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In re Patent No. 5,068,846 KRAMER, PIETER
Issue Date: November 26, 1991
Appl No.: 06/858,550
Filed: April 23, 1986
For: Correction of Inventorship

DECISION GRANTING PETITION
37 CFR 1.324

This is a decision on the petition filed 11/10/2008 to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

/Wayne Young/
Supervisory Patent Examiner, Art Unit 2627
Technology Center 2600

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

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DATE: February 22, 2012
TO: Certificates of Correction Branch
FROM: WAYNE YOUNG
SPE, Art Unit 2627
SUBJECT: REQUEST FOR CERTIFICATE OF CORRECTION

Please issue a Certificate of Correction in U. S. Letters Patent No. 5,068,846 as specified on the attached Certificate.

/Wayne Young/
Supervisory Patent Examiner, Art Unit 2627

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE

Patent No. 5,068,846
Patented: November 26, 1991

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 U.S.C. 256, it has been found that the above identified patent, through error and without deceptive intent, improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

Pieter Kramer,
Gijsbertus Bouwhuis

/Wayne Young/
Supervisory Patent Examiner, Art Unit 2627

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
06/858,550	04/23/1986	PIETER KRAMER	PHN 6493D	9543

24737 7590 02/23/2012
PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER
WEINHARDT, ROBERT A

ART UNIT	PAPER NUMBER
2309	

NOTIFICATION DATE	DELIVERY MODE
02/23/2012	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):

vera.kublanov@philips.com
debbie.henn@philips.com
marianne.fox@philips.com

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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In re Patent No. 5,068,846 KRAMER, PIETER
Issue Date: November 26, 1991
Appl No.: 06/858,550
Filed: April 23, 1986
For: Correction of Inventorship

DECISION GRANTING PETITION
37 CFR 1.324

This is a decision on the petition filed 11/10/2008 to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

/Wayne Young/
Supervisory Patent Examiner, Art Unit 2627
Technology Center 2600

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper no. 32

Robert Kinberg
VENABLE LLP
P.O. BOX 34385
WASHINGTON DC 20043-9998

MAILED
DEC 20 2010
OFFICE OF PETITIONS

In re Application of :
Richard S. RANSOM :
Application No. 07/018,566 : DECISION GRANTING
Filed: February 27, 1987 : PETITION
Attorney Docket No. 38952-180887 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed June 16, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an authorization to remove all security markings from the application; (2) the petition fee of $1620; (3) a proper statement of unintentional delay; and (4) a terminal disclaimer and fee as required by 37 CFR 1.137(d).

The terminal disclaimer is accepted and has been made of record.

As requested by petitioners, duplicate petition fees totaling $1620 and excess terminal disclaimer fees totaling $280 have been credited to deposit account 22-0261.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3209.

This application is being referred to Technology Center AU 3662 for further processing.

BethAnne Dayoan
PCT Legal Analyst
Office of PCT Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KEVIN MCMAHON
69 PROSPECT AVENUE
LARCHMONT NY 10538

MAILED

JUN 13 2011

OFFICE OF PETITIONS

In re Patent No. 6,107,023	:	
Issue Date: August 22, 2000	:	
Application No. 07/208,512	:	NOTICE
Filed: June 17, 1998	:	
Attorney Docket No. 4600-0062	:	

This is a notice regarding your request, April 16, 2011, for acceptance of a fee deficiency submission under 37 CFR 1.28.

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

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

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

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

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a request to change the address of record should be filed. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record. Petitioner should note that a change of correspondence address would not affect the fee address. Therefore, if petitioner desires to receive future correspondence, which **may** be mailed regarding maintenance fees for the above-identified patent, the "fee address" and/or "customer number" forms should be submitted.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

cc: KEVIN MCMAHON
191 MARSHALL RIDGE ROAD
NEW CANAAN, CT 06840

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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MAILED

MAR 08 2011

OFFICE OF PETITIONS

PAUL M. DENK
763 SOUTH NEW BALLAS ROAD
ST. LOUIS MO 63141

In re Patent No. 4,896,856	:	
Issued: January 30, 1990	:	
Application No. 07/251,125	:	ON PETITION
Filed: September 29, 1988	:	
Atty. Dkt. No.: 6276	:	

This is a decision on the petition filed September 20, 2010. This matter is being treated under 37 CFR 1.377 as a petition for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent. The required petition fee of $400.00 has been charged to the authorized deposit account.

The petition is **DISMISSED**.

Any request for reconsideration of this matter must be submitted within TWO MONTHS of the mail date indicated above. No petition for extension of time under 37 CFR 1.136 will be available.

The patent issued January 30, 1990. The 11.5 year maintenance fee could have been paid from January 30, 2001 to July 30, 2001 without a surcharge or from July 1, 2001 to January 30, 2002 with a surcharge. The record does not reflect that the maintenance fee was timely submitted. Accordingly, the patent expired January 30, 2002 for failure to timely submit the 11.5-year maintenance fee. Notice of Patent Expiration was mailed March 5, 2002.

Petitioner asserts that Aluma-Form Inc. (Assignee) had one maintenance fee due during July, 2001, and it was the third maintenance fee due upon the Electrical Equipment Cluster Mount patent No. 4,896,*865*, presumably petitioner is referring to the instant '856 patent.

Petitioner further alleges that on July 23, 2001, his office sent a check in the amount of $1,495.00 made out to the Commissioner for Patents, to cover the third maintenance fee for the instant patent. Petitioner has included what petitioner purports to be a copy of a page from an account book for July, 2001 and asserts that this document establishes that a maintenance fee was paid for Aluma-Form on July 23, 2001 in the amount of $1,495.00. Petitioner states this fee was "was probably the cost for a third maintenance fee in the year 2001." Petitioner has included a copy of a page from a bank account statement for July, 2001 indicating that a check was cashed on July 31, 2001 in the amount of $1,495.00. Petitioner argues that the maintenance fee for the '856 patent was paid, but Assignee was not credited with the payment of the fee, and that the patent expired, "unbeknown to all parties involved."

The petition and supporting documents have been carefully considered, but are not found persuasive.

37 CFR 1.377 states:

(a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent may petition the Director to accept and record the maintenance fee.

(b) Any petition under this section must be filed within two months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(g). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

(c) Any petition filed under this section must comply with the requirements of § 1.181(b) and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

The patent expired January 30, 2002. A Notice of Patent Expiration was mailed on March 5, 2002 to the correspondence address of record. Petitioner has failed to provide any explanation for the delay in submitting the petition. Thus, the petition fails to comply with 37 CFR 1.377(b) as the instant petition is untimely filed.

Moreover, petitioner has failed to establish that the 11.5 year maintenance fee was timely submitted. The copy of the account book is illegible. The copy of the page from the bank statement does not establish that the check in question was mailed to the USPTO with instruction to apply the maintenance to the 11.5 year maintenance fee for the instant patent. The copy of the page from the bank statement does not establish the date that the check was mailed. Petitioner has not provided a copy of the maintenance fee transmittal form. Petitioner has not provided a copy of the check at issue.

Petitioner has failed to establish that the 11.5 year maintenance fee for the instant patent was timely submitted and thereafter refused by the Office. Moreover, the instant petition was not timely submitted within the meaning of 37 CFR 1.181(f). Accordingly, as to both the merits and timeliness, the instant petition is accordingly **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 facsimile:

(571) 273-8300

By hand:

U.S. Patent and Trademark Office
Customer Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

/ALESIA M. BROWN/

Alesia M. Brown
Attorney Advisor
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

OCT 18 2010

David B. Quick
ICE MILLER LLP
One American Square
Suite 2900
Indianapolis, IN 46282-0200

In Re: Patent Term Extension
Application for
U.S. Patent No. 4,919,140

Dear Mr. Quick :

An order granting interim extension under 35 U.S.C. § 156(d)(5) is enclosed extending the term of U.S. Patent No. 4,919,140 for a period of 1 year. A copy of the Federal Register notice published in accordance with 35 U.S.C. 156(d)(5)(B) on October 13, 2009 at 75 Fed. Reg. 62767 is enclosed herewith. While a courtesy copy of this letter and the interim extension is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to patent expiration dates.

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

RE: Andara™ OFS™ System
FDA Docket No.:

Attention: Beverly Friedman

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Purdue Research Foundation	:	
Request for Patent Term Extension	:	**ORDER GRANTING**
U.S. Patent No. 4,919,140	:	**INTERIM EXTENSION**

On September 13, 2010, the patent owner, Purdue Research Foundation, timely filed a third application under 35 U.S.C. § 156(d)(5) for an interim extension of the term of U.S. Patent No. 4,919,140. The patent claims the medical device known as Andara™ OFS™ System and a method of using the Andara™ OFS™ System. The application indicates that a Humanitarian Device Exemption, HDE 070002, for the medical device Andara™ OFS™ System has been filed and is currently undergoing regulatory review before the Food and Drug Administration for permission to market or use the product commercially.

Review of the application indicates that except for permission to market or use the product commercially, the subject patent would be eligible for an extension of the patent term under 35 U.S.C. § 156, and that the patent should be extended for an additional one year as required by 35 U.S.C. § 156(d)(5)(B). Because it is apparent that the regulatory review period will continue beyond the extended expiration date of the patent (October 14, 2010), interim extension of the patent term under 35 U.S.C. § 156(d)(5) is appropriate.

A third interim extension under 35 U.S.C. § 156(d)(5) of the term of U.S. Patent No. 4,919,140 is granted for a period of one year from the extended expiration date of the patent, i.e., until October 14, 2011.

October 8, 2010

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

Dated: October 7, 2010.

Robert W. Bahr,

Acting Associate Commissioner for Patent Examination Policy, United States Patent and Trademark Office.

[FR Doc. 2010–25768 Filed 10–12–10; 8:45 am]

BILLING CODE 3510–16–P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO–P–PTO–P–2010–0081]

Grant of Interim Extension of the Term of U.S. Patent No. 4,919,140; Andara™ OFS™ System

AGENCY: United States Patent and Trademark Office.

ACTION: Notice of interim patent term extension.

SUMMARY: The United States Patent and Trademark Office has issued an order granting interim extension under 35 U.S.C. 156(d)(5) for a third one-year interim extension of the term of U.S. Patent No. 4,919,140.

FOR FURTHER INFORMATION CONTACT: Mary C. Till by telephone at (571) 272–7755; by mail marked to her attention and addressed to the Commissioner for Patents, Mail Stop Hatch-Waxman PTE, P.O. Box 1450, Alexandria, VA 22313–1450; by fax marked to her attention at (571) 273–7755, or by e-mail to *Mary.Till@uspto.gov.*

SUPPLEMENTARY INFORMATION: Section 156 of Title 35, United States Code, generally provides that the term of a patent may be extended for a period of up to five years if the patent claims a product, or a method of making or using a product, that has been subject to certain defined regulatory review, and that the patent may be extended for interim periods of up to one year if the regulatory review is anticipated to extend beyond the expiration date of the patent.

On September 13, 2010, the patent owner, Purdue Research Foundation, timely filed an application under 35 U.S.C. 156(d)(5) for a third interim extension of the term of U.S. Patent No. 4,919,140. The patent claims the medical device Andara™ OFS™ System and a method of using the Andara™ OFS™ System. The application indicates that a Humanitarian Device Exemption, HDE 070002, for the medical device Andara™ OFS™ System has been filed and is currently undergoing regulatory review before the Food and Drug Administration for permission to market or use the product commercially.

Review of the application indicates that except for permission to market or use the product commercially, the subject patent would be eligible for an extension of the patent term under 35 U.S.C. 156, and that the patent should be extended for an additional one year as required by 35 U.S.C. 156(d)(5)(B). Because it is apparent that the regulatory review period will continue beyond the extended expiration date of the patent (October 14, 2010), interim extension of the patent term under 35 U.S.C. 156(d)(5) is appropriate.

A third interim extension under 35 U.S.C. 156(d)(5) of the term of U.S. Patent No. 4,919,140 is granted for a period of one year from the extended expiration date of the patent, *i.e.*, until October 14, 2011.

Dated: October 7, 2010.

Robert W. Bahr,

Acting Associate Commissioner for Patent Examination Policy, United States Patent and Trademark Office.

[FR Doc. 2010–25767 Filed 10–12–10; 8:45 am]

BILLING CODE 3510–16–P

DEPARTMENT OF DEFENSE

Office of the Secretary

[Transmittal Nos. 10–53, 10–54, 10–55, 10–59, 10–60, 10–61, and 10–63]

36(b)(1) Arms Sales Notifications

AGENCY: Defense Security Cooperation Agency, DoD.

ACTION: Notice.

SUMMARY: The Department of Defense is publishing the unclassified text of seven section 36(b)(1) arms sales notifications to fulfill the requirements of section 155 of Public Law 104–164, dated 21 July 1996.

FOR FURTHER INFORMATION CONTACT: Ms. B. English, DSCA/DBO/CFM, (703) 601–3740.

SUPPLEMENTARY INFORMATION: The following are copies of letters to the Speaker of the House of Representatives, Transmittals 10–53, 10–54, 10–55, 10–59, 10–60, 10–61, and 10–63 with associated attachments.

Dated: October 6, 2010.

