § 1.102 & M.P.E.P.
: § 708.02

This is a decision on the petition filed on April 15, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in an agreement that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a Final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the Final Office action, applicant must: 1) promptly file a Notice of Appeal, an Appeal Brief and Appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after Final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

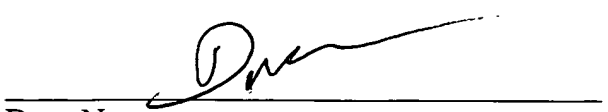
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a Final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Dave T Nguyen, Technology Center Quality Assurance Specialist, at (571) 272-0731.



Dave Nguyen
TQAS TC 1600

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BUDDE, SCHOU & OSTENFELD, A/S
VESTER SOEGADE 10, 5TH FLOOR
COPENHAGEN DK-16-01 DK DENMARK

MAILED

JUL 20 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Claus Felby, et al. | : | |
| Application No. 12/102,976 | : | DECISION GRANTING PETITION |
| Filed: April 15, 2008 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 132212 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed July 16, 2009, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on July 1, 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]

The petition is not signed by an attorney of record. Nevertheless, in accordance with 37 CFR 1.34, the signature of Mr. Robert C. Casad appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts. If Mr. Rober C. Casad desires to receive future correspondence regarding this file, the appropriate power of attorney documents must be submitted. All future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

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

This application is being referred to Technology Center AU 1654 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment and information disclosure statement.

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

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LIEBERMAN & BRANDSDORFER, LLC
802 STILL CREEK LANE
GAITHERSBURG MD 20878

COPY MAILED

MAR 19 2009

OFFICE OF PETITIONS

In re Application of
Randolph E. Bridwell
Application No. 12/103,006
Filed: April 15, 2008
Attorney Docket No.: **1288-201**

ON PETITION

This is a decision on the petition filed December 22, 2008, to withdraw the holding of abandonment. The petition is being treated under 37 CFR 1.181 in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.[1]
The petition under 37 CFR 1.181(b) is **GRANTED.**

This application became abandoned for failure to file a timely response to the Property Rights Letter "REQUIREMENT FOR STATEMENT UNDER § 152 OF THE ATOMIC ENERGY ACT" mailed August 6, 2008, which set a one (1) month statutory period for reply. Accordingly, a Notice of Abandonment was mailed October 29, 2008. Petitioner asserts that neither the office action nor Notice of Abandonment was received.

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[1]MPEP 711.03(c) states, in pertinent part:
In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).
To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited'to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.
Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.
A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The file record discloses that the Office Action was mailed to the address of record which is the same address used on all correspondences from the USPTO. A review of the record indicates no irregularity in the mailing of the Office Action mailed on August 6, 2008, and in the absence of any irregularity in the mailing, there is a strong presumption that the Office Action mailed on August 6, 2008, was properly mailed to the address of record. This presumption may be overcome by a showing that the Office Action mailed on August 6, 2008 was not in fact received.

In support of the allegation that the Office Action mailed on August 6, 2008 was never received, petitioners have submitted a copy of counsel's docket record and mail log to show that the Office Action was not received.

Accordingly, there was no abandonment in fact. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

This matter is being referred to Technology Center 3600 for a re-mailing of the Office Action and for a restarting of the period for response.

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

PTO/SB/130 (08-08)
Approved for use through 08/31/2008. 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 | 12103007 | Confirmation Number | 1184 | Filing Date | 2008-04-15 |
| Attorney Docket Number (optional) | FRIEL-145(152*337) | Art Unit | 3723 | Examiner | |
| First Named Inventor | DANIEL D. FRIEL, SR. | | | | |
| Title of Invention | PRECISION SHARPENER FOR HUNTING AND ASIAN KNIVES | | | | |

**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 |
|---|---|---|---|
| DANIEL | D. | FRIEL | Sr. |

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 | /HAROLD PEZZNER/ | Date (YYYY-MM-DD) | 2008-08-21 |
| Name | HAROLD PEZZNER | Registration Number | 22112 |

PTO/SB/130 (08-08)
Approved for use through 08/31/2008. 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.

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In re Application of
Daniel D. Friel

Application No. 12103007

Filed: April 15,2008

Attorney Docket No. FRIEL-145 (152*337)

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

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1), filed 22-AUG-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 inquiries concerning this electronic decision should be directed to the Electronic Business Center at 866-217-9197.

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

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PIONEER HI-BRED INTERNATIONAL, INC.
7250 N.W. 62ND AVENUE
P.O. BOX 552
JOHNSTON, IA 50131-0552

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Khusi Ram Tiwari | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7612264 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/03/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/103,036 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : 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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P.O. BOX 552
JOHNSTON, IA 50131-0552

Mail Date: 04/20/2010

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|---|---|---|
| **Applicant** | : Todd Elliott Piper | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7612265 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/03/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/103,043 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : 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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**THE LAW OFFICES OF THOMAS L. ADAMS**
**120 Eagle Rock Avenue**
**Suite 130**
**East Hanover, NJ 07936**

**MAILED**

MAY 05 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Joshua Holtz | : | |
| Application No. 12/103,044 | : | DECISION ON PETITION |
| Filed: April 15, 2008 | : | TO WITHDRAW |
| Attorney Docket No. HTZ | : | 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 9, 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 Thomas L. Adams 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 Joshua Holtz at the address indicated below.

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

Terri Johnson
Petitions Examiner
Office of Petitions

cc: **Joshua Holtz**
**16 Undercliff Terrace**
**West Orange, NJ 07052**

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/103,044 | 04/15/2008 | Joshua Holtz | HTZ |

**CONFIRMATION NO. 1241**

**POWER OF ATTORNEY NOTICE**

20238
THE LAW OFFICES OF THOMAS L. ADAMS
120 EAGLE ROCK AVENUE
Suite 130
EAST HANOVER, NJ 07936

*OC000000041456153*

Date Mailed: 05/04/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 02/09/2010.

- 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.

/tsjohnson/

---

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

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PIONEER HI-BRED INTERNATIONAL, INC.
7250 N.W. 62ND AVENUE
P.O. BOX 552
JOHNSTON, IA 50131-0552

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Todd Elliott Piper | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7619149 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/17/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/103,065 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : 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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MURATA MANUFACTURING COMPANY, LTD.
C/O KEATING & BENNETT, LLP
1800 ALEXANDER BELL DRIVE
SUITE 200
RESTON, VA 20191

MAILED

JUN 17 2010

OFFICE OF PETITIONS

In re Application of :
Daisuke Haga, et al. :
Application No. 12/103,089 : DECISION GRANTING PETITION
Filed: April 15, 2008 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 36856.1612 :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed June 17, 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 8, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 1791 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

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

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

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JOHNSTON, IA 50131-0552

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Lori Lisa Carrigan | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7655843 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/103,106 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : 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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JOHNSTON, IA 50131-0552

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Matthew David Smalley | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7663031 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/103,108 | : OF WYETH |
| **Filed** | : 04/15/2008 | : |
| | | : |

The Patentee's Request for Recalculation is **DISMISSED.**

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

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

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

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PRYOR CASHMAN, LLP
7 Times Square
NEW YORK NY 10036-6569

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JUL 23 2010

OFFICE OF PETITIONS

In re Application of :
Woo, et al. :
Application No. 12/103,125 : DECISION ON PETITION
Filed: April 15, 2008 :
Attorney Docket No 14286.00004. :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 29, 2010 and supplemented May 12, 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 and failure to submit corrected drawings in a timely manner in reply to the January 26, 2010 Notice of Allowance and Fee(s) Due and the January 26, 2010 Notice of Allowability, respectively. Both Notices set a period for reply of three (3) months. Accordingly, the date of abandonment of this application is April 27, 2010. A Notice of Abandonment was mailed May 5, 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 $755.00, the publication fee of $300.00, and corrected drawings; (2) the petition fee of $81.00; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.

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

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

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GE GLOBAL PATENT OPERATION
P.O. BOX 861
2 CORPORATE DRIVE, SUITE 648
SHELTON, CT 06484

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OFFICE OF PETITIONS

In re Application of :
Mahesh Jaywant Rane et al :
Application No. 12/103,157 :
Filed: April 15, 2008 :
Attorney Docket No. 232225-1 :

ON PETITION

This is a decision on the petition filed October 13, 2009 under 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the Issue fee and Publication Fee in a timely manner in reply to the Notice of Allowance mailed June 18, 2009, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on September 19, 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 payment of the Issue fee and Publication Fee; (2) the petition fee; (3) the required statement of unintentional delay have been received. Accordingly, the issue fee is accepted as having been unintentionally delayed.

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

This matter is being referred to the Office of Data Management for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,167 | 04/15/2008 | Takeshi Yamamoto | 70404.281/ha | 1448 |

54072 7590 08/05/2009

SHARP KABUSHIKI KAISHA
C/O KEATING & BENNETT, LLP
1800 Alexander Bell Drive
SUITE 200
Reston, VA 20191

| EXAMINER | |
|---|---|
| LEE, BENJAMIN C | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2612 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 08/05/2009 | 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):

JKEATING@KBIPLAW.COM
uspto@kbiplaw.com
pmedley@kbiplaw.com

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1800 Alexander Bell Drive
SUITE 200
Reston VA 20191

| | | |
|---|---|---|
| In re Application of | : | |
| YAMAMOTO, TAKESHI, et al. | : | DECISION ON REQUEST TO |
| Application No. 12/103,167 | : | PARTICIPATE IN PATENT |
| Filed: April 15, 2008 | : | PROSECUTION HIGHWAY |
| Attorney Docket No.: **70404.281/ha** | : | 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 3, 2009, to make the above-identified application special.

The request and petition are **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 is deficient as follows:

Petitioner has not complied with items 2 and 5. It is not clear whether petitioner has complied with item 2 above. Allowed claims have been provided for JPO application 2008-100757 and correspondence to the claims of the instant application shown. However, the relationship of the above JPO application and that of JPO application 2004-045471 for which priority is claimed has not been established. In response to this decision, Requestor should establish the relationship between the application containing the allowed claims and those for which priority is claimed. In regard to item 5, the petition fails to include 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.

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.

Any response must be submitted via EFS-web.

Telephone inquiries concerning this decision should be directed to Doris To at 571-272-7629.

All other inquiries concerning the examination or status of the application should be directed to Patent Application Information Retrieval (PAIR) system.

_/Doris To/_____
Doris To
Quality Assurance Specialist
Technology Center 2600
Communications

D20

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,167 | 04/15/2008 | Takeshi Yamamoto | 70404.281/ha | 1448 |

54072 7590 10/07/2009

SHARP KABUSHIKI KAISHA
C/O KEATING & BENNETT, LLP
1800 Alexander Bell Drive
SUITE 200
Reston, VA 20191

| EXAMINER | |
|---|---|
| LEE, BENJAMIN C | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2612 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 10/07/2009 | 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):

JKEATING@KBIPLAW.COM
uspto@kbiplaw.com
pmedley@kbiplaw.com

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C/O KEATING & BENNETT, LLP
1800 Alexander Bell Drive
SUITE 200
Reston VA 20191

| | | |
|---|---|---|
| In re Application of | : | |
| YAMAMOTO, TAKESHI et al. | : | DECISION ON REQUEST TO |
| Application No. 12/103,167 | : | PARTICIPATE IN PATENT |
| Filed: April 15, 2008 | : | PROSECUTION HIGHWAY |
| Attorney Docket No. **70404.281/ha** | : | PROGRAM AND PETITION |
| | : | TO MAKE SPECIAL UNDER |
| | : | 37 CFR 1.102(d) |

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 August 10, 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 now comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Doris To at 571-272-7629.

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.

/Doris To/

_____

Doris To
Quality Assurance Specialist
Technology Center 2600
Communications

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,227 | 04/15/2008 | Eric Duchesne | 05456.105085 (CA920080013 | 1553 |

78148 7590 06/23/2008

KING & SPALDING
1180 PEACHTREE ST.
ATLANTA, GA 30309

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2825 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/23/2008 | PAPER |

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The time period for reply, if any, is set in the attached communication.

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KING & SPALDING
1180 Peachtree St.
Atlanta, GA 30309

| | |
|---|---|
| In re Application of:<br>DUCHESNE *et al.*<br>Serial No.: 12/103,227<br>Filed: April 15, 2008<br>Title: **METHOD TO OPTIMIZE THE MANUFACTURING OF INTERCONNECTS IN MICROELECTRONIC PACKAGES** | DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02 |

This is a decision on the petition filed on April 15, 2008, to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any dependent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions I.1-4; II.5, 5.1-5.3, 6, 6.1-6.4 and 6.6, above are considered to have been met. However, the petition fails to comply with conditions II 6.5, above. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirements of II.6.5, the examination support document must include a showing of where **each limitation** of the application claims finds support under 35 USC 112, first paragraph, in the written description of the specification. The examination support document includes a broad statement of the support being found between a range of paragraphs. As such, the examination support document neither clearly shows support for each limitation, nor is it pointed out in the written description of the specification. A more specific description of where each limitation finds support is required. For these reasons, the petition does not meet the requirements of II. 6.5, as set forth above.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Clayton E. LaBalle, Special Program Examiner, at (571) 272-1594.

Clayton E. LaBalle
Special Program Examiner
Technology Center 2800

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,227 | 04/15/2008 | Eric Duchesne | CA920080013US1 (105085) | 1553 |

78148 7590 08/15/2008

KING & SPALDING
1180 PEACHTREE ST.
ATLANTA, GA 30309

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2825 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/15/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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KING & SPALDING
1180 Peachtree Street
Atlanta, GA 30309

In re Application of:
DUCHESNE *et al.*
Serial No.: 12/103,227
Filed: April 15, 2008
Title: **METHOD TO OPTIMIZE THE MANUFACTURING OF INTERCONNECTS IN MICROELECTRONIC PACKAGES**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 CFR 1.102

This decision is a reply to the communication filed July 23, 2008. The communication is being treated as a petition requesting reconsideration of the previous decision of June 23, 2008, dismissing the petition to make special under 37 C.F.R. §1.102(d) filed April 15, 2008.

The petition to make the application special is GRANTED.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 C.F.R. §1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 C.F.R. §1.97 and §1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 C.F.R. §1.181, §1.182 or §1.183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve-month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to the undersigned at (571) 272-1594.

Clayton E. LaBalle, T-QAS
Technology Center 2800 - Semiconductors,
Electrical & Optical Systems & Components

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**LADAS & PARRY LLP**
**224 SOUTH MICHIGAN AVENUE, SUITE 1600**
**CHICAGO, IL 60604**

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FEB 05 2010

OFFICE OF PETITIONS

In re Application of
**Eun Young LEE**, et *al.*
Application No. 12/103,266
Filed: April 15, 2008
Attorney Docket No. **CU-6648 WWP**

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 4, 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 December 30, 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 2454 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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In re Application of
E. Neal Caldwell

Application No. 12103302
Filed:

Attorney Docket No. 63125.US

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

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1) ,filed 15-APR-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 04/30/2008. 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 | 12/103,302 | Confirmation Number | 1687 | Filing Date | 2008-04-15 |
| Attorney Docket Number (optional) | 63125.US | Art Unit | | Examiner | |
| First Named Inventor | E. Neal Caldwell | | | | |
| Title of Invention | Landscape Edging | | | | |

**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 |
|---|---|---|---|
| E. | Neal | Caldwell | |

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 | /Robert O. Fox/ | Date (YYYY-MM-DD) | 2008-04-15 |
| Name | Robert O. Fox | Registration Number | 34165 |

PTO/SB/130 (03-08)
Approved for use through 04/30/2008. 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.

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In re Application of
DANIEL D. FRIEL,

Application No. 12103352

Filed: April 15,2008

Attorney Docket No. FRIEL-146(152*338)

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

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1), filed 25-AUG-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 inquiries concerning this electronic decision should be directed to the Electronic Business Center at 866-217-9197.

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

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

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| **Larry R. PEASE, et al.** | : | |
| Application No. 12/103,362 | : | DECISION GRANTING PETITION |
| Filed: April 15, 2008 | : | UNDER 37 CFR 1.313(c)(3) |
| Attorney Docket No. **07039-391003** | : | |

This is a decision on the petition, filed August 28, 2009, under 37 CFR 1.313(c)(3) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

Petitioner requests that the above-identified application be withdrawn from issue for express abandonment. *See* 37 CFR 1.313(c)(3).

The application is hereby withdrawn from issue, and the abandonment is hereby recognized.

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.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

cc: **FISH & RICHARDSON, PC**
**3200 RBC PLAZA**
**60 SOUTH SIXTH STREET**
**MINNEAPOLIS, MN 55402**

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

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JUN 05 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Donald Robert Martin Boys, et al. | : | |
| Application No. 12/103,415 | : | DECISION ON PETITION |
| Filed: April 15, 2008 | : | TO MAKE SPECIAL UNDER |
| Attorney Docket No. P730 | : | 37 CFR 1.102(c)(1) |
| | : | |

This is a decision on the petition under 37 CFR 1.102(c)(1), filed March 10, 2009, to make the above-identified application special based on applicant's health as set forth in M.P.E.P. § 708.02, Section III.

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102(c)(1) and MPEP § 708.02, Section III: Applicant's Health, must be accompanied by evidence showing such as a doctor's certificate or other medical certificate that the state of health of the applicant is such that he or she might not be available to assist in the prosecution of the application if it were to run its normal course. No fee is required

The instant petition includes a doctor's note stating that the applicant, Susan Araiza-Boys has a condition that may prevent her to assist in the prosecution of the application if it were to run its normal course. Accordingly, the above-identified application has been accorded "special" status.

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

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

The application is being forwarded to the Technology Center Art Unit 3625 for action on the merits commensurate with this decision.

David Bucci
Petitions Examiner
Office of Petitions

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NEW YORK NY 10112-4498

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MAY 2 0 2008

OFFICE OF PETITIONS

In re Application of :
Young, Shrivastava, Borg, Shumer, Weiss, :
Simeon and Osman : DECISION ACCORDING STATUS
Application No. 12/103,440 : UNDER 37 CFR 1.47(a)
Filed: 04/15/2008 :
Attorney Docket No. 003168.0498 :
Title: INTEGRATION OF MARKERS INTO :
BAR ARMS USING A WARM-FORMING :
PROCESS :

This is a decision on the petition filed on April 15, 2008, under 37 CFR 1.47(a).

The petition is GRANTED.

Petitioners have shown that the non-signing inventor, Eugene Young, has refused to join in the filing of the above-identified application after having been sent a copy of the application papers.

Specifically, petitioners' registered patent practitioner, Kelly McCrystle, states that a copy of the application was sent to the non-signing inventor's last known address. Attorney McCrystle further states that emails and telephone calls were made to the non-signing inventor asking him to return the executed declaration, but that the non-signing inventor has failed so to do. As such, the showing of record is that the non-signing inventor has constructively refused to sign the declaration naming him as a joint inventor.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the addresses given the Declaration. Notice of the filing of this application will also be published in the Official Gazette.

The application is being referred to the Office of Patent Application Processing for further processing.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-32311.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Eugene Young
4765 Randi Court
Union City CA 94587

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MAY 2 0 2008

OFFICE OF PETITIONS

In re Application of :
Young, Shrivastava, Borg, Shumer, Weiss, Simeon :
and Osman :
Application No. 12/103,440 : LETTER
Filed: 04/15/2008 :
Attorney Docket No. 003168.0498 :
Title: INTEGRATION OF MARKERS INTO BAR :
ARMS USING A WARM-FORMING PROCESS :

Dear Mr. Young:

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. Requests for information regarding your application should be directed to the File Information Unit at 571- 272-3150. Information regarding how to pay for and order a copy of the applicationl or a specific paper in the application, should be directed to Certification Division at 571-272-3150 or 1-800-972-6382 (outside the Washington D.C. area).

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

BAKER BOTTS L.L.P.
30 ROCKEFELLER PLAZA
44th FLOOR
NEW YORK NY 10112-4498

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,510 | 04/15/2008 | Sayaka Nishi | JP920070193US1 | 2078 |

38245 7590 06/18/2008

JEROME D. JACKSON (JACKSON PATENT LAW OFFICE)
211 N. UNION STREET, SUITE 100
ALEXANDRIA, VA 22314

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2841 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/18/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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JEROME D. JACKSON (JACKSON PATENT LAW OFFICE)
211 N. UNION STREET, SUITE 100
ALEXANDRIA VA 22314

| | | |
|---|---|---|
| In re Application of:<br>NISHI et al<br>Serial No.: 12/103,510<br>Filed: April 15, 2008<br>Attorney Docket No.: JP20070193US1 | :<br>:<br>:<br>:<br>:<br>:<br>: | DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.2 |

This is a decision on the petition filed on April 15, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:
1. be filed with the application;
2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner; and

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation; and

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists; and

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions regarding the application (section I, subsections 1-4) discussed above are considered to have been met. Additionally, the conditions regarding the petition (section II,

subsections 1-4 and 6) are considered to have been met. However, the petition fails to comply with the all the conditions set forth in section II, subsection 5. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirements of section II, subsection 5.1 above, it appears the search outlined in the petition omitted critical search areas by not searching in class 257 subclasses 692, 730, 737, e23.069, and e23.07 at a minimum to include a bus structure, bump leads, ball grid arrays and lead layout. Keyword searching utilizing the following class/subclasses 257/688-700, 730, 734, 737, 738, 773-786, e23.004, e23.01- 23.015, e23.02, e23.021, e23.024, e23.047, e23.063, e23.069, e23.07, e23.079, e23.123, e23.151 and e23.153 with text search: And: ((Ball bump solder) with (array plural$3 multi$4))
And: ((bus interconnect$3 inter-connect$3 trace pattern$3 layer line wire) with (shape$3 arrang$3 arrangement geometr$3 layout configurat$3))
And: ((wir$3 connection) same (pad electrode terminal))
And: ((bus interconnect$3 inter-connect$3 trace pattern$3 layer line wire) same (pad electrode terminal) would be an appropriate search. Any renewed petition should include the above outlined additional searching.

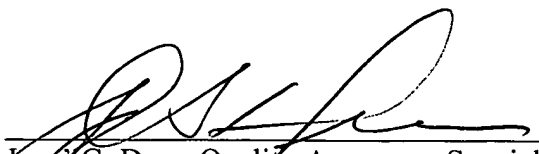
## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petition is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiries regarding this decision should be directed to Quality Assurance Specialist Jose' G. Dees at (571) 272-1569.



Jose' G. Dees, Quality Assurance Specialist
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,510 | 04/15/2008 | Sayaka Nishi | JP920070193US1 | 2078 |

38245 7590 09/05/2008

JEROME D. JACKSON (JACKSON PATENT LAW OFFICE)
211 N. UNION STREET, SUITE 100
ALEXANDRIA, VA 22314

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2841 | |

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| 09/05/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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JEROME D. JACKSON (JACKSON PATENT LAW OFFICE)
211 N. UNION STREET, SUITE 100
ALEXANDRIA VA 22314

In re Application of:
NISHI et al.
Serial No.: 12/103,510
Filed: April 15, 2008
Attorney Docket No.: JP20070193US1

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the request for reconsideration of the petition to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d) filed July 17, 2008. The petition to make special under 37 C.F.R. § 1.102(d) was dismissed on June 18, 2008.

The petition to make the application special is GRANTED.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

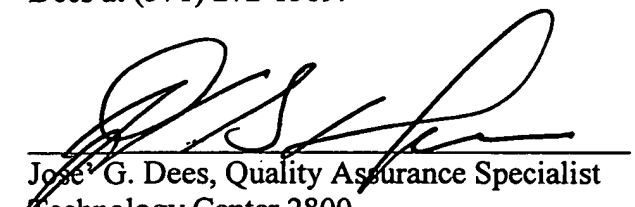
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Quality Assurance Specialist Jose' G. Dees at (571) 272-1569.



Jose' G. Dees, Quality Assurance Specialist
Technology Center 2800
Semiconductors, Electrical and Optical
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www.uspto.gov

Wenderoth, Lind & Ponack, L.L.P
2033 K Street, NW
Suite 800
Washington DC 20006

MAY 06 2008

In re Application of: Narita, Izuru.
Application No.: 12/103,516
Filed: April 15, 2008
Title: METHOD OF DETERMINING OPTIMAL AIR CONDITIONER CONTROL

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 15, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 U.S.C. 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 U.S.C. 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 U.S.C. 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 U.S.C. 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 U.S.C. 103(c).

## REVIEW OF FACTS

The conditions I: 1-4, II: 1-5, 5.3, 6, 6.1, 6.3, 6.4 and 6.6 above are considered to have been met. However, the petition fails to comply with conditions II: 5.2, 6.2, and 6.5 above. Therefore, the

petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

**Discussion**

When referring to "the petition" herein below, the received papers under consideration include the four page PTO/SB/28 form "Petition to Make Special Under Accelerated Examination Program", the "pre-examination search document" including pages 1-4; the "accelerated examination support document" comprising pages 1-5, and two Information Disclosure Statement.

Regarding the requirements of section II element 5.2 outlined above, it appears the search outlined in the petition omitted a critical search area by not searching in class 62 subclasses 259.2, 175, 199; class 361 subclass 688, and class 700 subclasses 276, 278. EAST search terms should include alone and/or in combination as appropriate the following terms: air condition$3, power consumption, server, computer room, calorie, heat, load, efficiency curve, maximum efficiency.

Note in regard to the requirement of section II element 6.1: in response to this communication, Applicant should clearly make of record which IDS lists the prior art most closely related to the claimed invention in support of the petition, and which IDS contains references which are not submitted in support of the petition.

Regarding the requirements of section II element 6.2 outlined above, the petition fails to identify all of the limitations in the application claims that are disclosed in each of the reference(s) and where the limitation is disclosed in each of the cited reference. As stated in the policy published in the Federal Register on June 26, 2006 (71 Fed. Reg. 36323), for each reference cited, the examination support document must include an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference. The policy statement does not caveat "the independent claims", nor does it allow for grouping and general discussions. A grantable petition must delineate every limitation of every claim and identify where the equivalent limitation is disclosed in each piece of prior art cited on the IDS. As is published on www.uspto.gov/web/patents/accelerated/ in "Guidelines for Applicants under the new accelerated examination procedures"):

> *For each reference cited, the accelerated examination support document must include an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference. Applicants should specify where in each of the cited references the particular claim limitations are found. This process is intended to be analogous to the analysis an examiner uses when locating a relevant prior art reference and then determining whether the reference contains the claimed limitation. For each claimed limitation, the examiner would consider the disclosure of the reference and all reasonable portions in the reference where the limitation is shown. When preparing an Office Action, the examiner would correlate the limitation to the portion of reference which best characterizes the limitation. This part of the AESD is not intended to be an exhaustive listing of every conceivable subjective interpretation of how a claim limitation may read on the reference. Applicants should*

*point out what are considered to be the relevant representations of the limitation in the reference. A limitation may be found in more than one portion of the reference and should be pointed out, yet the intention is not to have applicants point out every conceivable interpretation. The USPTO will adopt a rule of reason when evaluating this portion of the AESD. Unless the representation is so deficient that it would materially effect examination of the application (e.g., numerous instances where the limitations are not shown where applicant states they are), the representation will be deemed to be sufficient for this part of the AESD.*

Petitioner's submission is not specific enough. Petitioner points out some limitations of the claim and provides direction to areas of the prior art where the corresponding limitation may be found. Petitioner does not address each limitation and where it is (or state that it is not) found in each one of the most closely related prior art. The requirement of section II element 6.2 can be satisfied by listing the presently filed claim (i.e., by listing verbatim the claim of the instant application) and by indicating where each limitation of each one of said presently filed claims is taught (or is not taught) in each one of the cited most closely related references, by specifically indicating the element number and/or the relevant page/paragraph and line number(s), or by indicating "(not disclosed)" where appropriate - in order to ensure that no limitation was left out inadvertently. This one-to-one mapping should be performed individually, with regard to each one of the most closely related prior art that has been cited, one reference at a time.

Regarding the requirements of section II element 6.5 outlined above, the requirements of this section are not met because lack of specificity. A grantable petition requires petitioner to provide a showing of where each limitation of the claims finds support under 35 U.S.C. 112, first paragraph, in the written description of the specification. The instant petition only identifies figures and paragraphs of text with respect to claim paragraphs as opposed to the disclosure of the required claim limitations, addressed individually for each limitation in the claim. The requirement of section II element 6.5 can be satisfied by listing verbatim the presently filed claim and by indicating where the instant application teaches each limitation in said presently filed claim, by indicating the element number and/or the relevant page and line numbers.

## DECISION

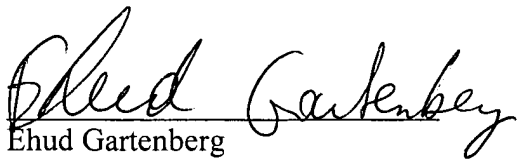
For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address all of the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal

of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Ehud Gartenberg, TC 3700 Special Programs Examiner, at (571) 272-4828. In his absence, an inquiry can be directed to Colleen P. Cooke, Special Program Examiner, at 571 272-1170.



Ehud Gartenberg
Special Programs Examiner
Technology Center 3700

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2033 K Street, NW
Suite 800
Washington DC 20006

JUN 18 2008

In re Application of: Narita, Izuru
Application No.: 12/103,516
Filed: April 15, 2008
Title: METHOD OF DETERMINING OPTIMAL AIR CONDITIONER CONTROL

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the renewed petition filed on June 6, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is GRANTED.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Ehud Gartenberg, TC 3700 Special Program Examiner, at (571) 272-4828. In his absence, an inquiry can be directed to J. Harrison, Special Program Examiner, at (571) 272-4449.

Ehud Gartenberg, Special Programs Examiner
Technology Center 3700

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,519 | 04/15/2008 | John Atkinson Fifield | BUR9-07-0243US1 | 2097 |

38245 7590 06/05/2008

JEROME D. JACKSON (JACKSON PATENT LAW OFFICE)
211 N. UNION STREET, SUITE 100
ALEXANDRIA, VA 22314

| EXAMINER | |
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| ART UNIT | PAPER NUMBER |
| 2819 | |

| MAIL DATE | DELIVERY MODE |
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The time period for reply, if any, is set in the attached communication.

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JEROME D. JACKSON (JACKSON PATENT LAW OFFICE)
211 N. UNION STREET, SUITE 100
ALEXANDRIA VA 22314

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|---|---|---|
| In re Application of:<br>FIFIELD et al<br>Serial No.: 12/103,519<br>Filed: April 15, 2008<br>Attorney Docket No.: BUR9-07-0243US1 | : | DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.2 |

This is a decision on the petition filed on April 15, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner; and

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation; and

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists; and

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions regarding the application (section I, subsections 1-4) discussed above are considered to have been met. Additionally, the conditions regarding the petition (section II, subsections 1-4) are considered to have been met. However, the petition fails to comply with the all the conditions set forth in section II, subsections 5 and 6. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirements of section II, subsection 5.1 above, it appears the search outlined in the petition omitted critical search areas by not searching in class 716 subclass 1, at a minimum to include circuit design. Any renewed petition should include the above outlined additional searching.

Regarding the requirements of section II, subsection 6, the support document supplied by petitioner does not satisfy the requirements set forth in subsection 6.3 The petition fails to specifically point out the particular language of the claims that distinguishes over the references. The petition fails to provide a detailed explanation of how each of the claims are patentable over each of the references with particularity required by 37 CFR 1.111(b) and (c) and not merely state that the references do not disclose the claim limitations. 37 CFR § 1.111 (b) states "[a] general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." 37 CFR § 1.111 (c) states in part "the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made." For example, with respect to the Lin, Lin et al and the Osada et al references, petitioner does not point out why the claims are patentable over the references individually. The petition should clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references. Further, the Osada et al reference is not even mentioned in the detailed explanation of patentability. For these reasons, the petition does not meet the requirement of subsection 6.3.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petition is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal

of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiries regarding this decision should be directed to Quality Assurance Specialist Jose' G. Dees at (571) 272-1569.

Jose' G. Dees, Quality Assurance Specialist
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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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. |
|---|---|---|---|---|
| 12/103,519 | 04/15/2008 | John Atkinson Fifield | BUR9-07-0243US1 | 2097 |

38245 7590 09/12/2008

JEROME D. JACKSON (JACKSON PATENT LAW OFFICE)
211 N. UNION STREET, SUITE 100
ALEXANDRIA, VA 22314

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2819 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 09/12/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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JEROME D. JACKSON (JACKSON PATENT LAW OFFICE)
211 N. UNION STREET, SUITE 100
ALEXANDRIA VA 22314

| | |
|---|---|
| In re Application of:<br>FIFIELD et al.<br>Serial No.: 12/103,519<br>Filed: April 15, 2008<br>Title: STRUCTURE FOR SYSTEMS AND METHODS OF MANAGING A SET OF PROGRAMMABLE FUSES ON AN INTEGRATED CIRCUIT | DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.2 |

This is a decision on the renewed petition filed on July 6, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The renewed petition to make the application special is **DENIED**.

A petition to make special was filed in the above-identified application under 37 C.F.R. § 1.102(d) on April 15, 2008. That petition was dismissed in a decision dated June 5, 2008 wherein a non-extendible period of 1 (one) month or 30 (thirty) days, whichever was longer, was set to request reconsideration.

The reason for dismissal was an inadequate pre-examination search and inadequate accelerated examination support document. The pre-examination search document omitted critical search areas. The accelerated examination support document failed to provide a detailed explanation of how each of the claims is patentable over each of the references.

The amended accelerated examination support document filed on July 6, 2008 corrects the deficiencies of the previous accelerated examination search document. However, petitioner has declined to amend the pre-examination search document by searching the omitted critical search area of class 716, subclass 1.

As mentioned in the petition decision of June 5, 2008, subsection 5 of Conditions Regarding the Petition requires that "the preexamination search must involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature including an identification of the field of search by United States class and subclass where applicable." Instead of supplying a supplemental search document specifying the field of search by United States class and subclass as outlined, petitioner states that no further search is necessary.