Mitchell S. Bryman,

Alternate OSD Federal Register Liaison Officer, Department of Defense.

Transmittal No. 10–53

The following is a copy of a letter to the Speaker of the House of Representatives, Transmittal 10–53 with attached transmittal and policy justification.

BILLING CODE 5001–06–P

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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JUN 20 2011

Oblon, Spivak, McCleeand, Maier & Neustadt, P.C.
1940 Duke Street
Alexandria, VA 22314

In Re: Patent Term Extension
Application for
U.S. Patent No. 4,977,138

Dear Mr. Doughty:

An interim extension under 35 U.S.C. § 156(e)(2) is enclosed extending the term of U.S. Patent No. 4,977,138 for an additional period of 1 year. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates set forth in the Patent and Exclusivity Data Appendix of the Orange Book (Approved Drug Products with Therapeutic Equivalence Evaluations) or in the Patent Information set forth in the Green Book (FDA Approved Animal Drug Products). Effective August 18, 2003, patent submissions for publication in the Orange Book and Docket *95S-0117 need to be submitted on form FDA-3542 which may be downloaded from FDA's Electronic Forms Download Website: http://www.fda.gov/opacom/morechoices/fdaforms/default.html (http://www.fda.gov/opacom/morechoices/fdaforms/FDA-3542.pdf).

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

RE: ISTODAX®
FDA Docket No.: FDA-2010-E-0405

Attention: Beverly Friedman

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Celgene Corporation	:	
Request for Patent Term Extension	:	**ORDER GRANTING**
U.S. Patent No. 4,977,138	:	**INTERIM EXTENSION**

Astellas Pharma Inc., the owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 4,977,138, through their licensee, now Celgene Corporation, filed an application for interim patent term extension under 35 U.S.C. § 156 on March 29, 2011. The extended term of the patent will expire on July 6, 2011. The patent claims the active ingredient, romidepsin, in the human drug product ISTODAX® which was approved by the Food and Drug Administration for commercial marketing or use on November 5, 2009. An extension of 1,523 days is requested.

The initial USPTO review of the application to date indicates that the subject patent is eligible for extension of the patent term under 35 U.S.C. § 156. A final determination of the length of the extension of the patent term and issuance of a patent term extension certificate cannot be made until a final determination of the length of the regulatory review period is made. Because the extended term of the patent would expire before a certificate of patent term extension can be issued, an interim extension of the patent term is appropriate.

An interim extension under 35 U.S.C. § 156(e)(2) of the term of U.S. Patent No. 4,977,138 is granted for a period of one year from the extended expiration date of the patent.

David J. Kappos

June 8, 2011
Date

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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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TRASKBRITT, P.C./ ALLIANT TECH SYSTEMS
P.O. BOX 2550
SALT LAKE CITY UT 84110

MAILED

OCT 14 2010

OFFICE OF PETITIONS

In re Application of:
BERCHTOLD, et al.
Application No. 07/376,813
Filed: July 7, 1989
Attorney Docket No. 1341016

ON PETITION

This is a decision on the Petition to Expunge Under 37 C.F.R. § 1.59, filed October 11, 2010. The requisite $200.00 petition fee has been charged to Deposit Account No. 20-1469 as authorized in the Petition.

The petition is **GRANTED**.

Petitioner urges that information sensitive in nature was included on a previously submitted Power of Attorney. It is agreed that under the circumstances of this case, petitioner has shown to the satisfaction of the Director that expungement is appropriate.

The file entry of the subject document has been closed. As such, the document is no longer available to the public for inspection, which is the Image File Wrapper (IFW) equivalent to removal of a paper document from a paper file wrapper.

Telephone inquiries concerning this decision should be directed to Brian W. Brown at (571) 272-5338.

Brian W. Brown
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NOV - 1 2010

Abbott Diabetes Care Inc.
Bozicevic, Field & Francis LLP
1900 University Ave.
Suite 200
East Palo Alto, CA 94303

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,262,035

An order granting interim extension under 35 U.S.C. § 156(e)(2) is enclosed extending the term of U.S. Patent No. 5,262,035 for a period of one (1) year. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to patent expiration dates.

Inquiries regarding this communication should be directed to Raul Tamayo by telephone at (571) 272-7728, or by e-mail at raul.tamayo@uspto.gov.

Mary C. Till
Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

Attention: Beverly Friedman

RE: FreeStyle Navigator®
Continuous Glucose Monitoring
FDA Docket No.: FDA-2009-E-0673

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Abbott Diabetes Care Inc.	:	
Request for Patent Term Extension	:	ORDER GRANTING
U.S. Patent No. 5,262,035	:	INTERIM EXTENSION

Abbott Diabetes Care Inc., the owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 5,262,035, filed an application for patent term extension under 35 U.S.C. § 156 on May 9, 2008. The original term of the patent is due to expire on November 16, 2010. The patent claims the medical device, the FreeStyle Navigator® Continuous Glucose Monitoring System, which was approved by the Food and Drug Administration for commercial marketing or use on March 12, 2008. An extension of 5 years is requested.

The initial USPTO review of the application to date indicates that the subject patent is eligible for extension of the patent term under 35 U.S.C. § 156. A final determination of the length of the extension of the patent term and issuance of a patent term extension certificate cannot be made until a final determination of the length of the regulatory review period is made. Because the original term of the patent would expire before a certificate of patent term extension can be issued, an interim extension of the patent term is appropriate.

An interim extension under 35 U.S.C. § 156(e)(2) of the term of U.S. Patent No. 5,262,035 is granted for a period of one year from the original expiration date of the patent.

October 29, 2010

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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

NOV 21 2011

Abbott Diabetes Care Inc.
Bozicevic, Field & Francis LLP
1900 University Ave.
Suite 200
East Palo Alto, CA 94303

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,262,035

An order granting interim extension under 35 U.S.C. § 156(e)(2) is enclosed extending the term of U.S. Patent No. 5,262,035 for a period of one (1) year. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to patent expiration dates.

Inquiries regarding this communication should be directed to Raul Tamayo by telephone at (571) 272-7728, or by e-mail at raul.tamayo@uspto.gov.

Mary C. Till
Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

Attention: Beverly Friedman

RE: FreeStyle Navigator®
Continuous Glucose Monitoring
FDA Docket No.: FDA-2009-E-0673

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Abbott Diabetes Care Inc.	:	
Request for Patent Term Extension	:	ORDER GRANTING
U.S. Patent No. 5,262,035	:	INTERIM EXTENSION

Abbott Diabetes Care Inc., the owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 5,262,035, filed an application for patent term extension under 35 U.S.C. § 156 on May 9, 2008. The extended term of the patent is due to expire on November 16, 2011. The patent claims the medical device, the FreeStyle Navigator® Continuous Glucose Monitoring System, which was approved by the Food and Drug Administration for commercial marketing or use on March 12, 2008. An extension of 5 years is requested.

The USPTO review of the application to date indicates that the subject patent is eligible for extension of the patent term under 35 U.S.C. § 156. Issuance of a patent term extension certificate cannot be made until a final determination of the length of the extension is made. Because the extended term of the patent would expire before a certificate of patent term extension can be issued, an interim extension of the patent term is appropriate.

An interim extension under 35 U.S.C. § 156(e)(2) of the term of U.S. Patent No. 5,262,035 is granted for a period of one year from the extended expiration date of the patent.

November 16, 2011

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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

FEB - 8 2011

Dennis A. Bennett
Global Patent Group, LLC
1005 North Warson Road
Suite 201
Saint Louis, Missouri 63132

In Re: Patent Term Extension
Application for
U.S. Patent No. 4,971,802

Dear Mr. Bennett:

An order granting a fourth interim extension under 35 U.S.C. § 156(d)(5) is enclosed extending the term of U.S. Patent No. 4,971,802 for a period of one (1) year. Pursuant to 35 U.S.C. § 156(d)(5)(B), a notice regarding the grant of an interim extension under 35 U.S.C. § 156(d)(5) was published in the Federal Register of February 1, 2011, at 76 Fed. Reg. 5564; a copy of the notice is enclosed for your records.

Inquiries regarding this communication should be directed to Raul Tamayo by telephone at (571) 272-7728; by mail marked to his attention and addressed to the Commissioner for Patents, Mail Stop Hatch-Waxman PTE, P.O. Box 1450, Alexandria, VA 22313-1450; by fax marked to his attention at (571) 273-7728; or by e-mail to Raul.Tamayo@uspto.gov.

Mary C. Till
Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

Attention: Beverly Friedman

RE: Mifamurtide (muramyl tripeptide phosphatidyl ethanolamine)
FDA Docket No.:

UNITED STATES PATENT AND TRADEMARK OFFICE

In re IDM Pharma	:	
Request for Patent Term Extension	:	**ORDER GRANTING**
U.S. Patent No. 4,971,802	:	**INTERIM EXTENSION**

On September 30, 2010, IDM Pharma, agent/licensee of patent owner Novartis, timely filed an application under 35 U.S.C. § 156(d)(5) for a fourth interim extension of the term of U.S. Patent No. 4,971,802. Claims of the patent cover muramyl tripeptide phosphatidyl ethanolamine, which is labeled as the active ingredient in the human drug product Mifamurtide. The application indicates that a New Drug Application (NDA No. 22-092) for the human drug product Mifamurtide has been filed and is currently undergoing regulatory review before the Food and Drug Administration for permission to market or use the product commercially.

Review of the application indicates that except for permission to market or use the product commercially, the subject patent would be eligible for an extension of the patent term under 35 U.S.C. § 156, and that the patent should be extended for one year as required by 35 U.S.C. § 156(d)(5)(B). Because it is apparent that the regulatory review period will continue beyond the extended expiration date of the patent (November 20, 2010), interim extension of the patent term under 35 U.S.C. § 156(d)(5) is appropriate.

An interim extension under 35 U.S.C. § 156(d)(5) of the term of U.S. Patent No. 4,971,802 was granted for an additional period of one year from the extended expiration date of the patent, i.e., until November 20, 2011.

January 27, 2011

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,770,572	1998-06-23	07/410,778	1989-06-30	GERSHONI3

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/rlb/	Date (YYYY-MM-DD)	2012-02-28
Name	Roger L. Browdy	Registration Number	25618

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5770572
Issue Date: June 23,1998
Application No. 07410778
Filed: June 30,1989
Attorney Docket No. 3

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 28,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 28,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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.
07/443,018	11/29/1989	JOSEPH T. EVANS	2668-0003	5966

82652 7590 03/02/2011

Davidson Berquist Jackson & Gowdey LLP
(Ramtron Cases)
4300 Wilson Blvd
Suite 700
Arlington, VA 22203

EXAMINER	
BANSAL, GURTEJ	

ART UNIT	PAPER NUMBER
2189	

MAIL DATE	DELIVERY MODE
03/02/2011	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

Davidson Berquist Jackson & Gowdey LLP
(Ramtron Cases)
4300 Wilson Blvd, Suite 700
Arlington VA 22203

In re Application of: EVANS et al.
Application No. 07/443,018
Filed: November 29, 1989
For: NON-VOLATILE MEMORY CIRCUIT USING FERROELECTRIC CAPACITOR STORAGE ELEMENT

DECISION ON PETITION

This is a decision on the petition filed on march 5, 2008, under 37 CFR 1.181(a) to invoke Supervisory Authority requesting that a new office action be mailed in the instant application.

A review of the file wrapper record shows that an Allowance was mailed by examiner in the instant application on February 25, 2011.

Accordingly, the instant petition, filed under 37 CFR §1.181 in this application, is rendered moot.

Accordingly, the Petition is **DISMISSED as moot**.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-4210.

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

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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MAILED

AUG 15 2011

OFFICE OF PETITIONS

ROTHWELL, FIGG, ERNST & KURZ
555 13TH STREET, N.W., SUITE 701E
WASHINGTON DC 20004

In re Patent No. 5,167,961 :
Issue Date: December 1, 1992 :
Application No. 07/460,177 : NOTICE
Filed: April 2, 1990 :
Attorney Docket No. 1181213A :

This is a notice regarding your request, July 13, 2011, 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.**

A courtesy copy of this decision is being mailed to the address given on the petition.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

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

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

AKIN GUMP STRAUSS HAUER & FELD LLP
1111 LOUISIANA STREET
44TH FLOOR
HOUSTON TX 77002

MAILED
JUN 14 2011
OFFICE OF PETITIONS

In re Patent No. 6,101,324 :
Issue Date: August 8, 2000 :
Application No. 07/474,682 : NOTICE
Filed: February 6, 1990 :
Attorney Docket No. C90083US :

This is a notice regarding your requests, filed April 29, 2011 and May 10, 2011, 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**.

A courtesy copy of this decision is being mailed to the address given on the petition.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

cc: JOHN M. CONNELL
7 WARREN AVENUE
SALEM, NH 03078

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

JUN 20 2011

Elizabeth W. Mata
Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
P.O. Box 9133
Concord, MA 01742-9133

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,218,108

Dear Ms. Mata:

An interim extension under 35 U.S.C. § 156(e)(2) is enclosed extending the term of U.S. Patent No. 5,218,108 for a period of one year. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates set forth in the Patent and Exclusivity Data Appendix of the Orange Book (Approved Drug Products with Therapeutic Equivalence Evaluations) or in the Patent Information set forth in the Green Book (FDA Approved Animal Drug Products). Effective August 18, 2003, patent submissions for publication in the Orange Book and Docket *95S-0117 need to be submitted on form FDA-3542 which may be downloaded from FDA's Electronic Forms Download Website: http://www.fda.gov/opacom/morechoices/fdaforms/default.html (http://www.fda.gov/opacom/morechoices/fdaforms/FDA-3542.pdf).

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

RE: VOLUVEN® (6% hydroxyethyl starch 130/0.4 in 0.9% sodium chloride injection)
Docket No.: FDA-

Attention: Beverly Friedman

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Fresenius Kabi Deutschland GmbH	:	
Request for Patent Term Extension	:	ORDER GRANTING
U.S. Patent No. 5,218,108	:	INTERIM EXTENSION

Fresenius Kabi Deutschland GmbH, the owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 5,218,108, filed an application for patent term extension under 35 U.S.C. § 156 on February 21, 2008. The extended term of the patent is due to expire on June 8, 2011. The patent claims the active ingredient 6% hydroxyethyl starch 130/0.4 in 0.9% sodium chloride injection in the human drug product VOLUVEN® which was approved by the Food and Drug Administration for commercial marketing or use on December 27, 2007. An extension of 1,371 days is requested.

The initial USPTO review of the application to date indicates that the subject patent is eligible for extension of the patent term under 35 U.S.C. § 156. A final determination of the length of the extension of the patent term and issuance of a patent term extension certificate cannot be made until a final determination of the length of the regulatory review period is made. Because the extended term of the patent would expire before a certificate of patent term extension can be issued, an interim extension of the patent term is appropriate.

An interim extension under 35 U.S.C. § 156(e)(2) of the term of U.S. Patent No. 5,218,108 is granted for a period of one year from the extended expiration date of the patent.

David J. Kappos

June 8, 2011

Date

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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

AUG - 5 2010

Donald R. Steinberg
Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,196,404

Dear Mr. Steinberg :

An interim extension is enclosed extending the term of U.S. Patent No. 5,196,404 for a period of 1 year from its previously extended expiration date. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates set forth in the Patent and Exclusivity Data Appendix of the Orange Book (Approved Drug Products with Therapeutic Equivalence Evaluations) or in the Patent Information set forth in the Green Book (FDA Approved Animal Drug Products). Effective August 18, 2003, patent submissions for publication in the Orange Book and Docket *95S-0117 need to be submitted on form FDA-3542 which may be downloaded from FDA's Electronic Forms Download Website: http://www.fda.gov/opacom/morechoices/fdaforms/default.html (http://www.fda.gov/opacom/morechoices/fdaforms/FDA-3542.pdf).

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

RE: Angiomax®
FDA Docket No.: 01E-0213

Attention: Beverly Friedman

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Biogen Idec MA Inc.	:	ORDER GRANTING
U.S. Patent No. 5,196,404	:	INTERIM EXTENSION

Biogen Idec MA Inc., the owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 5,196,404 (the '404 patent), through its authorized agent, The Medicines Company, filed an application for patent term extension under 35 U.S.C. § 156 on February 14, 2001. The '404 patent claims the active ingredient bivalirudin, in the human drug product Angiomax®, which was approved by the Food and Drug Administration for commercial marketing or use on December 15, 2000. An extension of 1,728 days is requested.

The original term of the patent expired on March 23, 2010. On March 18, 2010, the USPTO granted a first interim extension extending the term of the '404 patent through May 23, 2010. On May 21, 2010, the USPTO granted a second interim extension extending the term of the '404 patent through and including the day ten days after the United States District Court for the Eastern District of Virginia, Alexandria Division issued an Order deciding the pending cross motions for summary judgment in *The Medicines Company v. David Kappos et al.*, Civil Action No. 01:10-cv-286. That Order issued on August 3, 2010.

A third interim extension is hereby granted, extending the term of U.S. Patent No. 5,196,404 until August 13, 2011.

August 5, 2010

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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

Donald R. Steinberg
Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, MA 02109

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,196,404

MAILED
JUL 28 2011
OFFICE OF PETITIONS

Dear Mr. Steinberg:

An interim extension under 35 U.S.C. § 156(e)(2) is enclosed extending the term of U.S. Patent No. 5,196,404 for an additional one year period. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates set forth in the Patent and Exclusivity Data Appendix of the Orange Book (Approved Drug Products with Therapeutic Equivalence Evaluations) or in the Patent Information set forth in the Green Book (FDA Approved Animal Drug Products). Effective August 18, 2003, patent submissions for publication in the Orange Book and Docket *95S-0117 need to be submitted on form FDA-3542 which may be downloaded from FDA's Electronic Forms Download Website: http://www.fda.gov/opacom/morechoices/fdaforms/default.html (http://www.fda.gov/opacom/morechoices/fdaforms/FDA-3542.pdf).

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

Attention: Beverly Friedman

RE: ANGIOMAX® (bivalirudin)
Docket No.: FDA-2001-E-0027

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Biogen Idec MA Inc.	:	ORDER GRANTING
U.S. Patent No. 5,196,404	:	INTERIM EXTENSION

Biogen Idec MA Inc., the owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 5,196,404 (the '404 patent), through its authorized agent, The Medicines Company, filed an application for patent term extension under 35 U.S.C. § 156 on February 14, 2001. The '404 patent claims the active ingredient bivalirudin in the human drug product Angiomax®, which was approved by the Food and Drug Administration for commercial marketing or use on December 15, 2000. An extension of 1,728 days is requested.

The original term of the patent expired on March 23, 2010. On March 18, 2010, the USPTO granted a first interim extension extending the term of the '404 patent through May 23, 2010. On May 21, 2010, the USPTO granted a second interim extension extending the term of the '404 patent through and including the day ten days after the United States District Court for the Eastern District of Virginia, Alexandria Division, issued an Order deciding the pending cross motions for summary judgment in *The Medicines Company v. David Kappos et al.*, Civil Action No. 01:10-cv-286. That Order issued on August 3, 2010. A third interim extension was issued on August 5, 2010, and expires on August 13, 2011.

A fourth interim extension is hereby granted, extending the term of U.S. Patent No. 5,196,404 until August 13, 2012.

July 28, 2011

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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TRASKBRITT, P.C./ ALLIANT TECH SYSTEMS
P.O. BOX 2550
SALT LAKE CITY UT 84110

MAILED

SEP 13 2010

OFFICE OF PETITIONS

In re Application of: :
LUND, Gary :
Application No. 07/584,210 : ON PETITION
Filed: September 18, 1990 :
Attorney Docket No. 2507-6807US(20908-US) :

This is a decision on the Communication Requesting Withdrawal of Power of Attorney and Sensitive Personal Information from the Record, filed August 17, 2010, which has been treated as a Petition To Expunge under 37 CFR 1.59(b). The requisite $200.00 petition fee has been charged to Deposit Account No. 20-1469 as authorized in the Petition.

The petition is **GRANTED**.

Petitioner urges that information sensitive in nature was included on a previously submitted Power of Attorney. It is agreed that under the circumstances of this case, petitioner has shown to the satisfaction of the Director that expungement is appropriate.

The file entry of the subject document has been closed. As such, the document is no longer available to the public for inspection, which is the Image File Wrapper (IFW) equivalent to removal of a paper document from a paper file wrapper.

Telephone inquiries concerning this decision should be directed to Brian W. Brown at (571) 272-5338.

Brian W. Brown
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 28 2010

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Holly D. Koslowski
Porter, Wright, Morris & Arthur LLP
250 East Fifth Street, Suite 2200
Cincinnati, OH 45202

In Re: Interim Patent Term Extension
Application for
U.S. Patent No. 5,109,844

FINAL DECISION REGARDING INTERIM PATENT TERM EXTENSION APPLICATION UNDER 35 U.S.C. § 156(d)(5) FOR U.S. PATENT NO. 5,109,844

This is in response to the application for interim extension of the term of U.S. Patent No. 5,109,844 ("the '844 patent") filed under 35 U.S.C. § 156(d)(5) in the United States Patent and Trademark Office ("USPTO") on September 22, 2010 ("the PTE Application"). The PTE Application was filed by Duke University ("Applicant"). Interim extension is sought based upon the continuing premarket review of the Argus 60 Chronic Retinal Stimulation System ("Argus II Visual Stimulation System") under section 515 of the Federal Food Drug and Cosmetic Act ("FFDCA"). Because the USPTO has determined, and Food and Drug Administration ("FDA") has confirmed, that the time period identified in 35 U.S.C. § 156(g)(3)(B)(ii) has NOT begun for the Argus II Visual Stimulation System, as required under section 35 U.S.C. § 156(d)(5) for an interim extension of a medical device, Applicant's request for interim extension of the patent term of the '844 patent is **DENIED.**

A. Factual Background

(1) On December 31, 2004, Applicant filed an Investigational Device Exemption Application No. G050001 with the FDA for the Argus II Visual Stimulation System with FDA.

(2) Applicant has not yet filed a Pre-Market Approval ("PMA") application or a Humanitarian Device Exemption ("HDE") for the Argus II Visual Stimulation System.

(3) On September 22, 2010, Applicant filed an application for interim patent term extension under 35 U.S.C. § 156(d)(5) with the USPTO, seeking to extend the term of the '844 patent, which expires on October11, 2010.

(4) On September 23, 2010, the USPTO communicated the filing of the present PTE Application to FDA and requested whether an application within the meaning of 156(g)(3)(B)(ii) had been filed for the Argus II Visual Stimulation System. FDA confirmed that no PMA or HDE has been filed for the Argus II Visual Stimulation System. Attachment 1.

B. Decision

Applicant has filed for an interim extension under 35 U.S.C. § 156(d)(5). That provision provides for interim patent term extension where regulatory approval of a product claimed in the patent has been sought, but not yet received. Section 156(d)(5)(A) states in relevant part:

> If the owner of record of the patent or its agent reasonably expects that the applicable regulatory review period described in paragraphs (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) **that began** for a product that is the subject of such patent may extend beyond the expiration date of the patent term in effect, the owner or its agent may submit an application to the Director for an interim extension during the period beginning 6 months, and ending 15 days before such term is due to expire.

See 35 U.S.C. § 156(d)(5)(A) (emphasis added).

By its express terms, section 156(d)(5)(A) requires the "regulatory review period described in paragraphs (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) " to have begun at the time of the interim patent term extension application. Paragraph (3)(B)(ii) of subsection (g) applies to medical devices and identifies the regulatory review period as:

> the period beginning on the date an application was initially submitted with respect to the device under section 515 and ending on the date such application was approved under such Act or the period beginning on the date a notice of completion of a product development protocol was initially submitted under section 515(f)(5) and ending on the date the protocol was declared completed under section 515(f)(6).

See 35 U.S.C. § 156(g)(3)(B)(ii).

Paragraph (3)(B)(ii) is commonly considered to refer to the "approval phase" for a medical device. Thus, for purposes of section 156(d)(5)(A), the owner of record of the patent or its agent must show that the approval phase has commenced via the filing of a PMA or HDE to secure an interim patent term extension for a patent protecting a medical device.

Here, Applicant has not filed a PMA or HDE for the Argus II Visual Stimulation System. Applicant admits as much in its PTE application, stating "[a]n application for product approval or notice of completion of a product development protocol under Section 515 of the Federal Food Drug and Cosmetic Act has not yet been submitted." PTE Application at 10. Thus, because the approval phase has not begun with a PMA or HDE, Applicant is not entitled to an interim patent term extension under section 156(d)(5)(A).

Applicant states that a Humanitarian Use Device (HUD) designation was received on June 2, 2009, for the Argus II Visual Stimulation System. *Id.* at 10. Section 156(d)(5) expressly requires the regulatory review period specified in section 156(g)(3)(B)(ii) to have begun for a medical device, claimed by the patent, in order to be eligible for interim extension under 35 U.S.C. § 156(d)(5). The grant of a HUD designation does not serve as the trigger of the regulatory review period in section 156(g)(3)(B)(ii). The USPTO has no discretion to consider the testing phrase set forth in section

156(g)(3)(B)(i) as the start of the regulatory review period of section 156(g)(3)(B)(ii) or consider the grant of HUD designation as the start of the regulatory review period specified in section 156(g)(3)(B)(ii). Accordingly, since Applicant admits that the approval phase has not commenced with the filing of a PMA or HDE, the USPTO must deny Applicant's application for an interim patent term extension under 35 U.S.C. § 156(d)(5) for the '844 patent.

C. Conclusion

For the reasons set forth above, the '844 patent is not eligible for interim patent term extension under 35 U.S.C. § 156. Accordingly, the application for interim patent term extension of the '844 patent is **DENIED**.

This is considered a final agency decision within the meaning of 5 U.S.C. § 704.

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

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

By FAX: (571) 273-7755

Telephone inquiries related to this determination should be directed to the Mary C. Till at (571) 272-7755.

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Building 51, Room 6222
Silver Spring, MD 20993-0002

Attention: Beverly Friedman

RE: Argus II Visual Stimulation System

Till, Mary

From: Friedman, Beverly J [Beverly.Friedman@fda.hhs.gov]
Sent: Thursday, September 23, 2010 10:25 AM
To: Till, Mary
Subject: RE: URGENT information request

Mary,

according to CDRH, an investigational device exemption has been submitted for this product, but the application for approval for marketing the product (HDE or PMA) has not been submitted yet.