Petitioner provides several reasons why the search is unnecessary and asserts that no references more pertinent than those already identified are to be found in the omitted critical search area of class 716, subclass 1.

Petitioner's justification for not searching the omitted searched area includes the following reasons; the text search performed covered all USPTO classes and subclasses, the class 327, subclass 525 search was the search used in the closest prior art reference and the omitted critical search area of class 716, subclass 1 is not related to the body of the claim, but related to the preamble and the preamble is anticipated by the Osada et al reference.

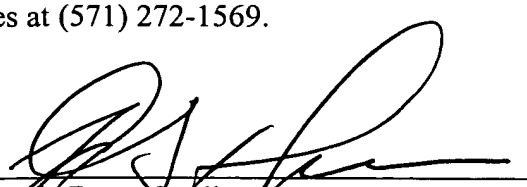
The suggested additional search may not uncover references which are more pertinent than those cited in the accelerated support document, however, the search should have been completed. MPEP 904.02 defines the general search guidelines for the examiner and states that the "examiner must conduct a thorough search of the prior art by following three distinct steps: (A) identifying the field of search; (B) selecting the proper tool(s) to perform the search; and (C) determining the appropriate search strategy for each search tool selected. Each step is critical for a complete and thorough search." In this case, the examiner has determined that the omitted critical search area of class 716, subclass 1 is the appropriate search strategy and petitioner admits that the omitted critical search area of class 716, subclass 1 is related to the claim.

Further, MPEP 904.03 states "It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment."

For the above stated reasons, the renewed petition is denied. The application will therefore be taken up the examiner for action in its regular turn.

Petitioner is reminded that a single opportunity to perfect the petition is given. Therefore, further petitions for accelerated examination in this application will not be entertained.

Any inquiries regarding this decision should be directed to Quality Assurance Specialist Jose' G. Dees at (571) 272-1569.



Jose' G. Dees, Quality Assurance Specialist
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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OFFICE OF PETITIONS

**KING & SPALDING LLP**
**P.O. BOX 889**
**BELMONT, CA 94002-0889**

| | | |
|---|---|---|
| In re Application of | : | |
| Michael GERTNER, et al | : | |
| Application No. 12/103,534 | : | DECISION ON PETITION |
| Filed: April 15, 2008 | : | TO WITHDRAW |
| Attorney Docket No. 67224-8004 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 27, 2009.

The request is **NOT APPROVED.**

The Office will no longer accept address changes to a new practitioner or law firm filed with a Request, absent the filing of a power of attorney to the new representative. The Office will either change the correspondence address of record to the most current address information provided for the assignee of the entire interest who properly became of record under 37 CFR 3.71 or, if no assignee of the entire interest has properly been made of record under 37 CFR 3.71, the most current address information provided for the first named inventor.

Accordingly, since no current address has been provided for: (1) the first named inventor; or (2) an assignee of the entire interest who properly became of record under 37 C.F.R 3.71, the request cannot be granted.

All future communications from the Office will continue to be directed to the above-identified address until otherwise properly notified.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-6735.

/Diane Goodwyn/
Diane Goodwyn
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

SEP 14 2009

HAYNES AND BOONE, LLP
IP Section
2323 Victory Avenue, Suite 700
Dallas, TX 75219

| | | |
|---|---|---|
| In re application of | : | DECISION ON REQUEST TO |
| Ronald Henry Deibert | : | PARTICIPATE IN PATENT |
| Application No. 12/103,536 | : | PROSECUTION HIGHWAY PILOT |
| Filed: April 15, 2008 | : | PROGRAM AND PETITION |
| For: MULTIPLE-USE VERMIN ELECTROCUTION TRAP AND METHOD | : | 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 9, 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 CIPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the CIPO application.
(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 CIPO 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 CIPO application containing the allowable/patentable claim(s);
(6) Applicant must submit an IDS listing the documents cited by the CIPO examiner in the CIPO office action(s) 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).

In light of the preliminary amendment filed September 9, 2009 in which the claims have been amended to sufficiently correspond to the allowable/patentable claims in the CIPO 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.

Telephone inquires concerning this decision should be directed to Teri P. Luu, Quality Assurance Specialist, at 571-272-7045.

All other inquiries concerning the examination or status of the application should be directed to the Patent Application Information Retrieval (PAIR) system.

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

/Teri P. Luu/

Teri P. Luu
Quality Assurance Specialist
Technology Center 3600

TL: 9/14/09

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

Mail Date: 04/28/2010

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|---|---|---|
| **Applicant** | : Eric Ojard | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7633993 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/15/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 12/103,603 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/15/2008 | : 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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United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,646 | 04/15/2008 | Steve Hotelling | 106842509101 | 2358 |

7590 10/15/2008

APPLE C/O MORRISON AND FOERSTER ,LLP
LOS ANGELES
555 WEST FIFTH STREET SUITE 3500
LOS ANGELES, CA 90013-1024

| EXAMINER | |
|---|---|
| EISEN, ALEXANDER | |
| **ART UNIT** | **PAPER NUMBER** |
| 2617 | |
| **MAIL DATE** | **DELIVERY MODE** |
| 10/15/2008 | PAPER |

# DECISION GRANTING PETITION UNDER 37 CFR 1.138(d)

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Betty Powell

Patent Publication Branch
Office of Data Management

Adjustment Date: 10/16/2008 BPOWELL
04/16/2008 INTEFSW 00003930 031952 12103646
02 FC:1111 510.00 CR

Adjustment date: 10/16/2008 BPOWELL
04/16/2008 INTEFSW 00003930 031952 12103646
02 FC:1111 510.00 CR

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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. |
|---|---|---|---|---|
| 12/103,705 | 04/15/2008 | Dibyendu Das | IN920070076US1/RKC100023 | 2463 |

76089 7590 07/28/2008
CARPENTER & ASSOCIATES
5 PIPESTEM COURT
ROCKVILLE, MD 20854

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2195 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 07/28/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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CARPENTER & ASSOCIATES
5 PIPESTEM COURT
ROCKVILLE MD 20854

| | |
|---|---|
| In re Application of:<br>Dibyendu Das et al.<br>Serial No.: 12/103705<br>Filed: April 15, 2008<br>Docket: IN920070076US1/RKC100023<br>Title: METHOD FOR COMPUTATION-COMMUNICATION OVERLAP IN MPI APPLICATIONS | DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02 |

This is a decision on the petition filed on April 15, 2008 to make the above-identified application special for accelerated examination procedure 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;
5. The petition must be filed with the application.

The application as filed is not eligible for the accelerated examination under 37 C.F.R. § 1.102(d) because it is a utility application filed under 37 CFR 1.111(a) and was not complete

under 37 CFR 1.51 and in condition for examination at the time of filing. The mailing of the Notice to File Corrected Application Papers on April 21, 2008 is evidence that the application was not complete and in condition for examination at the time of filing.

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 the undersigned at (571) 272-3719. If attempts to reach the undersigned are unsuccessful, Mano Padmanabhan., Quality Assurance Specialist can be reached at (571)272-4210.

/Kakali Chaki/

Kakali Chaki, Quality Assurance Specialist

Technology Center 2100

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MICROSOFT CORPORATION
ONE MICROSOFT WAY
REDMOND WA 98052

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OFFICE OF PETITIONS

In re Application of :
Hulten, et al. :
Application No. 12/103,713 : DECISION
Filed: 16 April, 2008 :
Attorney Docket No. 321642.01 :

This is a decision on the petition, filed 28 May, 2009, for revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b).

The petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(b)."

This is **not** a final agency action within the meaning of 5 U.S.C.§704.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

**Petitioner does not appear to have addressed the reply requirement(s) under the rule. These deficiencies must be overcome.**

**Petitioners attentions always are directed to the guidance in the Commentary at MPEP §711.03(c )(II).**

## BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the Notice of Missing Parts (oath/declaration, surcharge) mailed on 6 May, 2008, with reply due absent extension of time on or before 6 July, 2008.

The application went abandoned after midnight 6 July, 2008.

The Office mailed the Notice of Abandonment on 12 January, 2009.

On 28 May, 2009, Petitioner filed, *inter alia*, a petition (with fee) pursuant to 37 C.F.R. §1.137(b), with statement of unintentional delay, a reply in the form of an oath/declaration executed by co-inventors Messrs. Hulten, Rehfuss, Franczyk, Meek and Scarrow for themselves and on behalf of non-signing inventor Andrew Newman (Mr. Newman) with a petition pursuant to 37 C.F.R. §1.47, but with no fee or authorization. (A search of the file does not reveal the presence of a continuing authorization of fees.) Because the fee is jurisdictional, it is not possible to address the substance of the petition, and, thus, no reply is deemed present.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

**Petitioners attentions always are directed to the guidance in the Commentary at MPEP §711.03(c )(II) as to a petition pursuant to 37 C.F.R. §1.137.**

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

---

[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

[2] 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[3]))

As to Allegations of
Unintentional Delay

As indicated above, the requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a proper reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

As discussed above, it does not appear that Petitioner has satisfied the reply requirement under the rule.

## CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.137(b) is **dismissed**.

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

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

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

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

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Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[3] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[4]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[4] The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of Petitioners or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MICROSOFT CORPORATION
ONE MICROSOFT WAY
REDMOND WA 98052

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JUN 23 2009

OFFICE OF PETITIONS

In re Application of :
Hulten, et al. :
Application No. 12/103,713 : DECISION
Filed: 16 April, 2008 :
Attorney Docket No. 321642.01 :

This is a decision on the petition, filed 28 May, 2009, under 37 C.F.R. §1.47.

The petition as considered under 37 C.F.R. §1.47(a) is **DISMISSED**.

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

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) petition and fee; (2) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification: description, claims and drawings); (3) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; and (4) a statement of the last known address of the non-signing inventor(s)—with diligence in the effort to ascertain the validity of the address set forth as the reasonably believed to be last known/current/valid address.

Petitioner does not seem to have worked through the requirements of the petition, as set forth above, in satisfaction of those requirements. And, in particular, Petitioner, *inter alia*, has not as of this writing satisfied the showing of the fee, the transmittal of the entire application (description, claims, abstract and drawings) to the non-signing inventor(s) at the reasonably believed to be last known/valid/current address of the non-signing inventor(s). (*See, generally:* MPEP §409.03, and §409.03(a)—the applicable statute (35 U.S.C.§ 116) requires that a "diligent

effort" have been expended in attempting to find or reach the non-signing inventor to ensure transmittal to the non-signing inventors a copy of the entire application (description, claims, abstract, drawings) with a copy of the transmittal letter) to the non-signing inventor(s).)

*Further, Petitioners always are reminded that for transmission by Email of any document to be accepted by the Office, written acknowledgment of receipt and readability will be required.*

## BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the Notice of Missing Parts (oath/declaration, surcharge) mailed on 6 May, 2008, with reply due absent extension of time on or before 6 July, 2008.

The application went abandoned after midnight 6 July, 2008.

The Office mailed the Notice of Abandonment on 12 January, 2009.

On 28 May, 2009, Petitioner filed, *inter alia*, a petition (with fee) pursuant to 37 C.F.R. §1.137(b), with statement of unintentional delay, a reply in the form of an oath/declaration executed by co-inventors Messrs. Hulten, Rehfuss, Franczyk, Meek and Scarrow for themselves and on behalf of non-signing inventor Andrew Newman (Mr. Newman) with a petition pursuant to 37 C.F.R. §1.47, but with no fee or fee authorization. (A search of the file did not reveal the presence of a general/continuing authorization of fees.) Because the fee is jurisdictional, it is not possible to address the substance of the petition. It is noted that there is no demonstration that:

- Petitioner has made a diligent search in an effort to identify a reasonably believed to be last known/valid/current address for Mr. Newman; and

- the entire application (description, claims, abstract, drawings) was sent to Mr. Newman

Petitioner must resolve these matters on any renewed petition and is reminded that a grantable petition under 37 C.F.R. §1.47(a) requires: (1) petition and fee; (2) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification: description, claims and drawings); (3) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; and (4) a statement of the last known address of the non-signing inventor(s)—with diligence in the effort to ascertain the validity of the address set forth as the reasonably believed to be last known/current/valid address.

Petitioner must satisfy the requirements pursuant to the Rule and the guidance in the Commentary at MPEP §409.03, and §409.03(a) et seq.

Thus, the present incompleteness of the record makes granting of the instant petition inappropriate.

*Petitioners always are reminded that for transmission by Email of any document to be accepted by the Office, written acknowledgment of receipt and readability will be required.*

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

The instant petition under 37 C.F.R. §1.47(a) is **dismissed**.

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

[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[2]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

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[2] The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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SEP 14 2009

**OFFICE OF PETITIONS**

In re Application of :
Hulten, et al. :
Application No. 12/103,713 : DECISION
Filed: 16 April, 2008 :
Attorney Docket No. 321642.01 :

This is a decision on the petition, filed on 18 August, 2009, for revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b).

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

As to the Allegations
of Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

*Petitioners attentions always are directed to the guidance in the Commentary at MPEP §711.03(c)(II).*

## BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the Notice of Missing Parts (oath/declaration, surcharge) mailed on 6 May, 2008, with reply due absent extension of time on or before 6 July, 2008.

The application went abandoned after midnight 6 July, 2008.

The Office mailed the Notice of Abandonment on 12 January, 2009.

On 28 May, 2009, Petitioner filed, *inter alia*, a petition (with fee) pursuant to 37 C.F.R. §1.137(b), with statement of unintentional delay, a reply in the form of an oath/declaration executed by co-inventors Messrs. Hulten, Rehfuss, Franczyk, Meek and Scarrow for themselves and on behalf of non-signing inventor Andrew Newman (Mr. Newman) with a petition pursuant to 37 C.F.R. §1.47, but with no fee or authorization for that petition. (A search of the file did not reveal the presence of a continuing authorization of fees.) Because the fee is jurisdictional, it was not possible to address the substance of the petition, and, thus, no reply was deemed present—the petition was dismissed on 23 June, 2009.

On 18 August, 2009, Petitioner filed, *inter alia*, a petition (with fee) pursuant to 37 C.F.R. §1.137(b), with statement of unintentional delay, a reply in the form of an oath/declaration executed by co-inventors Messrs. Hulten, Rehfuss, Franczyk, Meek and Scarrow for themselves and and Scarrow for themselves and on behalf of non-signing inventor Andrew Newman (Mr. Newman) with a petition and fee pursuant to 37 C.F.R. §1.47.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office **must** inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

*Petitioners attentions always are directed to the guidance in the Commentary at MPEP §711.03(c)(II) as to a petition pursuant to 37 C.F.R. §1.137.*

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

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[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

[2] 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

Unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[3]))

As to Allegations of
Unintentional Delay

As indicated above, the requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a proper reply, a proper statement and/or showing of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee.

As discussed above, it appears that Petitioner has satisfied the requirements under the rule.

## CONCLUSION

Accordingly, the petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to the Office of Patent Application Processing (OPAP) for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the OPAP in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the OPAP where that change of status must be effected—that does not occur in the Office of Petitions.

[3] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[4]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[4] The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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REDMOND WA 98052

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OFFICE OF PETITIONS

In re Application of :
Hulten, et al. :
Application No. 12/103,713 : DECISION
Filed: 16 April, 2008 :
Attorney Docket No. 321642.01 :

This is a decision on the petition, filed on 18 August, 2009, under 37 C.F.R. §1.47.

The petition as considered under 37 C.F.R. §1.47(a) is **GRANTED**.

A grantable petition under 37 C.F.R. §1.47(a) requires: (1) petition and fee; (2) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification: description, claims and drawings); (3) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; and (4) a statement of the last known address of the non-signing inventor(s)—with diligence in the effort to ascertain the validity of the address set forth as the reasonably believed to be last known/current/valid address.

*Petitioners always are reminded that for transmission by Email of any document to be accepted by the Office, written acknowledgment of receipt and readability will be required.*

## BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the Notice of Missing Parts (oath/declaration, surcharge) mailed on 6 May, 2008, with reply due absent extension of time on or before 6 July, 2008.

The application went abandoned after midnight 6 July, 2008.

The Office mailed the Notice of Abandonment on 12 January, 2009.

On 28 May, 2009, Petitioner filed, *inter alia*, a petition (with fee) pursuant to 37 C.F.R. §1.137(b), with statement of unintentional delay, a reply in the form of an oath/declaration executed by co-inventors Messrs. Hulten, Rehfuss, Franczyk, Meek and Scarrow for themselves and on behalf of non-signing inventor Andrew Newman (Mr. Newman) with a petition pursuant to 37 C.F.R. §1.47, but with no fee or fee authorization for that petition. (A search of the file did not reveal the presence of a general/continuing authorization of fees.) Because the fee is jurisdictional, it was not possible to address the substance of the petition. It is noted that there was no demonstration that: Petitioner made a diligent search in an effort to identify a reasonably believed to be last known/valid/current address for Mr. Newman; and the entire application (description, claims, abstract, drawings) was sent to Mr. Newman. The petition was dismissed on 23 June, 2009.

On 18 August, 2009, Petitioner filed a renewed petition ) pursuant to 37 C.F.R. §1.137(b), which has been addressed, and a reply in the form of an oath/declaration executed by co-inventors Messrs. Hulten, Rehfuss, Franczyk, Meek and Scarrow for themselves and on behalf of non-signing inventor Andrew Newman (Mr. Newman) with a petition pursuant to 37 C.F.R. §1.47 with fee, and pointing back to the prior submission demonstrating, *inter alia*, the non-signing inventor's constructive refusal to sign and so compliance with the requirements of a grantable petition under 37 C.F.R. §1.47(a): (1) petition and fee; (2) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification: description, claims and drawings); (3) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; and (4) a statement of the last known address of the non-signing inventor(s)—with diligence in the effort to ascertain the validity of the address set forth as the reasonably believed to be last known/current/valid address. (Thus, Petitioner sought to satisfy the requirements pursuant to the Rule and the guidance in the Commentary at MPEP §409.03, and §409.03(a) et seq.)

*Petitioners always are reminded that for transmission by Email of any document to be accepted by the Office, written acknowledgment of receipt and readability will be required.*

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88

## CONCLUSION

The instant petition under 37 C.F.R. §1.47(a) is **granted** (status is accorded pursuant to 37 C.F.R. §1.47(a).)

As provided in 37 C.F.R. §1.47(c), this Office will forward notice of this application's filing to the non-signing inventors at the addresses given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

The instant application is released to the Office of Patent Application Processing (OPAP) for further processing in due course.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[2]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

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and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office). See specifically, the regulations at 37 C.F.R. §10.18.

[2] The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**
All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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

ANDREW NEWMAN
726 GINGER LAKE
FRANKLIN, NJ 07417

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Hulten, et al. | : | |
| Application No. 12/103,713 | : | COMMUNICATION |
| Filed: 16 April, 2008 | : | |
| Attorney Docket No. 321642.01 | : | |

Dear Andrew Newman:

You are named as an inventor in the above-identified United States patent application, filed under the provisions of 35 U.S.C. §116 (United States Code), and 37 C.F.R. §1.47 (Code of Federal Regulations), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein 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 C.F.R. §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 the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 C.F.R. §1.63.

Should you elect to join in the application, the contact information for Counsel of Record is set forth at the end of this Communication.

Should you seek to identify independent Counsel, you may find the Patent Attorneys/Agents Search engine of assistance (https://oedci.uspto.gov/OEDCI/ ).

Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (571) 272-3150 or 1 (800) 972-6382 (outside the Washington, DC area).

Telephone inquiries regarding this communication may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[1]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s) Moreover, the Office can neither advise you nor recommend Counsel in this matter.

/JG

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

Counsel of Record
MICROSOFT CORPORATION
ONE MICROSOFT WAY
REDMOND WA 98052

[1] The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt

PTO/SB/130 (03-08)
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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it 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 | 12103722 | Confirmation Number | 2506 | Filing Date | 2008-04-16 |
| Attorney Docket Number (optional) | PA0007391US | Art Unit | | Examiner | |
| First Named Inventor | Frederick Joslin | | | | |
| Title of Invention | Electro Chemical Grinding (ECG) Quill and Method to Manufacture a Rotor Blade Retention Slot | | | | |

**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 |
|---|---|---|---|
| Frederick | | Joslin | |

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 | /David L. Wisz/ | Date (YYYY-MM-DD) | 2008-04-16 |
| Name | David L. Wisz | Registration Number | 46350 |

PTO/SB/130 (03-08)
Approved for use through 04/30/2008. 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.

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P.O. Box 1450
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In re Application of
Frederick Joslin

Application No. 12103722

Filed:

Attorney Docket No. PA0007391U;67097-1065PUS1

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

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1) ,filed 16-APR-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.

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Cantor Colburn LLP-IBM Europe
20 Church Street
22nd Floor
Hartford CT 06103

**MAIL**

JUN 03 2008

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Carl BINDING, et al.
Serial No.: 12/103,775
Filed: April 16, 2008

Title: **METHOD FOR TRACKING CONTAINERS USING A LOW-RATE WIRELESS PERSONAL AREA NETWORK SYSTEM**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 16, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions set forth under section I. above are considered to have been met. However, the petition fails to comply with conditions set forth under section II. , items 5 through 5.3.

Regarding the requirement in item 5. through 5.3 above, the preexamination search document provided with the instant petition is deficient as follows: The US field of search and database searches which are to be provided under section 8(A) are not sufficient. In addition to the search areas provided, applicant would also need to search in the following class/subclasses: 340/ 10.1, 425.5, 572.1, 438, 36, 5.92; 235/ 385 and 384; 705/ 13, 22, and 28; 701/ 2; 180/ 271 and 290; and 455/ 435.1.

Please note that any request for reconsideration must include an Information Disclosure Statement citing any newly found relevant prior art and an updated Accelerated Examination Support Document (AESD) meeting all of requirements 6.1 – 6.6 for any documents uncovered by the new search(es) as required above.

For the reason cited above, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Krista Zele, Quality Assurance Specialist, at (571) 272-7288.

/Krista Zele/

Krista Zele
Quality Assurance Specialist
Technology Center 2600
Communications

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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

Cantor Colburn LLP-IBM Europe
20 Church Street
22nd Floor
Hartford CT 06103

In re Application of:
CARL BINDING et al
Serial No.: 12/103775
Filed: April 16, 2008
Attorney Docket Number: CH920070026US2
Title: **METHOD FOR TRACKING CONTAINERS USING A LOW-RATE WIRELESS PERSONAL AREA NETWORK SYSTEM**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on June 27, 2008 requesting reconsideration to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:

To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Eileen Lillis, Quality Assurance Specialist, at (571) 272-6928.

/Eileen D. Lillis/

Eileen D. Lillis
Quality Assurance Specialist
Technology Center 2600

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

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SEP 26 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Nadreau, Yvin, and Le Moine | : | |
| Application Number: 12/103,781 | : | DECISION ACCORDING STATUS |
| Filing Date: 04/16/2008 | : | UNDER 37 CFR 1.47(a) |
| Attorney Docket Number: | : | |
| 3340.239US02 | : | |

This is a decision on the petition under 37 CFR 1.47(a) filed on August 25, 2008.

The petition is **GRANTED**.

Petitioners have shown that the non-signing inventor, Michael Nadreau, has refused to join in the filing of the above-identified application after having been sent a copy of the application papers. Specifically, petitioners have shown that a copy of the application papers was sent to the non-signing inventor, but that the non-signing inventor sent back a letter stating that he would not sign the declaration unless he was paid additional compensation.

As such, the showing of record is that the non-signing inventor expressly refused to sign the declaration naming him as a joint inventor along with Jean-Claude Yvin and Patrick Le Moine.

The address in the declaration and the cover letter addressed to the non-signing inventor is being construed as the last known address. Petitioners must inform the Office if this is an incorrect interpretation.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given the Declaration. Notice of the filing of this application will also be published in the *Official Gazette*.

The application is being referred to the Office of Patent Application Processing for further processing.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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Michael Nadreau
5 rue de General Leclerc
29400 Landivisiau
FRANCE

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SEP 2 6 2008

In re Application of
Nadreau et al.
Application No. 12/103,781
Filed: April 16, 2008
For: SYSTEM AND METHOD FOR AUTOMATICALLY DETERMINING THE SEX OF CHICKS AND FOR CONVEYING LIVING ANIMALS

Dear Mr. Nadreau:

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 571/272-3231. Requests for information regarding your application should be directed to the File Information Unit at 571-272-3150. 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 571-272-3150 or 1-800-972-6382 (outside the Washington D.C. area).

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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

PTO/SB/130 (03-08)
Approved for use through 04/30/2008. 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 | 12103793 | Confirmation Number | 2663 | Filing Date | 2008-04-16 |
| Attorney Docket Number (optional) | ST-2 | Art Unit | | Examiner | |
| First Named Inventor | Simon Tseytlin | | | | |
| Title of Invention | A bottomhole tool and a method for enhanced oil production and stabilization of wells with high gas-to-oil ratio | | | | |

**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 |
|---|---|---|---|
| Simon | | Tseytlin | |

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 | /leschinsky/ | Date (YYYY-MM-DD) | 2008-04-16 |
| Name | Boris Leschinsky | Registration Number | 41404 |

PTO/SB/130 (03-08)
Approved for use through 04/30/2008. 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.

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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In re Application of
Simon Tseytlin

Application No. 12103793

Filed:

Attorney Docket No. ST-2

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

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1) ,filed 16-APR-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.

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**C/O PORTFOLIOIP**
**P.O. BOX 52050**
**MINNEAPOLIS MN 55402**

MAILED

MAY 20 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Gad Liwerant | : | DECISION ON PETITION |
| Application No. 12/103,797 | : | TO WITHDRAW |
| Filed: April 16, 2008 | : | FROM RECORD |
| Attorney Docket No. LIWG-0002-P01 | : | |

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 12, 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 Paul E. Lewkowicz on behalf of all attorneys of record who are associated with Customer No. 43520.

All attorneys/agents associated with Customer Number 43520 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the applicant 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

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Gad Liwerant
16 Essex Road
Chestnut Hill, MA 02467

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P.O. Box 1450
Alexandria, VA 22313-1450
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April 12, 2010 BC

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|---|---|---|
| In re application of<br>Naomu Kitano et al.<br>Serial No. 12/103,813<br>Filed: April 16, 2008<br>For: SPUTTERING FILM FORMING METHOD, ELECTRONIC DEVICE MANUFACTURING METHOD, AND SPUTTERING SYSTEM | :<br>:<br>:<br>:<br>:<br>:<br>: | 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 filed March 04, 2010.

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, note where the JPO 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 JPO application with similar claims and the JPO priority 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 to obtain a copy from 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), 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 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 claims(s) or
   ii. if the allowable/patentable claim(s) are from "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 is available via the Dossier Access System (DAS), applicant may request the USPO obtain a copy from the DAS; however, if the USPTO is unable to obtain a copy of 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 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 JPO examiner in the JPO 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 comply with the above requirements. Accordingly, the above-identified application has been accorded "special" status.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Any inquiry regarding this decision should be directed to Blaine Copenheaver, Quality Assurance Specialist, at (571) 272-1156.

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.

/Blaine Copenheaver/

Blaine Copenheaver
Quality Assurance Specialist
Technology Center 1700

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**MATTHIAS SCHOLL**
**14781 MEMORIAL DRIVE**
**SUITE 1319**
**HOUSTON TX 77079**

COPY MAILED
JAN 28 2010

| | | |
|---|---|---|
| In re Application of | : | |
| Zhang, Yue | : | |
| Application No. 12/103,827 | : | ON PETITION |
| Filed: April 16, 2008 | : | |
| Attorney Docket No. CSRZ-00701-UUS | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed November 23, 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 a Reply to Non-Final Office Action under 37 CFR 1.111, (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 3744 for further examination on the merits.

Liana Walsh
Petitions Examiner
Office of Petitions

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,843 | 04/16/2008 | Ruthie D. Lyle | CAM920070169US2 | 2766 |

63605 7590 08/29/2008

CANTOR COLBURN LLP - IBM LOTUS
20 Church Street
22nd Floor
Hartford, CT 06103

| EXAMINER | |
|---|---|
| LUU, LE HIEN | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2141 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/29/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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CANTOR COLBURN LLP - IBM LOTUS
20 Church Street
22nd Floor
Hartford CT 06103

In re Application of: LYLE et al.
Serial No.: 12/103,843
Filed: April 16, 2008
Docket: CAM920070169US2
Title: SYSTEM ALLOWING PARTICIPANT IN A CHAT SESSION TO USE EITHER PUBLIC TAG OR PRIVATE TAG TO MANAGE CHAT HISTORIES

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 16, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d), and the supplemental AESD filed on August 26, 2008.

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:

If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:

To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve-month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application. In addition, Applicant is reminded that due to the dismissal of the previous petition submission, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to the undersigned at (571) 272-4210. If attempts to reach the undersigned by telephone are unsuccessful, Kakali Chaki, Quality Assurance Specialist, can be reached at (571) 272-3719.

Mano Padmanabhan,
Quality Assurance Specialist
Technology Center 2100
Computer Architecture, Software and Information Security

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,844 | 04/16/2008 | DER-ING LIAO | CL3761USNA | 2767 |

23906 7590 03/08/2010

E I DU PONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1122B
4417 LANCASTER PIKE
WILMINGTON, DE 19805

| EXAMINER | |
|---|---|
| JOIKE, MICHELE K | |
| **ART UNIT** | **PAPER NUMBER** |
| 1636 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 03/08/2010 | 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):

PTO-Legal.PRC@usa.dupont.com

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WILMINGTON DE 19805

| | | |
|---|---|---|
| In re Application of | : | |
| Liao, DER-ING et al. | : | DECISION ON PETITION |
| Application No.12/103844 | : | TO MAKE SPECIAL UNDER |
| Filed: April 16, 2008 | : | THE GREEN TECHNOLOGY |
| Attorney Docket No. CL3761USNA | : | PILOT PROGRAM |

This is a decision on the petition under 37 CFR 1.102, filed February 24th, 2010, to make the above-identified application special under the pilot program for applications pertaining to Green Technologies as set forth 74 Federal Register Notice 64666 (December 8, 2009).

The petition is **GRANTED**.

A grantable petition to make an application special under 37 CFR 1.102 and the pilot program as set forth in 74 FR 64666 must be directed to a nonprovisional application filed under 35 USC 111(a) or be a national stage entry under 35 USC 371, exclusive of any reissue applications and be filed prior to the date of the notice, December 8, 2009.

In order to qualify for special status, the following requirements must be met. 1) The application must be classified in one of the eligible US classifications listed in section VI of the notice. 2) The application must have no more than 3 independent claims and no more than 20 total claims. 3) The application must not contain any multiple dependent claims. 4) The petition must state the basis for seeking special status, i.e., the claimed invention either: A) materially enhances the quality of the environment or B) materially contributes to: i) the discovery or development of renewable energy resources, ii) the more efficient utilization and conservation of energy resources, or iii) greenhouse gas emission reduction. 5) If the disclosure is not clear on its face that the claimed invention materially contributes under category (A) or (B), the petition must be accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office explaining how the materiality standard is met. 6) A statement that applicant will agree to make an election without traverse in a telephonic interview if a restriction requirement is made by the examiner. 7) The petition to make special must be filed electronically. 8) The petition must be filed at least one day prior to the date that a first Office Action appears in the Patent Application Information Retrieval (PAIR) system. 9) The petition

must be accompanied by a request for early publication in compliance with 37 CFR 1.219 and include the publication fee as set forth in 37 CFR 1.18(d).

The requirement for a fee for consideration of the petition to make special for applications pertaining to Green Technologies has been waived.

The instant petition complies with items 1–9 above. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquires concerning this decision should be directed to Manjunath Rao at 571-272-0939.

The application is being forwarded to the Technology Center Art Unit 1636 for action on the merits commensurate with this decision.

/Manjunath Rao/

Manjunath Rao
Supervisory Patent Examiner
Technology Center 1600

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In re Application of
JOHN SHEPARD

Application No. 12103847

Filed: April 16,2008

Attorney Docket No. DN1696

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

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1), filed 23-MAR-2010 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 inquiries concerning this electronic decision should be directed to the Electronic Business Center at 866-217-9197.

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,890 | 04/16/2008 | Jonathan Limburn | GB920080099US1 | 2853 |

45046 7590 07/16/2008

IBM CORPORATION (SWP)
C/O SUITER SWANTZ PC LLO
14301 FNB PARKWAY, SUITE 220
OMAHA, NE 68154-5299

| EXAMINER | |
|---|---|
| BULLOCK JR, LEWIS ALEXANDER | |
| **ART UNIT** | **PAPER NUMBER** |
| 2193 | |
| **MAIL DATE** | **DELIVERY MODE** |
| 07/16/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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IBM CORPORATION (SWP)
C/O SUITER SWANTZ PC LLO
14301 FNB PARKWAY, SUITE 220
OMAHA, NE 68154-5299

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|---|---|---|
| In re Application of | : | |
| Jonathan Limburn et al. | : | DECISION ON PETITION TO |
| Appl. No.: 12/103,890 | : | MAKE SPECIAL FOR NEW |
| Filed: April 16, 2008 | : | APPLICATION UNDER 37 |
| Docket : GB920080099US1 | : | C.F.R. § 1.102 & M.P.E.P. § |
| For: A Method For Transforming Data From A Model Into A Secondary Model To Optimize Code Generation | : | 708.02 |

This is a decision on the petition filed on April 16, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition is dismissed.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any dependent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

REVIEW OF FACTS

The conditions I.1 – I.4, II.1 – II.4, II5.1, II.5.3, II.6.4 and II.6.6 above are considered to have been met. However, the petition fails to comply with conditions II.5.2, II.6.2, II.6.3, and II.6.5 above. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirement of MPEP § 708.02(a)(I.)(H) and items II.5, 5.2 above, the preexamination search must be directed to the (instant) claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation.