Beverly

From: Till, Mary [mailto:Mary.Till@USPTO.GOV]
Sent: Thursday, September 23, 2010 8:50 AM
To: Friedman, Beverly J
Subject: URGENT information request

Dear Beverly:

We have received a request for interim extension for U.S. Patent No. 5,109,844 (expiring on October 11, 2010) seeking to extend the term of the patent under the provisions of 35 U.S.C. 156(d)(5) based on the continuing regulatory review of the Argus 60 Chronic Retinal Stimulation System (IDE G050001). As you know, in order for a patent, which claims a medical device, to be eligible for extension pursuant to the (d)(5) provisions, the regulatory review period set forth in 156(g)(3)(B)(ii) must have begun. In the present application, the patent owner indicates that an HUD designation was received June 2, 2009 and that they are currently in the process of preparing a Humanitarian Device Exemption. Based in this information, we understand that the period set forth in 156(g)(3)(B)(ii) has NOT begun. Can you please confirm that an application for marketing approval, within the meaning 156(g)(3)(B)(ii), has not been filed for this device?

Thank you for your time and attention to this matter

Sincerely,
Mary

Mary C. Till
Legal Advisor
Office of Patent Legal Administration
United States Patent and Trademark Office

600 Dulany St.
Alexandria, VA 22313

(571) 272-7755

This e-mail message is intended only for individual(s) to whom it is addressed. If you believe you have received this message in error, please advise the sender by return e-mail and delete it from your mailbox. Thank you.

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SPENCER & FRANK
1100 NEW YORK AVE., NW
WASHINGTON DC 20005-3955

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OFFICE OF PETITIONS

Paper No. 22

In re Patent No. 5,122,464
Issue Date: June 16, 1992
Application No. 07/595,733
Filed: October 10, 1990
Inventor: Richard H. Wilson et al

: DECISION ON PETITION

This is a decision on the petition for expungement of information, filed September 28, 2010, which is being treated as petitions under 37 CFR 1.182 to invalidate an assignment previously recorded against the above-identified application.

The petition is **dismissed**. This is not a final agency action.

Petitioner indicates an assignment recorded on August 1, 2006 was erroneously filed for the above identified application and requests this assignment record be expunged from the file.

As discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or "expunge" assignment records are granted only if the petitioner can prove that:

(A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and
(B) the integrity of the assignment records will not be affected by granting the petition.

In regard to B, petitioner has not sufficiently explained how the removal of a document in its entirety will not affect the assignment records. The removal of a document in its entirety will affect the assignment records. The integrity of the records is recognized as separate from the chain of title, and the USPTO endeavors to maintain a complete history of claimed interests in a given property to permit, among other things, the review of matters like chain of title by a competent authority.

Moreover, petitioner seeks an extraordinary remedy, properly addressed under 37 CFR 1.182. The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982).

As set forth in MPEP 323, an error in a recorded assignment is not corrected by invalidating the previous document, but by simply submitting a "corrective document". The "corrective document" must include 1) a copy of the original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and 2) a new Recordation Form Cover Sheet (form PTO-1595). The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06. Petitioner should note that the "assignment documents" and "corrective documents" are not limited to assignments, but include any documents affecting title to a patent or application. See MPEP § 313.

Therefore, the rules of practice and the procedures before the USPTO provide an avenue for the requested relief without relying upon extraordinary measures. That is, the chain of title can be clarified in the assignment records through the recording of a corrective document. As a request for the Office to invalidate an assignment is both extraordinary and contrary to USPTO policy, this petition must be dismissed.

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 USC 261 and 37 CFR 3.11. However, the recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. Moreover, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment document will be retained, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992).

It is well settled that the Office is not the appropriate forum for resolving a dispute concerning the ownership of an application or patent, and, as such, the USPTO will not permit itself to become embroiled in ownership disputes, particularly as it does not have the means or the authority to resolve such disputes. Indeed, the USPTO has no authority to decide ownership issues. See Cedars-Sinai Medical Center v. Watkins, 11F.3d 1573, 1581 n.10, 29 USPQ 2d 1188, 1194 n.10 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. (1994). Rather, state law governs contractual obligations and transfers of property rights, including those relating to patents. See Regents of the University of New Mexico v. Knight, 66 USPQ2d 1001, 1008 (Fed. Cir. 2003). The USPTO cannot settle disputes as to title as a judicial tribunal is the appropriate forum to resolve such controversy. See Jim Arnold Corp. v. Hydrotech Sys., Inc., 109 F.3d 1567, 1572, 42 USPQ2d 1119, 1123 (Fed. Cir. 1997)("the question of who owns the patent right and on what terms typically is a question exclusively for state courts"); Roach v. Crouch, 24 N.W. 2d 400, 33

USPQ2d 1361 (Iowa 1994)(patent ownership issue properly triable in state court); In re Haines, 1900 C.D. 102, 103 (Comm'r Pat. 1900)(same).

If petitioner is successful in resolving this dispute, the proper documentation should be promptly submitted to the USPTO for recordation against the patent.

Also, Office records do not indicate that a change of address has been filed in this case, although the address given on the petition differs from the address of record. If appropriate, 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.

A petition to expunge assignment documents is properly addressed under 37 CFR 1.182 and a fee of $400.00 is required. The $400 petition fee has been charged to petitioner's deposit account.

Telephone inquiries concerning this communication should be directed to Carl Friedman at (571)272-6842.

Christopher Bottorff
Supervisor
Office of Petitions

Cc: Womble Carlyle Sandridge & Rice PLLC
P.O. Box 7037
Atlanta Georgia 30357-0037

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OFFICE OF PETITIONS

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

In re Patent No. :
5,530,101 :
Application No. 07/634,278 : DECISION GRANTING PETITION
Filing Date: December 19, 1990 :
Issue Date: June 25, 1996 :
Attorney Docket No. 11823-26

This is a decision on the renewed petition under 37 CFR 1.182, filed November 24, 2010, requesting issuance of duplicate Letters of Patent for the above-identified patent.

The petition is **granted**.

The file record discloses that the instant application matured into U.S. Patent No. 5,530,101 on June 25, 1996. Petitioner contends, however, that the patent was lost .

In view of the facts set forth in the petition, it is concluded that the original Letters of Patent was lost. The Office of Data Management is directed to issue duplicate Letters of Patent.

The petition fee of $400.00 was received.

Any questions concerning this decision may be directed to the undersigned at (571)272-3222. Any questions concerning issuance of the duplicate Letter of Patent should be directed to the Office of Data Management.

A copy of this decision is being forwarded to the Office of Data Management for issuance of a duplicate Letter of Patent.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

cc: Ollie Person—Office of Data Management FAX: 571-270-9764
Kimberly Terrell—Office of Data Management FAX: 571-270-9958

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
Office of Patent Legal Administration

Gail E. Poulos
USDA-ARS-OTT
5601 Sunnyside Avenue
Beltsville, MD 20705-5131

AUG 0 2 2010

In re Patent Term Extension Application of	
United States Department of Agriculture for	Decision on Request for Withdrawal of
U.S. Patent No. 5,135,759	Interim Extension; Petition under 37 C.F.R.
Issue Date: August 4, 1992	§§1.182 and 1.183 for Extension of Time
Application No. 07/692,958	To File an Application for Second Interim
Filing Date: April 26, 1991	Patent Term Extension; and Request for
Title: Method To Preselect the Sex of Offspring	Second Interim Extension

The request for withdrawal of interim extension of patent term, filed January 29, 2010, the petition under 37 C.F.R. § 1.183 and 1.182 filed on July 27, 2010 and the request for subsequent interim patent term extension pursuant to § 156(d)(5)(C), filed on July 27, 2010, have been forwarded to the Office of the Associate Commissioner for Patent Examination Policy in the United States Patent and Trademark Office (the "USPTO") for consideration.

Because the USPTO properly granted the interim extension of July 28, 2009, based on the August 4, 2009 expiration date of US. Patent No. 5,135,759, the request to withdraw the interim extension is **DENIED**. Because §§ 1.182 and 1.183 do not provide the USPTO with authority to grant an extension of time to comply with a statutory time period (i.e., waive a statutory requirement), the petition is **DENIED**. Additionally, because the request for second interim patent term extension fails to comply with the timeliness requirement of § 156(d)(5)(C), the request for a second interim extension is **DENIED**.

Factual Background

1. On August 4, 1992, the USPTO granted U.S. Patent No. 5,135,759 (the '759 patent) to Lawrence A. Johnson who assigned his rights to the United States Department of Agriculture ("USDA").

2. On June 8, 2009, the USDA filed a request for interim patent term extension under the provisions of 35 U.S.C. § 156(d)(5). Because the patent was set to expire on August 4, 2009, the application on June 8, 2009 was timely filed within the period beginning 6 months and ending 15 days before the original expiration date of the patent as required by § 156(d)(5)(A).

3. On July 28, 2009, the USPTO granted an interim patent term extension pursuant to § 156(d)(5)(B) for the period of one year from the original expiration date of August 4, 2009,

through and including August 4, 2010. On August 4, 2009, notice of the grant of interim extension was published in the Federal Register in accordance with § 156(d)(5)(B).

4. On January 29, 2010, USDA filed a request to withdraw the interim extension granted on July 28, 2009 on the theory that the actual expiration date of the '759 patent was April 26, 2011 based on the change to § 154 under the Uruguay Round of Agreements Act ("URAA").

5. On July 27, 2010, USDA ("USDA" or "Petitioner") filed a petition under 37 C.F.R. §§ 1.182 and 1.183 ("Petition') along with a request for a second subsequent interim patent term extension pursuant to § 156(d)(5)(C). Petitioner alleges that it filed its second interim extension request late due to a shortcoming of an automated docketing system used by a law firm that represents Petitioner's licensee.

Decision

A. USPTO's previously granted interim extension was proper based on the August 4, 2009 expiration date.

Section 156(d)(5) sets forth certain criteria which must be met in order for the USPTO to grant an interim extension. First, the regulatory review period for the product claimed by the patent must be in the "approval phase," that is, "the period described in paragraphs (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of subsection (g) of § 156" must have begun for the product. See § 156(d)(5)(A). USDA met this requirement because their Premarket Approval application ("PMA") is undergoing continuing review at FDA. Second, an application must be submitted during the period beginning 6 months, and ending 15 days before such term [of the patent] is due to expire. See § 156(d)(5)(A). USDA met this requirement by submitting their application on June 8, 2009, clearly within 6 months prior to the August 4, 2009 expiration date and not less than 15 days before the August 4, 2009 expiration date. Section 156(d)(5)(A)(i)-(v) sets forth the information that the application for extension must contain. USDA's application fulfilled these statutory requirements. Under § 156(d)(5)(B), when the Director determines that the patent would be eligible for an extension of patent term under § 156, except for the permission for commercial marketing or use, the Director shall publish in the Federal register a notice of such determination, including the identity of the product under regulatory review, and shall issue to the applicant a certificate of interim extension for a period of not more than 1 year. Here, the USPTO accepted the timely application for interim extension filed by USDA on June 8, 2009, then USPTO fulfilled its statutory mandate set forth in § 156(d)(5)(B) and granted an interim extension for the '759 patent and provided notice of the interim extension grant by way of the Federal Register publication on August 4, 2009.

On January 29, 2010, USDA filed a request seeking withdrawal of the previously granted interim extension. The rationale for the request was that the '759 patent does not expire until April 26, 2011. According to the January 2010 request, the '759 patent, which was in force on June 8, 1995 (the effective date of the URAA), receives a patent term which is the greater of 17 years from grant or 20 years from the filing date of the application. Petitioner is correct regarding the ability of the '759 to acquire the longer of the two terms, but petitioner is incorrect

in its approach to calculating the 20-year term involved here, and hence its conclusion that the 20-year term is longer than the conventional 17-year term is also flawed.

Although USDA is correct that the actual filing date of the application which matured into the '759 patent was April 26, 1991, the trigger date for the twenty-year term for the '759 patent is actually May 10, 1989 (based on a benefit claim, under 35 U.S.C. § 120, in the '759 patent to an earlier application filed May 10, 1989). See 35 U.S.C. § 154(a)(2) (defining the start date of the 20-year term as the earliest application filing date to which the issued patent claims priority under 35 U.S.C. §§ 120, 121, of 365(c)). Thus, the expiration date of the '759 patent, which would be calculated as the greater of 17 years from grant (August 4, 2009) or 20 years from the earliest claimed filing date (May 10, 2009), was August 4, 2009. See 35 U.S.C. § 154(c) (providing that the term of a patent in force when the URAA was enacted is the longer of 17 years from grant or the expiration of the 20-year term provided in 35 U.S.C. § 154 (a)(2)).

Because the interim extension was properly granted, the USPTO will not withdraw the previously granted interim extension. Therefore, the request is denied. As a result, the expiration date of the '759 patent's initial interim extension is August 4, 2010.

B. 37 C.F.R. §§ 1.182 and 1.183 do not permit the USPTO to extend the time period to file an application for a subsequent interim patent term extension.

Because Peitioner's request for a second interim extension was not filed 30 days before the expiration of initial interim extension, Petitioner relies on the provisions of 37 C.F.R. §§ 1.182 and 1.183 to extend the time period within which to file a subsequent interim patent term extension application. Petition at 1. Both of these regulations relate to mechanisms for individuals to file petitions to seek waiver of a rule or relief from the enforcement of a rule.

In particular, 37 C.F.R. 1.182 addresses cases where there is no other specific rule which provides a mechanism for a petitioner to seek redress of a situation. Here, petitioner appears to be seeking a general extension of time within which to file a subsequent interim patent term extension application in accordance with 35 U.S.C. § 156(d)(5)(C) and 37 C.F.R. § 1.790(a). Although the USPTO has authority to grant relief over certain regulatory requirements, the USPTO has no authority to grant relief for failure to comply with a statutory requirement. Because the relief that petitioner seeks is from a statute, the USPTO, without any statutory authority to grant such relief, cannot excuse failure to comply with the statutory timing requirement of § 156(d)(5)(C), and thus, must deny the petition under 37 C.F.R. § 1.182.

Similarly, 37 C.F.R. § 1.183 addresses cases where, under extraordinary circumstances, waiver of a rule is necessary when justice would so require. Although petitioner alleges an extraordinary circumstance, that is, the failure of their computer docketing system to track the proper (or any) due date for a subsequent interim patent term extension application, waiver of a regulatory requirement would not provide sufficient relief such that the USPTO could accept the late filed subsequent interim patent term extension application. Petitioner's situation is controlled by statute, thus, there is no rule which can be waived which would provide sufficient relief. Accordingly, the USPTO must deny the petition under 37 C.F.R. § 1.183.

C. The plain meaning of 35 U.S.C. § 156(d)(5)(C) mandates that grant of a subsequent interim patent term extension is predicated on a timely filed subsequent application for interim extension.

Petitioner argues that the language, structure and purpose of § 156 give the USPTO discretion to authorize a second interim patent term extension outside the statutory timing window. Petition at 5. Petitioner argues that the meaning of "shall" in § 156(d)(5)(C) does not always mean a mandatory, nondiscretionary duty and should be interpreted by examining the language and purpose of the statute. Petition at 5.

The USPTO finds that the best definition of "shall" as used throughout section 156 indicates an imperative duty based upon the text, structure, and purpose of the statute. In making this determination, the USPTO notes that section 156(d) squarely deals with the procedural requirements for obtaining a patent term extension. In particular, section 156(d)(5)(C) is solely directed to the proper time period for submitting an application for a subsequent interim patent term extension. The USPTO's interpretation here is thus undertaken in the course of governing the conduct of its proceedings.

Any analysis of a statute begins with the language of the statute itself. The statutory provision at issue here reads:

> [t]he owner of record of a patent, or its agent, for which an interim extension has been granted under subparagraph (B), may apply for not more than 4 subsequent interim extensions under this paragraph . . . . Each such subsequent application ***shall*** be made during the period beginning 60 days before, and ending 30 days before, the expiration of the preceding interim extension.

35 U.S.C. § 156(d)(5)(C) (emphasis added). To determine what the term "shall" means, the USPTO looks to the words surrounding that term, namely the phrase, "[e]ach subsequent application shall be made during the period beginning 60 days before, and ending 30 days before, the expiration of the preceding interim extension." The statutory provision requires that an application be made. "A subsequent application shall be made" is interpreted to mean that the patent owner or his agent must submit an application to the USPTO. Because the USPTO can only act upon documents filed with the USPTO, the statute clearly requires a submission. If the timing requirement of § 156(d)(5)(C) were discretionary or non-essential as Petitioner argues, Congress could have ended the requirement and simply require an application be made. However, in enacting the provision Congress contemplated that the submission would be made to USPTO prior to expiration of the previously granted interim extension. In particular, Congress required a specific time period—during the period beginning 60 days before, and ending 30 days before the expiration of the previously granted interim extension—for submission of the application. By including a time period within which to file the subsequent interim patent term extension application, Congress sought to ensure timely consideration of the subsequent interim patent term extension application by the USPTO which, if the other statutory criteria were met, would result in issuance of a certificate of interim patent term extension. Thus, the plain meaning of "shall" in § 156(d)(5)(C) imposes an imperative duty upon any patent owner seeking additional term under § 156(d)(5).

1. The USPTO has previously interpreted the timing provision of § 156(d)(5)(C).

The provisions which were codified at 35 U.S.C. § 156(d)(5)(A)-et seq. were passed in Public Law 103-179 as part of the Patent and Trademark Office Authorization Act of 1993. Within two months of passage of the new interim patent term extension provisions, the USPTO issued guidelines regarding implementing the interim extension provisions in the Official Gazette, "Guidelines For Interim Extension Under 35 U.S.C. 156(d)(5) of a Patent Term Prior To Regulatory Approval of a Product For Commercial Marketing or Use--Public Law 103-179 (December 3, 1993)," 1159 Off. Gaz. Pat. Office 12 (February 1, 1994) (copy attached as exhibit 1). There, the USPTO explained that the conditions for interim extension of patent term required an application to be submitted:

> . . .during the period beginning 6 months, ending 15 days, before the expiration of the patent term; or in the case of a subsequent interim extension, during the period beginning 60 days before, and ending 30 days before, the expiration of the preceding interim extension.

1159 Off. Gaz. Pat. Office 12 § B.

Following the initial guidelines for interim patent term extensions under 35 U.S.C. § 156(d)(5) of February of 1994, in accordance with 35 U.S.C. § 2(a)(2)(A), the USPTO engaged in notice and comment rulemaking contemporaneous with the passage of the statute. There the USPTO promulgated new regulations to govern conduct before the agency with respect to applications for interim patent term extension involving patents claiming products which are under on-going regulatory review. The USPTO issued a notice of proposed rulemaking in November of 1994 providing the regulatory framework for submission of applications for interim patent term extension under 35 U.S.C. § 156(d)(5). See 59 Fed. Reg. 56015 (November 10, 1994). After receiving a single comment relating to the scope of a proper applicant for patent term extension, the USPTO issued the final rules which implement the provisions of Public Law 103-179 relating to interim patent term extension. See 60 Fed Reg. 25616 (May 12, 1995). Additionally, the USPTO, in providing further guidance on the implementation of the Hatch-Waxman Act in the Manual of Patent Examining Procedure ("MPEP") explain at MPEP 2755, that "a series of one-year interim extension may be granted if requested in a timely manner (in the window of time between thirty and sixty days before the extended expiration date)." In issuing contemporaneous guidelines, promulgating regulations and including guidance in the MPEP regarding the filing window for subsequent applications under 35 U.S.C. § 156(d)(5)(C), the USPTO has previously provided its statutory interpretation of the provision at issue here.

2. The USPTO has no discretion to issue a subsequent interim patent term extension under 35 U.S.C. § 156(5)(d)(C) without a timely filed subsequent interim patent term extension application.

Petitioner urges that based on their construction of "shall" in § 156(d)(5)(C), the USPTO has discretion to accept a late filed subsequent interim patent term extension application and this is an appropriate case to exercise that discretion. Petition at 10. While the USPTO appreciates the importance of the '759 patent to USDA and is aware of the impact a denial of an interim patent term extension may have on the USDA, the statutory time period is non-discretionary.

That is, § 156(d)(5) neither provides for a grace period, nor gives the USPTO discretion to extend the time period for submitting a subsequent interim patent term extension application. As such, the PTO is bound by statute to implement the provisions of § 156(d)(5)(C), including the timeliness provisions.

The USPTO must adhere to the Congressional mandate of § 156(d)(5)(C) that, "[e]ach such subsequent application shall be made during the period beginning 60 days before, and ending 30 days before, the expiration of the preceding interim extension." Because USDA's application was filed 8 days before expiration preceding interim extension (i.e., outside of the period beginning 60 days before, and ending 30 days before the expiration of the preceding interim extension), the application is untimely and must be denied.

Petitioner also indicates that should the USPTO grant the second interim extension and believe that a sanction is appropriate, the sanction could be to subtract the time of the late filing from the time of the extension granted. Petition at 10-11. There is no provision in any part of title 35 of the United States code which gives authority to the USPTO to grant an interim patent term extension for a late filed subsequent application for interim extension and certainly no authority to administer a sanction if the USPTO could extend the period within which to file a subsequent interim patent term extension application.

D. Petitioners arguments regarding statutory construction are unpersuasive

Petitioner argues that the statute "requires" the timely filing (by using "shall") and the rule uses "may." Petition at 6. At the outset, Petitioner's argument fails to appreciate the "if" at the end of the introduction to 37 C.F.R. 1.720(a). Specifically, the rule states, "[t]he term of a patent may be extended ***if***." The use of "if" in the rule language serves to require certain information in order for the Director to have authority to issue an extension. Thus, the "may" to which petitioner refers, when read in conjunction with the "if" of the phrase, actually means "may only." In essence, the USPTO may only grant a patent term extension if certain conditions are met. Because the USPTO may only grant a patent term extension if certain conditions are met, the "may. . . if" of 37 C.F.R. § 1.720 has the effect of requiring a timely filing, i.e. "shall." The USPTO's use of "may . . .if" does not mean that the USPTO is departing from "shall."

Petitioner points out that when Congress repeats the same word in the same statute, it intends for that word to have the same meaning. Petition at 6 (quoting *The Medicines Company v. Kappos*, ____F.Supp._____, 2010 WL 1005261 *5-8 (E.D. Va. March 16, 2010)). Were the USPTO to accept Petitioner's argument that "shall" is discretionary in § 156(d)(5)(C) and apply the other tenet that Petitioner espouses, namely that the same word in the same statute should be given the same meaning, would inherently mean that when an applicant for patent term extension fulfills the statutory requirements for receiving a certificate of extension, the USPTO could, within their discretion, choose to deny the grant of a certificate of interim extension.

As an example, section 156(d)(5)(B), the statutory provision under which an initial interim extension must be filed for a patent claiming a product undergoing continuing regulatory review, uses "shall" in two different instances. The statute provides:

> [i]f the Director determines that, except for permission to market or use the product commercially, the patent would be eligible for extension of the patent term under this section [§ 156], the Director

> ***shall*** publish in the Federal Register a notice of such determination, including the identity of the product under regulatory review and ***shall*** issue to the applicant a certificate of interim extension for a period of not more than 1 year.

See § 156(d)(5)(B) (emphases added). The first imperative is that the Director ***shall*** publish a notice of the grant of an interim extension in the Federal Register. The second imperative is that the Director ***shall*** issue the certificate of interim extension for a period of not less than 1 year. Applying Petitioner's rationale that "shall" is discretionary, when the patent owner has met the requirements of the statute, the USPTO could, within their discretion, choose to deny the certificate of interim extension. Clearly, such a reading would not further the letter of the law and would be contrary to the intent of the patent term restoration provisions of the Hatch-Waxman Act. Additionally, as noted by the use of "shall" the statutory scheme does not give the USPTO any latitude to not grant an extension. Thus, since "shall" indicates an imperative duty upon the USPTO to grant an extension when the statutory requirements have been met, the same recitation of "shall" can admit of no other reading than an imperative duty upon the applicant to timely submit a subsequent interim patent term extension application.

Furthermore, Petitioner's reading fails to comport with the plain meaning of the statute and the mandate articulated by the court in *Merck & Co. Inc. v Hi-Tech Pharmacal Co., Inc.*, 482 F.3d 1317 (Fed. Cir. 2007). As Petitioner accurately notes from *Merck*, the Federal Circuit held that "shall be extended" indicated an imperative. Petitioner notes that other parts of § 156 "require a more flexible interpretation." Petition at 6. While the *Merck* court did note that some parts of § 156 are flexible, the "flexibility" noted by the *Merck* court was in relation to the meaning of "original expiration date" as stated in § 156(a) in light of the Uruguay Round Agreements Act when the issue of "original expiration date" was litigated in *Merck & Co. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996). There was no suggestion by the *Merck* court in 2007 or the earlier *Merck* court in 1996 that the recitation of "shall" throughout § 156 was anything other than imperative duty.

Next Petitioner argues that the USPTO has indicated that the timing provision of § 156(d)(1) is remedial as stated in the USPTO's letter to FDA of July 12, 1988, in U.S. Patent No. 4,146,029, and as such, should be liberally construed. Petition at 6. First, the timeliness language of § 156(d)(1) and § 156(d)(5)(C) are not the same, one is in reference to a time period following the grant of permission for commercial marketing or use of the product subject to the regulatory review period and the other is in reference to days before expiration of a preceding interim extension. Second, this document is not "precedent" or a "decision, " but instead is simply a letter from USPTO to FDA wherein USPTO expresses the opinion that the date of FDA approval should be excluded from the sixty-day count for purposes of § 156(d)(1)—a view USPTO has since repudiated and because it involves a different statutory provision, irrelevant to the calculus here. Third, while section 156, and more generally the Hatch-Waxman Act, in part, was certainly meant to remedy the loss of effective patent term due to lengthy regulatory delay, it does not follow that every provision within section 156 is "remedial." In section 156(d)(5)(C), Congress provided a window within which a patentee can file its subsequent interim patent term extension application. No provision for extension of the time period is included. By creating such a non-extendable period, Congress provided a date-certain by which all players would know their future rights.