With respect to item II.5.2 above, claim limitations, some of which have been asserted as patentable features distinguishing the claimed invention from the cited prior art, i.e. "transforming parsed data into the secondary model" and "generating code through java emitter templates based upon said secondary model," or any search terms covering these limitations do not appear to have been included in any of the Patent database searches and the Non-Patent literature (NPL) search. Petitioner should review all claim limitations, especially those asserted as patentable distinctions from the cited references to ensure that both the patent database search and the NPL search cover these concepts, and update the search and/or provide any clarifications if deemed necessary.

Further, with respect to item II.5.2 above, petitioner is required to provide keywords and phrases encompassing limitations of each claim including those deemed by the applicant as patentable features distinguishing the claimed invention from the cited prior art used in any database search. Petitioner should review all claim limitations, especially those believed to be patentable distinctions from the cited references to ensure that the search covered these concepts, and update the search and/or provide any clarifications if deemed necessary.

Additionally, the statement of patentability in the Examination Support Document indicates that none of the references deemed to be most closely related to the claimed invention discloses any of the features of the claimed invention, thus it is unclear whether the search included any of the features recited in any of the claims. Examples of a properly documented search are available at http://www.uspto.gov/web/patents/accelerated/ae_presearch_sample.doc.

Regarding the requirement of MPEP § 708.02(a)(I.)(I)(3) and item 6.2 above, the Accelerated Examination support Document only provides a general discussion of pertinent references without specifically pointing out which claim limitations are disclosed by each of the references, as required. Applicant should provide a claim-by-claim mapping of the pertinent subject matter disclosed in each of the references, specifically identifying each claim limitation and corresponding disclosure within the reference, citing to specific relevant portions of each reference. Correction is required.

Regarding item 6.3 above, it should be noted that while applicant's detailed explanation of how the claim is patentable over the cited references (every reference fails to teach **any** limitation of the sole claim) is technically acceptable, not finding even one reference that teaches even one claimed limitation may be another indication of the inadequacy of the search. It is assumed that after the supplemental search is completed new references will be found that better read on the claimed invention and will be properly analyzed in the Support Document include with any renewed petition.

the Support Document fails to provide a detailed explanation of how the claim is patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c).

Specifically, 37 CFR § 1.111 (b) states "[a] general allegation that the claims define a patentable invention without specifically pointing out *how the language of the claims patentably distinguishes* them from the references does not comply with the requirements of this section."

37 CFR § 1.111 (c) states in part "the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made."

Specifically, the petitioner's "Detailed Explanation of Patentability" is not clear and consistent as to how the claim is patentable over the references cited. In particular, petitioner assertion in section 9(C) of the Support Document that "the claim is seen patentably distinguish over each of these references alone or in combination" after reciting all the limitations of claim 1 fails to comply with 37 CFR § 1.111 (b). In addition, petitioner should review the Detailed Explanation of Patentability section in view of changes and clarifications added to section 9(B) and provide clarifications, if deemed necessary, to ensure compliance with the requirement of MPEP § 708.02(a)(I.)(I)(3) and item 6.3 above.

Regarding to the requirement of MPEP § 708.02(a)(I.)(I)(5) and item II.6.5 above, the Accelerated Examination Support Document only identifies pages 3 and 4, paragraph [0007] of the instant specification and figure 1 as providing support for the sole claim 1. However, the requirement of MPEP § 708.02(a)(I.)(I)(5) and item II.6.5 above clearly states that the petitioner is required to specifically **identify what corresponding elements in the** figures and/or specifically **identify where the corresponding written description in the cited portions of the instant specification** can find support under 35 U.S.C. § 112, first paragraph for **each limitation of the** claim 1. A review of the paragraph [0007] on pages 3 and 4 indicates that the description on these pages is identical to the claimed language of claim 1, except the legal phraseology used in patent claim (e.g. "said"). It is pointed out that the written description requirement has several policy objectives. The essential goal of the description of the invention requirement is to clearly convey the information that an applicant has invented the subject matter which is claimed. Another objective is to put the examiner in Possession of what the applicant claims as the invention - the written description requirement implements the principle that a patent application must describe the technology that is sought to be patented; the requirement serves both to satisfy

the inventor's obligation to disclose the technologic knowledge upon which the application is based and to demonstrate that the applicants were in possession of the invention that is claimed. Further, the written description requirement promotes the progress of expedite examination by ensuring that applicants adequately describe their inventions in sufficient detail in their applications in exchange for the right to take-up out of order of examination. Thus, a general statement that all limitations of claim(s) can be found in all of the figures and pointing to the specification having a verbatim of the claim language cannot be accepted to satisfy such a requirement of MPEP § 708.02(a)(I.)(I)(5) and item II.6.5 above. A clarification and identification of support is required.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Eddie C. Lee at (571) 272-1732. If attempts to reach the undersigned are unsuccessful, Kakali Chaki, Quality Assurance Specialist, Technology Center 2100 can be reached at (571)272-3719.

/Eddie C. Lee/

Eddie C. Lee
Technology Center 2100

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. |
|---|---|---|---|---|
| 12/103,890 | 04/16/2008 | Jonathan Limburn | GB920080099US1 | 2853 |

82294 7590 12/22/2008

IBM CORPORATION (ACCSP)
c/o Suiter Swantz pc llo
14301 FNB Parkway, Suite 220
Omaha, NE 68154

| EXAMINER | |
|---|---|
| BULLOCK JR, LEWIS ALEXANDER | |
| ART UNIT | PAPER NUMBER |
| 2193 | |
| MAIL DATE | DELIVERY MODE |
| 12/22/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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December 23 2008

IBM CORPORATION (ACCSP)
c/o Suiter Swantz pc llo
14301 FNB Parkway, Suite 220
Omaha NE 68154

In re Application of:
Jonathon Limburn
Serial No.: 12/103,890
Filed: 04/16/2008
Docket: GB920080099US1
Title: METHOD FOR TRANSFORMING DATA FROM A MODEL INTO A SECONDARY MODEL TO OPTIMIZE CODE GENERATION

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the requests for reconsideration filed on August 18, 2008 and December 17, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy conditions I1-I4, II1-II4, II5.1-II5.3, and II.6.1-II6.6 listed in the original decision.

## REVIEW OF FACTS

The conditions I1-I4, II1-II4, II5.1-II5.3, and II.6.1-II6.6 above are met. Therefore, the petition meets the required conditions to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

## DECISION

For the above-stated reasons, the petition is **Granted**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-

elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
The twelve-month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a

Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed Gail Hayes, Quality Assurance Specialist, at (571) 272-3591.

/Gail Hayes/

_____

Gail Hayes, Quality Assurance Specialist
Technology Center 2100

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**JEAN YVES CASSAGNOL**
**20, FLINT AVE.**
**HEMPSTEAD NY 11550**

COPY MAILED

AUG 1 1 2008

In re Application of :
**JEAN Y. CASSAGNOL** et al. :
Application No. 12/103,924 : DECISION ON PETITION
Filed: June 19, 2008 : TO MAKE SPECIAL UNDER
Attorney Docket No. : 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed June 19, 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 Jean Cassagnol 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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Jean Yves Cassagnol
20, Flint Ave.
Hempstead NY 11550

AUG 20 2008

In re Application of: CASSAGNOL et al.
Serial No.: 12/103,924
Filed: June 19, 2008
Title: METHOD OF EXTRACTING ENERGY FROM OCEAN WAVES

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 19, 2008 to make the above-identified application special for accelerated examination procedure 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:

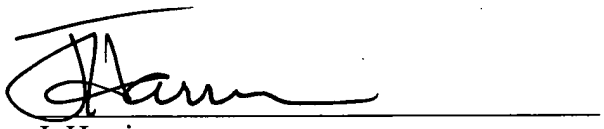
1. The application must be a non-reissue utility or design application filed under 37 CFR 1.111(a);
2. The application, the petition and the required fees must be filed electronically using the USPTO's electronic filing system (EFS), or EFS-web; if not filed electronically, a statement asserting that 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.
5. The petition must be filed with the application.

The application as filed is not eligible for the accelerated examination under 37 C.F.R. § 1.102(d) because the application the application, at the time of filing, was not complete under 37 CFR 1.51 and in condition for examination, as evidenced by the mailing of the Notice to File Corrected Application Papers on April 28, 2008. See 71 Fed. Reg. 36323 notice, section VIII, Conditions for Examination. The opportunity to perfect a petition does not apply to applications that are not in condition for examination on filing.

As noted in the policy statement referenced above, any petition to make special filed on or after the effective date must meet the new requirements set forth in the 71 Fed. Reg. 36323 notice.

For the above-stated reasons, the petition for Accelerated Examination, as set forth in MPEP 708.02(a) is **DENIED**. The application has been granted "special" status based upon applicant's age. The application is being forwarded to Technology Center Art Unit 3748 for assignment to an examiner and examination commensurate with MPEP 708.02, IV.

Any inquiry regarding this decision should be directed to J. Harrison, TC 3700 Special Program Examiner, at (571) 272-4449.



J. Harrison
Special Program Examiner
Technology Center 3700

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,931 | 04/16/2008 | Kenichi FUKUOKA | 325286US0 | 2929 |

7590 08/17/2009

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

| EXAMINER | |
|---|---|
| CROUSE, BRETT ALAN | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1794 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 08/17/2009 | ELECTRONIC |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Betty Powell

Patent Publication Branch
Office of Data Management

Adjustment date: 08/14/2009 BPOWELL
04/17/2008 INTEFSW 00000029 12103931
02 FC:1111 -510.00 OP

Adjustment date: 08/14/2009 BPOWELL
04/17/2008 INTEFSW 00000029 12103931
02 FC:1111 -510.00 OP

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,934 | 04/16/2008 | Oug-Ki LEE | PPC20080002US | 2934 |

66390 7590 05/13/2008
LEXYOUME IP GROUP, LLC
1233 TWENTIETH STREET, N.W.
SUITE 701
WASHINGTON, DC 20036

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2829 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/13/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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United States Patent and Trademark Office
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LEXYOUME IP GROUP, LLC
1233 TWENTIETH STREET, N.W.
SUITE 701
WASHINGTON, DC 20036

| | | |
|---|---|---|
| In re Application of | : | |
| Oug-Ki LEE | : | DECISION ON REQUEST TO |
| Application No. 12/103,934 | : | PARTICIPATE IN PATENT |
| Filed: 04/16/2008 | : | PROSECUTION HIGHWAY |
| Attorney Docket No. PPC20080002US | : | PILOT 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) pilot program and the petition under 37 CFR 1.102(d), filed April 29, 2008, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH pilot program and petition to make special require:

(1) The U.S. application is (a) a Paris Convention application, or (b) a national stage application under the PCT, or (c) a so-called bypass application filed under 35 USC 111(a) validly claiming benefit under 35 USC 120 to a PCT application, the PCT application validly claiming benefit under 35 USC 119(a) and 37 CFR 1.55 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).

## CONCLUSION

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.

Response must be faxed to Michael Day at 571-273-1568.

Telephone inquiries concerning this decision should be directed to Michael Day at 571-272-1568.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://uspto.gov/ebc/index.html.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Michael Day
TQAS
Technology Center 2800- Semiconductors,
Electrical & Optical Systems & Components

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,959 | 04/16/2008 | Yiling XU | 678-3485 | 2991 |

7590 01/12/2010

THE FARRELL LAW FIRM, LLP
290 Broadhollow Road
Suite 210E
Melville, NY 11747

| EXAMINER |
|---|
| KOENIG, ANDREW Y |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2423 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 01/12/2010 | PAPER |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Nimi Farmer

Patent Publication Branch
Office of Data Management

Notice Date: [illegible] 2332270792

Credit Card Refund Total: [illegible]

Adjustment date: 01/13/2010 NFARMER
04/[illegible]/2010 INTEFSW 00000407 12103959
02 FC:1111 -512.00 OP
04 FC:1202 -450.00 OP
05 FC:1201 -630.00 OP



FORM PET651G (Rev. 08/07)

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CANTOR COLBURN LLP - IBM LOTUS
20 Church Street
22nd Floor
Hartford CT 06103

JUL 02 2008

In re Application of: Lance, John, et al.
Application No.: 12/103,965
Filed: April 16, 2008
Title: METHODS FOR BUDDY INTERACTION REMINDER

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the renewed petition filed on April 16, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is GRANTED.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Ehud Gartenberg, TC 3700 Special Program Examiner, at (571) 272-4828. In his absence, an inquiry can be directed to J. Harrison, Special Program Examiner, at (571) 272-4449.

Ehud Gartenberg, Special Programs Examiner
Technology Center 3700

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,972 | 04/16/2008 | Laurie Donohue | LAF-2007-CSSB-010 | 3011 |

47598 7590 06/04/2008

LUIS FIGARELLA
27 TODD ROAD
NASHUA, NH 03064

| EXAMINER | |
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| MENON, KRISHNAN S | |
| ART UNIT | PAPER NUMBER |
| 1797 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/04/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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6-4-08

In re application of
Laurie Donohue
Serial No. 12/103,972
Filed: April 16, 2008
For: COMBINATION STRAINER AND SERVICE BOWL

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition filed on April 16, 2008 to make the above-identified application special under the accelerated examination program.

The petition to make the application special is **DISMISSED.**

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any dependent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner;

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document.

An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions regarding the application (section I, subsections 1-4) discussed above are considered to have been met. Additionally, the conditions regarding the petition, section II, subsections 1-4, are considered to have been met. However, the petition fails to comply with condition II, subsections 5 and 6.

First, it appears that the search is incomplete. Note that a search in Class 210, subclasses 299, 416.2, 455, 473, 474, 477, 482, 498 and 499; Class 99, subclasses 456, 459, 503, 534 and 535 and Class 220, subclasses 560.03, 601, 606, 607, 608, 629, 676, 726 and 737 is also required.

Secondly, there are 11 claims currently pending in the present application (with claims 1, 10 and 11 being independent), however the Accelerated Examination Support Document (AESD) discusses and lists only 9 claims (with claims 1, 8 and 9 being independent). It appears that claims 1, 8 and 9 of the AESD correspond to claims 1, 10 and 11 of the present application (although they are not identical). It is requested that the AESD include a copy of the current claims and the relationship of the cited prior art to these current claims (especially those claims that are not discussed in the AESD). Furthermore, it is unclear why strike-through has been used to describe some of the elements of the prior art. For example, was this used to show that the prior art does not include these features? Clarification is required.

Furthermore, the statement showing support for the present claims on the last page of the AESD is not sufficient. It is required that petitioner provide a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. Merely stating that support for the claims, as a whole, is found in Figures 1 and 4 is not sufficient.

Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

## DECISION

For the above-stated reasons, the petition is dismissed. The application will therefore be taken up by the examiner in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However,

due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

/Christine Tierney/

Christine Tierney
Quality Assurance Specialist
Technology Center 1700

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,972 | 04/16/2008 | Laurie Donohue | LAF-2007-CSSB-010 | 3011 |

47598 7590 07/17/2008

LUIS FIGARELLA
27 TODD ROAD
NASHUA, NH 03064

| EXAMINER | |
|---|---|
| MENON, KRISHNAN S | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1797 | |

| MAIL DATE | DELIVERY MODE |
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| 07/17/2008 | PAPER |

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CST

7-17-08

In re application of
Laurie Donohue
Serial No. 12/103,972
Filed: April 16, 2008
For: COMBINATION STRAINER AND SERVICE BOWL

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the Request for Reconsideration of Petition to Make Special under the Accelerated Examination Program filed on June 30, 2008 to make the above-identified application special.

The petition to make the application special is **GRANTED.**

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

/Christine Tierney/

Christine Tierney
Quality Assurance Specialist
Technology Center 1700

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,974 | 04/16/2008 | Oug-Ki LEE | PPC20080003US | 3013 |

66390 7590 05/21/2008
LEXYOUME IP GROUP, LLC
1233 TWENTIETH STREET, N.W.
SUITE 701
WASHINGTON, DC 20036

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
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1233 Twentieth Street, N.W.
Suite 701
Washington, DC 20036

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| In re Application of | : | |
| LEE, Oug-Ki | : | DECISION ON REQUEST TO |
| Application No. 12/103,974 | : | PARTICIPATE IN PATENT |
| Filed: April 16, 2008 | : | PROSECUTION HIGHWAY |
| Attorney Docket No. PPC20080003US | : | PILOT 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) pilot program and the petition under 37 CFR 1.102(d), filed April, 29, 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 is (a) a Paris Convention application, or (b) a national stage application under the PCT, or (c) a so-called bypass application filed under 35 USC 111(a) validly claiming benefit under 35 USC 120 to a PCT application, the PCT application validly claiming benefit under 35 USC 119(a) and 37 CFR 1.55 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 pilot program and petition are dismissed because:

(i) All the claims in the U.S. application do not sufficiently correspond to the allowable/patentable claim(s) in the KIPO application(s);
(ii) Applicant have not 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;

**Discussion:**

(a) Referring to item (i) above, it is noted that the instant claim 23 does not sufficiently correspond to the allowable/patentable claim 5 in the KIPO application 10-2007-0128843. Claim 5 (now claim 23 in US application No. 12/103,974) in the KIPO application 10-2007-0128843 depends from claim 2 that corresponds to claim 20 in the US application. Consequently, it appears that the instant claim 23 should depend from claim 20, and not claim 19. Because claim 19 and claim 20 differ in scope, the instant claim 23 does not sufficiently correspond to the allowable or patentable claim 5 in the KIPO application 10-2007-0128843.

(b) Still referring to item (i) above, it is noted that translation of claim 7 of KIPO application 10-2007-0128843 refers to claim 19, however, KIPO application 10-2007-0128843 does not have a claim 19. It has been determined that claim 7 of KIPO application 10-2007-0128843 in fact depends from claim 1. Because claim 7 of KIPO application 10-2007-0128843 in fact depends from claim 1, it has been determined that the instant claim 25 sufficiently corresponds to claim 7 in KIPO application 10-2007-0128843.

(c) Referring to item (ii) above, it does not appear that applicant have 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. The US Patent Office received a document titled "Official Actions of 10-2007-128827, 10-2007-128831, 10-2007-128835, 10-2007-128843, 10-2007-128847 by Korean Intellectual Property Office". The US Patent Office, however, has only received a "Preliminary Official Action" for "application code:120000063927".

**A proper response in this case must:**

(a) Amend claim 23 to depend from claim 20, or take alternative corrective action;

(b) Verify that claim 7 of KIPO application 10-2007-0128843 depends from claim 1, or take alternative appropriate corrective action; and,

(c) 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(s) is accurate, or if the KIPO application(s) is a first action allowance then no office action from the KIPO is necessary and should be indicated on the request/petition form (note that applicant must submit (or have submitted) 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).

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 Michael Day at 571-273-1568.

Telephone inquiries concerning this decision should be directed to Michael Day at 571-272-1568.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://uspto.gov/ebc/index.html.

Michael Day
TQAS
Technology Center 2800- Semiconductors,
Electrical & Optical Systems & Components

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/103,974 | 04/16/2008 | Oug-Ki LEE | PPC20080003US | 3013 |

66390 7590 07/11/2008

LEXYOUME IP GROUP, LLC
1233 TWENTIETH STREET, N.W.
SUITE 701
WASHINGTON, DC 20036

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
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| MAIL DATE | DELIVERY MODE |
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| 07/11/2008 | PAPER |

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1233 Twentieth Street, N.W.
Suite 701
Washington, DC 20036

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|---|---|---|
| In re Application of | : | |
| LEE, Oug-Ki | : | DECISION ON REQUEST TO |
| Application No. 12/103,974 | : | PARTICIPATE IN PATENT |
| Filed: April 16, 2008 | : | PROSECUTION HIGHWAY |
| Attorney Docket No. PPC20080003US | : | PILOT 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) pilot program and the petition under 37 CFR 1.102(d), filed April, 29, 2008, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH pilot program and petition to make special require:

(1) The U.S. application is (a) a Paris Convention application, or (b) a national stage application under the PCT, or (c) a so-called bypass application filed under 35 USC 111(a) validly claiming benefit under 35 USC 120 to a PCT application, the PCT application validly claiming benefit under 35 USC 119(a) and 37 CFR 1.55 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).

## CONCLUSION

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.

Response must be faxed to Michael Day at 571-273-1568.

Telephone inquiries concerning this decision should be directed to Michael Day at 571-272-1568.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at http://uspto.gov/ebc/index.html.

The application is being forwarded to the examiner for action on the merits commensurate with this decision.

Michael Day
TQAS
Technology Center 2800- Semiconductors,
Electrical & Optical Systems & Components

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/104,044 | 04/16/2008 | Jed Hickory Rankin | BUR920070229US1 | 3148 |

76055 7590 07/15/2008

PRTSI, INC
4661 CARISBROOKE LN
FAIRFAX, VA 22030

| EXAMINER | |
|---|---|
| ROSASCO, STEPHEN D | |
| **ART UNIT** | **PAPER NUMBER** |
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CST

7-15-08

In re application of
Jed H. Rankin et al
Serial No. 12/104,044
Filed: April 16, 2008
For: PHOTOMASK ELECTRICAL MONITOR FOR PRODUCTION PHOTOMASKS

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition filed on April 16, 2008 to make the above-identified application special under the accelerated examination program.

The petition to make the application special is **DISMISSED.**

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any dependent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner;

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document.

An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions regarding the application (section I, subsections 1-4) discussed above are considered to have been met. Additionally, the conditions regarding the petition, section II, subsections 1-5, are considered to have been met. However, the petition fails to comply with condition II, subsection 6.

With respect to the references discussed in the Accelerated Examination Support Document (AESD) on pages 2-4, petitioner has failed to identify where each and every limitation of the claims are disclosed in the cited references, for example by column and line. Applicant is required to show how the cited references correspond to the present claims, for example by mapping each and every claim limitation to the corresponding teaching in the cited reference.

Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

## DECISION

For the above-stated reasons, the petition is dismissed. The application will therefore be taken up by the examiner in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

/Christine Tierney/

Christine Tierney
Quality Assurance Specialist
Technology Center 1700

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. |
|---|---|---|---|---|
| 12/104,044 | 04/16/2008 | Jed Hickory Rankin | BUR920070229US1 | 3148 |

76055 7590 08/25/2008

PRTSI, INC
4661 CARISBROOKE LN
FAIRFAX, VA 22030

| EXAMINER | |
|---|---|
| ROSASCO, STEPHEN D | |
| **ART UNIT** | **PAPER NUMBER** |
| 1795 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/25/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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CST

8/25/08

In re application of
Jed H. Rankin et al
Serial No. 12/104,044
Filed: April 16, 2008
For: PHOTOMASK ELECTRICAL MONITOR FOR PRODUCTION PHOTOMASKS

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the Request for Reconsideration of Petition to Make Special under the Accelerated Examination Program filed on August 15, 2008 to make the above-identified application special.

The petition to make the application special is **GRANTED.**

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

/Christine Tierney/

Christine Tierney
Quality Assurance Specialist
Technology Center 1700

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**Finnegan, Henderson, Farabow, Garrett & Dunner LLP**
**901 New York Avenue, NW**
**Washington, DC 20001-4413**

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DEC 0 2 2008

**OFFICE OF PETITIONS**

In re Application of :
Eric Bernstein et al. : DECISION ON PETITION
Application No. 12/104,047 : TO MAKE SPECIAL UNDER
Filed: April 16, 2008 : 37 CFR 1.102(c)(1)
Attorney Docket No. 09778.0010-00

This is a decision on the petition under 37 CFR 1.102(c)(1), filed November 06, 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 from applicant. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Shelley Clement at (571)272-6052 or in her absence to the undersigned at (571)272-7099.

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 2884 for action on the merits commensurate with this decision.

David Bucci
Petitions Examiner
Office of Petitions

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**STEPHEN C. GLAZIER**
**K&L GATES LLP**
**1601 K STREET, N.W.**
**WASHINGTON DC 20006-1600**

**MAILED**

FEB 19 2009

**OFFICE OF PETITIONS**

In re Application of :

**MARTIN III**, Sidney E. :
Application No. 12/104,080 : DECISION ON PETITION
Filed: April 16, 2008 : TO WITHDRAW
Attorney Docket No. **0341638.00010** : 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 24, 2008.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. 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 Stephen C. Glazier on behalf of all attorneys of record who are associated with customer No. 35602. All attorneys/agents associated 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 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: **NORTHEAST MARITIME INSTITUTE, INC.**
**c/o ERIC DAWICKI**
**32 WASHIGNTON STREET**
**FAIRHAVEN, MA 02719**

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PANITCH SCHWARZE BELISARIO & NADEL LLP
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA PA 19103

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hsheih et al. | : | |
| Application No. 12/104131 | : | DECISION GRANTING |
| Filing or 371(c) Date: 04/16/2008 | : | STATUS UNDER |
| Attorney Docket No. | : | 37 CFR 1.47(b) |
| 681438-22U4 | : | |

This is in response to the Petition Under 37 CFR § 1.47(b), filed July 30, 2008, in response to the Notice of Incomplete Reply, mailed July 8, 2008. Applicant files a copy of the oath/declaration from prior application 11/318,873, of which the above-identified application is a Divisional application. Applicant has also filed a copy of a Decision granting a petition according status under 37 CFR 1.47(b) in the prior application, no. 11/318,873.

As provided in 37 CFR 1.63(d)

> (1) A newly executed oath or declaration is not required under § 1.51(b)(2) and § 1.53(f) in a continuation or divisional application, provided that:
> (i) The prior nonprovisional application contained an oath or declaration as prescribed by paragraphs (a) through (c) of this section;
> (ii) The continuation or divisional application was filed by all or by fewer than all of the inventors named in the prior application;
> (iii) The specification and drawings filed in the continuation or divisional application contain no matter that would have been new matter in the prior application; and
> (iv) A copy of the executed oath or declaration filed in the prior application, showing the signature or an indication thereon that it was signed, is submitted for the continuation or divisional application.
> (2) The copy of the executed oath or declaration submitted under this paragraph for a continuation or divisional application must be accompanied by a statement requesting the deletion of the name or names of the person or persons who are not inventors in the continuation or divisional application.
> (3) Where the executed oath or declaration of which a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under § 1.47, the copy of the executed oath or declaration

for such prior application must be accompanied by:
(i) A copy of the decision granting a petition to accord § 1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under § 1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c); and
(ii) If one or more inventor(s) or legal representative(s) who refused to join in the prior application or could not be found or reached has subsequently joined in the prior application or another application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c), a copy of the subsequently executed oath(s) or declaration(s) filed by the inventor or legal representative to join in the application.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.63(d). This application is hereby accorded Rule 1.47(b) status. The Office will dispense with the Notice to the nonsigning inventor and the announcement in the Official Gazette.[1].

The application file is being referred to the Office of Patent Application Processing for continued processing in the normal course of business.

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

/Derek L. Woods/
Derek L. Woods
Attorney
Office of Petitions

[1] See 37 CFR 1.47(c) and MPEP 201.06(c).

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ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Fwu-Iuan Hshieh and Brian D. Pratt | : | |
| Application No. 11/318873 | : | DECISION GRANTING |
| Filing or 371(c) Date: 12/27/2005 | : | PETITION UNDER |
| Attorney Docket Number: | : | 37 CFR 1.47(b) |
| 681438-22U1 | : | |

This is in response to the Request for Reconsideration of Petition Under 37 C.F.R. § 1.47(b), filed November 13, 2006, to allow a person to whom an inventor has assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the matter justifying such action, to make application on behalf of and as agent for all inventors.

The petition is **granted**.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(b). This application is hereby accorded Rule 1.47(b) status.

Petitioner has shown that the non-signing inventors, Fwu-Iuan Hshieh and Brian D. Pratt, refuse to join in the application.

As provided in Rule 1.47, this Office will forward notice of this application's filing to the non-signing inventors at the addresses given in the Petition. Notice of the filing of this application will also be published in the Official Gazette.

The application file is being referred to the Office of Initial Patent Examination for continued processing.

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

Derek L. Woods
Attorney
Office of Petitions

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2005 MARKET STREET, SUITE 2200
PHILADELPHIA PA 19103

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**OFFICE OF PETITIONS**

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| In re Application of | : | |
| Hsheih et al. | : | |
| Application No. 12/104137 | : | DECISION GRANTING |
| Filing or 371(c) Date: 04/16/2008 | : | STATUS UNDER |
| Attorney Docket No. | : | 37 CFR 1.47(b) |
| 681438-22U5 | : | |

This is in response to the Petition Under 37 CFR § 1.47(b), filed July 30, 2008, in response to the Notice of Incomplete Reply, mailed July 8, 2008. Applicant files a copy of the oath/declaration from prior application 11/318,873, of which the above-identified application is a Divisional application. Applicant has also filed a copy of a Decision granting a petition according status under 37 CFR 1.47(b) in the prior application, no. 11/318,873.

As provided in 37 CFR 1.63(d)

> (1) A newly executed oath or declaration is not required under § 1.51(b)(2) and § 1.53(f) in a continuation or divisional application, provided that:
> (i) The prior nonprovisional application contained an oath or declaration as prescribed by paragraphs (a) through (c) of this section;
> (ii) The continuation or divisional application was filed by all or by fewer than all of the inventors named in the prior application;
> (iii) The specification and drawings filed in the continuation or divisional application contain no matter that would have been new matter in the prior application; and
> (iv) A copy of the executed oath or declaration filed in the prior application, showing the signature or an indication thereon that it was signed, is submitted for the continuation or divisional application.
> (2) The copy of the executed oath or declaration submitted under this paragraph for a continuation or divisional application must be accompanied by a statement requesting the deletion of the name or names of the person or persons who are not inventors in the continuation or divisional application.
> (3) Where the executed oath or declaration of which a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under § 1.47, the copy of the executed oath or declaration

for such prior application must be accompanied by:
(i) A copy of the decision granting a petition to accord § 1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under § 1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c); and
(ii) If one or more inventor(s) or legal representative(s) who refused to join in the prior application or could not be found or reached has subsequently joined in the prior application or another application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121, or 365(c), a copy of the subsequently executed oath(s) or declaration(s) filed by the inventor or legal representative to join in the application.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.63(d). This application is hereby accorded Rule 1.47(b) status. The Office will dispense with the Notice to the nonsigning inventor and the announcement in the Official Gazette.[1].

The application file is being referred to the Office of Patent Application Processing for continued processing in the normal course of business.

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

/Derek L. Woods/
Derek L. Woods
Attorney
Office of Petitions

[1] See 37 CFR 1.47(c) and MPEP 201.06(c).

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/104,149 | 04/16/2008 | Hiroshi Tsutagaya | TAYUX.060149US | 3344 |

7590 07/20/2010

Law Office of Katsuhiro Arai
22471 Aspan Street
Suite 205 C
Lake Forest, CA 92630

| EXAMINER |
|---|
| DESAI, ANISH P |

| ART UNIT | PAPER NUMBER |
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| 1787 | |

| NOTIFICATION DATE | DELIVERY MODE |
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| 07/20/2010 | ELECTRONIC |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Nimi Farmer

Patent Publication Branch
Office of Data Management

Refund Ref:
07/16/2010 [illegible]

Credit Card Refund Total: $5[illegible]

Adjustment date: 07/16/2010 NFARMER
04/17/2008 INTEFSU 03002059 1210414
02 FC:1111 -510.00 OP



FORM PET651G (Rev. 08/07)

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**STEPHEN C. GLAZIER**
**K & L GATES LLP**
**1601 K STREET, N.W.**
**WASHINGTON, DC 20006-1600**

MAILED

JUL 06 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Martin et al. | : | DECISION ON PETITION |
| Application No. 12/104,152 | : | TO WITHDRAW |
| Filed: April 16, 2008 | : | FROM RECORD |
| Attorney Docket No. N0494.70001US01 | : | |

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 24, 2008.

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

A review of the file record indicates that on March 12, 2009 the power of attorney to K & L Gates LLP was revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to the undersigned at 571-272- 7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Wolf Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston MA 02210-2206

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PORTER WRIGHT MORRIS & ARTHUR, LLP
INTELLECTUAL PROPERTY GROUP
41 SOUTH HIGH STREET
28TH FLOOR
COLUMBUS OH 43215

In re application of : **DECISION ON PETITION**
Pollock et al. : **TO MAKE SPECIAL FOR**
Application No. 12/104,153 : **NEW APPLICATION**
Filed: April 16, 2008 : **UNDER 37 CFR 1.102**
For: SYSTEM AND METHOD FOR FINANCING OTHER POST EMPLOYMENT BENEFIT (OPEB) PLANS

This is a decision on the petition for accelerated examination filed on April 16, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the

first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed to a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated

examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

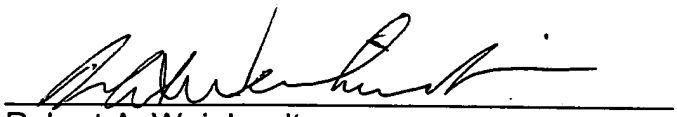
9. Proceedings Outside the Normal Examination Process:
If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

    If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is

involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Robert Weinhardt, Business Practice Specialist, at (571) 272-6633.



Robert A. Weinhardt,
Business Practice Specialist
Technology Center 3600

RW/SMD/5/21/08

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**PORTER WRIGHT MORRIS & ARTHUR, LLP**
**INTELLECTUAL PROPERTY GROUP**
**41 SOUTH HIGH STREET**
**28TH FLOOR**
**COLUMBUS OH 43215**

MAILED

OCT 15 2009

OFFICE OF PETITIONS

In re Application of :
Mark G. Pollock et al :
Application No. 12/104,153 : DECISION ON PETITION
Filed: April 16, 2008 :
Attorney Docket No. 4005088-165789 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 3, 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 RCE and an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final rejection mailed November 3, 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 3626 for appropriate action by the Examiner in the normal course of business on the reply received August 3, 2009.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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Brinks Hofer Gilson & Lione/Seiko Instruments Inc.
P.O. Box 10395
Chicago, IL 60611

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Takashi Imura | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7646574 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/12/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/104,183 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/16/2008 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **125** 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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GOODWIN PROCTER, LLP
PATENT ADMINISTRATOR
53 STATE STREET
EXCHANGE PLACE
BOSTON, MA 02109-2881

MAILED

JUN 10 2010

OFFICE OF PETITIONS

In re Application of
Matthew P. Warden, et. al.
Application No. 12/104,192
Filed: April 16, 2008
Attorney Docket No. MWN-002

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) or 37 CFR 10.40, filed April 30, 2010.

The request is **APPROVED**.

The request was signed by John V. Forcier on behalf of himself and all attorneys/agents associated with customer number 051414. Therefore, John V. Forcier and all the attorneys/agents associated with customer number 051414 have been withdrawn.

Applicant is reminded that there are no attorneys/agents of record at this time.

This application file is being referred to Technology Center Art Unit 3767 for review of the amendment filed on May 12, 2010.

All future communications from the Office will be directed to the sole inventor at the address listed below until otherwise properly notified by the applicant.

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

Andrea Smith
Petitions Examiner
Office of Petitions

cc: Matthew P. Warden
2 Putney Road
Bow, NH 03304

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/104,192 | 04/16/2008 | Matthew P. Warden | MWN-002 |

**CONFIRMATION NO. 3410**

**POWER OF ATTORNEY NOTICE**

51414
GOODWIN PROCTER LLP
PATENT ADMINISTRATOR
53 STATE STREET
EXCHANGE PLACE
BOSTON, MA 02109-2881

Date Mailed: 06/09/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 04/30/2010.

- 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.

/amsmith/

---

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

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BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON, MA 02110-1618

**COPY MAILED**

MAY 27 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Lacapra et al. | : | DECISION REFUSING STATUS |
| Application No. 12/104,197 | : | UNDER 37 CFR 1.47(a) |
| Filed: April 16, 2008 | : | |
| Attorney Docket No. 3193/129 | : | |

This is in response to the petition under 37 CFR 1.47(a), filed December 19, 2008.

The petition is **DISMISSED**.

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

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

As to item (1), the applicable statute (35 U.S.C.§ 116) requires that a "diligent effort" have been expended in attempting to find or reach the non-signing inventor. *See* MPEP 409.03(a). The showing currently fails to demonstrate, with a documented showing, that a diligent effort was made to find or locate non-signing inventors Peter Nickolov and Vladimir Miloushev (or Mr. Miloushev's legal representative, if he is deceased), such that the declaration can be accepted under 37 CFR 1.47(a). Where inability to find or locate a named inventor(s) is alleged, 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 to locate the inventor.

Petitioner has not demonstrated that all efforts were expended in trying to locate inventor non-signing Peter Nickolov and Vladimir Miloushev (or Mr. Miloushev's legal representative, if he is

deceased). In this regard, petitioner should, at the very least, conduct a search of the regional or national registry(s). The results of such search should be made in any future petition for reconsideration. *See* MPEP 409.03(d). Additionally, petitioner should state whether he has access to the inventors' personnel records and, if so, what does inspection of the records reveal as to a current address, forwarding address, or an address of the nearest living relative? What does inspection of the phone directories for those address locations reveal? Further, the petition fails to indicate that correspondence was ever mailed unsuccessfully to the inventor's last known address. Therefore, at the very least, petitioner should mail correspondence to the inventor's last known address, return receipt and/or forwarding address requested. If a forwarding address is provided, petitioner should then mail a complete copy of the application papers (specification, claims, drawings, oath, etc.) to the respective addresses of Peter Nickolov and Vladimir Miloushev (or Mr. Miloushev's legal representative, if he is deceased), return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. If the papers are returned and all other attempts to locate or reach the inventor, e.g., through personnel records, co-workers, E-mail, the Internet or the telephone, etc., continue to fail, then applicant will have established that the inventor cannot be reached after diligent effort or has refused to join in the application. **The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein and should be accompanied by documentary evidence in support of the statement of facts.** It is important that the forthcoming communication contain statements of fact as opposed to conclusions.

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration by the party to whom the refusal was made. Where there is a written refusal, a copy of the document(s) evidencing that refusal must be made part of the affidavit or declaration. The declaration of Keith Corbin fails to list the time and place of the refusal.

When it is concluded by the rule 47 applicant that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

As to item (2), the declaration, filed December 19, 2008, does not comply with 37 CFR 1.63 and 1.64 since inventor Vladimir Miloushev is not indicated as deceased and the name of the legal representative is not set forth on the declaration. 35 U.S.C. § 117 provides that a legal representative may file a patent application on behalf of a deceased inventor and since the legal representative has refused to join in the application, 35 U.S.C. § 116 and 37 CFR 1.47(a) permit filing of the application on behalf of the legal representative. Accordingly, a new declaration, which is signed by the remaining inventors and sets forth the name of the deceased inventor, as well as the name, residence and citizenship of the legal representative of the deceased inventor, is **REQUIRED**. *See* MPEP § 409.03(a).

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

By mail: Mail Stop PETITIONS
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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

Telephone inquiries should be directed to Ramesh Krishnamurthy at (571) 272-4914.

David Bucci
Petitions Examiner
Office of Petitions

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

**MAILED**

MAR 05 2009

OFFICE OF PETITIONS

In re Application of :
Peter Furka :
Application No. 12/104,237 : DECISION ON PETITION
Filed: April 16, 2008 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 08049.0884-01 :

This is a decision on the petition filed January 21, 2009, under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of a prior-filed non-provisional application nos. 10/474,724 filed October 14, 2003.

The petition is **DISMISSED**.

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

**(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not satisfy item (1) above.

The reference to add the prior-filed application on page one following the first sentence of the specification is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by

reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See* Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

The specification provided on filing did not incorporate by reference non-provisional application nos. 10/474,724 as does the amendment filed

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either a Supplemental Application Data Sheet (signed in compliance with 37 CFR 1.33(b) and in compliance with 37 CFR 1.76) or a substitute amendment (complying with the provisions of 37 CFR 1.121) to correct the above matters are required.

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

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Alexandria, VA 22313-1450

By hand: Customer Service Window
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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 Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

Anthony Knight
Supervisor
Office of Petitions

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GARRETT & DUNNER LLP
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WASHINGTON DC 20001-4413

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JUN 15 2009

OFFICE OF PETITIONS

In re Application of :
Peter Furka :
Application No. 12/104,237 : DECISION ON PETITION
Filed: April 16, 2008 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 08049.0884-01 :

This is a decision on the renewed petition filed May 5, 2009, under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of prior-filed non-provisional application no. 10/474,724 filed October 14, 2003.

The renewed petition is **GRANTED.**

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

**(1)** the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

A petition filed January 21, 2009 was dismissed March 5, 2009 because there did not appear to be co-pendency between the present application and application no. 10/474,724, and because the amendment filed with the petition improperly incorporated by reference the prior filed application.

Comes now petitioner with the instant renewed petition and argues that the incorporation by reference of application no. 10/474,724 was implied in that the specification was amended in the first Preliminary Amendment to insert the required

reference to prior PCT Application No. PCT/US02/11593, filed April 15, 2002 and prior U.S. Provisional Application No. 60/283,356, filed April 13, 2001 from which benefit is claimed.

Petitioner's arguments have been considered and it is concluded that the incorporation by reference statement is acceptable and is limited therefore to PCT Application No. PCT/US02/11593, filed April 15, 2002 and prior U.S. Provisional Application No. 60/283,356, filed April 13, 2001.

All the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

***The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.***

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center Art Unit 3623 for appropriate action on the amendment filed January 21, 2009, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. 120 to the prior-filed application.

Anthony Knight
Supervisor
Office of Petitions

**ATTACHMENT**: Corrected Filing Receipt

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| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 12/104,237 | 04/16/2008 | 3623 | 1240 | 08049.0884-01 | 15 | 4 |

**CONFIRMATION NO. 3509**

**CORRECTED FILING RECEIPT**

22852
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

Date Mailed: 06/08/2009

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

Peter FURKA, Secaucus, NJ;

**Assignment For Published Patent Application**

United States Postal Services, Washington, DC

**Power of Attorney:** The patent practitioners associated with Customer Number 22852

**Domestic Priority data as claimed by applicant**

This application is a CON of 10/474,724 10/14/2003 ABN
which is a 371 of PCT/US02/11593 04/15/2002
which claims benefit of 60/283,356 04/13/2001

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 05/02/2008

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 12/104,237**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

MANIFEST DELIVERY SYSTEM AND METHOD

**Preliminary Class**

705

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

## LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as

set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

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

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

**NOT GRANTED**

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

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

MAILED

MAR 23 2010

OFFICE OF PETITIONS

Applicant: Hachiro Kamada
Appl. No.: 12/104,260
Filing Date: April 16, 2008
Title: METHOD FOR PLACENTAL ESFOLIATION USING OXO-ARACHIDONIC ACID OR THE LIKE
Pub. No.: US 2009/0082448 A1
Pub. Date: March 26, 2009

This is a decision on the request for a corrected patent application publication under 37 CFR 1.221(b) or (a), received on May 26, 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 in the specification in paragraph [0035], wherein the phrase "α starch" is misprinted as "a starch".

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

The error noted by requestor wherein the phrase "α starch" is misprinted as "a starch" in the clause

> Examples of the excipient include celluloses (such as crystalline cellulose), starches (such as rice starch, potato starch, corn starch, wheat starch, and a starch), dextrin, dextran, sugar alcohols (such as mannitol, erythritol, xylitol, maltose, maltitol, and sorbitol), lactose, and glucose.

[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).

is not a material Office error under 37 CFR 1.221(b). The misprinting of the word does not affect the understanding of the application, as it is one of several starches listed and one of ordinary skill in the art would recognize that it is "α starch". 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 to 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

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

Paper No.

LOUIS J. HOFFMAN, P.C.
11811 North Tatum Boulevard, Suite 2100
Phoenix AZ 85028

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SEP 0 3 2008

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| John Louis Spiesberger | : | DECISION ON PETITION |
| Application No. 12/104,275 | : | PURSUANT TO |
| Filed: April 16, 2008 | : | 37 C.F.R. § 1.57(A) |
| Attorney Docket No. 79-CON | : | |
| Title: METHODS FOR ESTIMATING LOCATION USING SIGNAL WITH VARYING SIGNAL SPEED | : | |

This is a decision on the petition pursuant to 37 C.F.R. § 1.57(a), filed on June 26, 2008, requesting that the above-referenced application be accorded a filing date of April 16, 2008.

Application papers in the above-identified application were deposited on April 16, 2008. However, on May 6, 2008, the Office of Initial Patent Examination mailed Applicant a "Notice of Incomplete Nonprovisional Application," notifying Applicant, that the application papers had not been accorded a filing date because the application was deposited without drawings.

In response, Applicant timely filed this petition, where it is acknowledged that the drawings were inadvertently omitted on submission of the present application. Applicant has argued, however, that the inadvertently omitted drawings were constructively present on filing however, due to a benefit claim that was present on filing.

It is noted that a preliminary amendment was present on filing, and it directs the entry of a priority claim into the specification - as such, the present application is a continuation of U.S. Application No. 11/803,235.

Applicant's arguments and evidence have been considered. However, it is controlling that a review of the application confirms that as filed the application contained at least one method claim. MPEP § 601.01(f) provides that:

> It has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

Thus, pursuant to MPEP § 601.01(f), a drawing is not considered essential for a filing date. Thus, the application is entitled to a filing date without drawings present in the application.

Accordingly, the Office should have mailed a Notice of Omitted Items and not a Notice of Incomplete Nonprovisional Application. As stated in MPEP § 601.01(g), if an application is entitled to a filing date, the mailing of a Notice of Omitted Items will permit, *inter alia*:

> If an application was filed on or after September 21, 2004, and contains a claim under 37 CFR 1.55 for priority of a prior-filed foreign application, or a claim under 37 CFR 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application that was present on the filing date of the application, and the omitted portion of the drawing(s) was inadvertently omitted from the application and is completely contained in the prior-filed application, applicant may submit an amendment to include the inadvertently omitted portion of the drawing(s) pursuant to 37 CFR 1.57(a). The amendment should be submitted in response to the Office action and must comply with 37 CFR 1.57(a) and 37 CFR 1.121. See MPEP § 201.17.

It follows that no petition is required.

Although Petitioner has submitted 19 pages of drawings, it does not appear that Petitioner has submitted an amendment directing the entry of the same. Petitioner may wish to submit this amendment. Any such amendment will, of course, be reviewed by the examiner for new matter,[1] where the examiner will compare the

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1 See MPEP §§ 608.02(h) and 608.04.

drawings to those contained in prior-filed Application No. 11/803,235 in order to verify that they are an accurate copy of the figures contained therein and that they contain no new matter. The amendment is not new matter if the substance was a part of the disclosure of prior-filed Application No. 11/803,235.

To the extent the present petition requests a filing date of April 16, 2008 with no drawings present in the application, the petition is **GRANTED**.

Given the basis for granting this petition, the petition fee will be refunded to Petitioner's credit card in due course.

Pursuant to this decision, the application will be referred to the Office of Patent Application Processing (OPAP) for:

- **correction of the filing date to April 16, 2008**;
- **for indication in Office records, as appropriate, that "0" sheets of drawings were present on filing,** and;
- **for issuance of a filing receipt**.

The general phone number for OPAP is 571-272-4000. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.

Anthony Knight
Supervisor
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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NOV 1 0 2009

OFFICE OF PETITIONS

**MORRISON & FOERSTER LLP**
**425 MARKET STREET**
**SAN FRANCISCO, CA 94105-2482**

In re Application of :
Clark Dean :
Application No. 12/104,306 :
Filed: April 16, 2008 :
Attorney Docket No. 9010/96665 (08-0004) :

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 September 10, 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 Morrison & Foerster LLP was revoked by the assignee of the patent application on September 29, 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: FITCH EVEN TABIN & FLANNERY
120 SOUTH LASALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

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PAUL D. YASGER
ABBOTT LABORATORIES
100 ABBOTT PARK ROAD
DEPT. 377/AP6A
ABBOTT PARK IL 60064-6008

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JAN 20 2009

In re Application of :
Song, et al. :
Application No.: 12/104,319 : ON PETITION
Filed: April 16, 2008 :
Attorney Docket No. 8798US01 :

This is in response to the petition under 37 CFR 1.137(b) filed December 9, 2008. This is also a decision on the petition under 37 CFR 1.48, also filed December 9, 2008.

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

The petition under 37 CFR 1.48 is **dismissed as moot**.

A "Notice to File Missing Parts of Nonprovisional Application" (the "Notice") was mailed by the Office on May 6, 2008, allowing a shortened period of reply of two-months from its mailing date. Extensions of time set for reply were available pursuant to 37 CFR 1.136(a). The Notice required an oath or declaration to be filed and $130.00 surcharge for the late filing of the same. A complete response was not received within the allowable period, and the application became abandoned on July 7, 2008.

**TREATMENT UNDER 37 CFR 1.48**

By the instant petition, petitioner seeks to add Xilu Wang and Aaron R. Kunzer as joint inventors on the subject application. It is noted that the subject application was not, on filing, accompanied by an oath or declaration executed by any of the joint inventors. Where the no executed declaration is filed with the original application papers, the inventorship for the application, as finally recorded by the Office, is taken from the executed declaration when it is filed. Any changes to the inevntorship after a declaration is filed that is executed by any of the joint inventor must then be by way of petition under 37 CFR 1.48. Further to this point, 37 CFR 1.48(f)(1) provides, that:

> (1) *Nonprovisional application-filing executed oath/declaration corrects inventorship.* If the correct inventor or inventors are not named on filing a nonprovisional application under § 1.53(b) without an executed oath or declaration under § 1.63 by any of the inventors, the first submission of an executed oath or declaration under § 1.63 by any of the inventors during the pendency of the application will act to correct the earlier identification of inventorship. See §§ 1.41(a)(4) and 1.497(d) and (f) for submission of an executed oath or declaration to enter the national stage under 35 U.S.C. 371 naming an inventive entity different from the inventive entity set forth in the international stage.

Accordingly, the inventorship for this application will be as set forth in the first executed declaration that was filed December 9, 2008, which includes Xilu Wang and Aaron R. Kunzer. The petition under 37 CFR 1.48 is dismissed as moot, accordingly.

A corrected filing receipt is enclosed.

**TREATMENT UNDER 37 CFR 1.137(b)**

The petition under 37 CFR 1.137(b) is granted in view of the declaration and surcharge filed December 9, 2008.

This application is being directed to the Office of Patent Application Processing for further processing.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 12/104,319 | 04/16/2008 | 1614 | 1420 | 8798USO1 | 6 | 3 |

**CONFIRMATION NO. 3655**

**CORRECTED FILING RECEIPT**

23492
PAUL D. YASGER
ABBOTT LABORATORIES
100 ABBOTT PARK ROAD
DEPT. 377/AP6A
ABBOTT PARK, IL 60064-6008

Date Mailed: 01/15/2009

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

Xiaohong Song, Grayslake, IL;
Hong Ding, Gurnee, IL;
Steven W. Elmore, Northbrook, IL;
Milan Bruncko, Green Oaks, IL;
David J. Madar, Miami, FL;
Andrew J. Souers, Evanston, IL;
Cheol-min Park, Gurnee, IL;
Zhi-fu Tao, Gurnee, IL;
Xilu Wang, Grayslake, IL;
Aaron R Kunzer, Shaumburg, IL;

**Assignment For Published Patent Application**

Abbott Laboratories, Abbott Park, IL

**Power of Attorney:** None

**Domestic Priority data as claimed by applicant**

This appln claims benefit of 60/949,683 07/13/2007
and claims benefit of 60/912,049 04/16/2007

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 05/02/2008

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 12/104,319**

**Projected Publication Date:** To Be Determined - pending completion of Missing Parts

**Non-Publication Request:** No

**Early Publication Request:** No
**Title**

7-NONSUBSTITUTED INDOLE MCL-1 INHIBITORS

**Preliminary Class**

514

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

## LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

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

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

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

**NOT GRANTED**

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

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

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MAY 2 2 2008

OFFICE OF PETITIONS

In re Application of :
**BOWERS,** Loren E. :
Application No. 12/104,329 : DECISION ON PETITION
Filed: April 16, 2008 : TO MAKE SPECIAL UNDER
Attorney Docket No. **61318/B944** : 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed April 16, 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 attesting that Loren E. Bowers is over 65 years of age. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Michelle R. Eason at 571-272-4231.

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

This application is being referred to the Office of Initial Patent Examination to await a reply to the Notice to File Corrected Application Papers (Notice) mailed May 05, 2008. This application will be accorded "special" status when pre-examination processing is done.

C

Michelle R. Eason
Paralegal Specialist
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. BOX 2938
MINNEAPOLIS MN 55402

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JAN 07 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Olaffson, McKinney, Fransdonk, | : | DECISION REFUSING STATUS |
| Michels, Hammill, and Crowder | : | UNDER 37 CFR 1.47(a) |
| Application Number: 12/104335 | : | |
| Filing Date: 04/16/2008 | : | |
| Attorney Docket Number: | : | |
| 2059.036US1 | : | |

This is in response to the petition filed under 37 CFR 1.47(a) on December 11, 2008.

The petition is **DISMISSED**.

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

The above-identified application was filed on April 16, 2008, without an executed oath or declaration. Accordingly, on May 7, 2008, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on December 11, 2008 (certificate of mailing date December 8, 2008), the present petition was filed, along with a five (5) month extension of time and a declaration naming Atli Olafsson, Jonathan McKinney, Robert W. Fransdonk, Shawn Michels, Greg Hammill, and Scott Richard Crowder as joint inventors, signed by joint inventor Olafsson on behalf of himself and non-

signing joint inventors McKinney, Fransdonk, Michels, Hammill, and Crowder.

Petitioners state that "*bona fide* attempts have been made to present a copy of the application papers (specification, including claims, drawings, and declaration) to the client to obtain signatures for [the non-signing inventors]."

Petitioners state that a copy of the application was sent by email, but that the non-signing inventors have not responded to the email. In support, petitioners have included a declaration of Sandra D. Newman, a Case Management Assistant at counsel's law firm, in which she states, in pertinent part.

> On April 22, 2008, I sent an e-mail with attachments that included copy of the application papers (specification, including claims, drawings, and substitute declaration) to the following people representing Entriq, Inc., SLW's client, Adam Ross, Robert Fransdonk, Marcie Gately, Sean Moore, and Andre Marias, an attorney for Schwegman, Lundberg, and Wossner, an e-mail for the inventors signatures.

Petitioners state that the application was emailed 11 times in all to the above people. Several of the emails were also forwarded to Tiffany Sistani.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of $130 or $65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1), (3), and (5).

At the outset, it is noted that the email, including a copy of the application as filed, was sent only to non-signing inventor Fransdonk. It is unclear what connection the other people who received the email have to the inventors. 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). MPEP 409.03(d).

As such, before a bona fide refusal to sign can be alleged, The application **must** be sent to each inventor, or to his or her counsel.

Further, with regard to the non-signing inventor who was sent the e-mails, petitioners have not shown proof that the non-signing inventor acknowledged receipt of the emailed documents and was able to read them. Petitioners are reminded that 37 CFR 1.63 requires the inventor to state that he or she has reviewed and understands the contents of the application.

The transmission of documents via Email, while a common practice, can be problematic. Transmission and receipt of documents-whether in image, word-processing, spreadsheet or other form-can be affected by differences in software generation between the sender and recipient(s), and other interferences include but are not limited to sender's and recipient's Internet service provider's (ISP) and/or office/personal security firewall systems.

Thus, in the absence of an express statement from a non-signing inventor(s) that he/she/they have received, opened and read a document, unlike a printed page in the language of the recipient there is as of this writing no basis to presume that an Emailed document was in a form that can be read and comprehended.

Petitioners may show proof that a copy of the application was sent or given to each of the non-signing inventors for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

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

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

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

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

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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P.O. BOX 2938
MINNEAPOLIS MN 55402

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APR 27 2009

OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Olaffson, McKinney, Fransdonk, | : | DECISION REFUSING STATUS |
| Michels, Hammill, and Crowder | : | UNDER 37 CFR 1.47(a) |
| Application Number: 12/104335 | : | |
| Filing Date: 04/16/2008 | : | |
| Attorney Docket Number: | : | |
| 2059.036US1 | : | |

This is in response to the renewed petition filed under 37 CFR 1.47(a) on March 12, 2009.

The petition is again **DISMISSED**.

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

The above-identified application was filed on April 16, 2008, without an executed oath or declaration. Accordingly, on May 7, 2008, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on December 11, 2008 (certificate of mailing date December 8, 2008), the present petition was filed, along with a five (5) month extension of time and a declaration naming Atli Olafsson, Jonathan McKinney, Robert W. Fransdonk, Shawn Michels, Greg Hammill, and Scott Richard Crowder as joint inventors, signed by joint inventor Olafsson on behalf of himself and non-

signing joint inventors McKinney, Fransdonk, Michels, Hammill, and Crowder. On January 7, 2009, the petition was dismissed.

On March 12, 2009 (certificate of mailing date March 9, 2009) the subject renewed petition was filed. Petitioners state, *inter alia*, that a copy of the application was sent by Federal Express to each of the non-signing inventors. In support, a cover letter transmitting the application papers to the non-signing inventors has been provided. Petitioners assert that joint inventors McKinney, Fransdonk, and Crowder received the application papers but have failed to sign and return the declaration. Petitioners further assert that the application papers sent to joint inventors Michels and Hammill have been returned as undeliverable.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of $130 or $65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

With regard to joint inventors Michels and Hammill, petitioners have not provided proof that they cannot be reached despite diligent efforts.

In this regard, a brief Internet search suggests that non-signing inventor Michels now resides in Chicago, IL 60647-4421.

Additionally, it appears that inventor Hammill's first name was misspelled on the Federal Express shipment sent to him. Specifically, the declaration filed on December 11, 2008 lists the fifth named inventor as Greg Hammill, while the Federal Express shipment is addressed to "**Gregg** Hammill."

It is noted that a brief Internet search suggests that non-signing inventor Hammill now resides at a different address in Carlsbad, CA 92009.

Petitioners should verify the last known address of the non-signing inventor, and, if a more recent address is discovered, provide a copy of the application as filed to the non-signing inventor at the inventor's most recent address. Petitioners may show proof that a copy of the application was sent or given to the non-signing inventor for review by providing a copy of the cover letter transmitting the application papers (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

If the application is returned as undeliverable, petitioners should provide a copy of an envelope showing that a letter sent to the last known address of the non-signing inventor was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign the declaration can be alleged, petitioners must show that a copy of the application was sent or given to the inventor. If the inventor refuses in writing, petitioners must submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of fact.

If the inventor cannot be reached at his or her last known address, petitioners must provide details, in an affidavit or declaration of facts by a person with first hand knowledge of the details, of the efforts, such as Internet, e-mail, or telephone directory searches, which have been undertaken to locate that inventor, send or give a copy of the application papers to him or her, and request that he or she sign and return the declaration.

If repeated attempts to contact the inventor by telephone, mail, and e-mail, are unsuccessful, petitioners will have established that the inventor cannot be found despite diligent efforts.

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

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

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

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

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

DIWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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DIW Nov-09

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

MAILED

OCT 03 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Olaffson, McKinney, Fransdonk, | : | DECISION ACCORDING STATUS |
| Michels, Hammill, and Crowder | : | UNDER 37 CFR 1.47(a) |
| Application Number: 12/104335 | : | |
| Filing Date: 04/16/2008 | : | |
| Attorney Docket Number: | : | |
| 2059.036US1 | : | |

This is in response to the renewed petition filed under 37 CFR 1.47(a) on August 31, 2009 (certificate of mailing date August 27, 2009).

The petition is **GRANTED**.

Petitioners have shown that a copy of the application as filed was sent to the last known addresses of each of the non-signing inventors. Further, petitioners have shown that non-signing inventors McKinney, Fransdonk, Crowder, and Michels received the application but failed to sign and return the declaration. Furthermore, petitioners have shown that diligent efforts were made to locate a new last known address for non-signing inventor Hammill, and a copy of the application papers was sent to his last known address. Despite these diligent efforts, Hammill could not be located to sign the declaration.

As such, the showing of record is that joint inventors McKinney, Fransdonk, Crowder, and Michels constructively refused to join in the filing of the application, and that joint inventor Hammill could not be located, despite diligent efforts by petitioners.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). The application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventors at the address given in the subject renewed petition, not the

Declaration. Notice of the filing of this application will also be published in the *Official Gazette*.

As the petition fee was paid with the petition filed on December 11, 2008, the duplicate fee paid with the subject petition is unnecessary and will be credited to counsel's deposit account.

The application is being referred to the Office of Patent Application Processing for further processing.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

/D Wood/

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
DIW Nov-09

Greg Hammill
7368 Escallonia Ct.
Carlsbad CA 92008

In re Application of
Olaffson et al.
Application No. 12/104,335
Filed: April 16, 2009
For: PROXY SERVER ACCESS RESTRICTION APPRATUS, SYSTEMS, AND METHODS

Dear Mr. Hammill:

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 571/272-3231. Requests for information regarding your application should be directed to the File Information Unit at 571-272-3150. 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 571-272-3150 or 1-800-972-6382 (outside the Washington D.C. area).

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

HAMILTON, BROOK, SMITH & REYNOLDS PC
530 VIRGINIA ROAD
PO BOX 9133
CONCORD MA 01742-9133

UNITED STATES PATENT AND TRADEMARK OFFICE

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Jonathan McKinney
12593 Sora Way
San Diego CA 92129

In re Application of
Olaffson et al.
Application No. 12/104,335
Filed: April 16, 2009
For: PROXY SERVER ACCESS RESTRICTION APPRATUS, SYSTEMS, AND METHODS

Dear Mr. McKinney:

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 571/272-3231. Requests for information regarding your application should be directed to the File Information Unit at 571-272-3150. 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 571-272-3150 or 1-800-972-6382 (outside the Washington D.C. area).

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

HAMILTON, BROOK, SMITH & REYNOLDS PC
530 VIRGINIA ROAD
PO BOX 9133
CONCORD MA 01742-9133

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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DIW Oct-09

Robert W. Fransdonk
Jan Teulingslaan 47
Amstelveen SG 1187
NETHERLANDS

In re Application of
Olafsson et al.
Application No. 12/104,335
Filed: April 16, 2009
For: PROXY SERVER ACCESS RESTRICTION APPRATUS, SYSTEMS, AND METHODS

Dear Mr. Fransdonk:

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 571/272-3231. Requests for information regarding your application should be directed to the File Information Unit at 571-272-3150. 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 571-272-3150 or 1-800-972-6382 (outside the Washington D.C. area).

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

HAMILTON, BROOK, SMITH & REYNOLDS PC
530 VIRGINIA ROAD
PO BOX 9133
CONCORD MA 01742-9133

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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Scott Richard Crowder
6486 Franciscan Rd
Carlsbad CA 92009

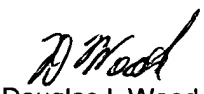
In re Application of
Olaffson et al.
Application No. 12/104,335
Filed: April 16, 2009
For: PROXY SERVER ACCESS RESTRICTION APPRATUS, SYSTEMS, AND METHODS

Dear Mr. Crowder:

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 571/272-3231. Requests for information regarding your application should be directed to the File Information Unit at 571-272-3150. 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 571-272-3150 or 1-800-972-6382 (outside the Washington D.C. area).



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

HAMILTON, BROOK, SMITH & REYNOLDS PC
530 VIRGINIA ROAD
PO BOX 9133
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Shawn Michels
1934 Oakley Ave
Chicago IL 60647-4421

In re Application of
Olaffson et al.
Application No. 12/104,335
Filed: April 16, 2009
For: PROXY SERVER ACCESS RESTRICTION APPRATUS, SYSTEMS, AND METHODS

Dear Mr. Michels:

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 571/272-3231. Requests for information regarding your application should be directed to the File Information Unit at 571-272-3150. 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 571-272-3150 or 1-800-972-6382 (outside the Washington D.C. area).

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

HAMILTON, BROOK, SMITH & REYNOLDS PC
530 VIRGINIA ROAD
PO BOX 9133
CONCORD MA 01742-9133

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P.O. Box 1450
Alexandria, VA 22313-1450
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SHEPPARD, MULLIN, RICHTER
HAMPTON, LLP
333 SOUTH HOPE STREET, 48TH FLOOR
LOS ANGELES, CA 90071-1448

COPY MAILED

JUL 29 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Ross N. WILLIAMS | : | |
| Application No. 12/104,348 | : | DECISION ON PETITION |
| Filed: April 16, 2008 | : | TO WITHDRAW |
| Attorney Docket No. 16HC-134312 | : | 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 25, 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 Daniel N. Yannuzzi on behalf of the attorneys of record associated with Customer No. 30764.

The attorneys of record associated with Customer No. 30764 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 address identified 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: ROSS N. WILLIAMS
803/15 NAUGMAN PLACE
ADELAIDE, 5000 AUSTRALIA

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 |
|---|---|---|---|
| 12/104,348 | 04/16/2008 | Ross N. Williams | 16HC-134312 |

**CONFIRMATION NO. 3707**

**POWER OF ATTORNEY NOTICE**

30764
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP
333 SOUTH HOPE STREET
48TH FLOOR
LOS ANGELES, CA 90071-1448

Date Mailed: 07/29/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 06/25/2009.

- 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.

/dcgoodwyn/

---

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

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ABBOTT LABORATORIES
100 ABBOTT PARK ROAD
DEPT. 377/AP6A
ABBOTT PARK IL 60064-6008

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JUL 0 9 2009

OFFICE OF PETITIONS

In re Application of :
BIRKENMEYER et al. :
Application No. 12/104,410 : DECISION ON PETITION
Filed: 04/16/2008 :
Attorney Docket No. 8507USO1 :

This is a decision on the "PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR § 1.181(a), OR ALTERNATELY, FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR § 1.137(b)" filed January 21, 2009.

The petition under 37 CFR 1.181 is DISMISSED.

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

On May 9, 2008, the Office mailed a Notice to File Missing Parts of Nonprovisional Application, which set a two-month extendable period to submit an executed oath or declaration and a surcharge to avoid abandonment. On December 9, 2008, petitioners submitted a request for an extension of time for response within the fifth month (and fee), an executed declaration, and a $130.00 surcharge. On December 30, 3008, the Office mailed a Notice of Incomplete Reply, stating that the Office had received the reply of December 9, 2008; however, the signature to the oath or declaration is by a person other than the inventor or person qualified under 37 CFR 1.42, 1.43 or 1.47. The Notice indicated that the period to submit a complete reply remained as set for in the Notice to File Missing Parts of Nonprovisional Application of May 9, 2008. On January 13, 2009, the Office mailed a Notice of Abandonment for failing to submit a timely and proper reply to the Notice to File Missing Parts of Nonprovisional Application.

On January 21, 2009, petitioners filed the present petition, a declaration signed by Lowell Tyner as the legal representative of deceased inventor Joan Tyner, and an authorization to charge the Deposit Account for any necessary fees. Petitioners state:

4. It appears that the Patent Office rejected the filing of the executed Declaration in response to the Notice formerly done by applicants' counsel as inadequate because it is signed by Joan Tyner's heir and legal representative, Lowell Tyner, and the legal relationship is not stated within the Declaration itself. A Notice of Incomplete Reply was mailed by the Patent Office on December 30, 2008 (appended as Attachment C). The Notice of Incomplete Reply states that the period of reply remains "as set forth in the Notice" and that extensions of time are available. The Notice of Abandonment was subsequently mailed on January 13, 2009.

5. Applicants request that the Patent Office recognize the substantial efforts and cost that were made in complying with the Notice (e.g., locating and requesting assistance from Joan Tyner's heir; Lowell Tyner's review of numerous patent documents of his mother's under sad circumstances; $130 for late filing of the Declaration; $2350 authorized in time extension fees). Applicants respectfully submit that the abandonment of the application might appear an overly harsh remedy for failure to recite directly within a Declaration the legal relatedness of the heir of a deceased coinventor. Applicants request that an appropriate and equitable remedy instead would be for the Patent Office, as done in other circumstances of a deficient oath, to treat the Notice of Incomplete Reply as restarting the clock for compliance, and allotting the applicants a further two month period in which to comply with the oath requirement inadvertently missed.