Petitioner has accurately pointed out instances where the USPTO has interpreted statutory provisions in order to ensure no loss of rights to applicants and patentees. Petition at 7. In all of those instances, Congress has provided the avenue for the relief available at the agency, and thus to the applicant or patentee. In light of that, it speaks volumes that Congress provided no avenue to allow the USPTO to accept a late subsequent interim patent term extension application filed under section 156(d)(5)(C). Given Congress's unquestionable awareness that lawyers make mistakes, and the various provisions it provided to redress those mistakes, Congress's failure to include a similar provision related to the section 156(d)(5)(C) thirty to sixty day filing window compels the conclusion that Congress did not intend the provision to be remedial, or to be interpreted in a way that benefits late-filing applicants.

Petitioner argues that the USPTO has discretion because the time window set forth in § 156(d)(5)(C) is not essential to § 156. Petition at 7. Although Petitioner states that the time window is a detail of procedure, Petitioner fails to point to any statutory language or legislative history which would indicate that the timing requirement is not essential or merely a detail of procedure. When Congress used the word "shall," in section 156, contrary to the position of Petitioner, Congress intends for the action by the administrator of the statute to be an imperative duty. See *Merck & Co. v. Hi-Tech Pharmacal Co.* at 1322. Furthermore, to make the timing requirement of § 156(d)(5)(C) non-essential would mean that the public notice function of § 156(d)(5)(B) would not be served since there would be no timely publication of the notice that a patent was being extended based on the on-going regulatory review of a product claimed by the patent.

Petitioner next urges that equity weighs in favor of granting the untimely filed subsequent interim patent term extension application. However, the Federal Circuit has pointed out that interpreting the timing requirement of § 156(d)(1) is "purely a case of statutory interpretation, so any equitable considerations" are inappropriate. See *Unimed, Inc. v. Quigg*, 888 F.2d 826, 829 (Fed. Cir. 1989). Thus, similarly, interpreting the timing requirement of § 156(d)(5)(C) would also involve pure statutory construction, and as such, any equitable consideration would not be appropriate.

Petitioner cites to *Blacklight Power Inc. v. Rogan*, 295 F.3d 1269 (Fed. Cir 2002) for the proposition that the meaning of "shall" in § 156(d)(5)(C) does not always mean a mandatory, nondiscretionary duty and should be interpreted by examining the language and purpose of the statute. Petition at 5 and 8. It is noted that the Federal Circuit's discussion of the use of "shall" in a different statutory provision, 35 U.S.C. § 151, was indeed mandatory:

> [w]e agree with the PTO that while the words, "shall issue" indeed impose a duty, the preface to § 151 places a condition on that duty. This preface conditions not only the issuance of the notice of allowance, but also the ensuing steps of § 151. . . .Section 151 does not prohibit the Office from interrupting the sequence if the condition set forth in the opening clause is reasonably believed not to have been met.

Blacklight at 1273.

In *Blacklight*, the preface condition, "[i]f it appears that applicant is entitled to a patent under the law," was not met. Thus, even though the remaining "steps" of § 151 had been met, the USPTO

was within its authority when it withdrew the application from issue in order to fulfill their obligation of issuing valid patents. *Id.*

In the *Blacklight* case, the USPTO did not exercise discretion in its interpretation of "shall" in §151. Rather, because issuance of a patent is predicated on entitlement "to a patent under the law," the USPTO recognized, albeit after payment of the issue fee, that the applicant in *Blacklight* did not appear to be entitled to a patent under the law. Thus, the USPTO adhered to their statutory mandate because, even though the issue fee was paid, the "written notice of allowance" (§ 151, ¶1) was premature in *Blacklight* since the applicant failed to comply with all of the patent laws.

In *Ute Indian Tribe v. Hodel*, 673 F.Supp. 619, 620 (D.D.C 1987), the court there held that the fiduciary duty of the Secretary as trustee overcame the "shall" language. *Ute Indian Tribe* at 622. In that case, although there was "discretion" by the Secretary to decide whether to approve per capita payments from the judgment fund, the discretion was only due to the stringent fiduciary duty as trustee, such fiduciary duty is clearly not present here. Id.

Petitioner urges that the court held in *The Medicines Company v. Kappos*, ____ F.Supp. 2d _____, 2010 WL 1005261, at *5-8, that the USPTO abused its discretion in denying an extension application filed outside the 60 day time period of § 156(d)(1). Petitioner's characterization of *The Medicines Company* decision does not comport with the actual holding of the case. There the court vacated the previously issued denial and remanded the case back to the agency with instructions that the USPTO had discretion to consider a business day construction of the word "date" in § 156(d)(1) of the statute and that the USPTO must properly address every argument of the applicant for extension in their request for reconsideration. Moreover, the issue in *The Medicines Company* was whether the application for patent term extension PTE was actually timely filed based on construction of the term "date" in § 156(d)(1). The issue was not whether the PTO has discretion to accept a late filed patent term extension application in general. Specifically, any discretionary authority by the USPTO to accept a late filed application for patent term extension was not at issue. Under The Medicines Company's construction, their application for patent term extension was timely based on construing the word "date" in § 156(d)(1) as business date. Here, Petitioner admits that their application for a subsequent interim patent term extension is late.

In summary, as discussed *supra*, "shall" imposes upon the USPTO an imperative duty. Accordingly, the USPTO has no authority to accept a late filed subsequent interim patent term extension application and thus cannot grant the petition for an extension of the time period in § 156(d)(5)(C) to file a subsequent interim patent term extension application.

CONCLUSION

1. The request for withdrawal of interim extension filed January 29, 2010 is **denied**. The petition filed July 27, 2010 for an extension of the timeliness requirement in § 156(d)(5)(C) for filing a subsequent interim patent term extension application is **denied**. The request for subsequent interim patent term extension is **denied**.

2. This decision is designated a **final agency action** within the meaning of 5 U.S.C. § 704.

3. Telephone inquiries related to this decision should be directed to Mary C. Till, Legal Advisor, at (571) 272-7755

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

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

Brian E. Hanlon

Brian E. Hanlon
Director
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

Reg. No.	Serial No.	Reg. Date
954,702	72/418,096	3/06/1973
954,708	72/399,766	3/06/1973
954,714	72/409,562	3/06/1973
954,715	72/391,295	3/06/1973
954,716	72/397,761	3/06/1973
954,718	72/406,791	3/06/1973
954,721	72/408,453	3/06/1973
954,722	72/373,829	3/06/1973
954,727	72/378,860	3/06/1973
954,733	72/368,280	3/06/1973
954,735	72/380,477	3/06/1973

Response Requested to 1993 Patent Examiner's Action Survey

As part of the continuing quality reinforcement efforts of the Patent and Trademark Office, the Office has sent out a Patent Action Survey Form with each Patent Examiner's Office action mailed during a period of several weeks during December, 1993-January, 1994. **If you have received one or more of these forms, please complete each one, no later than the time of response to the Office action being surveyed.**

The survey is intended to determine whether Office actions are perceived to be clear and complete on certain specific and important items related to patent examining practices and procedures. The results of the survey will be used in the development of Office training programs. The survey is a follow-up to the Patent Action Surveys conducted in 1991 and 1992. Where training is provided to address identified deficiencies in performance, follow-up surveys are intended to be conducted in the future to determine whether the training was effective enough to improve performance in the measured areas.

The Survey Form is brief and easy to complete and does not permit identification of the respondent or of the particular application involved. The Survey Form may be completed at the time of response to the Office Action. It is possible that a practitioner may receive many Office Actions containing a Survey Form during the survey period. To have results that are meaningful, the Office needs a high response rate. Therefore, it is **important** that patent practitioners complete each survey form **no later than the time of response to the Office action being surveyed.** To assure that this form is completed and mailed back to the address indicated on the Survey Form, it would be desirable for patent practitioners to have their office managers/docketing personnel take appropriate steps to keep the form and Office action together for the practitioner's benefit.

Your cooperation in completing the Survey Form is appreciated.

Nov. 16, 1993

STEPHEN G. KUNIN
Acting Assistant Commissioner for Patents

GUIDELINES FOR INTERIM EXTENSION UNDER 35 U.S.C. § 156(d)(5) OF A PATENT TERM PRIOR TO REGULATORY APPROVAL OF A PRODUCT FOR COMMERCIAL MARKETING OR USE - PUBLIC LAW 103-179 (December 3, 1993)

This notice is intended to establish initial guidelines for patent owners who are seeking interim extensions of patent terms pursuant to newly enacted 35 U.S.C. § 156(d)(5). These guidelines will be in effect until further notice. These guidelines do not affect the rights of a patent owner or the procedures to request interim extensions under 35 U.S.C. § 156(e)(2).

Section 156(d)(5)(A) of Title 35, United States Code, provides that a patent owner seeking an interim extension of the terms of a patent pursuant to its provisions must submit an application to the Commissioner of Patents and Trademarks (Commissioner) within a certain defined period of time. Section 156(d)(5) specifies certain components the application is to contain, including "such patent or other information as the Commissioner may require." See 35 U.S.C. § 156(d)(5)(A)(v). Section 156(h) provides that the "Commissioner may establish such fees as the Commissioner determines appropriate to cover the costs to the Office of receiving and acting upon applications under this section." The purpose of this notice is to provide guidelines which a patent owner or its agent should use in (1) deciding whether the requirements for the submission of an application for an interim extension of the term of a patent are satisfied, and (2) making the submission of such an application to the Patent and Trademark Office.

This notice includes guidelines as to the actual content of an application for interim extension of the term of a patent. The guidelines should be used in determining whether a patent is subject to, and meets the conditions for interim extension of its term under section 156(d)(5). The guidelines should also be used in preparing and filing an application for interim extension of the patent term. If any application for interim extension of the term of a patent is filed in accordance with 35 U.S.C. § 156(d)(5), but is not in compliance with the requirements of this notice, applicant will be notified of the deficiences in the application and will be given a period of time within which to correct the deficiences.

GUIDELINES

§ A. Patents eligible for interim extension of the patent term.

(a) Any patent which claims a product as defined in paragraph (b) of this section, or a method of using such a product, is eligible for an interim extension of its patent term in accordance with 35 U.S.C. § 156(d)(5).

(b) The term "product" referred to in paragraph (a) of this section means a product as defined in 35 U.S.C. 156(f).

§ B. Conditions for interim extension of patent term.

A patent may be granted an interim extension of its term if:

(a) the patent claims a product or a method of using or manufacturing a product as defined in § A of this notice;

(b) the term of the patent has been extended under 35 U.S.C § 156(e);

(c) an application for interim extension under § 156(d) is submitted pursuant to § E of this notice;

(d) the product is currently undergoing a regulatory review as described in paragraph (1)(B)(ii), (2)(B)(ii), (3)(B)(ii), (4)(B)(ii), or (5)(B)(ii) of 35 U.S.C. § 156(g);

(e) the product has not received permission for commercial marketing or use; or, in the case of a patent claiming a method of manufacturing a product which primarily uses recombinant DNA technology in the manufacture of the product, no permission for commercial marketing or use has been granted for a product manufactured under the process claimed in the patent; and,

(f) the application is submitted during the period beginning 6 months, ending 15 days, before the expiration of the patent term; or, in the case of a subsequent interim extension, during the period beginning 60 days before, and ending 30 days before, the expiration of the preceding interim extension.

§ C. Applicant for interim extension of patent term.

Any application for interim extension of a patent term must be submitted by the owner of record of the patent or its agent and must comply with the requirements of § E of this notice.

§ D. Filing date of application for interim extension of patent term.

(a) The filing date of an application for interim extension of patent term is the date on which a complete application is received in the Patent and Trademark Office, or filed pursuant to the "Certificate of Mailing" provisions of 37 CFR § 1.8 or "Express Mail" provisions of 37 CFR § 1.10.

A complete application shall include:

(1) identification of the product then under regulatory review;

(2) identification of each Federal statute under which regulatory review is occurring;

(3) identification of the patent for which an interim extension is sought;

(4) identifiation of each claim of the patent which claims the product or a method of using or manufacturing the product then under regulatory review;

(5) sufficient information to enable the Commissioner to determine that, except for permission to market or use the product commercially, the patent would be eligible for an extension of its term under 35 U.S.C. § 156; and,

(6) a brief description of the activities undertaken by the applicant during the applicable regulatory review period with respect to the product or a method of using or manufacturing the product then under regulatory review and the significant dates applicable to such activities.

(b) If any application submitted pursuant to this section is held to be incomplete, applicant may seek to have this holding reviewed under 37 CFR § 1.181.

§ E. Application for interim extension of patent term.

(a) An application for interim extension of a patent term must be made in writing to the Commissioner of Patents and Trademarks.