*Petition dated 01/21/09, p. 2.*

It is undisputed that petitioners' reply filed on December 9, 2008, was not proper. Specifically, the declaration signed by Lowell Tyner did not state that Mr. Tyner is the legal representative of deceased inventor Joan D. Tyner, nor identify his citizenship, residence, and mailing address in compliance with 37 CFR 1.64.

37 CFR 1.64 provides:

Person making oath or declaration.

(a) The oath or declaration (§ 1.63), including any supplemental oath or declaration (§ 1.67), must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43, 1.47, or § 1.67.

(b) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, 1.47, or § 1.67), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor is 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.

Furthermore, 37 CFR 1.135 provides:

> (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
> (b) Prosecution of an application to save it from abandonment [37 CFR 1.153(a)] must include such complete and proper reply as the condition of the application may require[.]

The filing of the incomplete reply on December 9, 2008, did not toll the two month extendable period to submit a complete and proper reply to the Notice to File Missing Parts of Nonprovisional Application. As the Notice of Incomplete Reply did not set a new period for response, the application became abandoned by operation of law for failure to file a timely and proper reply to the Notice to File Missing Parts within the period for response, including any available extensions of time. Although the Office attempts to notify parties as to defective papers in order to permit timely refiling, it has no obligation to do. Rather, applicants were ultimately responsible for filing a timely, proper and complete reply to the Notice to File Missing Parts of Nonprovisional Application within the time period provided in the Notice to save the application from abandonment.

In view of the above, the application was properly held abandoned. Therefore, the petition under 37 CFR 1.181 is dismissed.

As to the petition under 37 CFR 1.137(b), petitioners have supplied (1) the reply in the form of a declaration; (2) the petition fee; and (3) an adequate statement of unintentional delay.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" be submitted. However, the statement presented will be accepted and construed as the statement required by 37 CFR 1.137(b)(3). Petitioners must notify the Office if this is not a correct interpretation of the statement contained in the present petition.

As petitioners have met the requirements under 37 CFR 1.137(b) to revive the application, the petition is granted.

As petitioners previously paid the 130.00 surcharge on December 9, 2008, the additional payment of $130.00 is unnecessary. Accordingly, the Office will refund the duplicate $130.00 fee charged to the Deposit Account on January 21, 2009, in due course.

This matter is being referred to the Office of Patent Application Processing for pre-examination processing.

Telephone inquiries specific to this decision may be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
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**JAGTIANI + GUTTAG**
**10363-A DEMOCRACY LANE**
**FAIRFAX VA 22030**

**MAILED**

FEB 19 2009

OFFICE OF PETITIONS

In re Application of :
**SISSOM,** Bradley J. et al. :
Application No. 12/104,470 : DECISION ON PETITION
Filed: April 17, 2008 : TO WITHDRAW
Attorney Docket No. **INPI-0001-DV2** : 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 10, 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 Steven B. Kelber on behalf of all attorneys of record. Steven B. Kelber has been withdrawn as attorney or agent of record; all other attorneys remain of record.

The correspondence address of record remains unchanged.

There is no outstanding office action 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

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No.**: _____

**DATE** : 02/22/10

**TO SPE OF** : ART UNIT 2877

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 12104471 Patent No.: 7586603

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (C of C)**
**Randolph Square 9D40-D**
**Palm Location 7580**

You can fax the Directors/SPE response to 571-270-9990

Lamonte Newsome

**Certificates of Correction Branch**

**703-756-1574**

**Thank You For Your Assistance**

---

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

Note your decision on the appropriate box.

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

**Comments:** Approved.

Gregory J. Toatley, Jr. — **SPE**

2877 — **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
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MAILED

JUN 07 2010

OFFICE OF PETITIONS

**LATIMER INTELLECTUAL PROPERTY LAW, LLP**
**P.O. BOX 711200**
**HERNDON, VA 20171**

| | | |
|---|---|---|
| In re Application of | : | |
| Wilson et al. | : | DECISION ON PETITION |
| Application No. 12/104,500 | : | TO WITHDRAW |
| Filed: April 17, 2008 | : | FROM RECORD |
| Attorney Docket No. AVID-102 | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed April 27, 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 Matthew T. Latimer, on behalf of all practitioners of record associated with Customer Number 59241

Customer Number 59241 has 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.

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 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: SAMUEL B. WILSON, AVID LLC
322 FREEDOM BLVD. SUITE C
YORKTOWN, VA 23692

cc: MATTHEW T. LATIMER
13873 PARK CENTER ROAD, SUITE 106
HERNDON, VA 20171

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/104,500 | 04/17/2008 | Samuel B. Wilson III | AVID-102 |

**CONFIRMATION NO. 3982**

**POWER OF ATTORNEY NOTICE**

59241
LATIMER INTELLECTUAL PROPERTY LAW, LLP
P.O. BOX 711200
HERNDON, VA 20171

Date Mailed: 06/07/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 04/27/2010.

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

/atkelley/

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

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TUNG & ASSOCIATES / RANDY W TUNG ESQ
838 W LONG LAKE ROAD
SUITE 120
BLOOMFIELD HILLS MI 48302

MAILED

APR 23 2009

OFFICE OF PETITIONS

In re Application of :
McCarville, et al. :
Application No. 12/104,529 : ON PETITION
Filed: April 17, 2008 :
Attorney Docket No. 07-0956 :
(82,000-160)

This is a decision on the petition to revive under 37 CFR 1.137(a), filed March 27, 2009.

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

The application was held abandoned due to failure to timely file a reply to the Notice to File Corrected Application Papers, mailed May 20, 2008. This Notice set an extendable period for reply of two (2) months. No reply having been received, the application became abandoned on July 21, 2008. The Office mailed a Notice of Abandonment on January 29, 2009.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). Decisions on reviving abandoned applications on the basis of

"unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[1]

Moreover, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."[2]

To establish nonreceipt of an Office action, a petitioner must: 1) include a statement that the Office action was not received; 2) attest to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and 3) include a copy of the docket record where the nonreceived Office action would have been entered had it been received and docketed.[3] A proper docket report consists of a "docket record where the nonreceived Office action would have been entered had it been received and docketed."[4] "For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket record showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted..."[5]

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[1] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

[2] Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

[3] See MPEP 711.03(c)(II).

[4] MPEP 711.03(c)(II) (emphasis added).

[5] Id.

With the instant petition, petitioner has submitted a copy of a master docket report, showing all of his replies docketed for a due date during the period from June 2, 2008 to August 31, 2008. An entry for the instant application is absent on July 20, 2008, supporting the conclusion that the May 20, 2008 Notice was not received.

In view thereof, the petition is granted.

The application is being forwarded to the Office of Patent Application Processing for re-mailing of the May 20, 2008 Notice to File Corrected Application Papers, setting a new period for reply.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAIL

SEP 16 2008

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

KED & ASSOCIATES, LLP
P.O. Box 221200
Chantilly VA 20153-1200

In re Application of :
YI, SEUNG JUNE et al. :
Application No. 12/104,542 :
Filed: April 17, 2008 :
Attorney Docket No.: P-0426.01 :

DECISION ON REQUEST TO PARTICIPATE IN PATENT PROSECUTION HIGHWAY PILOT 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) pilot program and the petition under 37 CFR 1.102(d), filed July 10, 2008, to make the above-identified application special.

The request and petition are **GRANTED**.

A grantable request to participate in the PPH pilot program and petition to make special require:

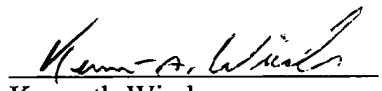
(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the KIPO;
(2) Applicant must submit a copy of the allowable/patentable claim(s) from the KIPO application(s) along with an English translation thereof and a statement that the English translation 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 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 Kenneth Wieder at 571-272-2986.

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.



Kenneth Wieder
Quality Assurance Specialist
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

Mail Date: 05/10/2010

| | | |
|---|---|---|
| **Applicant** | : RAMAPRASATH VILANGUDIPITCHAI | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7622955 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/24/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 12/104,580 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/17/2008 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **41** 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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NOV 05 2009

JONDLE & ASSOCIATES P.C.
858 HAPPY CANYON ROAD SUITE 230
CASTLE ROCK CO 80108

In re Application of:
Dennis L. Schultze
Serial No.: 12/104,607
Filed: April 17, 2008
Attorney Docket No.: **1423-109**

: PETITION DECISION

This is in response to the petition under 37 CFR § 1.59(b), filed November 3, 2009, to expunge information from the above identified application. This application has not been allowed.

Petitioner requests that the Reply to Request for Information under 37 CFR 1.105, and attachment thereto, submitted to the Patent Office on November 3, 2009, be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

This is an examined application which is currently under non-final rejection. As such the information provided has been reviewed, in part, but proceedings in the application have not been terminated. As stated in M.P.E.P. 724, upon allowance or other action closing prosecution in an application, petition may be made for return of Proprietary information. The information cannot be expunged at this time.

The petition is **DISMISSED**. Petitioner may resubmit the petition subsequent to a Notice of Allowability or *ex parte Quayle* action being mailed in the application. No additional petition fee will be required at that time.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/104,607 | 04/17/2008 | Dennis L. Schultze | 1423-109 | 4162 |

32905 7590 01/28/2010

JONDLE & ASSOCIATES P.C.
858 HAPPY CANYON ROAD SUITE 230
CASTLE ROCK, CO 80108

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1638 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 01/28/2010 | 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):

JondleOA@jondlelaw.com

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JAN 2 8 2010

JONDLE & ASSOCIATES P.C.
858 HAPPY CANYON ROAD SUITE 230
CASTLE ROCK CO 80108

In re Application of:
Dennis L. Schultze
Serial No.: 12/104,607
Filed: April 17, 2008
Attorney Docket No.: **1423-109**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed January 25, 2010, to expunge information from the above identified application. This application has been allowed.

Petitioner requests that the Reply to Request for Information Under 37 CFR 1.105, and all attachments thereto, submitted to the Patent Office on November 3, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

The reasons set forth in this petition establishes to the satisfaction of the Director that expungement of the information is appropriate. The file entry for this document has been closed and as such the document is no longer publicly available, which is the IFW equivalent to removal of a paper document from a paper file wrapper.

Therefore, petitioner's petition is GRANTED.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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VIERRA MAGEN/SANDISK CORPORATION
575 MARKET STREET
SUITE 2500
SAN FRANCISCO, CA 94105

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Mordechai TEICHER | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7591657 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/104,616 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/17/2008 | : 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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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/104,619 | 04/17/2008 | Dennis L. Schultze | 1423-108 | 4191 |

32905 7590 02/22/2010

JONDLE & ASSOCIATES P.C.
858 HAPPY CANYON ROAD SUITE 230
CASTLE ROCK, CO 80108

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |
| **ART UNIT** | **PAPER NUMBER** |
| 1638 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 02/22/2010 | 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):

JondleOA@jondlelaw.com

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FEB 2 2 2010

JONDLE & ASSOCIATES P.C.
858 HAPPY CANYON ROAD SUITE 230
CASTLE ROCK CO 80108

In re Application of:
Dennis L. Schultze
Serial No.: 12/104,619
Filed: April 17, 2008
Attorney Docket No.: **1423-108**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed February 12, 2010, to expunge information from the above identified application. This application has been allowed.

Petitioner requests that the Reply to Request for Information Under 37 CFR 1.105, and all attachments thereto, submitted to the Patent Office on November 3, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

The reasons set forth in this petition establishes to the satisfaction of the Director that expungement of the information is appropriate. The file entry for this document has been closed and as such the document is no longer publicly available, which is the IFW equivalent to removal of a paper document from a paper file wrapper.

Therefore, petitioner's petition is GRANTED.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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

| | | |
|---|---|---|
| In re Application of | : | |
| Clifford M. Liu, et al. | : | |
| Application No. 12/104,635 | : | DECISION ON PETITION |
| Filed: April 17, 2008 | : | TO WITHDRAW |
| Attorney Docket No. 18554-097001 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 20, 2009.

The request is **APPROVED**.

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

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor interest at the first copied address below until otherwise properly notified by the applicant.

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **James Edward Barrington**
**31 Dewey Road**
**Lexington, MA 02420-1017**

cc: **Omnisonics Medical Technologies, Inc.**
**c/o John Aquino (Bankruptcy Trustee)**
**Anderson Aquino LLP**
**240 Lewis Wharf**
**Boston, MA 02110**

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/104,635 | 04/17/2008 | Clifford M. Liu | 18554-097001 |

**CONFIRMATION NO. 4223**

**POWER OF ATTORNEY NOTICE**

26161
FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

*OC0000000037537019*

Date Mailed: 08/27/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 07/20/2009.

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

/tswilliams/

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

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JUL 09 2008
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TECHNOLOGY CENTER 2600

Chad W. Schwartz
IBM CORPORATION (SWP)
C/O SUITER SWANTZ PC LLO
14301 FNB PARKWAY, SUITE 220
OMAHA NE 68154-5299

In re Application of:
Chris Bygrave et al
Serial No.: 12/104668
Filed: April 17, 2008
Attorney Docket number: GB920080115US1
Title: **EARLY WARNING SYSTEM FOR APPROACHING EMERGENCY VEHICLES**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 17, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions set forth under section I. above are considered to have been met. However, the petition fails to comply with conditions set forth under section II, items 5, 5.1, 6.1, 6.2 and 6.3.

For these reasons cited above, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.
Regarding the requirement in item 5.2 and 5.3 above, the preexamination search document provided with the instant petition is deficient as follows: The search was too narrow. Search should have additionally included Class/subclass:

340/902
340/903
340/438

If any request for reconsideration is filed, an updated preexamination search must be conducted as per items 5.2 and 5.3 above, and the Preexamination Search Document must be amended to indicate such; a new Information Disclosure Statement should be filed to cite any newly found prior art, and the Accelerated Examination Support Document must also be amended to include the necessary reference and discussion of any newly found and cited prior art in accordance with all of items 6 through 6.6 above.

Regarding the requirement in item 6.1 above, the accelerated examination support document only discuses eight references deemed most closely related to the subject matter of the claims. However, the IDS lists several additional references. All references deemed most closely related to the subject matter of the claims must be discussed in the accelerated examination support document. *Therefore, any request for reconsideration must provide a detailed explanation in regard to the claim with respect to the other three cited references as set forth in items 6.2 and 6.3 above or an explanation of why the references are no longer deemed most closely related.*

Regarding the requirement in item 6.2 above, the Accelerated Examination Support Document is deficient because section 9(B) titled "Identification of Limitations Disclosed by References" provides only a broad general description of each reference cited. However, the petition fails to identify all of the limitations in the claim of the application that are disclosed by each reference cited and specifying where each limitation is disclosed by each cited reference as required by item 6.2. Clarification is required

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Eileen Lillis, Quality Assurance Specialist, at (571) 272-6928.

/Eileen Lillis/

Eileen Lillis
Quality Assurance Specialist
Technology Center 2600

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IBM CORPORATION (SWP)
C/O SUITER SWANTZ PC LLO
14301 FNB PARKWAY, SUITE 220
OMAHA NE 68154-5299

In re Application of:
Chris Bygrave et al.
Serial No.: 12/104,668
Filed: 04/17/2008
Docket: GB920080115US1
Title: **EARLY WARNING SYSTEM FOR APPROACHING EMERGENCY VEHICLES**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 17, 2008 with a revised AE support document dated August 11, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not

file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Kenneth Wieder, Special Program Examiner, at (571) 272-2986.

Kenneth A. Wieder,
Quality Assurance Specialist
Technology Center 2600
Communications

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/104,730 | 04/17/2008 | Dennis L. Schultze | 1423-107 | 4409 |

32905 7590 11/13/2009

JONDLE & ASSOCIATES P.C.
858 HAPPY CANYON ROAD SUITE 230
CASTLE ROCK, CO 80108

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1638 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 11/13/2009 | 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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JONDLE & ASSOCIATES P.C.
858 HAPPY CANYON ROAD SUITE 230
CASTLE ROCK CO 80108

In re Application of:
Dennis L. Schultze
Serial No.: 12/104,730
Filed: February 28, 2008
Attorney Docket No.: **1423-107**

: PETITION DECISION

This is in response to the petition under 37 CFR § 1.59(b), filed November 3, 2009, to expunge information from the above identified application. This application has not been allowed.

Petitioner requests that the Reply to Request for Information under 37 CFR 1.105, and attachment thereto, submitted to the Patent Office on November 3, 2009, be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

This is an examined application which is currently under non-final rejection. As such the information provided has been reviewed, in part, but proceedings in the application have not been terminated. As stated in M.P.E.P. 724, upon allowance or other action closing prosecution in an application, petition may be made for return of Proprietary information. The information cannot be expunged at this time.

The petition is **DISMISSED**. Petitioner may resubmit the petition subsequent to a Notice of Allowability or *ex parte Quayle* action being mailed in the application. No additional petition fee will be required at that time.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/104,730 | 04/17/2008 | Dennis L. Schultze | 1423-107 | 4409 |

32905 7590 02/22/2010

JONDLE & ASSOCIATES P.C.
858 HAPPY CANYON ROAD SUITE 230
CASTLE ROCK, CO 80108

| EXAMINER | |
|---|---|
| MCELWAIN, ELIZABETH F | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1638 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 02/22/2010 | 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):

JondleOA@jondlelaw.com

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FEB 22 2010

JONDLE & ASSOCIATES P.C.
858 HAPPY CANYON ROAD SUITE 230
CASTLE ROCK CO 80108

In re Application of:
Dennis L. Schultze
Serial No.: 12/104,730
Filed: April 17, 2008
Attorney Docket No.: **1423-107**

: PETITION DECISION

This is in response to the renewed petition under 37 CFR § 1.59(b), filed February 5, 2010, to expunge information from the above identified application. This application has been allowed.

Petitioner requests that the Reply to Request for Information Under 37 CFR 1.105, and all attachments thereto, submitted to the Patent Office on November 3, 2009 be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

The reasons set forth in this petition establishes to the satisfaction of the Director that expungement of the information is appropriate. The file entry for this document has been closed and as such the document is no longer publicly available, which is the IFW equivalent to removal of a paper document from a paper file wrapper.

Therefore, petitioner's petition is GRANTED.

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

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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**KED & ASSOCIATES, LLP**
**P.O. BOX 221200**
**CHANTILLY VA 20153-1200**

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FEB 19 2009

OFFICE OF PETITIONS

In re Application of
Chang Hun Oh et al
Application No. 12/104,744
Filed: April 17, 2008
Attorney Docket No. K-0990

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 14, 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; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notices mailed May 6, 2008 and December 15, 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 the Office of Patent Application Processing for pre-examination processing.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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KED & ASSOCIATES, LLP
P.O. BOX 221200
CHANTILLY, VA 20153-1200

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OFFICE OF PETITIONS

In re Application of :
Chang Hun Oh et al :
Application No. 12/104,754 : ON PETITION
Filed: April 17, 2008 :
Attorney Docket No. K-0992 :

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice To File Missing Parts of Nonprovisional Application (Notice) mailed May 6, 2008. The Notice set a period for reply of two (2) months from the mail date of the Notice. Five-month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on December 7, 2008.

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

This matter is being referred to the Office of Patent Application Processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

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**HARMAN-BRINKS HOFER CHICAGO**
**Brinks Hofer Gilson & Lione**
**P.O. Box 10395**
**Chicago, IL 60610**

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JUL 29 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Tim Haulick, et al. | : | |
| Application No. 12/104,836 | : | DECISION ON PETITION |
| Filed: April 17, 2008 | : | TO WITHDRAW |
| Attorney Docket No. 11336-1853 (P07073US) | : | 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 15, 2009.

The request is **APPROVED**.

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

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Tim Haulick**
**In den Schlosswiessen 14**
**Blaubeuren, 89143**
**Germany**

cc: **Robert P. Hart, Esq.**
**Harman International Industries, Inc.**
**8500 Balboa Boulevard**
**Northridge, CA 91329**

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/104,836 | 04/17/2008 | Tim Haulick | 11336-1853 (P07073US) |

**CONFIRMATION NO. 4570**

81166
HARMAN - BRINKS HOFER CHICAGO
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

**POWER OF ATTORNEY NOTICE**

*OC000000037135638*

Date Mailed: 07/29/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 06/15/2009.

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

/tswilliams/

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

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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

Mail Date: 07/30/2010

| | | |
|---|---|---|
| **Applicant** | : Tuan Van Ngo | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7652537 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 12/104,849 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/17/2008 | : 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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CONLEY ROSE, P.C.
David A. Rose
P.O. BOX 3267
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**OFFICE OF PETITIONS**

In re Application of :
Tedeschi et al. : DECISION ON PETITION
Application No. 12/104,856 :
Filed: April 17, 2008 :
Atty Docket No. 1030-40401 :

This is a decision on the "PETITION TO ACCORD THE NONPROVISIONAL APPLICATION THE APRIL 17, 2008 FILING DATE" filed Monday, September 8, 2008. Applicant requests that the above-identified application be given its original filing date of April 17, 2008, including figure 13. Applicant further requests that the Office refund the petition fee.

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

Application papers in the above-identified application were deposited on April 17, 2008. However, on May 6, 2008, the Office mailed applicant a NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION notifying applicant *inter alia* that the application papers had been accorded a filing date of April 17, 2008; however, figures 13, 14 described in the specification appeared to be omitted from the application. This Notice set a two month time limit for reply, with extensions of time obtainable under 37 CFR 1.136(a). A response, made timely by an accompanying one month extension of time, was received on August 6, 2008. The response included inter alia 11 drawing sheets including figures 1-11, 12A and 12B. The response did not address omitted figures 13 and 14. Accordingly, on August 14, 2008, the Office mailed applicant a NOTICE OF INCOMPLETE REPLY again notifying applicant that figures 13, 14 described in the specification appeared to be omitted from the application. Further, on August 21, 2008, the Office mailed a NOTICE OF INCOMPLETE REPLY requiring applicant to submit a complete set of

new and replacement drawings. In the August Notices, the period for reply continued to run from the mail date of the Notice mailed May 6, 2008.

In response, applicant filed the instant petition, made timely by a further two month extension of time[1]. Applicant petitions to maintain the original filing date of April 17, 2008. Applicant acknowledges an error in the specification in that applicant inadvertently referred to a figure 14. Applicant states that they have removed all reference to figure 14. With respect to figure 13, applicant states that the drawing of figure 13 was included in U.S. Provisional Patent Application No. 61/038,888 filed March 24, 2008, which the present application claimed the benefit of and expressly incorporated by reference in the application as originally filed.

A review of the application as filed confirms that on filing it included both the claim for the benefit of and the express incorporation by reference of application No. 61/038,888. Accordingly, this application may[2] be amended to include omitted drawing figure 13 and maintain a filing date of April 17, 2008. However, no petition is necessary for this purpose as this application is entitled to a filing date of April 17, 2008 notwithstanding the incorporation by reference of figure 13.

As stated in the MPEP 201.06(c),

> The inclusion of this incorporation by reference statement will permit an applicant to amend the continuation or divisional application to include subject matter from the prior application(s), without the need for a petition provided the continuation or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

Likewise, this MPEP section further provides:

> If a continuation or divisional application as originally filed on or after September 21, 2004 does not include an explicit incorporation by reference statement and is

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[1] The one month extension of time is being refunded. Only an extension of time within the second month was necessary to make timely both replies to the May 6, 2008 Notice filed August 6, 2008 and Monday, September 8, 2008.

[2] Given the explicit incorporation by reference statement, consideration of whether the requirements of 37 CFR 1.57(a) have been met is unnecessary.

> entitled to a filing date despite the inadvertent omission of a portion of the prior application(s), applicant may be permitted to add the omitted material by way of an amendment under 37 CFR 1.57(a).

In sum, when an application is entitled to a filing date, and the omitted material is present in an application incorporated by reference[3] on filing or to which a benefit or priority claim was made on filing, applicant need not file a petition. Rather, within the time period for reply (or within such other time as set by the Office) applicant should submit an amendment (based on the express incorporation by reference or pursuant to 37 CFR 1.57(a)(1)) adding the omitted material.

Receipt of the petition fee is acknowledged. The $400 petition fee is required and will not be refunded. Applicant filed this petition due to their filing error in inadvertently omitting figure 13 described in the specification.

The application will retain a filing date of April 17, 2008 and the amendment to enter the drawings may be entered by the examiner.

The application is being forwarded to the Office of Patent Application Processing for completion of pre-examination processing with a filing date of April 17, 2008 using the application papers received in the Office and presently accorded that date.

Applicant will receive appropriate notifications regarding the fees owed, if any, and other information in due course from the Office of Patent Application Processing.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney, Nancy Johnson at (571) 272-3219.

Anthony Knight
Supervisory Petitions Examiner
Office of Petitions

---

[3] It is specifically noted that the incorporation by reference statement may be relied on when the prior application is a provisional.

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**BOYLE FREDRICKSON S.C.**
**840 NORTH PLANKINTON AVENUE**
**MILWAUKEE WI 53203**

**MAILED**

MAY 18 2010

**OFFICE OF PETITIONS**

In re Application of :
Jason B. PARMANN :
Application No. 12/104,892 : DECISION ON PETITION
Filed: April 17, 2008 : TO WITHDRAW
Attorney Docket No. 1690.001 : 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, 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 37 CFR 10.40(c).

The request was signed by Kirk L. Deheck on behalf of the attorneys of record associated with Customer No. 23598.

The attorneys of record associated with Customer No. 23598 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 until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-6735.

/dcg/
Diane C. Goodwyn
Petitions Examiner
Office of Petitions

cc: JASON B. PARMANN
621 W. LA BELLE AVENUE
OCONOMOWOC, WI 53066

UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/104,892 | 04/17/2008 | Jason B. Parmann | 1690.001 |

**CONFIRMATION NO. 4670**

**POWER OF ATTORNEY NOTICE**

23598
BOYLE FREDRICKSON S.C.
840 North Plankinton Avenue
MILWAUKEE, WI 53203

Date Mailed: 05/12/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/11/2010.

- 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.

/dcgoodwyn/

---

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

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WYETH, LLC
PATENT LAW GROUP
5 GIRALDA FARMS
MADISON, NJ 07940

MAILED
MAR 26 2010
OFFICE OF PETITIONS

In re Patent No. 7,626,023 :
Issue Date: December 1, 2009 :
Application No. 12/104,921 : ON PETITION
Filed: April 17, 2008 :
Patentee(s): Arie Zask, et. al. :

This is a decision on the request under 37 CFR 3.81[1], filed January 7, 2010, to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

As authorized, the $130 processing fee will be charged to petitioner's deposit account.

Since the present request complies with the requirements of 37 CFR 3.81, the request is **GRANTED**.

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

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3226. Inquiries regarding the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

Andrea Smith
Petitions Examiner
Office of Petitions

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/104,967 | 04/17/2008 | Pierre Pellaton | P+TS-43648 | 4816 |

7590 01/28/2010

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

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 3673 | |
| MAIL DATE | DELIVERY MODE |
| 01/28/2010 | PAPER |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Nimi Farmer

Patent Publication Branch
Office of Data Management

Adjustment date: 01/29/2010 NFARMER
04/18/2008 INTEFSW 00001773 160820 12104967
02 FC:1111 510.00 CR
04 FC:1202 408.00 CR

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JUL 0 1 2009

OFFICE OF PETITIONS

O"MELVENY & MYERS LLP
IP&T CALENDAR DEPARTMENT LA-13-A7
400 SOUTH HOPE STREET
LOS ANGELES CA 90071-2899

In re Application of :
**MOORE**, Bob M. II. :
Application No. 12/104,968 : DECISION ON PETITION
Filed: April 17, 2008 : TO WITHDRAW
Attorney Docket No. **335,699-104** : 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 John Kappos on behalf of all attorneys of record who are associated with customer No. 34263. All attorneys/agents associated with the Customer Number 34263 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence address of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

cc: **BOB M. MOORE II**
**3793 MAGNOLIA LANE**
**NESBIT MS 38651**

cc: **UNIVERSITY OF TENNESSEE RESEARCH FOUNDATION**
**920 MADISON AVENUE**
**SUITE 515**
**MEMPHIS TN 38163**

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**HARMAN-BRINKS HOFER CHICAGO**
**Brinks Hofer Gilson & Lione**
**P.O. Box 10395**
**Chicago, IL 60610**

MAILED

AUG 10 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| John B. Bogdan, et al. | : | |
| Application No. 12/104,975 | : | DECISION ON PETITION |
| Filed: April 17, 2008 | : | TO WITHDRAW |
| Attorney Docket No. 11336-1856 (P08 109US) | : | 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 15, 2009.

The request is **APPROVED**.

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

The request was signed by 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 correspondence address of record has been changed and the new correspondence address is the address indicated below.

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Robert P. Hart, Esq.**
**Harman International Industries, Inc.**
**6500 Balboa Boulevard**
**Northridge, CA 91329**

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/104,975 | 04/17/2008 | John B. Bogdan | 11336-1856 (P08109US) |

**CONFIRMATION NO. 4832**

**POWER OF ATTORNEY NOTICE**

81166
HARMAN - BRINKS HOFER CHICAGO
Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

Date Mailed: 07/29/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 06/15/2009.

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

/tswilliams/

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

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**DIEHL SERVILLA LLC**
**77 BRANT AVE**
**SUITE 210**
**CLARK NJ 07066**

**MAILED**

MAY 2 4 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Thorner, Craig | : | DECISION ON PETITION |
| Application No. 12/105,007 | : | TO WITHDRAW |
| Filed: April 17, 2008 | : | FROM RECORD |
| Attorney Docket No. THO0005-06CT | : | |

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, 2010 and again on April 29, 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 Glen M. Diehl on behalf of all attorneys/agents of record who are associated with Customer Number 48394. All attorneys/agents associated with Customer Number 48394 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, Craig Thorner, at the address indicated below.

There is an outstanding Office action, mailed March 25, 2010, which required a reply from the applicant. Failure to timely and properly do so will result in abandonment of the instant application.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Liana Walsh
Petitions Examiner
Office of Petitions

cc: CRAIG THORNER
14 STUYVESANT ROAD
BRICK, NJ 08723

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SHOEMAKER AND MATTARE, LTD
10 POST OFFICE ROAD – SUITE 100
SILVER SPRING, MD 20910

**MAILED**

MAY 10 2010

OFFICE OF PETITIONS

In re Application of :
Barry Van Foster :
Application No. 12/105,081 : DECISION ON PETITION
Filed: April 17, 2008 : TO WITHDRAW
Attorney Docket No. 6197 : 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 8, 2010.

The request is **APPROVED**.

The request was signed by Charles Fallow on behalf of the practitioners of record associated with Customer Number 26936.

Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to inventor Barry Van Foster at the address indicated below.

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

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Barry Van Foster
2501 Lebanon Church Road
Jefferson, GA 30549

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/105,081 | 04/17/2008 | Barry Van Foster | 6197 |

**CONFIRMATION NO. 5049**

SHOEMAKER AND MATTARE, LTD
10 POST OFFICE ROAD - SUITE 100
SILVER SPRING, MD 20910

**POWER OF ATTORNEY NOTICE**

*OC000000041517577*

Date Mailed: 05/07/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/08/2010.

- 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.

/idingle/

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

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/105,081 | 04/17/2008 | Barry Van Foster | 6197 |

**CONFIRMATION NO. 5049**

Barry Van Foster
2501 Lebanon Church Road
Jefferson, GA 30549

**POA ACCEPTANCE LETTER**

Date Mailed: 05/07/2010

## 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.

/idingle/

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/105,122 | 04/17/2008 | Heiko Wolf | 2008_0542A | 5143 |

78806 7590 06/27/2008

Wenderoth, Lind & Ponack, L.L.P
2033 K Street, NW
Suite 800
Washington, DC 20006

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

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/27/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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CST

6-27-08

In re application of
Heiko Wolf et al
Serial No. 12/105,122
Filed: April 17, 2008
For: METHOD OF TRANSFERRING NANOPARTICLES TO A SURFACE

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition filed on April 17, 2008 to make the above-identified application special under the accelerated examination program.

The petition to make the application special is **DISMISSED.**

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any dependent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner;

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document.

An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions regarding the application (section I, subsections 1-4) discussed above are considered to have been met. Additionally, the conditions regarding the petition, section II, subsections 1-4 and 6, are considered to have been met. However, the petition fails to comply with condition II, subsection 5.

It appears that the search is incomplete. Note that a search in Class 156/subclasses 235, 230, 241, 249, 297 and 344 is also required.

Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

## DECISION

For the above-stated reasons, the petition is dismissed. The application will therefore be taken up by the examiner in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

/ Christine Tierney /

Christine Tierney
Quality Assurance Specialist
Technology Center 1700

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/105,122 | 04/17/2008 | Heiko Wolf | 2008_0542A | 5143 |

78806 7590 08/01/2008
Wenderoth, Lind & Ponack, L.L.P
2033 K Street, NW
Suite 800
Washington, DC 20006

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

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/01/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CST

8-1-08

In re application of
Heiko Wolf et al
Serial No. 12/105,122
Filed: April 17, 2008
For: METHOD OF TRANSFERRING NANOPARTICLES TO A SURFACE

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the Request for Reconsideration of Petition to Make Special under the Accelerated Examination Program filed on July 25, 2008 to make the above-identified application special.