(b) A formal application for interim extension of the patent term shall include:

(1) a complete identification of the product under regulatory review as by appropriate chemical and generic name, physical structure or characteristics, and, where the requested extension is based on a method claim, the method of using or method of manufacturing the product then under regulatory review;

(2) a complete identification of the Federal statute including the applicable provision of law under which the regulatory review is occurring;

(3) in the case of a human drug product, an identification of each active ingredient in the product and as to each active ingredient, a statement that it has not been previously approved for commercial marketing or use under the Federal Food, Drug and Cosmetic Act, the Public Health Service Act, or the Virus-Serum-Toxin Act, or a staement of when the active ingredient was approved for commercial marketing or use (either alone or in combination with other active ingredients) the use for which it was approved, and the provision of law under which it was approved;

(4) a statement that the application is being submitted within the period permitted for submission pursuant to § B of this notice, and an identification of the date of the first and last days on which the application could be submitted;

(5) a complete identification of the patent for which an interim extension is sought by the name of the inventor, the patent number, the date of issue, and the date of expiration;

(6) a copy of the patent for which an interim extension is sought, including the entire specification (with claims) and drawings;

(7) a copy of any disclaimer, certificate of correction, receipt of maintenance fee payment, or reexamination certificate issued in the patent;

(8) a statement that the patent claims the product or a method of using or manufacturing the product under regulatory review, and a showing which lists each applicable patent claim and demonstrates the manner in which each applicable patent claim reads on the product or a method of using or manufacturing the product under regulatory review;

(9) a statement beginning on a new page, of the relevant dates and information pursuant to 35 U.S.C. § 156(g) of the applicable current regulatory review period as follows:

(i) for a patent that claims a human drug, antibiotic, or human biological product, the effective date of the investigational new drug (IND) application and the IND number, and the date on which a new drug application (NDA) or a Product License Application (PLA) was initially submitted and the NDA or PLA number;

(ii) for a patent claiming a new animal drug, the date a major health or environmental effects test on the drug was initiated and any available substantiation of the date or the date of an exemption under subsection (j) of section 512 of the Federal Food, Drug and Cosmetic Act became effective for such animal drug; and the date on which a new animal drug application (NADA) was initially submitted and the NADA number;

(iii) for a patent claiming a veterinary biological product, the date the authority to prepare an experimental biological product under the Virus-Serum-Toxin Act became effective; and the date an application for license was submitted under the Virus-Serum-Toxin Act;

(iv) for a patent claiming a food or color additve, the date a major health or environment effects test on the additive was initiated and any available substantiation of that date; and the date on which a petition for product approval under the Federal Food, Drug and Cosmetic Act was initially submitted and the petition number;

(v) for a patent claiming a medical device, the effective date of the investigational device exemption (IDE) and the IDE number, if applicable, or the date on which the applicant began the first clinical investigation involving the device if no IDE was submitted and any available substantiation of that date; and the date on which any application for product approval or notice of completion of a product development protocol under section 515 of the Federal Food, Drug and Cosmetic Act was initially submitted and the number of the application;

(10) a brief description beginning on a new page of the significant activities undertaken by the applicant during the applicable regulatory review period with respect to the product under regulatory review and the significant dates applicable to such activities;

(11) a statement that applicant acknowledges a duty to disclose to the Commissioner of Patents and Trademarks any information which is material to the determination of entitlement to the interim extension sought;

(12) the prescribed fee for receiving and acting upon the application for extension (see § F of this notice);

(13) the name, address, and telephone number of the person to whom inquires and correspondence relating to the application for interim patent term extension are to be directed;

(14) a duplicate of the application papers, certified as such; and,

(15) an oath or declaration as set forth in paragraph (c) of this section.

(c) Any oath or declaration submitted in compliance with paragraph (b) of this section must be signed by the owner of record of the patent or its agent, specifically identify the papers and the patent for which an interim extension is sought and aver that the person signing the oath or declaration;

(1) is the owner, an official of a corporate owner authorized to obligate the corporation, or a patent attorney or agent authorized to practice before the Patent and Trademark Office and who has general authority from the owner to act on behalf of the owner in patent matters;

(2) has reviewed and understands the contents of the application being submitted pursuant to this section;

(3) believes the patent is eligible for extension pursuant to § A of this notice;

(4) believes an interim extension is justified under 35 U.S.C. § 156(d)(5) and the guidelines of this notice; and,

(5) believes the patent for which the extension is being sought meets the conditions for interim extension of the term of a patent as set forth in § B on this notice.

(d) If any application for interim extension of patent term submitted pursuant to this section is held to be informal, applicant may seek to have that holding reviewed by filing a petition with the required fee, as necessary, pursuant to 37 C.F.R. §§ 1.181, 1.182 or 1.183, as appropriate, within such time as may be set in the notice that the application has been held to be informal, or if no time is set, within one month of the date on which the application was held informal. The time periods set forth herein are subject to the provisions of 37 C.F.R. § 1.136.

§ F. Fees for receiving and acting on application filed pursuant to 35 U.S.C § 156(d)(5).

Pursuant to 35 U.S.C. § 156(h), the Commissioner has determined that the following fees are appropriate to cover the costs to the Patent and Trademark Office of receiving and acting upon applications for interim patent terms extension filed pursuant to 35 U.S.C. § 156(d)(5):

(a) for an initial application for "interim extension" under 35 U.S.C. § 156(d)5(A): $400.00; and,

(b) for each application requesting a "subsequent interim extension" under 35 U.S.C. § 156(d)(5)(C): $200.00.

The appropriate fee should accompany the application when filed. If a fee in a different amount is adopted in Title 37 of the Code of Federal Regulations, applicant will be refunded any excess or required to submit any deficiency.

§ G. Address for filing applications pursuant to 35 U.S.C. § 156(d)(5).

All applications for interim extension of the term of a patent and any communications relating thereto should be addressed to the Commissioner of Patents and Trademarks, Box Patent Ext., Washington, D.C., 20231. When appropriate, the communication should be marked to the attention of a particular individual.

§ H. Termination of Interim Extension.

Any interim extension granted under 35 U.S.C. § 156(d)(5) terminates at the end of the 60-day period beginning on the date on which the product involved receives permission for commercial marketing or use. If within that 60-day period the patent owner or its agent files additional information required under 35 U.S.C. § 156(d)(1) not contained in the application for interim extension, the patent shall be further extended in accordance with the provisions of 35 U.S.C. § 156.

§ I. For further information contact:

Charles E. Van Horn by telephone at (703) 305-9054 or Gerald A. Dost by telephone at (703) 305-8813; or by mail marked to their attention and addressed to the Commissioner of Patents and Trademarks, Washington, D.C., 20231.

Summary

The initial guidelines set forth above are considered to be appropriate and authorized by 35 U.S.C. § 156. They will provide appropriate guidelines to patent owners and their agents pending appropriate changes which will be made in Title 37 of the Code of Federal Regulations.

Jan. 6, 1994

BRUCE A. LEHMAN
Assistant Secretary of Commerce and Commissioner of Patents and Trademarks

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DEPARTMENT OF COMMERCE

Patent and Trademark Office

Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedures on Trademark Trial and Appeal Board Inter Partes Proceedings

Trademark Rule 2.116(a) provides that, except as otherwise provided, and wherever applicable and appropriate, procedure and practice in Trademark Trial and Appeal Board (Board) inter partes proceedings shall be governed by the Federal Rules of Civil Procedures. Trademark Rule 2.120(a) provides, in part, that the provisions of the Federal Rules of Civil Procedure relating to discovery shall apply in opposition, cancellation, interference, and concurrent use registration proceedings except as otherwise provided in Trademark Rule 2.120; and that the opening of discovery is governed by the Federal Rules of Civil Procedure. Thus, where the Board has its own rule concerning a particular matter of practice or procedure, that rule governs; if there is no Board rule concerning the matter, the Federal Rules of Civil Procedure apply, where applicable and appropriate.

On December 1, 1993, certain of the rules in the Federal Rules of Civil Procedures were amended, and one new rule was added. Specifically, Rules 1, 4, 5, 11, 12, 15, 16, 26, 28, 29, 30, 31, 32, 33, 34, 36, 37, 38, 50, 52, 53, 54, 58, 71A, 72, 73, 74, 75, and 76 were amended, and new Rule 4.1 was added. Included in the amendments are changes in the discovery rules to require that the parties to a civil action: (1) make a series of automatic disclosures, during the pretrial stages of the proceedings, of certain evidence; (2) file the disclosures with the court; (3) meet, early in the proceeding, to discuss, inter alia, the automatic disclosure and to develop a plan for discovery; and, (4) transmit to the court a written report outlining the discovery plan. The timing of some of these matters is tied to the timing of a scheduling conference to be held, or a scheduling order to be issued, by the court. The timing and sequence of other of the matters depends upon the direction of the court. Further, parties are prohibited from seeking any of the traditional forms of discovery until after they have met and developed their discovery plan.

The Patent and Trademark Office (Office) believes that the application of the cited provisions in inter partes proceedings before the Board would increase the complexity and cost of the proceeedings and would be unduly burdensome both to the Board and the parties. For these reasons, the Office is now of the opinion that these provisions would have a detrimental effect on, and are not appropriate for, Board proceedings. Moreover, the Office's Public Advisory Committee for Trademark Affairs has recommended that incorporation of the amendments in Board practice be deferred until the Office can evaluate the effects of the amendments on civil actions. On the other hand, some of the provisions added by the amendments are not objectionable, and others so clearly do not apply in, and/or are not appropriate for, Board proceedings that they need not be mentioned.

Accordingly, application of Rule 2.120(a) is hereby waived, in pertinent part, to the extent that the following provisions of the Federal Rules of Civil Procedure, as amended, which otherwise arguably would apply in Board proceedings, and which would, in the opinion of the Office, have a detrimental effect on those proceedings, shall not be applied therein unless and until further notice is given:

1. **Rule 16(b)** [requirement that court issue a scheduling order, after consulting with parties by scheduling conference, telephone, mail, or other suitable means]

2. **Rules 26(a)(1)-26(a)(4)** [requirements for series of automatic disclosures of evidence]

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

MAILED

MAR 14 2011

OFFICE OF PETITIONS

RONALD ZIBELLI
XEROX CORP.
XEROX SQUARE 020
ROCHESTER NY 14644

In re Application of

Williams, et al.

Application No. 07/715,258

Filed: June 14, 1991

Attorney Docket No. **DS/91068**

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181(a) to withdraw the holding of abandonment, filed February 8, 2011.

The petition under 37 CFR 1.181(a) to withdraw the holding of abandonment is **granted**.

This application was held abandoned on November 21, 2010, after it was believed that no response was received to the Notice of Allowance and Issue Fee Due. The notice allowed a s statutory period for reply of three (3) months from its mailing date. Extensions of the time set for reply were available pursuant to 37 CFR 1.136(a). A Notice of Abandonment was mailed on December 3, 2010, indicating that a reply to the notice was not received.

A review of the application file record did reveal that a response to the Notice of Allowance and Issue Fee Due was filed on September 7, 2010, in the form of payment of the issue fee and a completed Form PTOL-85b. Based on the aforementioned, it appears that the application was improperly held abandoned as a response was received prior to expiration of the statutory period for reply. The holding of abandonment is withdrawn, accordingly.

The application file is being forwarded to the Office of Data Management for further processing.

Further inquires regarding this decision may be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

RONALD ZIBELLI
XEROX CORPORATION
XEROX SQUARE 020
ROCHESTER NY 14644

MAR 03 2011

In re Application of :
BRIGHT, STEPHEN K. et al. :
Application No.: 07/715,840 : DECISION ON
Filing or 371(c) Date: June 14, 1991 : PETITION
Attorney Docket Number: DS/91065 :

This is a decision on the Petition to Withdraw Holding of Abandonment received in the United States Patent and Trademark Office (USPTO) on February 8, 2011.

This petition is **GRANTED**.

The application was inadvertently abandoned for failure to timely submit the Issue Fee and Publication fee as required by the Notice of Allowance mailed August 20, 2010 which set forth a three (3) month statutory period of reply. The Notice of Abandonment was mailed on December 7, 2010.

Petitioner states that the issue fee transmittal and payment were timely filed via the USPTO on September 7, 2010. Petitioner submitted a copy of the original submission which included a properly completed Certificate of Mailing/Transmission. As authorized, the issue fee of $860.00 was charged to Deposit Account.

In view of the foregoing, the holding of abandonment for failure to timely pay the issue fee is hereby withdrawn and the application restored to pending status.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 756-1547.

Kay D. Pinkney
Application Assistance Unit
Office of Data Management

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 18 2011

John D. Conway
sanofi-aventis U.S. Inc.
U.S. Patent Operations
Route #202-206/P.O. Box 6800
MAILCODE: BWD-303A
Bridegwater, NJ 08807-0800

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,223,510

Dear Mr. Conway:

An interim extension under 35 U.S.C. § 156(e)(2) is enclosed extending the term of U.S. Patent No. 5,223,510 for a period of 1 year. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates set forth in the Patent and Exclusivity Data Appendix of the Orange Book (Approved Drug Products with Therapeutic Equivalence Evaluations) or in the Patent Information set forth in the Green Book (FDA Approved Animal Drug Products). Effective August 18, 2003, patent submissions for publication in the Orange Book and Docket *95S-0117 need to be submitted on form FDA-3542 which may be downloaded from FDA's Electronic Forms Download Website: http://www.fda.gov/opacom/morechoices/fdaforms/default.html (http://www.fda.gov/opacom/morechoices/fdaforms/FDA-3542.pdf).