The petition to make the application special is **GRANTED.**

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
   If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
   An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
   A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

   For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

   To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
   Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

/Christine Tierney/

Christine Tierney
Quality Assurance Specialist
Technology Center 1700

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HAYES SOLOWAY P.C.
3450 E. SUNRISE DRIVE, SUITE 140
TUCSON, AZ 85718

Mail Date: 04/23/2010

| | | |
|---|---|---|
| **Applicant** | : Prabhu Thiagarajan | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7660335 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/09/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/105,126 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/17/2008 | : 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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Alexandria, Virginia 22313-1450
www.uspto.gov

KENYON & KENYON LLP
1500 K STREET, NW
WASHINGTON, DC 20005-1257

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Rikky MULLER | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7609112 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/27/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/105,159 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/17/2008 | : 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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**WILSON, SONSINI, GOODRICH & ROSATI**
**650 PAGE MILL ROAD**
**PALO ALTO CA 94304-1050**

**COPY MAILED**

NOV 16 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Liao et al. | : | DECISION ON PETITION |
| Application No. 12/105,173 | : | TO WITHDRAW |
| Filed: April 17, 2008 | : | FROM RECORD |
| Attorney Docket No. 32509-701.201 | : | |

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 9, 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 Paul Borchardt, Ph.D. on behalf of all attorneys/agents of record who are associated with Customer Number 21971.

All attorneys/agents associated with Customer Number 21971 have been withdrawn. Applicants are reminded that there is no attorney of record at this time.

All future correspondence will be directed to first-named inventor, Heather H. Liao, at the address indicated below.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Liana Walsh
Petitions Examiner
Office of Petitions

cc: HEATHER H. LIAO
280 CUESTA DRIVE
LOS ALTOS CA 94022

UNITED STATES PATENT AND TRADEMARK OFFICE

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**AXIOS LAW GROUP. PLLC**
**1525 4TH AVE, STE 800**
**SEATTLE, WA 98101-1648**

**MAILED**

MAR 2 9 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Michael F. Jones | : | DECISION ON PETITION |
| Application No. 12/105,178 | : | TO WITHDRAW |
| Filed: April 17, 2008 | : | FROM RECORD |
| Attorney Docket No. DK: SR3-3633-U | : | |

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 22, 2010.

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

A review of the file record indicates that Axios Law Group, PLLC was revoked as power of attorney by the assignee of the patent application on February 26, 2010. 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: R REAMS GOODLOE, JR. & R. REAMS GOODLOE, P.S.
24722 104TH. AVENUE S.E.
SUITE 102
KENT, WA 98030-5322

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/105,181 | 04/17/2008 | Kazuo NAKAMURA | 89277.0262 | 5263 |

7590 10/01/2009

HOGAN & HARTSON L.L.P.
1999 AVENUE OF THE STARS
SUITE 1400
LOS ANGELES, CA 90067

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 3747 | |
| NOTIFICATION DATE | DELIVERY MODE |
| 10/01/2009 | ELECTRONIC |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Patent Publication Branch
Office of Data Management

Adjustment date: 09/30/2009 NFARMER
09/25/2008 INTEFSW 00003033 501314 12105181
02 FC:1111 510.00 CR

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**LAW OFFICES OF LARRY K. ROBERTS, INC.**
**2 PARK PLAZA**
**SUITE 300**
**IRVINE, CA 92614**

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MAY 22 2008

OFFICE OF PETITIONS

In re Application of :
**KOSMOWSKI,** Wojciech B. :
Application No. 12/105,229 : DECISION ON PETITION
Filed: April 17, 2008 : TO MAKE SPECIAL UNDER
Attorney Docket No. **1976** : 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed April 17, 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 attesting that Wojciech B. Kosmowski is over 65 years of age. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Michelle R. Eason at 571-272-4231.

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

This application is being referred to the Office of Initial Patent Examination for processing. This application will be accorded "special" status when pre-examination processing is done.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

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**Fitzpatrick Cella (Marvel)**
**30 Rockefeller Plaza**
**New York, NY 10112-3800**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Chenglin Liu, et al. | : | |
| Application No. 12/105,235 | : | DECISION ON PETITION |
| Filed: April 17, 2008 | : | TO WITHDRAW |
| Attorney Docket No. MP1875 | : | 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 31, 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 Michael K. O'Neill on behalf of all attorneys of record. All attorneys/agents have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Chenglin Liu**
**1182 Adams Court**
**San Jose, CA 95132**

cc: **Marvell Patent Department c/o**
**Kevin Vivian**
**5488 Marvel Lane**
**Santa Clara, CA 95054**

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/105,235 | 04/17/2008 | Chenglin Liu | MP1875 |

**CONFIRMATION NO. 5348**

47215
FITZPATRICK CELLA (MARVELL)
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112-3800

**POWER OF ATTORNEY NOTICE**

*OC000000033126660*

Date Mailed: 11/17/2008

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 10/31/2008.

- 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

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**FRENKEL & ASSOCIATES**
**3975 UNIVERSITY DR., STE. 330**
**FAIRFAX VA 22030**

MAILED

JUN 14 2010

OFFICE OF PETITIONS

In re Application of :
Chuan-Lien TSENG :
Application No. 12/105,329 : DECISION ON PETITION
Filed: April 18, 2008 : TO WITHDRAW
Attorney Docket No. FACH 08-4 : 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 28, 2010.

The request is **NOT APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request cannot be approved because the attorneys of record were not appointed through use of Customer Number 31764, as indicated. In this regard, since the attorneys of record were appointed by naming each attorney individually, any future Request should indicate the same designation for withdrawing the attorneys.

Further, 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, the most current address information provided for the first named inventor. Accordingly, since the change of address is not that of an assignee who has properly been made of record under 37 CFR 3.71 or the inventor, the request to withdraw as attorney /agent cannot be approved.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary

evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

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

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-6735.

/dcg/
Diane C. Goodwyn
Petitions Examiner
Office of Petitions

cc: CHUAN-LIEN TSENG
P.O. BOX 46-669
TAIPEI TAIWAN

UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/105,393 | 04/18/2008 | Diko SULAHIAN | 8299.050 | 5658 |

28410 7590 05/02/2008
BERENATO, WHITE & STAVISH, LLC
6550 ROCK SPRING DRIVE
SUITE 240
BETHESDA, MD 20817

| EXAMINER | |
|---|---|
| STORMER, RUSSELL D | |
| **ART UNIT** | **PAPER NUMBER** |
| 3617 | |
| **MAIL DATE** | **DELIVERY MODE** |
| 05/02/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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FROM DIRECTORS OFFICE
MAY 02 2008
TECHNOLOGY CENTER 3600

Berenato, White & Stavish, LLC
6550 Rock Spring Drive
Suite 240
Bethesda, MD 20817

In re application of :
Diko Sulahian :
Application No. 12/105,393 :
Filed: April 18, 2008 :
For: VEHICLE WHEEL ASSEMBLY WITH TRANSITION RING MEMBER :

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 CFR 1.102

This is a decision on the petition filed on April 18, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed to a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

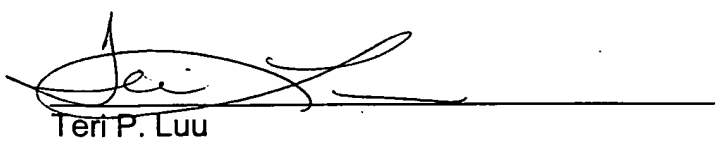
On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Quality Assurance Specialist Teri P. Luu, at (571) 272-7045.



Teri P. Luu
Quality Assurance Specialist
Technology Center 3600

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 07-15-09

**TO SPE OF** : ART UNIT 2627

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 12/105471 Patent No.: 7508743

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

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

**Angela Green**
**Certificates of Correction Branch**
**703-756-1541**

**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:** _____

/Paul Huber/
01/12/2010

_____ 2627
**SPE** **Art Unit**

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. |
|---|---|---|---|---|
| 12/105,479 | 04/18/2008 | Bradford Lawrence HUNTER | BUR920080002US1 | 5793 |

48148 7590 05/30/2008

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2817 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/30/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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052008

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

In re Application of:
Bradford Lawrence Hunter
Serial No.: 12/105,479
Filed: April 18, 2008
Docket: BUR920080002US1
Title: COMMON MODE CONTROLLED DIFFERENTIAL GAIN BOOSTED CURRENT MIRRORS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. §1.102

This is a decision on the petition filed on April 18, 2008, to make the above-identified application special for accelerated examination procedure under 37 C.F.R. §1.102(d) and M.E.P.E.P. §708.02(a).

The petition to make the application special is DISMISSED.

## REGULATION AND PRACTICE

A grantable petition to make special under 37 C.F.R. §1.102(d), M.P.E.P. §708.02(a) 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

1. the application must be a non-reissue utility or design application filed under 37 C.F.R. §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. at the time of filing, the application must be complete under 37 C.F.R. §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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner;

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation; and

5.3. encompass the disclosed features that may be claimed;

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 C.F.R. §1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with the particularity required by 37 C.F.R. §1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists; and

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The application is eligible for the accelerated examination program as set forth in section I above.

The petition meets conditions II.1 through II.5; II.6.1 through 6.4 and II.6.6 above. However, the petition does not meet conditions II.6.5 above.

Regarding condition set forth in II.6.5 above, the examination support document must point out where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. In the instant petition, the examination support document only refers to where support for claim 1, the only claim presented, is found in the specification but does not show where support of each limitation in the claims is found. Specifically, it is stated "[s]upport in the disclosure under 35 U.S.C § 112, first paragraph, is found at least at the paragraph beginning page 3, line 1, which corresponds to the claim, and in Figures 1-3." By stating that claim 1 is supported by the entire specification except for the sections discussing the "Field of the Invention" and "Description of the Related Art," and by referring to all the drawings, including Fig. 1 depicting the prior art, the petition fails to meet conditions II.6.5 above for special status.

It is noted that, in the preexamination search, the US field of search should have included class 330/255 and 263-265, and class 327/359 and 563 to more sufficiently cover the claimed invention. Also, the search logic should not have been too specific as to exclude discovery of relevant prior art that uses terminologies that are synonymous to the terminologies recited in claim 1.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a) is available) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to the undersigned at (571) 272-1606.

Hien H. Phan, Quality Assurance Specialist
Technology Center 2800 - Semiconductors,
Electrical & Optical Systems & Components

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/105,479 | 04/18/2008 | Bradford Lawrence HUNTER | BUR920080002US1 | 5793 |

48148 7590 07/08/2008
MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

| EXAMINER | |
|---|---|
| NGUYEN, KHANH V | |
| **ART UNIT** | **PAPER NUMBER** |
| 2817 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 07/08/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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072008

MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC
8321 OLD COURTHOUSE ROAD
SUITE 200
VIENNA, VA 22182-3817

In re Application of:
Bradford Lawrence Hunter
Serial No.: 12/105,479
Filed: April 18, 2008
Docket: BUR920080002US1
Title: COMMON MODE CONTROLLED DIFFERENTIAL GAIN BOOSTED CURRENT MIRRORS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. §1.102

This communication is a reply to the "Request for Reconsideration of Petition to Make Special" filed June 30, 2008, requesting reconsideration of the previous decision of May 30, 2008, dismissing the petition to make special under 37 C.F.R. §1.102(d) filed April 18, 2008.

The petition to make the application special is GRANTED.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to M.P.E.P. § 708.02(a) and to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the

examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 C.F.R. §1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 C.F.R. §1.97 and §1.98.
7. Post-Allowance Processing:

To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 C.F.R. §1.181, §1.182 or §1.183), the application will be treated special before and after such proceeding.

10. Final Disposition:
The twelve-month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to the undersigned at (571) 272-1606.

Hien H. Phan, Quality Assurance Specialist
Technology Center 2800 - Semiconductors,
Electrical & Optical Systems & Components

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**NFOCUS NEUROMEDICAL INC,**
**C/O LEVINE BAGADE HAN, LLP**
**2400 GENG ROAD, SUITE 120**
**PALO ALTO, CA 94303**

MAILED

JUN 22 2009

OFFICE OF PETITIONS

In re Application of :
**Leon V. RUDAKOV, et al.** :
Application No. 12/105,502 : DECISION ON PETITION TO
Filed: April 18, 2008 : WITHDRAW FROM RECORD
Attorney Docket No. **NFCSNZ00802** :

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 3, 2009.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to LEVINE BAGADE HAN LLP/NFOCUS NEUROMEDICAL INC has been revoked by the assignee of the patent application on April 2, 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: **ORRICK, HERRINGTON & SUTCLIFFE, LLP**
**IP PROSECUTION DEPARTMENT**
**4 PARK PLAZA, SUITE 1600**
**IRVINE, CA 92614-2558**

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**JOSEPH V. TASSONE, ESQ.**
**C/O: DAYCO PRODUCTS, LLC**
**1 PRESTIGE PLACE**
**MIAMISBURG OH 45342**

COPY MAILED

AUG 0 3 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Holt et al. | : | DECISION ON PETITION |
| Application No. 12/105,541 | : | TO WITHDRAW |
| Filed: April 18, 2008 | : | FROM RECORD |
| Attorney Docket No. 04-20 | : | |

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed June 26, 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 Petitions Examiner Joan Olszewski at (571) 272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

PTO/SB/130 (03-08)
Approved for use through 04/30/2008. 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 | 12105543 | Confirmation Number | 5923 | Filing Date | 2008-04-18 |
| Attorney Docket Number (optional) | 1564.007 | Art Unit | | Examiner | |
| First Named Inventor | CHARLES DAVID WINTILL | | | | |
| Title of Invention | DOUBLE PIN CONNECTOR AND HYDRAULIC CONNECT WITH SEAL ASSEMBLY | | | | |

**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 |
|---|---|---|---|
| WILLIAM | RYLE | DARNELL | |

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 | /WBUSKOP/ | Date (YYYY-MM-DD) | 2008-04-18 |
|---|---|---|---|
| Name | WENDY BUSKOP | Registration Number | 32202 |

PTO/SB/130 (03-08)
Approved for use through 04/30/2008. 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.

# UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of
Charles David Wintill

Application No. 12105543

Filed:

Attorney Docket No. 1564.007

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

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1) ,filed 18-APR-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.

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United States Patent and Trademark Office
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| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 12/105,564 | 04/18/08 | Klaus Kienzle | 4 0124/11202 (V 8077/KK) |

| EXAMINER |
|---|
| Bernarr E. Gregory |
| Art Unit 3662 |

DATE MAILED:

This is a communication from the examiner in charge of your application
COMMISSIONER OF PATENTS AND TRADEMARKS

The petition filed July 1, 2010 under 37 CFR §1.97(d)(2)(ii) for consideration of an information disclosure statement filed after allowance has been:

[ ] GRANTED.

[X ] DENIED.

The petition lacks:

[ ] The required fee under 37 CFR §§1.97(d)(2)(iii) and 1.17(i)(1).

[ X ] A proper certification as specified in 37 CFR §§1.97(d)(2)(i) and 1.97(e)

The information disclosure statement has been placed of record in the file but will not be considered by the examiner.

/Thomas H. Tarcza/

Thomas H. Tarcza
SPE Art Unit 3662
571-272-6979

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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**TRELLIS INTELLECTUAL PROPERTY LAW GROUP, PC**
**1900 EMBARCADERO ROAD, SUITE 109**
**PALO ALTO, CA 94303**

MAILED

MAY 04 2009

OFFICE OF PETITIONS

In re Application of :
Aloke GUHA, et al :
Application No. 12/105,598 : DECISION ON PETITION
Filed: April 18, 2008 : TO WITHDRAW
Attorney Docket No. 100150-000110US : FROM RECORD
:

This is a decision on the Request to Withdraw as attorney or agent under 37 C.F.R. § 1.36(b) filed February 11, 2009.

The request is **NOT APPROVED**.

A review of the file record indicates that Charles J. Kulas does not have power of attorney in this patent application. See 37 C.F.R. § 10.40. 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 below-listed address until otherwise properly notified by the applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-6735.

Diane Goodwyn
Petitions Examiner
Office of Petitions

cc: ALOKE GUHA, AUMNI DATA INC.
2175 TAMARACK DR.
LONG LAKE, MN 55356

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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General Motors Corporation
Legal Staff
Mail Code 482-C23-B21
P.O. Box 300
Detroit, MI 48265-3000

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Paul A. Bauerle | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7668687 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/23/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 12/105,601 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 04/18/2008 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **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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OFS FLTEL, LLC
(FORMERLY FURUKAWA ELECTRIC NORTH AMERICA, INC.)
2000 NORTHEAST EXPRESSWAY
NORCROSS, GA 30071

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APR 21 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Jeffrey Nicholson et al | : | |
| Application No. 12/105,652 | : | ON PETITION |
| Filed: April 18, 2008 | : | |
| Attorney Docket No. 313476US8 | : | |

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice To File Missing Parts of Nonprovisional Application (Notice) mailed June 6, 2008. The Notice set a period for reply of two (2) months from the mail date of the Notice. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on August 7, 2008.

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

This matter is being referred to the Office of Patent Application Processing.

Irvin Dingle
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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K&L GATES LLP
535 SMITHFIELD STREET
PITTSBURGH PA 15222

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JAN 05 2010

OFFICE OF PETITIONS

In re Application of :
Trayon Onett, III :
Application No. 12/105,661 :
Filed: April 18, 2008 :
Attorney Docket No. 080050 :

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b) filed November 6, 2009, which is being treated as a request to withdraw from employment in a proceeding before the Office under 37 C.F.R. § 10.40.

The request is **DISMISSED**.

A review of the file record indicates that K&L Gates LLP does not have power of attorney in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

The request to change the correspondence address of record is not accepted in view of K&L Gates LLP not having power of attorney. See MPEP §§ 601.03 and 405.

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.

Joan Olszewski
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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**DEAN P. ALDERUCCI**
**CANTOR FITZGERALD, L.P.**
**110 EAST 59TH STREET, 6TH FLOOR**
**NEW YORK, NY 10022**

**COPY MAILED**

MAY 0 1 2009

**OFFICE OF PETITIONS**

In re Application of :
**Stuart A. FRASER** :
Application No. 12/105,712 : DECISION ON PETITION TO MAKE
Filed: April 18, 2008 : SPECIAL UNDER 37 CFR 1.102(c)(1)
Attorney Docket No. **99-1008-1** :
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed April 21, 2009 to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

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

The instant petition includes the certification by registered attorney Glen Farbanish registration number 50561, attesting to the age of inventor Philip M. Ginsberg. Accordingly, the above-identified application has been accorded "special" status.

Inquiries concerning either the examination or status of the application should be directed to the Technology Center at 571-272-3600.

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

The application is being forwarded to the Technology Center Art Unit 3625 for action on the merits commensurate with this decision.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

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**CHOATE, HALL & STEWART LLP/WYETH LLC**
**PATENT GROUP**
**TWO INTERNATIONAL PLACE**
**BOSTON, MA 02110**

**MAILED**

FEB 22 2010

**OFFICE OF PETITIONS**

In re Application of :

**Jonathan L. GROSS**, et *al.* :
Application No. 12/105,804 :
Filed: April 18, 2008 :
Attorney Docket No. **2004658-1772 (AM102018 DI)** :

DECISION ON PETITION TO
WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed November 20, 2009.

The request is **NOT APPROVED**.

The request to withdraw as attorney/agent of record and change of correspondence address is hereby not accepted. Petitioner has not complied with current USPTO requirements, set forth in 37 CFR 10.40 concerning Request for Withdrawal as Attorney and Change of Correspondence Address.

Petitioner has not properly submitted a correspondence address change directing all future correspondence for the application.

The Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *who properly became of record under 37 CFR 3.71*, or if no assignee of the entire interest has properly been made of record, the most current address information provided for the first named inventor. 37 CFR 3.71 (c) states:

> ***An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73 (b) that is signed by a party who is authorized to act on behalf of the assignee.***

The Office will also no longer change the correspondence address to that of a new practitioner unless the Request is accompanied by a power of attorney to a new practitioner (e.g., Form PTO/SB/82). All future communications from the Office will be directed to the above-listed address until otherwise properly notified by the applicant or a proper change of correspondence address has been submitted.

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

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

/Monica A. Graves/
Petitions Examiner, Office of Petitions

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APR 13 2010

OFFICE OF PETITIONS

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

In re Application of :
Jobs et al. :
Application No. 12/105,863 : DECISION ON PETITION
Filed: April 18, 2008 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 18962-05001/P4564US1 :

This is a decision on the petition, filed January 22, 2010, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen-month publication country on March 27, 2009. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen-month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of July 15, 2010, accompanies this decision on petition.

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

This application is being referred to Technology Center Art Unit 3622 for examination on the merits.

Carl Friedman
Petitions Examiner
Office of Petitions

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/105,863 | 04/18/2008 | Steven Jobs | 18962-055001 / P4564US1 |

**CONFIRMATION NO. 6542**

26183
FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS, MN 55440-1022

**NONPUBLICATION RESCISSION LETTER**

Date Mailed: 04/09/2010

## Communication Regarding Rescission Of Nonpublication Request and/or Notice of Foreign Filing

Applicant's rescission of the previously-filed nonpublication request and/or notice of foreign filing is acknowledged. The paper has been reflected in the Patent and Trademark Office's (USPTO's) computer records so that the earliest possible projected publication date can be assigned.

The projected publication date is 07/15/2010.

If applicant rescinded the nonpublication request before or on the date of "foreign filing,"[1] then no notice of foreign filing is required.

If applicant foreign filed the application after filing the above application and before filing the rescission, and the rescission did not also include a notice of foreign filing, then a notice of foreign filing (not merely a rescission) is required to be filed within 45 days of the date of foreign filing. See 35 U.S.C. § 122(b)(2)(B)(iii), and Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(iv), 1272 Off. Gaz. Pat. Office 22 (July 1, 2003).

If a notice of foreign filing is required and is not filed within 45 days of the date of foreign filing, then the application becomes abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii). In this situation, applicant should either file a petition to revive or notify the Office that the application is abandoned. See 37 CFR 1.137(f). Any such petition to revive will be forwarded to the Office of Petitions for a decision. Note that the filing of the petition will not operate to stay any period of reply that may be running against the application.

Questions regarding petitions to revive should be directed to the Office of Petitions at (571) 272-3282.

[1] Note, for purpose of this notice, that "foreign filing" means "filing an application directed to the same invention in another country, or under a multilateral international agreement, that requires publication of applications 18 months after filing".

/atkelley/

---

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

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OFFICE OF PETITIONS

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

In re Application of Mugge et al. :
Application No. 12/105,902 :
Filing Date: April 18, 2008 :
Attorney Docket No. 03616.0368US01 :

Decision on Petition

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

The petition is **granted**.

The Office mailed a Notice of Missing Parts of Nonprovisional Application on May 8, 2008. The Notice set a period for reply of two (2) months from the mail date of the Notice. A reply was filed on May 29, 2008. A Notice of Incomplete Reply was mailed July 9, 2008. The Notice indicated the time period set forth in the May 8, 2008, continued to run. A second reply and payment for a one-month extension of time were filed July 24, 2008. A Notice of Incomplete Application was mailed August 5, 2008.

Petitioner did not file a new reply or make a request for an extension of time after the Office mailed the August 5, 2008 Notice. As a result, the application became abandoned on September 9, 2008. A Notice of Abandonment was mailed January 9, 2009.

The instant petition requests revival of the application.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:

(1) the reply required to the outstanding Office action or notice, unless previously filed,
(2) the petition fee,
(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
(4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

As to item (1), petitioner has submitted a new reply to the original Notice to File Missing Parts in the form of corrected drawings.

As to item (2), the petition requests the petition fee be charged to a credit card number listed in the petition. 37 CFR 1.23(b) states in part, with emphasis added, "Payment of a fee by credit card must specify the amount to be charged to the credit card *and such other information as is necessary to process the charge*, and is subject to collection of the fee." The petition does not provide the following items:

(A) A specific dollar amount to be charged,
(B) The expiration date of the credit card,
(C) The name appearing on the credit card, and
(D) The credit card billing address.

Since the petition fails to include the information necessary to process the credit card charge, the petition fee cannot be charged to petitioner's credit card.

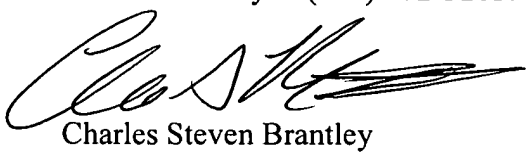
Although the petition fee cannot be charged to the credit card, one of the papers filed January 15, 2009, includes a general authorization to charge required fees to Deposit Account No. 13-2725. The Office has charged the $1,620 fee to the deposit account.

As to requirement (3), 37 CFR 1.137(b)(3) requires "a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) [was] unintentional." To the extent any statement of delay in the petition varies from this exact language, the statement will be construed as the equivalent of the statement above. If the entire delay from the date of abandonment until the date the petition was filed was not unintentional, petitioner must notify the Office.

As to requirement (4), a terminal disclaimer is not necessary since the application is a nonprovisional application filed after June 8, 1995.

The petition includes a credit card number. Petitioner may wish to file a petition to expunge under 37 CFR 1.59(b) in order to replace the original petition with a copy of the petition that has the credit card number redacted. Petitioner should note 37 CFR 1.23(b) states in part, "If credit card information is provided on a form or document other than a form provided by the Office for the payment of fees by credit card, the Office will not be liable if the credit card number becomes public knowledge."

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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K & L GATES LLP
HARMONHINDER BEDI
630 HANSEN WAY
PALO ALTO, CA 94304

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APR 22 2009

**OFFICE OF PETITIONS**

In re Application of :
Mateusz Bryning, et al. :
Application No. 12/105,927 : ON PETITION
Filed: April 18, 2008 :
Attorney Docket No. ZIKON-1 :

This is a decision in response to the petition, filed February 17, 2009, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Nonprovisional Application mailed June 9, 2008. It is noted that an executed declaration was submitted on April 23, 2008, without the $130 surcharge. A Notice of Abandonment was mailed on February 12, 2009. On February 17, 2009, the present petition was filed, along with replacement drawings. The $130.00 surcharge is being charged to counsel's deposit account as authorized.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) an executed declaration, surcharge and replacement drawings; (2) the petition fee of $810; and (3) an adequate statement of unintentional delay.

The application is being referred to the Office of Patent Application Processing (OPAP) for further processing.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to processing at OPAP should be directed to their hotline at (571) 272-4000.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/105,952 | 04/18/2008 | Andrew J.F. Bravery | GB920080026US1 | 6729 |

78571 7590 08/12/2008

Dillon & Yudell LLP
8911 N. Capital of Texas Hwy
Suite 2110
Austin, TX 78759

| EXAMINER | |
|---|---|
| BEAUSOLIEL JR, ROBERT W | |
| **ART UNIT** | **PAPER NUMBER** |
| 2113 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/12/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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DILLON & YUDELL LLP
8911 N. CAPITAL OF TEXAS HWY
SUITE 2110
AUSTIN TX 78759

| | |
|---|---|
| In re Application of: Bravery, et al.<br>Serial No.: 12/105,952<br>Filed: April 18, 2008<br>Docket: GB920080026US1<br>Title: DATA THROUGH COMMUNITY FEEDBACK | DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02 |

This is a decision on the petition filed on April 18, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees that the dependent claims will be grouped together with and not to separately argue the patentability of any independent claim from which they depend during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions I. 1-4 & II. 1-5, 5.1, & 6.1, 6.4 and 6.6 above are considered to have been met. However, the petition fails to comply with conditions II. 5.2 - 5.3, 6.2-6.3 & 6.5 above. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirement of MPEP § 708.02(a)(I.)(H)[1] and items 5.2 - 5.3 above, the pre-exam search must be directed to the (instant) claimed invention and encompass all of the disclosed features of the (instant) claims. The search logic does not seem to include the inventive concept or features included in the claim language and identified by Petitioner in the detailed explanation of patentability of the claims over the cited references. The search should consider individual features, combination of features as well as synonyms. The search should also cover the broadest scope encompassed by the claims. Based upon the claimed subject matter of the instant application, the following supplemental suggested search is presented:

Additional Class(es)/Subclass(es) should be searched:

714/45, 46; and additional text searches as below:

Use correct, correction, and correcting also in keywords search

(build$3 or construct$3) near5 (situation$2 near3 application)

display$3 near3 feedback near3 inputs

(detect$3 or sens$3) near3 (data adj item) near3 (error or problem)

(data adj item) with (error or problem) with (stor$4 or cache)

inputs with suggestion with improv$5

(automatic$5 or dynamic$5 or direct$2) near3 correct$3 near3 data

The additional search recommendations were confirmed with and recommended by a (primary) examiner in the pertinent art area.

With regard to the requirement of MPEP § 708.02(a)(I.)(I)(2) and item 6.2 above, "(2) For each reference cited, the accelerated examination support document must include an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference." In the instant case, the document fails to provide an identification of *all the limitations in the claims* that are disclosed by the cited references. The

[1] MPEP 8th ed. rev 5 August 2006

document provides an identification of the limitations of **only** Claim 1. No identification of the limitations of claims 2-6 is provided. Correction is required.

With regard to the requirement of MPEP § 708.02(a)(I.)(I)(3) and item 6.3 above, "((3)The accelerated examination support document must include a detailed explanation of how each of the claims are patentable over the references cited with the particularity required by 37 CFR 1.111(b) and (c)." In the instant case, the document fails to provide a detailed explanation of how *each of the claims* are patentable over the cited references. The document provides an explanation of how only claim 1 is patentable over the cited references. However, there is no explanation of patentability with respect to claims 2-6 in the instant petition. Correction is required.

With respect to the requirement of MPEP § 708.02(a)(I.)(I)(5) and item 6.5 above, Petitioner fails to identify where each limitation of the instant claims finds support under 35 USC 112, first paragraph, in the written description of the specification. Support for each limitation of each pending claim must be properly identified (by page, line or paragraph and/or figure). Specifically, reference is made to claims 2-6.

Clarification and identification of support for each limitation in the claims is required. Thus, the petition does not meet the conditions II. 5.2 - 5.3, 6.2-6.3 and 6.5 above.

## DECISION

For the above-stated reasons, the petition is **DISMISSED**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given ***a single opportunity*** to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a) is permitted) from the date of this decision in order to be considered timely. Any request for reconsideration ***must fully address all of the deficiencies indicated above***. [emphasis added]

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Brian Johnson, Quality Assurance Specialist, at (571) 272-3595. If attempts to reach the undersigned by telephone are unsuccessful, Kakali Chaki, Quality Assurance Specialist, can be reached at (571) 272-3719.

___For /Rehana Perveen/_____
Brian L. Johnson
Quality Assurance Specialist, WG 2110
Technology Center 2100

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/105,952 | 04/18/2008 | Andrew J.F. Bravery | GB920080026US1 | 6729 |

78571 7590 12/02/2008

Dillon & Yudell LLP
8911 N. Capital of Texas Hwy
Suite 2110
Austin, TX 78759

| EXAMINER | |
|---|---|
| BEAUSOLIEL JR, ROBERT W | |
| ART UNIT | PAPER NUMBER |
| 2113 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 12/02/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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12/01/2008

DILLON & YUDELL LLP
8911 N. CAPITAL OF TEXAS HWY
SUITE 2110
AUSTIN, TX 78759

In re Application of:
BRAVERY, et al.
Serial No.: 12/105,952
Filed: April 18, 2008
Docket: GB920080026US1
Title: DATA THROUGH COMMUNITY FEEDBACK

COMMUNICATION REGARDING ORDER OF EXAMINATION

A decision dismissing the petition to make the above-identified application special for accelerated examination was mailed on August 12, 2008 . The decision set a non-extendable time period of one month or 30 (thirty) days, whichever is longer, from its mailing date to correct the deficiency/deficiencies in the petition.

As of September 12, 2008, the expiry of the period set, neither a reply nor a renewed petition was received. Accordingly, the application is no longer eligible for the accelerated examination program.

The application will remain in its regular status and will be taken up by the examiner for action in its regular turn.

Petitioner is reminded that a single opportunity to perfect the petition is given. Therefore, further petitions for accelerated examination in this application will not be entertained.

Any inquiry regarding this decision should be directed to Brian Johnson, Quality Assurance Specialist, at (571) 272-3595. If attempts to reach the undersigned by telephone are unsuccessful, Kakali Chaki, Quality Assurance Specialist, can be reached at (571) 272-3719.

Brian L. Johnson
Quality Assurance Specialist, WG 2110
Technology Center 2100

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/105,977 | 04/18/2008 | Travis M. Grigsby | | 6789 |

78806 7590 06/02/2008

Wenderoth, Lind & Ponack, L.L.P
2033 K Street, NW
Suite 800
Washington, DC 20006

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2614 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 06/02/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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Wenderoth, Lind & Ponack, L.L.P
2033 K Street, NW
Suite 800
Washington DC 20006

In re Application of:
Travis M. GRIGSBY, et al.
Serial No.: 12/105,977
Filed: April 18, 2008

Title: **CONTEXT-BASED SYNCHRONIZATION FOR TERMINAL DEVICES**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 18, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview.

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner.

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the filed of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable interpretation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions set forth under section I. above are considered to have been met. However, the petition fails to comply with conditions set forth under section II. , items 5 through 5.3 and 6.5.

Regarding the requirement in item 5. through 5.3 above, the preexamination search document provided with the instant petition is deficient as follows: The US field of search and database searches which are to be provided under section 8(A) are not sufficient. In addition to the search areas provided, applicant would also need to search in the following class/subclasses: 381/ 91, 110, 111, 113; and 704/ 246, 248 and 275.

Please note that any request for reconsideration must include an Information Disclosure Statement citing any newly found relevant prior art and an updated Accelerated Examination Support Document (AESD) meeting all of requirements 6.1 – 6.6 for any documents uncovered by the new search(es) as required above.

Regarding the requirement in item 6.5 above, the Accelerated Examination Support Document is deficient in section 9(E) because applicant has only referred to steps of a flowchart shown in Figure 1 of the drawings. Item 6.5 requires a showing of *where* each limitation of the claims finds support in the *written description of the specification*.

For the reason cited above, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Krista Zele, Quality Assurance Specialist, at (571) 272-7288.

/Krista Zele/

Krista Zele
Quality Assurance Specialist
Technology Center 2600
Communications

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TECHNOLOGY CENTER 2600

Wenderoth, Lind & Ponack, L.L.P
2033 K Street, NW
Suite 800
Washington DC 20006

In re Application of:
GRIGSBY, TRAVIS M. et al,
Serial No.: 12/105,977
Filed: April 18, 2008

Title: **CONTEXT-BASED SYNCHRONIZATION FOR TERMINAL DEVICES**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on June 27, 2008 requesting reconsideration to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

All of the requirements to correct the deficiencies outlined in the petition decision mailed June 02, 2008 have been met.

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral

election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

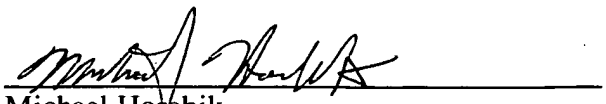
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Michael Horabik, Quality Assurance Specialist, at (571) 272-3068.



Michael Horabik
Quality Assurance Specialist
Technology Center 2600
Communications

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Alexandria, VA 22313-1450
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In re Application of
Paul J. Holenstein

Application No. 12106006

Filed: April 18,2008

Attorney Docket No. 9203-53US

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

This is a decision on the electronic petition under 37 CFR 1.102 (c)(1), filed 14-NOV-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 inquiries concerning this electronic decision should be directed to the Electronic Business Center at 866-217-9197.

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

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**LARSON NEWMAN & ABEL, LLP**
**5914 WEST COURTYARD DRIVE**
**SUITE 200**
**AUSTIN TX 78730**

MAILED

MAY 03 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Peter R. Menge et al | : | |
| Application No. 12/106,011 | : | DECISION GRANTING PETITION |
| Filed: April 18, 2008 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 1035-BI4970 | : | |

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 April 9, 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 2884 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment and IDS.

/Karen Creasy/
Karen Creasy
Petitions Examiner
Office of Petitions

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

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

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MAY 27 2009

OFFICE OF PETITIONS

In re Application of :
Terranova, et al. :
Application No. 12/106,044 : DECISION
Filed/Deposited: 18 April, 2008 :
Attorney Docket No. 325489US8X CONT :

This is a decision on the petition filed on 1 May, 2009, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting abandonment of and refund of the filing fees for the above-identified application.

The petition under 37 C.F.R. §1.181 is **DISMISSED**.

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

As to the Request to Abandon
And for Refund of Filing Fees

Petitioner is directed to the Commentary at MPEP §503, MPEP §607.02, and MPEP §711 for guidance as to the regulations at 37 C.F.R. §1.26, 37 C.F.R. §1.53, and 37 C.F.R. §1.138, the effects of which now seeks to review and so prays for relief pursuant to 37 C.F.R. §1.181.

Petitioner avers the filing of the instant application as a continuation, but now wishes to abandon the application and contemporaneously demands refund of the filing fee.

Petitioner appears not to have considered the guidance in the Commentary at MPEP §503, MPEP §607.02, and MPEP §711, as discussed below.

Thus Petitioner has failed to satisfy the requirements for relief pursuant to 37 C.F.R. §1.181.

## BACKGROUND

The record reflects as follows:

Petitioner avers that "during a status check in the parent application, no. 10/582,722 [the 722 application], Applicants' representative checked [Private] PAIR, where the Office Action dated October 18, 2007 was discovered." Petitioner avers that he:

- had not received and was unaware of the Office action;
- petitioned to restart the time period for reply therein; and
- "also filed on April 18, 2008, the instant continuation application (12/106,044) to ensure the pendency of a patent application for this invention."

Petitioner continues his explanation to state that because his petition in the '722 application was granted and "[a]pplicants no longer need to pursue continuation application 12/106,044 and request abandonment of the instant continuation application no 12/106,044 and a refund of all fees paid ... because of USPTO's incorrect abandonment of the parent application ...."

It is noted that Petitioner's relief for the instant request as to abandonment is under the provisions of 37 C.F.R. §1.138.

Similarly, it is noted that Petitioner's relief for the instant request as to refund is under the provisions of 37 C.F.R. §1.26.

However, it is noted that:

- the Office did not abandon the '722 application before Petitioner filed the instant application—the '722 application was pending at the time of the filing of the instant application;
- the Office in fact restarted the period of reply in the '722 application;
- a Notice of Abandonment was not mailed in the '722 application until on 14 July, 2008—and thereafter was withdrawn.

Clearly, then, the relief for Petitioner as to the possibility of abandonment of the '722 application was available to and in fact received by Petitioner in the '722 application, and Petitioner need not have filed the instant application.

As noted above, should Petitioner wish to abandon the instant application the regulations at 37 C.F.R. §1.138 provide the mechanism for express abandonment—Petitioner's failure to reply

timely to an Office action will yield abandonment pursuant to the regulations at 37 C.F.R. §1.135.

Petitioner's attentions also are drawn to the guidance in the Commentary at MPEP §503, which provides in pertinent part:

> ***
>
> Applications which are entitled to a filing date and are filed, whether by regular mail*>, by< "Express Mail" under 37 C.F.R. §1.10, by hand-delivery>, by the Office's Electronic Filing System (EFS),< or otherwise, will not be returned to applicant even if requested. See 37 C.F.R. §1.59. Accordingly, applicants must be careful not to file applications which are not intended to be filed, e.g., duplicates of applications already filed. Note that 37 C.F.R. §1.26(a) provides that a change of purpose after the payment of a fee, as when a party desires to withdraw the filing of a patent application for which the fee was paid, will not entitle the party to a refund of such fee. See MPEP § 607.02. (Emphasis supplied.)
>
> ***

However, should Petitioner wish to seek a refund of search and excess claim fees pursuant to the regulations at 37 C.F.R. §1.26, Petitioner's attentions are drawn to the guidance in the Commentary at MPEP §607.02 and MPEP §607.02(V).

As to the Request to Abandon
And for Refund of Filing Fees

Petitioner is directed to the Commentary at MPEP §503 for guidance as to the regulations at 37 C.F.R. §1.26, 37 C.F.R. §1.53, and 37 C.F.R. §1.138, the effects of which now seeks to review and so prays for relief pursuant to 37 C.F.R. §1.181.

The regulations at 37 C.F.R. §1.181 are not the proper route for relief, and Petitioner has not provided a showing for relief under the rule.

## CONCLUSION

Accordingly, The petition under 37 C.F.R. §1.181 is **dismissed**.

The instant application is released to the Office of Patent Application Processing for such processing as is necessary before release for substantive examination.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[1]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

/John J. Gillon, Jr./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[1] The regulations at 37 C.F.R. §1.2 provide:

**§1.2 Business to be transacted in writing.**

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/106,044 | 04/18/2008 | Sabine TERRANOVA | 325489US8X CONT | 6929 |

7590 06/12/2009
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

| EXAMINER |
|---|
| BARRON JR, GILBERTO |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2432 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 06/12/2009 | ELECTRONIC |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Nimi Farmer

Patent Publication Branch
Office of Data Management

Refund Ref:
06/11/2009 0030071078
---
Credit Card Refund Total: $370.00
Am Exp..: XXXXXXXXXXXX1002

Adjustment date: 06/11/2009 NFARMER
04/21/2008 INTEFSW 00003908 12106044
02 FC:1111 -510.00 OP
04 FC:1202 -550.00 OP

Refund Ref:
06/11/2009 0030071076
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Credit Card Refund Total: $1060.00
Am Exp..: XXXXXXXXXXXX1002

Adjustment date: 06/11/2009 NFARMER
07/22/2008 INTEFSW 00001490 12106044
01 FC:1203 -370.00 OP



FORM PET651G (Rev. 08/07)

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/106,045 | 04/18/2008 | Daniel Paul Kelaher | SJO920070115US1 | 6931 |

75922 7590 07/03/2008

PATENT ANALYSIS RESEARCH TECHNOLOGY SYSTEMS LLC
DBA, PARTS LLC
927 S. WALTER REED DRIVE
SUITE 24
ARLINGTON, VA 22204-2311

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2833 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 07/03/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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PATENT ANALYSIS RESEARCH TECHNOLOGY SYSTEMS LLC
DBA, PARTS LLC
927 S. Walter Reed Drive, Suite 24
Arlington, VA 22204-2311

| | | |
|---|---|---|
| In re Application of: | : | |
| Kelaher et al. | : | DECISION ON PETITION TO |
| Serial No.: 12/106,045 | : | MAKE SPECIAL FOR NEW |
| Filed: April 18, 2008 | : | APPLICATION UNDER 37 |
| Attorney Docket No.: SJO920070115US1 | : | C.F.R. § 1.102 & M.P.E.P. § 708.2 |
| Title: PANEL-MOUNT USB LOCKING LATCH | : | |

This is a decision on the petition filed on April 18, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:
1. be filed with the application;
2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner; and

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation; and

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists; and

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The conditions set forth in section I, subsections 1-4, are considered to have been met. Additionally, the conditions set forth in section II, subsections 1-5, are considered to have been met. However, the petition fails to comply with the all the conditions set forth in section II, subsection 6, specifically subsections 6.1, 6.2, 6.3 and 6.5. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirements of section II, subsection 6.1, while the references deemed most closely related to the claimed subject matter have been listed in the support document, there is no IDS in compliance with 37 CFR 1.98. Applicant must provide an IDS in compliance with 37 CFR 1.98.

Regarding the requirements of section II, subsection 6.2, the support document must identify all the limitations in the claims that are disclosed by the reference(s) specifying where the limitation is disclosed in the cited reference. Applicant should not group a large amount of claim limitations and then indicate that the reference does not teach the group of limitations. The support document must be specific as to what claim limitations are in the reference and where the claim limitations are disclosed in the reference. For example, the support document states that US Patent 6,139,350 teaches upper and lower spring-like latching members, but does not provide reference numbers and a specific line and column where these elements are found in the reference. Merely stating, see the "Abstract", Figs. 1-4 and the entire patent, is not specific enough to meet the requirements of section II, subsection 6.2.

Regarding the requirements of section II, subsection 6.3, a grantable petition requires a detailed description of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c). 37 CFR § 1.111 (b) states "[a] general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." 37 CFR § 1.111 (c) states in part "the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited." The support document states, "Some or all of the features in the table below are not taught by the above references, alone or in combination.", and then provides a table listing the entire claim 1. This amounts to a general allegation of patentability. Each reference should be discussed (in section II, subsection 6.2) indicating what it does disclose and then a detailed description (e.g., particular limitations of claim 1) of how each of the claims are patentable over the references cited with the particularity required by 37 CFR 1.111(b) and (c).

Regarding the requirements of section II, subsection 6.5, the support document does not specifically show where ***each limitation*** (italics added) of the claims finds support under 35 USC 112, first paragraph in the written description of the specification. The support document simply groups a large amount of claim limitations together and then refers a large portion of the disclosure (i.e., See the "Abstract", at least pages 2-3 and 6-13 of the specification and figures

1a-10). The showing of support under 35 USC 112, first paragraph, should provide reference numbers for each claimed element and an indication (e.g., page and line numbers) where in the written description of the specification support for the claimed element can be found.

DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petition is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiries regarding this decision should be directed to the Quality Assurance Specialist Clayton E. LaBalle at (571) 272-1594.

Clayton E. LaBalle, Quality Assurance Specialist
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/106,045 | 04/18/2008 | Daniel Paul Kelaher | SJO920070115US1 | 6931 |

75922 7590 08/15/2008

PATENT ANALYSIS RESEARCH TECHNOLOGY SYSTEMS LLC
DBA, PARTS LLC
927 S. WALTER REED DRIVE
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| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2833 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/15/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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DBA, PARTS LLC
927 S. Walter Reed Drive, Suite 24
Arlington, VA 22204-2311

In re Application of:
KELAHER *et al.*
Serial No.: 12/106,045
Filed: April 18, 2008
Title: **PANEL-MOUNT USB LOCKING LATCH**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 CFR 1.102

This decision is a reply to the communication filed July 23, 2008. The communication is being treated as a petition requesting reconsideration of the previous decision of July 07, 2008, dismissing the petition to make special under 37 C.F.R. §1.102(d) filed April 18, 2008.

The petition to make the application special is GRANTED.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 C.F.R. §1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 C.F.R. §1.97 and §1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 C.F.R. §1.181, §1.182 or §1.183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve-month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to the undersigned at (571) 272-1594.

Clayton E. LaBalle, T-QAS
Technology Center 2800 - Semiconductors,
Electrical & Optical Systems & Components

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**DEAN P. ALDERUCCI**
**CANTOR FITZGERALD, L.P.**
**110 EAST 59TH STREET (6TH FLOOR)**
**NEW YORK NY 10022**

**COPY MAILED**

AUG 3 1 2009

**OFFICE OF PETITIONS**

In re Application of :
**GINSBERG,** Philip M. et al. :
Application No. 12/106,147 : DECISION ON PETITION
Filed: April 18, 2008 : TO MAKE SPECIAL UNDER
Attorney Docket No. **00-1020-1** : 37 CFR 1.102(c)(1)
:

This is a decision on the petition under 37 CFR 1.102(c)(1), filed April 21, 2009, 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 attesting that Philip Myron Ginsberg is over 65 years of age. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to Michelle R. Eason at 571-272-4231.

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 3714 for action on the merits commensurate with this decision.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

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Alexandria, VA 22313-1450
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**Paul, Hastings, Janofsky & Walker**
**875 15th Street, NW**
**Washington, DC 20005**

**COPY MAILED**

APR 0 8 2009

**OFFICE OF PETITIONS**

In re Application of :
Ezhilkani Subbian et al. :
Application No. 12/106,173 : DECISION ON PETITION
Filed: April 18, 2008 : TO WITHDRAW
Attorney Docket No. 74495.00601.UTL1 : 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 25, 2009.

The request is **APPROVED**.

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

The request was signed by Martin R. Bader on behalf of attorney/agents associated with customer number 36183. All attorneys/agents associated with customer number 36183.

Applicant is reminded that there is no attorney of record at this time.

The correspondence address has been changed. All future correspondence will be mailed to the address of the assignee.

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

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Gevo, Inc.
345 Iverness Drive, South
Building C, Suite 310
Centennial, CO 80112

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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 12/106,173 | 04/18/2008 | Ezhilkani Subbian | 74495.00601.UTL1 |

**CONFIRMATION NO. 7195**

**POWER OF ATTORNEY NOTICE**

36183
PAUL, HASTINGS, JANOFSKY & WALKER LLP
875 15th Street, NW
Washington, DC 20005

Date Mailed: 04/08/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 03/25/2009.

- 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.

/kainabinet/

---

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

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/106,191 | 04/18/2008 | Ben Bakowski | GB920080114US1 | 7238 |

78754 7590 10/28/2008

IBM-ACC-Washington
c/o Myers Dawes Andras & Sherman, LLP
19900 MacArthur Blvd.
11th Floor
Irvine, CA 92612

| EXAMINER | |
|---|---|
| BADERMAN, SCOTT T | |
| ART UNIT | PAPER NUMBER |
| 2114 | |
| MAIL DATE | DELIVERY MODE |
| 10/28/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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IBM-ACC-WASHINGTON
C/O MYERS DAWES ANDRAS & SHERMAN, LLP
19900 MACARTHUR BLVD. 11TH FLOOR
IRVINE, CA 92612

In re Application of:
Ben Bakowski
Serial No.: 12/106191
Filed: April 18, 2008
Docket: GB920080114US1

Title: METHOD AND SYSTEM FOR TEST RUN PRIORITIZATION FOR SOFTWARE CODE TESTING IN AUTOMATED TEST EXECUTION

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 18, 2008 to make the above-identified application special for accelerated examination procedure 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;
5. The petition must be filed with the application.

The application as filed is not eligible for the accelerated examination under 37 C.F.R. § 1.102(d) because it is a utility application filed under 37 CFR 1.111(a) and was not complete. The Notice to File Corrected Application papers mailed on April 23, 2008 is evidence that the application was not complete and in condition for examination at the time of filing.

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 the undersigned at (571) 272-3719. If attempts to reach the undersigned are unsuccessful, Mano Padmanabhan., Quality Assurance Specialist can be reached at (571) 272-4210.

/Kakali Chaki/

Kakali Chaki, Quality Assurance Specialist

Technology Center 2100

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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

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DEC 15 2008

In re Application of :
Jennifer Barbour :
Application No. 12/106,201 : DECISION ACCORDING STATUS
Filed: April 18, 2008 : UNDER 37 CFR 1.47(b)
Attorney Docket No. MEDCI.037A :

This is a decision on the petition filed under 37 CFR 1.47(b) on December 4, 2008.

The petition is **GRANTED**,

The above-identified application was filed on April 18, 2008. The application named Jennifer Barbour as the sole inventor but was filed without an executed oath or declaration. A Notice to File Missing Parts was mailed May 7, 2008 requiring an executed oath or declaration and a surcharge for the late filing of the oath or declaration.

In response to the Notice to File Missing Parts, the instant petition under 37 CFR 1.47(b) was filed with a five month extension of time and argues that the inventor refuses to execute the oath or declaration and by her actions to cooperate with the filing of the instant application.

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a statement of the last known address of the non-signing inventor;

(5) proof of proprietary interest, and
(6) proof of irreparable damage.

The petition is accompanied by proof that the application materials have been presented to the non-signing sole inventor, and that she has not returned an executed oath or declaration. The petition is also accompanied by the petition fee, the last known address for the non-signing inventor and a declaration executed by Richard D. Peterson, Executive V.P., CFO, Treasurer of Medicis Pharmaceutical Corporation, Inc., the assignee by assignment from Jennifer Barbour, on behalf of Medicis Pharmaceutical Corporation, Inc. and in the absence of a signature by the sole inventor, a copy of the CONFIDENTIALITY AND BUSINESS INTEGRITY AGREEMENT previously executed by the sole inventor to show proprietary interest and a statement that the application is filed to preserve the applicants rights in the application and to prevent irreparable harm. Finally, applicant has submitted a signed statement under 37 CFR 3.73(b).

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(b). In view thereof, this application is hereby accorded Rule 1.47(b) status.

Thus, as provided in Rule 1.47c, this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

This matter is being referred to the Office of Patent Application Processing for further pre-examination processing.

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/106,207 | 04/18/2008 | Ben Bakowski | GB920080113US1 | 7277 |

78754 7590 10/28/2008

IBM-ACC-Washington
c/o Myers Dawes Andras & Sherman, LLP
19900 MacArthur Blvd.
11th Floor
Irvine, CA 92612

| EXAMINER | |
|---|---|
| BADERMAN, SCOTT T | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2114 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 10/28/2008 | PAPER |

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IBM-ACC-Washington
c/o Myers Dawes Andras & Sherman, LLP
19900 MacArthur Blvd.
11th Floor
Irvine CA 92612

In re Application of:
Ben Bakowski
Serial No.: 12/106207
Filed: April 18, 2008
Docket: GB920080113US1

Title: METHOD AND SYSTEM FOR TEST FAILURE ANALYSIS PRIORITIZATION FOR SOFTWARE CODE TESTING IN AUTOMATED TEST EXECUTION

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 18, 2008 to make the above-identified application special for accelerated examination procedure 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;
5. The petition must be filed with the application.

The application as filed is not eligible for the accelerated examination under 37 C.F.R. § 1.102(d) because it is a utility application filed under 37 CFR 1.111(a) and was not complete. The Notice of File missing parts of nonprovisional Application mailed on April 24, 2008 is evidence that the application was not complete and in condition for examination at the time of filing.

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 the undersigned at (571) 272-3719. If attempts to reach the undersigned are unsuccessful, Mano Padmanabhan., Quality Assurance Specialist can be reached at (571)272-4210.

/Kakali Chaki/

Kakali Chaki, Quality Assurance Specialist

Technology Center 2100

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/106,216 | 04/18/2008 | Michael S. DeFranks | SMCY-135-101 | 7307 |

28120 7590 05/02/2008

ROPES & GRAY LLP
PATENT DOCKETING 39/41
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 3673 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/02/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

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Ropes & Gray LLP
Patent Docketing 39/41
One International Place
Boston, MA 02110-2624

In re application of
Michael S. DeFranks et al.
Application No. 12/106,216
Filed: April 18, 2008
For: MICROALLOYED SPRING

DECISION ON PETITION
TO MAKE SPECIAL FOR
NEW APPLICATION
UNDER 37 CFR 1.102

This is a decision on the petition filed on April 18, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DENIED.**

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner;

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document.

An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-

function claim element that invokes consideration under 35 UDC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The petition fails to comply with conditions I.3, above.

Because the application was filed with drawings not electronically reproducible, the application is considered to be not in condition for examination as evidenced by the Notice to File Corrected Application Papers dated April 24, 2008.

Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure. Given the above failure of filing a complete application the petition has not been further reviewed on the merits.

## DECISION

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. Further petitions for accelerated examination in this application will not be entertained.

Any inquiry regarding this decision should be directed to Teri P. Luu, Quality Assurance Specialist, at (571) 272-7045.

Teri P. Luu
Quality Assurance Specialist
Technology Center 3600

TL/tl: 04/30/08

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/106,216 | 04/18/2008 | Michael S. DeFranks | SMCY-135-101 | 7307 |

28120 7590 07/15/2008

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| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 3683 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 07/15/2008 | PAPER |

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JUL 15 2008

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Ropes & Gray LLP
Patent Docketing 39/41
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In re application of
Michael S. DeFranks et al.
Application No. 12/106,216
Filed: April 18, 2008
For: MICROALLOYED SPRING

DECISION ON PETITION
TO MAKE SPECIAL FOR
NEW APPLICATION
UNDER 37 CFR 1.102

This is a decision on the renewed petition filed on May 28, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISED.**

REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner;

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation;

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document.

An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 UDC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-

function claim element that invokes consideration under 35 UDC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists;

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

## REVIEW OF FACTS

The petition fails to comply with conditions II.5.2 and II.6.1 above.

As to condition II.5.2, the petition lacks an indication of a preexamination search that encompasses all of the features of the claims. Specifically, applicant has listed six (6) classes that were searched. This would indicate that every patent in every subclass of each of the six classes had been reviewed. It is doubtful that such is the case. If that is the case, a statement on the record stating such should be made. If not, the specific subclasses that applicant reviewed needs to be listed, since the specifics of the required classification search needs to be supplied. With respect to the classification search, in addition to any areas already searched, the search needs to include at least a search of 148/580; 5/248, 256, 716, 720, 655.8 and 655.7; as well as 267/166-180, 288-291 and 91.

As to condition II.6.1, the IDS submitted cites four (4) U.S. references. Only two references are directed to a spring, one to a coil spring in an innerspring assembly in a cushioning article and the other to a spring of an automotive engine. Given the scope of the claimed subject matter, the finding of only a single reference of a coil spring in an innerspring assembly or even two references disclosing a coil spring is an indication that the evaluation of the search results fails to be directed to, and encompass all of the features of, the claims, giving the claims **the broadest reasonable interpretation**, as required. It appears that the search may have been completed on the concept of the disclosed invention rather than the "claimed invention " as is required.

In order to provide an adequate search applicant is required to submit an accelerated examination support document (AESD) that includes an IDS in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims (whether in independent or dependent form). Specifically:

**(1)** Applicant **is not** required to cite the references that are only relevant to the general subject matter of the claims because there are references that are more closely related to the subject matter of the claims. Applicant is also not required to cite a reference that is cumulative to any other reference cited in the IDS.

**(2)** Applicant **is** required to cite any reference that establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim (see 37 CFR 1.56(b)) in the IDS of the AESD.

**(3)** Applicant **is** required to cite the reference that discloses the most limitations in the independent claim.

**(4)** Applicant **is** required to cite any reference that discloses a limitation of an independent claim that is not shown in the other references.

**(5)** Applicant **is** required to cite any reference that discloses a limitation of a dependent claim that is not shown in the other references.

Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure. Given the above failure of filing a complete application the petition has not been further reviewed on the merits.

DECISION

For the above-stated reasons, the petition is **DISMISSED**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, (no extension of time under 37 CFR 1.136(a)) from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petitioner is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiry regarding this decision should be directed to Teri P. Luu, Quality Assurance Specialist, at (571) 272-7045.

Teri P. Luu
Quality Assurance Specialist
Technology Center 3600

TL/tl: 07/11/08

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/106,216 | 04/18/2008 | Michael S. DeFranks | SMCY-135-101 | 7307 |

28120 7590 01/07/2009

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| EXAMINER | |
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| ART UNIT | PAPER NUMBER |
| 3657 | |

| MAIL DATE | DELIVERY MODE |
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| 01/07/2009 | PAPER |

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JAN 06 2009

Ropes & Gray LLP
Patent Docketing 39/41
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Boston, MA 02110-2624

| | | |
|---|---|---|
| In re application of<br>Michael S. DeFranks et al.<br>Application No. 12/106,216<br>Filed: April 18, 2008<br>For: MICROALLOYED SPRING | : | DECISION ON PETITION<br>TO MAKE SPECIAL FOR<br>NEW APPLICATION<br>UNDER 37 CFR 1.102 |

This is a decision on the renewed petition filed on August 7, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d). The delay in answering this petition is regretted.

The petition to make the application special is **DENIED.**

A petition to make special was filed in the above-identified application under 37 CFR 1.102(d) on April 18, 2008. That petition was dismissed in a decision mailed July 15, 2008

The reason for the dismissal was an inadequate search and an inadequate Support Document. Specifically, with respect to the search, the petition lacked an indication of a preexamination search that encompasses all of the features of the claims. The AE search included a search of six classes, without the indication of which subclasses under each class was searched. In the decision mailed July 15, 2008, it was requested that applicant clarify if every patent in every subclass under each of the classes identified were searched and reviewed.

In the renewed petition, applicant has indicated that "all subclasses under this class have been searched using search strings" identified on certain pages of the AE search document. However, this is insufficient to satisfy the requirement that a U.S. classification search be performed and be directed to the claimed invention, given the claims their broadest reasonable interpretation. The classification search outlined in search strings 1-12 of the AE search document is in combination with a text search.

A "Guidelines for Applicants under the New Accelerated Examination Procedure" is provided on the USPTO internet website. Under Part I, item 8, the guidelines set forth:

> A search submitted in support of a petition for accelerated examination will be considered sufficient, absent any specific PTO identified deficiencies that require further search by the applicant, if the search includes:
>
> 1. A classified search of the US patents and published patent applications in the Class and subclass where the claimed invention is most likely to be classified in the current United States Patent Classification system (USPC). Consultation with the USPTO search notes for classification should be made to determine if any other highly relevant Classes should also be considered and thereafter, a further search be performed in those other Classes as appropriate. Where the PTO review considers that another or different classification is preferred or required, the search by the applicant will usually be considered acceptable unless the performed classified search is so divergent that it also calls other aspects of the pre-examination search into question; e.g. a text search that is limited to the same erroneous classification(s). In instances of differing views on the appropriate classified search area, the submitted search will be accepted and the examiner will perform the PTO preferred search during the examination process.
>
> 2. A text search of the US patents and published patent applications that covers the subject matter of the independent claims using terms recognized in the art given their broadest reasonable interpretation. The search should consider individual features by themselves and combinations of features. The search should cover the broadest scope encompassed by the claims as well as claims of narrow and intermediate breadth.

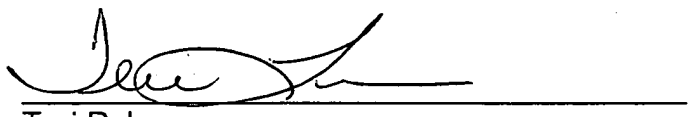
A classified search of the US patents and published applications is to be performed separate from the text search. Although a text search in combination with a classified search is not precluded, the classification search must at least be performed independently of any text search.

Since the preexamination search did not include a classified search independently performed from a text search, applicants have not satisfied all the conditions to accord this application Special status under the Accelerated Examination program.

For the above stated reason, the petition is denied. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is reminded that a single opportunity to perfect the petition is given. Therefore, further petitions for accelerated examination in this application will not be entertained.

Any inquiry regarding this decision should be directed to Quality Assurance Specialist Teri P. Luu at (571) 272-7045.



Teri P. Luu
Quality Assurance Specialist
Technology Center 3600

TL: 1/6/09

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/106,222 | 04/18/2008 | Sudhakar K. Rao | 070602-0822 | 7320 |

31824 7590 05/27/2008

MCDERMOTT WILL & EMERY LLP
18191 VON KARMAN AVE.
SUITE 500
IRVINE, CA 92612-7108

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2821 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 05/27/2008 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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| | | |
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| In re Application of:<br>Sudhakar K. RAO et al.<br>Serial No.: 12/106,222<br>Filed: April 18, 2008<br>Attorney Docket No.:070602- 0822 | : | DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.2 |

This is a decision on the petition filed on April 18, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **DISMISSED**.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:
1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner; and

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation; and

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists; and

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

REVIEW OF FACTS

The conditions regarding the application (section I, subsections 1-4) discussed above are considered to have been met. Additionally, the conditions regarding the petition (section II, subsections 1-4) are considered to have been met. However, the petition fails to comply with the all the conditions set forth in section II, subsections 5 and 6. Therefore, the petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

Regarding the requirements of section II, subsection 5.1 above, it appears the search outlined in the petition omitted critical search areas by not searching in class 343, subclasses 703 and 786 at a minimum to include measuring signal strength and wave guide with horn. Any renewed petition should include the above outlined additional searching.

Regarding the requirements of section II, subsection 6, the support document supplied by petitioner does not satisfy the requirements set forth in subsections 6.2, 6.3 and 6.5. The support document is required to discuss each reference cited on the IDS (i.e., references deemed most closely related to the subject matter of the claims – subsection 6.1), including an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference (subsection 6.2). The statement that the reference is not seen to teach or suggest the specific features and aspects recited in claims 1-20 is insufficient. Specifically, the petition does not identify, for example, the limitation found in the Klein reference of absorbing the polarization component of the radiation or the limitation found in the Eom et al reference of blocking unwanted electromagnetic radiation. A grantable petition requires an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference.

Regarding the requirements of section II, subsection 6.3 outlined above, the petition requires a detailed description of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c). 37 CFR § 1.111 (b) states "[a] general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." 37 CFR § 1.111 (c) states in part "the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited." The IDS submitted with the petition lists 3 U.S. patents, 1 U.S. pre-grant patent publication and 2 foreign patent documents. The support document, however, discusses only four of the references, Podgorski ('495 and '032), Anderson and Eigler. Each reference should be discussed indicating what it does disclose and then a detailed description of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c).

Regarding the requirements of section II, subsection 6.5 outlined above, the support document supplied by the petitioner does not specifically show where ***each limitation*** (italics added) of the claims finds support under 35 USC 112, first paragraph in the written description of the

specification. The support document simply states support in the disclosure under 35 USC 112, first paragraph, is found at least in Figures 1-5, 8-12 and 18 of the application and pages 8-23 of the application. It does not specifically mention any claim limitation and specifically where support for each claim imitation can be found.

DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petition is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

Any inquiries regarding this decision should be directed to Quality Assurance Specialist Jose' G. Dees at (571) 272-1569.

Jose' G. Dees, Quality Assurance Specialist
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/106,222 | 04/18/2008 | Sudhakar K. Rao | 070602-0822 | 7320 |

31824 7590 09/11/2008
MCDERMOTT WILL & EMERY LLP
18191 VON KARMAN AVE.
SUITE 500
IRVINE, CA 92612-7108

| EXAMINER | |
|---|---|
| ART UNIT | PAPER NUMBER |
| 2821 | |

| MAIL DATE | DELIVERY MODE |
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| 09/11/2008 | PAPER |

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18191 VON KARMAN AVE.
SUITE 500
IRVINE, CA 92612-7108

In re Application of:
Sudhakar Rao et al.
Serial No.: 12/106,222
Filed: April 18, 2008
Attorney Docket No.: 070602-0822
Title: GENERIC PICK-UP HORN FOR HIGH POWER THERMAL VACUUM TESTING OF SATELLITE PAYLOADS AT MULTIPLE FREQUENCY BANDS AND AT MULTIPLE POLARIZATIONS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the renewed petition filed on June 24, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The renewed petition to make the application special is **DENIED**.

A petition to make special was filed in the above-identified application under 37 C.F.R. § 1.102(d) on April 18, 2008. The petition was dismissed in a decision dated May 27, 2008 wherein a non-extendible period of 1 (one) month or 30 (thirty) days, whichever was longer, was set to request reconsideration. The renewed petition was timely filed.

The reasons for dismissal were: 1) an inadequate search (condition II. 5.1); 2) a failure to identify all the limitations in the claims that are disclosed by the references (condition II. 6.2); 3) a failure to describe how each of the claims are patentable over the cited references with the particularity required by 37 CFR 1.111(b) and (c) (condition II. 6.3); and 4) a failure to show where each claim limitation finds support under 35 USC 112, first paragraph, in the written description of the specification (condition II. 6.5).

The search is now adequate. However, although an improvement over the previous examination support document filed on April 18, 2008, the new support document filed on June 24, 2008 fails to correct the deficiencies of the previous examination support document.

As mentioned in the petition decision of May 27, 2008, item 6.2 of the Conditions Regarding the Petition requires "an identification of ***all the limitations in the claims*** that are disclosed by the reference specifying where the limitation is disclosed in the cited reference.". The latest examination support document does not identify ***claim limitations*** and indicate where the claim limitations are disclosed in each of the cited references. For example, Eom (US Pub. No. 2003/0080914) is cited with respect to claim 1 as appearing to disclose "an antenna with an electromagnetic condensing element (Figure 1, elements 1 and 3; and discussion in paragraphs [0012] through [0014]) that is used for blocking of unwanted electromagnetic radiation." However, claim 1 is directed to "a generic pick-up horn for absorbing radiation emitted by a transmit antenna" and not to "an antenna with an electromagnetic condensing element that is used for blocking of unwanted electromagnetic radiation." Indeed, it is not clear what relevance, if any, an antenna with an electromagnetic condensing element has to a pick-up horn for absorbing radiation emitted by a transmit antenna. Furthermore, claim 1 recites several claim elements, e.g., "at least one outer metal wall forming a metal body," and it is not clear from the examination support document that Eom discloses any of the claimed elements. Consequently, it is not clear that the reference to Eom has any relevance to the claimed invention.

As mentioned in the petition decision of May 27, 2008, item 6.3 of the Conditions Regarding the Petition requires a detailed explanation of how each of the claims are patentable over the references cited with the particularity required by 37 C.F.R. §1.111(b) and (c). Petitioner was advised that, as set forth in §1.111(b), "[a] general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." The latest examination support document does not describe how each of the claims are patentable over the cited references with the particularity required by 37 CFR 1.111(b) and (c). For example, the examination support document indicates with respect to independent claim 18 that "Podgorski '495 and '032 are not seen to teach or suggest a method of testing one or more payload antenna feeds, the method comprising: configuring one or more pick-up horns in proximity to one or more antenna feeds of a spacecraft payload; positioning each of the one or more pick-up horns to receive radiated power from respective one or more antenna feeds, wherein physical contact between each of the one or more pick-up horns and the one or more antenna feeds is avoided; placing the payload and the one or more pick-up horns in a vacuum; causing the one or more antenna feeds of the payload to produce radiated RF power; receiving the radiated RF power with the one or more pick-up horns; monitoring the temperature of the one or more pick-up horns; and controlling RF drive signals to the one or more antenna feeds to reduce the radiated power in the event the temperature of the one or more pick- up horns exceeds a specified value." However, such explanation encompasses the entirety of claim 18 and so comprises a general allegation that the references to Podgorski do not teach or suggest the method recited in independent claim 18. It is not clear what particular feature recited in the claim serves to patentably distinguish over the references to Podgorski.

As also mentioned in the petition decision of June 27, 2008, item 6.5 of Conditions Regarding the Petition requires "a showing of where each claim limitation finds support under 35 USC 112, first paragraph, in the written description of the specification." While the examination support

document provides a showing for the current application, as set forth in item 6.5 on page 2 of the decision, "if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists." The current application claims the benefit of several applications under title 35, United States Code, as noted on page 84 of the examination support document,[1] but the examination support document fails to provide a showing of support in any of the several applications.

For the above stated reasons, the renewed petition is denied. The application will therefore be taken up the examiner for action in its regular turn.

Petitioner is reminded that a single opportunity to perfect the petition is given. Therefore, further petitions for accelerated examination in this application will not be entertained.

Any inquiry regarding this decision should be directed to the undersigned at (571) 272-1569.

Jose G. Dees, Quality Assurance Specialist
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

JD/JC

[1] The examination support document fails to include US Application Serial No. 12/061,622 filed on 02 April 2008.

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| 12/106,222 | 04/18/2008 | Sudhakar K. Rao | 070602-0822 | 7320 |

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| In re Application of:<br>Sudhakar K. RAO et al.<br>Serial No.: 12/106,222<br>Filed: April 18, 2008<br>Attorney Docket No.:070602- 0822 | :<br>:<br>:<br>:<br>:<br>: | DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.2 |

This is a correction of the decision on petition mailed September 11, 2008. The decision on the renewed petition filed on June 24, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. § 1.102(d) should not have been denied. The decision on petition mailed September 11, 2008 denying the renewed petition to make the application special is vacated.

The renewed petition filed on June 24, 2008 to make the application special is **DISMISSED**.

A petition to make special was filed in the above-identified application under 37 C.F.R. § 1.102(d) on April 18, 2008. The petition was dismissed in a decision dated May 27, 2008 wherein a non-extendible period of 1 (one) month or 30 (thirty) days, whichever was longer, was set to request reconsideration. The renewed petition was timely filed.

This second dismissal is required because the previous dismissal letter failed to point out that the petition did not comply with the conditions set forth in section II, subsection 6.5. The current application claims the benefit of several applications under title 35, United States Code, as noted on page 11 of the examination support document filed April 18, 2008, but the examination support document fails to provide a showing of support in any of the several applications.

## REGULATION AND PRACTICE

A grantable petition to make special 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), must satisfy the following conditions:

I. Conditions Regarding the Application:

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. at the time of filing, the application 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.

II. Conditions Regarding the Petition:

The petition must:

1. be filed with the application;

2. include a statement that applicant agrees not to separately argue the patentability of any independent claim during any appeal in the application;

3. include a statement that applicant agrees to make an election without traverse in a telephone interview;

4. include a statement that applicant agrees to conduct such an interview when requested by the examiner; and

5. include a statement, made based on a good faith belief, that a preexamination search in compliance with the following requirements, was conducted, including an identification of the field of search by United States class and subclass, where applicable, and for database searches, the search logic or chemical structure or sequence used as a query, the name of the file(s) searched and the database service, and the date of the search.

The preexamination search must:

5.1 involve U.S. patents and patent application publications, foreign patent documents, and non-patent literature, unless the applicant can justify with reasonable certainty that no references more pertinent than those already identified are likely to be found in the eliminated sources and includes such a justification with this statement;

5.2. be directed to the claimed invention and encompass all of the features of the claims, giving the claims the broadest reasonable expectation; and

5.3. encompass the disclosed features that may be claimed.

6. must provide in support of the petition an accelerated examination support document. An accelerated examination support document must include:

6.1. an information disclosure statement (IDS) in compliance with 37 CFR 1.98 citing each reference deemed most closely related to the subject matter of each of the claims;

6.2. an identification of all the limitations in the claims that are disclosed by the reference specifying where the limitation is disclosed in the cited reference;

6.3. a detailed explanation of how each of the claims are patentable over the references cited with particularity required by 37 CFR 1.111(b) and (c);

6.4. a concise statement of the utility of the invention as defined in each of the independent claims (unless the application is a design application);

6.5. a showing of where each limitation of the claims finds support under 35 USC 112, first paragraph, in the written description of the specification. If applicable, the showing must also identify: (1) each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; and (2) the structure, material, or acts in the specification that corresponds to each means- (or step) plus-function claim element that invokes consideration under 35 USC 112, sixth paragraph; if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists; and

6.6. an identification of any cited references that may be disqualified under 35 USC 103(c).

REVIEW OF FACTS

The conditions regarding the application (section I, subsections 1-4) discussed above are considered to have been met. Additionally, the conditions regarding the petition (section II, subsections 1-5) are considered to have been met. However, the renewed petition fails to comply with the all the conditions set forth in section II, subsection 6. Therefore, the renewed petition fails to meet the required conditions to be accorded special status under the accelerated examination procedure.

As mentioned in the petition decision of May 27, 2008, item 6.2 of the Conditions Regarding the Petition requires "an identification of ***all the limitations in the claims*** that are disclosed by the reference specifying where the limitation is disclosed in the cited reference." The latest examination support document does not identify ***claim limitations*** and indicate where the claim limitations are disclosed in each of the cited references. For example, Eom (US Pub. No. 2003/0080914) is cited with respect to claim 1 as appearing to disclose "an antenna with an electromagnetic condensing element (Figure 1, elements 1 and 3; and discussion in paragraphs [0012] through [0014]) that is used for blocking of unwanted electromagnetic radiation." However, claim 1 is directed to "a generic pick-up horn for absorbing radiation emitted by a transmit antenna" and not to "an antenna with an electromagnetic condensing element that is used for blocking of unwanted electromagnetic radiation." Indeed, it is not clear what relevance, if any, an antenna with an electromagnetic condensing element has to a pick-up horn for absorbing radiation emitted by a transmit antenna. Furthermore, claim 1 recites several claim elements, e.g., "at least one outer metal wall forming a metal body," and it is not clear from the examination support document that Eom discloses any of the claimed elements. Consequently, it is not clear that the reference to Eom has any relevance to the claimed invention.

As mentioned in the petition decision of May 27, 2008, item 6.3 of the Conditions Regarding the Petition requires a detailed explanation of how each of the claims are patentable over the references cited with the particularity required by 37 C.F.R. §1.111(b) and (c). Petitioner was advised that, as set forth in §1.111(b), "[a] general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." The latest examination support document does not describe how each of the claims are

patentable over the cited references with the particularity required by 37 CFR 1.111(b) and (c). For example, the examination support document indicates with respect to independent claim 18 that "Podgorski '495 and '032 are not seen to teach or suggest a method of testing one or more payload antenna feeds, the method comprising: configuring one or more pick-up horns in proximity to one or more antenna feeds of a spacecraft payload; positioning each of the one or more pick-up horns to receive radiated power from respective one or more antenna feeds, wherein physical contact between each of the one or more pick-up horns and the one or more antenna feeds is avoided; placing the payload and the one or more pick-up horns in a vacuum; causing the one or more antenna feeds of the payload to produce radiated RF power; receiving the radiated RF power with the one or more pick-up horns; monitoring the temperature of the one or more pick-up horns; and controlling RF drive signals to the one or more antenna feeds to reduce the radiated power in the event the temperature of the one or more pick- up horns exceeds a specified value." However, such explanation encompasses the entirety of claim 18 and so comprises a general allegation that the references to Podgorski do not teach or suggest the method recited in independent claim 18. It is not clear what particular feature recited in the claim serves to patentably distinguish over the references to Podgorski.

As also mentioned in the petition decision of May 27, 2008, item 6.5 of Conditions Regarding the Petition requires "a showing of where each claim limitation finds support under 35 USC 112, first paragraph, in the written description of the specification." While the examination support document provides a showing for the current application, as set forth in item 6.5 on page 2 of the decision, "if the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under 35 USC 112, first paragraph, in each such application in which such supports exists." The current application claims the benefit of several applications under title 35, United States Code, as noted on page 84 of the examination support document,[1] but the examination support document fails to provide a showing of support in any of the several applications.

## DECISION

For the above-stated reasons, the petition is **dismissed**. The application will therefore be taken up by the examiner for action in its regular turn.

Petitioner is given a single opportunity to perfect the petition. Any request for reconsideration of this decision must be submitted within 1 (one) month or 30 (thirty) days, whichever is longer, from the date of this decision in order to be considered timely. Any request for reconsideration must address the deficiencies indicated above.

Petition is reminded that, upon granting of the special status of the application on request for reconsideration, the application will be processed expeditiously. However, due to the dismissal of the instant petition, examination may not be completed within twelve months of the filing date of the application.

[1] The examination support document fails to include US Application Serial No. 12/061,622 filed on 02 April 2008.

Any inquiries regarding this decision should be directed to Quality Assurance Specialist Jose' G. Dees at (571) 272-1569.

Jose' G. Dees, Quality Assurance Specialist
Technology Center 2800
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18191 VON KARMAN AVE.
SUITE 500
IRVINE, CA 92612-7108

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In re Application of:
Sudhakar K. Rao et al.
Serial No.: 12/106,222
Filed: April 18, 2008
Docket No.: 070602-0822
Title: GENERIC PICK-UP HORN FOR HIGH POWER THERMAL VACUUM TESTING OF SATELLITE PAYLOADS AT MULTIPLE FREQUENCY BANDS AND AT MULTIPLE POLARIZATIONS

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the renewed petition filed on October 10, 2008 to make the above-identified application special for accelerated examination procedure under 37 C.F.R. §1.102.

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
   If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 C.F.R. §1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 C.F.R. §1.97 and §1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

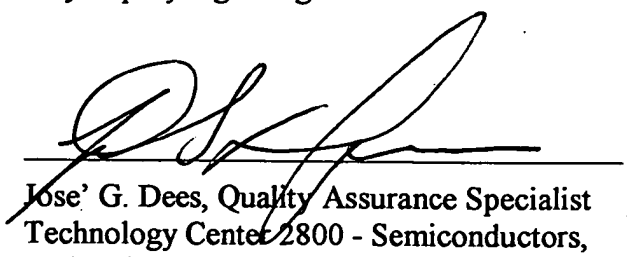
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 C.F.R. §1.181, §1.182 or §1.183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve-month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to the undersigned at (571) 272-1569.



Jose' G. Dees, Quality Assurance Specialist
Technology Center 2800 - Semiconductors,
Electrical & Optical Systems & Components

JD/jc

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FITZPATRICK CELLA HARPER & SCINTO
1290 Avenue of the Americas
NEW YORK NY 10104-3800

MAILED

JUN 07 2010

OFFICE OF PETITIONS

In re Application of
**RONALD H. HAAG**
Application No. 12/106,250
Filed: April 18, 2008
Attorney Docket No. **03875.001300.**

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 May 3, 2010.

The request is **NOT APPROVED**.

The request cannot be approved because the requested change in the 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, 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/
JoAnne Burke
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
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**General Motors Corporation**
**c/o REISING, ETHINGTON, BARNES, KISSELLE, P.C.**
**P.O. BOX 4390**
**TROY MI 48099-4390**

COPY MAILED

APR 0 3 2009

OFFICE OF PETITIONS

In re Application of :
Sethu K. Madhavan et al. :
Application No. 12/106,261 : DECISION ON PETITION
Filed: April 18, 2008 :
Attorney Docket No. P005004-OST-ALS :

This is a decision on the petition under 37 CFR 1.137(b), filed November 10, 2008, which, for the reasons stated below, is being treated as a request for a five (5) month extension of time.

The request for a five (5) month extension of time is **GRANTED**.

The record shows that the Notice to File Missing Parts of Nonprovisional Application (Notice), mailed May 7, 2008. Accordingly a reply was due on or before July 7, 2008, or on or before December 7, 2008, with the submission of a five (5) months extension of time up to an including five months, this case is not in fact abandoned. Accordingly, the filing of a petition to revive is inappropriate until the maximum extendable period for reply has expired.

Petitioner has submitted on November 10, 2008, a four (4) month extension of time fee of $1,730. However, since the response was filed on November 10, 2008, it is outside the four (4) months extension period but qualifies under the five (5) months of extension of time. Therefore, in view of the above, the $1,620 petition fee will be applied towards the purchase of the five months extension of time and the overpayment will be credited to petitioner's deposit account as authorized.

Inquiries concerning this decision may be directed to JoAnne Burke at (571) 272-4584.

This application is being referred to the Office of Patent Application Processing.

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

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P.O. Box 1450
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**NEIFELD IP LAW, PC**
**4813-B EISENHOWER AVENUE**
**ALEXANDRIA VA 22304**

MAILED

APR 28 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Eva Schmidt Dios | : | DECISION ON PETITION |
| Application No. 12/106,271 | : | TO WITHDRAW |
| Filed: April 19, 2008 | : | FROM RECORD |
| Attorney Docket No. UDAP0012U-US | : | |

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed March 12, 2010.

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) 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, a Notice of Allowance was mailed March 25, 2010 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

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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**NEIFELD IP LAW, PC**
**4813-B EISENHOWER AVENUE**
**ALEXANDRIA VA 22304**

**MAILED**

MAY 24 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Eva Schmidt Dios | : | DECISION ON PETITION |
| Application No. 12/106,271 | : | TO WITHDRAW |
| Filed: April 19, 2008 | : | FROM RECORD |
| Attorney Docket No. UDAP0012U-US | : | |

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 May 7, 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 Richard Neifeld on behalf of all attorneys of record who are associated with Customer No. 31518.

All attorneys/agents associated with Customer Number 31518 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, A Notice of Allowance and Fee(s) Due (Notice) was mailed March 25, 2010 that requires a reply by June 25, 2010.

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: TOP GRADE, S.L.
C/ SOLDER, 20 1 C
TARRAGONA, SPAIN 43004

12/106,284

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No.**:20100609

**DATE** : June 09, 2010

**TO SPE OF** : ART UNIT 3641

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,673,553

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

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - ST (South Tower) 9A22**
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

LN

**Thank You For Your Assistance** — **Certificates of Correction Branch**

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

Note your decision on the appropriated box.

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

**Comments:**

/MICHAEL CARONE/
Supervisory Patent Examiner.Art Unit 3641

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**BRENDA L. SPEER**
**BRENDA L. SPEER, LLC**
**2 NORTH CASCADE AVENUE**
**SUITE 1100**
**COLORADO SPRINGS CO 80903**

MAILED

JUN 23 2009

OFFICE OF PETITIONS

In re Application of
David Gitschlag
Application No. 12/106,288
Filed: April 19, 2008
For: RESUSCITATION DEVICE

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 16, 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 Brenda L. Speer, associated with customer no. 50824.

Attorney associated with the Customer Number 50824 have been withdrawn.

**Applicant is reminded that there is no attorney of record at this time.**

All future correspondence will be directed to the sole named inventor David Gitschlag at the address indicated below.

The application is being referred to Technology Center AU 3771 for examination in due course.

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

/Karen Creasy/
Karen Creasy
Petitions Examiner
Office of Petitions

cc:

**DAVID GITSCHIAG**
**2518 PALMER PARK**
**COLORADO SPRINGS CO 80909**

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 |
|---|---|---|---|
| 12/106,288 | 04/19/2008 | David Gitschlag | 1249-002 |

**CONFIRMATION NO. 7458**

**POWER OF ATTORNEY NOTICE**

50824
BRENDA L. SPEER
BRENDA L SPEER, LLC
2 NORTH CASCADE AVENUE
SUITE 1100
COLORADO SPRINGS, CO 80903

Date Mailed: 06/23/2009

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 02/16/2009.

- 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.

/kocreasy/

---

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

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IPADVISORS
Christopher Haigh
150 N. Michigan Ave.
STE. 2800
Chicago, IL 60601

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SEP 02 2009

OFFICE OF PETITIONS

In re Application of :
Samantha Kendall :
Application No. 12/106,298 : DECISION ON PETITION
Filed: April 19, 2008 :
Attorney Docket No. KendallUtility :

This is a decision on the petition under 37 CFR 1.137(a) filed March 17, 2009, to revive the above-identified application.

This application became abandoned for failure to respond to the Notice to File Missing Parts of Nonprovisional Application mailed on May 6, 2008. A Notice of Abandonment was mailed on January 12, 2009.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The instant petition does not satisfy requirement (3) above.

Petitioner is reminded that petitions under the unintentional provisions of 37 CFR 1.137 are required to be signed by an attorney or agent registered to practice before the United States Patent and Trademark Office (USPTO), the patentee, the assignee, or other party in interest. As Office records show that petitioner, Christopher Haigh, is no longer an active/registered attorney to practice before the USPTO, the petition is **dismissed**.

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) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

David Buecl
Petitions Examiner

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DEC 10 2009

OFFICE OF PETITIONS

IPXtract
150 N. Michigan, Ste. 2800
Chicago, IL 60601

In re Application of
Samantha Kendall
Application No. 12/106,298
Filed: April 19, 2008
Attorney Docket No. N/A

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed November 6, 2009, to revive the above-identified application.

In response to the decision mailed on September 2, 2009, petitioner submits the present petition under 37 CFR 1.137(b) along with the $810 petition fee and a $65 surcharge for the late filing of the oath/declaration.

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.

Since the petition satisfies the requirements of 37 CFR 1.137(b), in that petitioner has supplied (1) the reply in the form of an oath/declaration along with the $65 surcharge; (2) the petition fee of $810; and (3) a proper statement of unintentional delay, the petition is **GRANTED**.

This application file is being referred to the Office of Patent Application Processing for further processing.

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

Andrea Smith
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
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JUN 10 2008

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

LEVEQUE INTELLECTUAL PROPERTY LAW, P.C.
221 E. CHURCH STREET
FREDERICK MD 21701

In re Application of:
TIPTON, SANDRA L., et al.
Serial No.: 12/106,405
Filed: April 21, 2008

Title: **INTEGRATED SYSTEM AND METHOD FOR MOBILE AUDIO PLAYBACK AND DICTATION**

DECISION ON PETITION TO MAKE SPECIAL FOR NEW APPLICATION UNDER 37 C.F.R. § 1.102 & M.P.E.P. § 708.02

This is a decision on the petition filed on April 21, 2008 requesting that the above-identified application be made special for accelerated examination procedure under 37 C.F.R. § 1.102(d).

The petition to make the application special is **GRANTED**.

The application is eligible for accelerated examination and the petition complies with the conditions for granting the application special status pursuant to the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published June 26, 2006, in the Federal Register. (71 Fed. Reg. 36323).

The prosecution of the instant application will be conducted expeditiously according to the following guidelines.

1. The application will be docketed to an examiner and taken up for action within two weeks of the date of this decision.

2. Restriction Practice:
If the examiner determines that the claims are not directed to a single invention, a telephone request to elect one single invention will be made pursuant to MPEP 812.01. As a prerequisite to the grant of this petition, the applicant has agreed to make an oral election, by telephone, without traverse. If the applicant refuses to make an election without traverse, or the examiner cannot reach the applicant after a reasonable effort, the

examiner will treat the first claimed invention (invention defined by claim 1) as having being constructively elected without traverse for examination.

3. Office action:
If it is determined that, after appropriate consultation, there is a potential rejection or any other issue to be addressed, the examiner will telephone the applicant and arrange an interview to discuss and resolve the issue. An Office action, other than a Notice of Allowance and Fee(s) Due (Notice of Allowance), will not be issued unless either: 1) an interview was conducted but did not result in agreed to action that places the application in condition for allowance, or, 2) a determination is made that an interview would be unlikely to result in the application being placed in condition for allowance, and 3) an internal conference has been held to review any rejection of any claim.

4. Time for Reply:
An Office action other than a Notice of Allowance or a final Office action will set a shortened statutory period of one month or thirty days, whichever is longer, for reply with no extension of time available under 37 CFR 1.136(a). Failure to timely file a reply within this non-extendible period for reply will result in the abandonment of the application.

5. Reply by Applicant:
A timely reply to an Office action other than the Notice of Allowance must be submitted electronically via EFS or EFS-web and limited to addressing the rejections, objections and requirement made. Any amendment that attempts to: 1) add claims which would result in more than three pending independent claims or more than twenty pending total claims; 2) present claims not encompassed by the pre-examination search or an updated accelerated examination support document; or 3) present claims that are directed a non-elected invention or an invention other than that previously claimed and examined in the application, will be treated as not fully responsive and will not be entered.

For any amendment to the claims (including any new claim) that is not encompassed by the accelerated examination support document, applicant must provide an updated accelerated examination support document that encompasses the amended or new claims at the time of filing of the amendment.

To proceed expeditiously with the examination, it is recommended that a reply with amendments made to any claim or with any new claim being added be accompanied by an updated accelerated examination support document or a statement explaining how the amended or new claim is supported by the original accelerated examination support document.

6. Information Disclosure Statement (IDS):
Any IDS filed during prosecution must be submitted electronically via EFS or EFS-web, accompanied by an updated accelerated examination support document, and be in compliance with 37 CFR 1.97 and 1.98.

7. Post-Allowance Processing:
   To expedite processing of the allowed application into a patent, the applicant must: 1) pay the required fees within one month of the date of the Notice of Allowance, and 2) not file any post allowance papers not required by the Office. In no event may the issue fee be paid and accepted later than three months from the date of the Notice of Allowance.

8. After-Final and Appeal Procedures:
   To expedite prosecution, after receiving the final Office action, applicant must: 1) promptly file a notice of appeal, an appeal brief and appeal fees; and 2) not request a pre-appeal brief conference.

   Any amendment, affidavit or other evidence filed after final Office action must comply with applicable rules and the requirements outlined in numbered paragraphs 5 and 6 above.

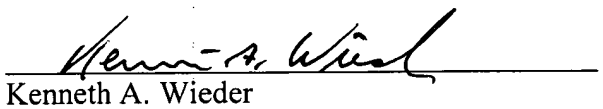
   On appeal, the application will proceed according to normal appeal procedures. After appeal, the application will again be treated special.

9. Proceedings Outside the Normal Examination Process:
   If the application becomes involved in a proceeding that is outside the normal examination process (e.g., a secrecy order, national security review, interference proceeding, petitions under 37 CFR 1.181, 182 or 183), the application will be treated special before and after such proceeding.

10. Final Disposition:
    The twelve month goal of this accelerated examination procedure ends with a final disposition. The mailing of a final Office action, a Notice of Allowance, the filing of a Notice of Appeal, or the filing of a Request for Continued Examination (RCE) is the final disposition.

If, during prosecution, a paper is not filed electronically using EFS-web, a reply is filed but is not fully responsive, the application is involved in an appeal, or a proceeding outside normal examination process, the application will still be examined expeditiously, however, the final disposition may occur more than twelve months from the filing of the application.

Any inquiry regarding this decision should be directed to Ken Wieder, Quality Assurance Specialist, at (571) 272-2986.



Kenneth A. Wieder
Quality Assurance Specialist
Technology Center 2600
Communications

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DLA PIPER LLP US
P. O. BOX 2758
RESTON VA 20195

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JUN 12 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Alexander Goerke and Matthias Rabald | : | DECISION GRANTING STATUS |
| Application No. 12/106,450 | : | UNDER 37 CFR 1.47(b) |
| Filed: April 21, 2008 | : | |
| Attorney Docket No. 370016-P0004 | : | |
| For: Method For Automatically Indexing Documents | : | |

This is in response to the petition under 37 CFR 1.47(b), filed May 18, 2009.

The petition is **GRANTED.**

Petitioner has shown that the non-signing inventors Goerke and Rabald have refused to join in the filing of the above-identified application.

The application and papers have been reviewed and found in compliance with 37 CFR 1.47(b). This application is hereby accorded Rule 1.47(b) status.

As provided in 37 CFR 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

This application is being referred to the Office of Patent Application Processing for pre-examination processing.

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

Charlema Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Alexander Goerke
LCI GmbH
Freiburger Str. 6
79199 Kirchzarten
Germany

MAILED

JUN 12 2009

OFFICE OF PETITIONS

In re Application of
Alexander Goerke and Matthias Rabald
Application No. 12/106,450
Filed: April 21, 2008
Attorney Docket No. 370016-P0004
For: Method For Automatically Indexing Documents

Dear Sir:

You are named as joint inventors 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(b), 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 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) 272-3215. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (571) 272-3150 or 1 (800) 972-6382 (outside the Washington, DC area).

Charlema Grant
Petitions Attorney
Office of Petitions

cc: DLA PIPER LLP US
P. O. BOX 2758
RESTON VA 20195

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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Matthias Rabald
LCI GmbH
Freiburger Str. 6
79199 Kirchzarten
Germany

MAILED

JUN 12 2009

OFFICE OF PETITIONS

In re Application of
Alexander Goerke and Matthias Rabald
Application No. 12/106,450
Filed: April 21, 2008
Attorney Docket No. 370016-P0004
For: Method For Automatically Indexing Documents

Dear Sir:

You are named as joint inventors 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(b), 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 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) 272-3215. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (571) 272-3150 or 1 (800) 972-6382 (outside the Washington, DC area).

Charlema Grant
Petitions Attorney
Office of Petitions

cc: DLA PIPER LLP US
P. O. BOX 2758
RESTON VA 20195

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DEC 17 2008

OFFICE OF PETITIONS

In re Application of :
Goerke et al. : DECISION REFUSING STATUS
Application No. 12/106,450 : UNDER 37 CFR 1.47(b)
Filed: April 21, 2008 :
Attorney Docket No. WO-436011CON4 :

This is in response to the "Petition Under 37 CFR 1.47(b), filed November 26, 2008.

The petition is **DISMISSED**.

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

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor cannot be reached after diligent effort or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
(3) the petition fee;
(4) a statement of the last known address of the non-signing inventor.
(5) proof of proprietary interest: and
(6) proof of irreparable damage.

Applicant lacks items (1) and (2) set forth above.

As to item (1), petitioner has failed to provide sufficient information to establish that inventors Goerke and Rabald after receiving the application papers have refused to execute the documents. Petitioner states the documents were sent to both inventors via UPS. A tracking summary from UPS has been provided showing that the package was delivered. However, the tracking summary shows that unknown parties Dornbrowski and Sunjic signed for the packages. Where the facts presented do not establish that the copy of the application papers (including specification, claims

and drawings) were received, the non-signing inventors conduct does not support a conclusion that the non-signing inventor has refused to execute the documents.

If it is determined that the non-signing inventor no longer resides at the address "diligent effort" will be required to demonstrate the inventor cannot be located.

As to item (2), the declaration provided fails to meet the requirement of 37 CFR 1.63(c)(1). Unless such information is supplied on an application data sheet in accordance with § 1.76, the oath or declaration must also identify the mailing address, and the residence if an inventor lives at a location which is different from where the inventor customarily receives mail, of each inventor. The address provided for inventor Rabald has not presented a complete address on the declaration a house address/number has not been provided.

Further the total declaration provided consists of four pages. However, the page numbers do not correspond.

Petitioner is reminded a declaration cannot be amended, altered or changed in any manner after it has been signed.

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

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
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By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

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

Charlema Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 12/106,452 | 04/21/2008 | Ming-Hung Huang | 250351-1040 | 7808 |

7590 03/01/2010
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
600 GALLERIA PARKWAY, S.E.
STE 1500
ATLANTA, GA 30339-5994

| EXAMINER |
|---|
| CHEN, KEATH T |

| ART UNIT | PAPER NUMBER |
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| 1792 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/01/2010 | PAPER |

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

*The declaration of express abandonment is recognized*

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

The petition is granted.

The express abandonment is recognized. Any previously paid search fee and excess claims fee are hereby refunded.

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

Patent Publication Branch
Office of Data Management

03/01/2010 3030300527

Adjustment date: 03/01/2010 NFARMER
04/21/2008 INTEFSG 00000542 12106452
02 FC:1111 -510.00 OP

Refund Total: 0510.00

Am exp.: XXXXXXXXXXX1.01



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CLEVELAND OH 44115-1414

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JUL 31 2008

**OFFICE OF PETITIONS**

In re Application of :
Sodhi, Garg, Mathur, and :
Syedmohammed : DECISION REFUSING STATUS
Application Number: 12/106481 : UNDER 37 CFR 1.47(a)
Filing Date: 04/21/2008 :
Attorney Docket Number: :
66329/00687 :

This is a decision on the petition filed on April 21, 2008, which is treated as a petition under 37 CFR 1.47(a).[1]

The petition is **DISMISSED**.

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

The above-identified application was filed on April 21, 2008. The original application papers included a declaration pursuant to 37 CFR 1.63 naming Ajit Sodhi, Man Garg, Alok Mathur, and Harish T. Syedmohammed as joint inventors, signed by all of the inventors except Syedmohammed on behalf of themselves and non-signing joint inventor Syedmohammed. The present petition was also filed on April 21, 2008.

Petitioners assert that joint inventor Syedmohammed cannot be located. Specifically, petitioners assert, via the declaration of Michael Young, Vice President of Engineering, Document Solutions Engineering, Toshiba American Business Solutions, Inc., that a letter including the declaration was sent to the non-

[1] A petition under 37 CFR 1.47(b) is inappropriate in this instance since all but one of the inventors has signed the declaration. A petition under 37 CFR 1.47(b) is only appropriate where none of the inventors will sign. Accordingly, the petition will be treated as a petition under 37 CFR 1.47(a).

signing inventor, but was returned as undeliverable. Petitioners further in the petition that the non-signing inventor "appears to have returned to India, leaving no forwarding address."

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee;

(4) a surcharge of $130 or $65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and

(5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1).

In regards to item (1), petitioners have not shown that diligent efforts have been made to locate the non-signing inventor.[2] Petitioners should send or give a copy of the application as filed (specification, including claims, drawings, if any, and the declaration) to the non-signing inventor at his last known address.

In the event that the application papers are returned as undeliverable, petitioners may show diligent efforts to locate the non-signing inventor by providing a copy of an envelope showing that a letter sent to the last known address of the non-signing inventor was returned as undeliverable by the post office. Furthermore, details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first-hand knowledge of the details. Additionally, if any inventor no longer lives at the last known address, petitioners may show diligent efforts by use of a national registry or other database to determine a current address for the non-signing inventor. If a more recent address is discovered, petitioners should send or give a copy of the application papers to the inventor at that address.

Petitioners have not provided a copy of the envelope showing that the letter sent to the last known address of the non-signing inventor was returned as undeliverable.

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[2] MPEP 409.03(d).

More importantly, petitioners have not shown that any efforts were made to locate a more recent address for the non-signing inventor. In particular, if petitioners believe that the non-signing inventor is now in India, petitioners should show that a bona fide attempt was made to locate him in India and provide him with a copy of the application papers (specification, including claims, drawings, if any, and the declaration).

If repeated attempts to contact the non-signing inventor are unsuccessful, petitioners will have shown that despite diligent efforts, the inventor could not be reached.

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

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

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

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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CLEVELAND OH 44115-1414

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In re Application of :
Sodhi, Garg, Mathur, and :
Syedmohammed : DECISION ACCORDING STATUS
Application Number: 12/106481 : UNDER 37 CFR 1.47(a)
Filing Date: 04/21/2008 :
Attorney Docket Number: :
66329/00687 :

This is a decision on the renewed petition under 37 CFR 1.47(a), filed on October 24, 2008.

The petition is **GRANTED**.

Petitioners have shown, via the statement of facts by petitioners registered patent practitioner, Susan L. Mizer, that non-signing inventor Harish T. Syedmohammed could not be located despite diligent efforts. Specifically, petitioners have established that the application was sent to the last known address of non-signing joint inventor Syedmohammed, but was returned as undeliverable. Additionally, practitioner Mizer states that a search was made of an online telephone directory, but that a more recent address for the non-signing inventor could not be found. A copy of the telephone directory search results has been included with the renewed petition.

Accordingly, petitioners have shown that despite diligent efforts, the non-signing inventor could not be located.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the Declaration. Notice of the filing of this application will also be published in the *Official Gazette*.

The application is being referred to Technology Center Art Unit 2173 for further processing.

Telephone inquiries related to this decision should be directed to the undersigned at 571-272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Harish T. Syedmohammed
23251 Los Alisos Boulevard #15
Lake Forest CA 92630

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In re Application of
Sodhi et al.
Application No. 12/106,481
Filed: April 21, 2008
For: SYSTEM AND METHOD FOR GENERATING AN INFORMATIONAL MEDIA DISPLAY ON A DOCUMENT PROCESSING DEVICE

Dear Mr. Syedmohammed:

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 571/272-3231. Requests for information regarding your application should be directed to the File Information Unit at 571-272-3150. 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 571-272-3150 or 1-800-972-6382 (outside the Washington D.C. area).

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

TUCKER ELLIS & WEST LLP
1150 HUNTINGTON BUILDING
925 EUCLID AVENUE
CLEVELAND OH 44115-1414