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

Attention: Beverly Friedman

RE: MULTAQ® (dronedarone hydrochloride)
Docket No.: FDA-2009-E-0039

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Sanofi-Aventis	:	
Request for Patent Term Extension	:	ORDER GRANTING
U.S. Patent No. 5,223,510	:	INTERIM EXTENSION

Sanofi-Aventis, the owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 5,223,510, filed an application for patent term extension under 35 U.S.C. § 156 on August 20, 2009. The original term of the patent is due to expire on July 26, 2011. Applicant filed a request for interim extension on April 20, 2011. The patent claims the active ingredient, dronedarone hydrochloride, in the human drug product MULTAQ® which was approved by the Food and Drug Administration for commercial marketing or use on July 1, 2009. An extension of 5 years is requested.

The initial USPTO review of the application to date indicates that the subject patent is eligible for extension of the patent term under 35 U.S.C. § 156. A final determination of the length of the extension of the patent term and issuance of a patent term extension certificate cannot be made until a final determination of the length of the regulatory review period is made. Because the original term of the patent would expire before a certificate of patent term extension can be issued, an interim extension of the patent term is appropriate.

An interim extension under 35 U.S.C. § 156(e)(2) of the term of U.S. Patent No. 5,223,510 is granted for a period of one year from the original expiration date of the patent.

July 8, 2011

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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

MAILED
MAY 02 2011
OFFICE OF PETITIONS

In re Patent No. 5,413,732 :
Issue Date: May 9, 1995 :
Application No. 07/747,179 : ON PETITION
Filed: August 19, 1991 :
Attorney Docket No. ABAX-009/00US :
010265-2059

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed February 9, 2011.

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

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

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

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

A. Kelley

Alicia Kelley
Petitions Examiner
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5648789	1997-07-15	07769849	1991-10-02	SLM-76073

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/john k. fitzgerald/	Date (YYYY-MM-DD)	2010-12-07
Name	John K. Fitzgerald	Registration Number	38881

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5648789
Issue Date: July 15,1997
Application No. 07769849
Filed: October 2,1991
Attorney Docket No. 2779.035443

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed December 7,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of December 7,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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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Paper No.

WENDEROTH, LIND AND PONACK,LLP
2033 K STREET, N.W., SUITE 800
WASHINGTON DC 20006

MAILED

FEB 22 2012

OFFICE OF PETITIONS

In re Application of :
Tsutsumi et al. :
Application No. 07/794,016 :
Patent No.: 5,206,204 : DECISION ON RENEWED PETITION
Filed: November 19, 1991 : PURSUANT TO
Issued: April 27, 1993 : 37 C.F.R. § 1.28(c)
Title: ABSORBENT FOR LOWER :
ALDEHYDES :

This is a notice regarding your renewed request for acceptance of a fee deficiency submission pursuant to 37 C.F.R. § 1.28, received on April 24, 2006. 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.

37 C.F.R. § 1.28(c)(2)(ii) sets forth that the party submitting the deficient payment must include:

(a) Each particular type of fee that was erroneously paid as a small entity, (e.g., basic statutory filing fee, two-month extension of time fee) along with the current fee amount for a non-small entity;
(b) The small entity fee actually paid, and when;
(c) The deficiency owed amount (for each fee erroneously paid); and
(d) The total deficiency payment owed, which is the sum or total of the individual deficiency owed

> amounts set forth in paragraph (c)(2)(ii)(C) of this section.

An original petition was submitted on July 6, 2005, where Petitioner identified the type of fee that was erroneously paid, the deficiency owed for the fee, and the total deficiency payment.

The original petition was dismissed via the mailing of a decision on February 24, 2006, which indicated that Petitioner failed to identify the small entity fee which was actually paid, or when said fee was paid.

With this renewed petition, Petitioner has identified the small entity fee which was actually paid and when said fee was paid.

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.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 02/09/12

TO SPE OF : ART UNIT: 2629 Attn: LAO LUN (LUN-YI) Y (SPE)

SUBJECT : Request for Certificate of Correction for Appl. No.: 07/825784 Patent No.: 7864151

CofC mailroom date: 02/10/2011

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

Note: Please check Claims
Should these claims be corrected as requested or not

Tasneem Siddiqui
Certificates of Correction Branch
703-756-1814 & 703-756-1593

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: _____

Lun-Yi Lao — SPE

2629 — Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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AUG 01 2011

OFFICE OF PETITIONS

M. Sharon Rogone
Small Beginnings, Inc.
17229 #E7 Lemon Street
Hesperia, CA 92345

In re Patent No. 5,613,502 :
Issued: March 25, 1997 : REQUEST FOR INFORMATION
Application No.: 07/826,096 :
Filing Date: July 23, 1992 :
Attorney Docket No. :

This is a request for information in response to the petition under 37 CFR 1.378(b), filed July 11, 2011.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed July 11, 2011. No additional fees are due.

The patent issued March 25, 2007. The 11.5 year maintenance fee could have been paid from March 25, 2008, through September 25, 2008, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from March 26, 2008, to March 25, 2009. Petitioner did not do so. Accordingly, the patent expired at midnight on March 25, 2009.

Petitioner is required to address the following points:

- USPTO records indicate that the 3.5-year and 7.5-year maintenance fees were paid on time. Yet, petitioner states that the attorney petitioner retained to prosecute the patent application did not inform petitioner that maintenance fees were due on the patent. From this, it is concluded that someone other than petitioner paid the 3.5-year and 7.5-year maintenance fees. A successful petition under 37 CFR 1.378(b) must affirmatively identify the cause of the delay in paying the 11.5-year maintenance fee and provide a statement from every person with first-hand knowledge of the circumstances surrounding the delay in paying the maintenance fee. Petitioner must provide statements from any person who may have been charged with paying the maintenance fee and statements from any person with first-hand knowledge of the circumstances surrounding the failure to pay the maintenance fees. Specifically, petitioner must identify who was responsible for tracking and paying the maintenance fees. If an attorney petitioner retained was responsible for paying the maintenance fees, then the petition must address how the delay in paying the maintenance fee was unavoidable as to the attorney. If it was petitioner's responsibility to pay the 11.5-year maintenance fee, petitioner must affirmatively state how the maintenance fee payment was missed.

- 37 CFR 1.378(b)(3) sets forth that a petition submitted under this portion of the Code of Federal Regulations must include a showing which is described as follows:

  A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

  Petitioner must, therefore, describe the steps that were in place to ensure that the maintenance fee was timely paid. This showing would include an explanation of who was responsible for paying tracking and paying the maintenance fee and the method this person, or entity, used for tracking the maintenance fee.

- Petitioner must describe when petitioner became aware that the patent was expired and the steps petitioner took to reinstate the patent

It is noted that petitioner requests that the petition filed in this patent matter be accepted as being filed in U.S. Patent Nos. 6,210,320 and 6,381,787. It appears that the USPTO Scanning Center accommodated this request. Petitioner is cautioned, however, that each patent matter is exclusive in, and of, itself. Accordingly, going forward, a separate "Response to Request for Information" and any other filings should be filed in each patent matter.

It is further noted that the address cited on the petition differs from the address of record. Petitioner should file a request to change the correspondence address with the Response to Request for Information.

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

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petition 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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MAILED

SEP 07 2011

OFFICE OF PETITIONS

(Mary) Sharon Rogone (AKA LEE)
140430 Choco Rd.
Apple Valley CA 92307

In re Patent No. 5,613,502
Issued: March 25, 1997
Application No.: 07/826,096
Filing Date: July 23, 1992
Attorney Docket No.

REQUEST FOR INFORMATION

This is a request for information in response to the petition under 37 CFR 1.378(b), filed August 29, 2011.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed July 11, 2011. No additional fees are due.

The patent issued March 25, 1997. The 11.5 year maintenance fee could have been paid from March 25, 2008, through September 25, 2008, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from March 26, 2008, to March 25, 2009. Petitioner did not do so. Accordingly, the patent expired at midnight on March 25, 2009.

Petitioner is required to address the following points:

- Petitioner states that Mr. Kenneth Crouteau was hired as the Chief Operating Officer of Small Beginnings, Inc. around late 2004. Petitioner further states that Mr. Crouteau and Mrs. Rogone were informed by a previous attorney of the need to pay maintenance fees on the patents and Mrs. Rogone believed she put all relevant due dates on a master calendar. In some portions of the Response to Request for Information, petitioner states that Mr. Crouteau was largely responsible for tracking and paying the maintenance fees and in other portions petitioner indicates that Mrs. Rogone shared that responsibility. Petitioner is required to clarify who was finally responsible for tracking and paying the maintenance fee.
- It is noted that petitioner states that Mr. Crouteau really became indisposed in 2006 with many hardships that befell him. Petitioner is required to explain if any steps were taken during this period to transfer responsibility for tracking and paying the maintenance fee to someone other than Mr. Crouteau or Mrs. Rogone who was also suffering her own hardships.
- Petitioner is required to provide more detail for the method/system used to track and pay the maintenance fee. Specifically, petitioner is required to establish that there was a business routine in place for tracking and paying the maintenance fee that could be reasonably relied upon to ensure the timely payment of the maintenance fee.
- If petitioner is asserting that Mr. Crouteau was chiefly responsible for tracking and paying the maintenance fee for a portion of the relevant period, i.e., March 2009 until the present, petitioner must establish that Mr. Crouteau's delay was unavoidable. Petitioner asserts that Ms. Crouteau

was suffered ill health during a portion of the relevant period, i.e., from March 2009, until he passed away in 2010. Petitioner is required to document the period of Mr. Crouteau's ill health. This can be done by submitting copies of medical records and/or notations from the treating physician. Petitioner is cautioned to redact any personal identifiers, i.e., social security numbers and account numbers, as these filings may be accessible to the public.

- Petitioner states that in early 2010, petitioner discovered the patent was expired. Yet, the first petition to reinstate the patent was not file until July 2011. Petitioner states that during this time, petitioner was researching how to reinstate the patent and trying communicate with the USPTO regarding the same. It seems, however, that well over one year passed between the time petitioner discovered the patent was expired and the petition to reinstate the patent was filed. Petitioner must explain how this entire period of delay was unavoidable.

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

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petition Attorney
Office of Petitions

cc:
M. Sharon Rogone
Small Beginnings, Inc.
17229 #E7 Lemon Street
Hesperia, CA 92345

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

MAILED

DEC 05 2011

OFFICE OF PETITIONS

(Mary) Sharon Rogone (AKA LEE)
140430 Choco Rd.
Apple Valley CA 92307

In re Patent No. 5,613,502 :
Issued: March 25, 1997 : REQUEST FOR INFORMATION
Application No.: 07/826,096 :
Filing Date: July 23, 1992 :
Attorney Docket No. :

This is a request for information in response to the petition under 37 CFR 1.378(b), filed October 5, 2011.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed July 11, 2011. No additional fees are due.

The patent issued March 25, 1997. The 11.5 year maintenance fee could have been paid from March 25, 2008, through September 25, 2008, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from March 26, 2008, to March 25, 2009. Petitioner did not do so. Accordingly, the patent expired at midnight on March 25, 2009.

Petitioner is required to address the following points:

- It is noted that petitioner states that Mrs. Rogone was responsible for tracking and paying the maintenance fee for the subject patent, including maintaining the master docket calendar on which maintenance fee due dates were entered. Petitioner asserts that, as a result of many hardships that befell Mrs. Rogone and her employees, the master docket calendar on which the maintenance fee due dates were docketed was forgotten about and later found in the files and papers of Mr. Crouteau. Section 711.03(c)(2) of the Manual of Patent Examining Procedure, provides, in pertinent part that:

  In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

  A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

  (A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

A delay resulting from an error, such a docketing error, on the part of an employee in the performance of a clerical function may provide the basis for a showing of unavoidable delay. Such a showing should identify the specific error (which petitioner states is the failure to consult with the master docket calendar), the individual who made the error, and the business routine in place for performing the action which resulted in the error. The showing must establish that the individual who erred was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. The showing should include information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned task.

- Petitioner is required to succinctly state the circumstances that may have affected Mrs. Rogone from the date the maintenance fee payment window opened, i.e., March 26, 2008, until July 2011, that may have prevented Mrs. Rogone from looking into the status of the patent and/or consulting with the master docket calendar to discover the maintenance fee was coming due. As petitioner states that Mrs. Rogone was chiefly responsible for tracking and paying the maintenance fees and maintaining the master docket calendar, this inquiry is directed to Mrs. Rogone only and not meant to solicit any other circumstances relating to Mr. Crouteau or other employees.

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

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petition 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

VIERRA MAGEN MARCUS & DENIRO LLP
575 MARKET STREET, SUITE 2500
SAN FRANCISCO CA 94105

MAILED

MAR 09 2012

OFFICE OF PETITIONS

In re Patent No. 5,264,933	:	
Issue Date: November 23, 1993	:	
Application No. 07/826,754	:	DECISION ON PETITION
Filed: January 28, 1992	:	
Attorney Docket No. SPTV-01148US0	:	

This is a decision on the petition under 37 CFR 1.182, filed December 19, 2011, requesting issuance of a duplicate Letters Patent for the above-identified patent.

The petition is **GRANTED**.

The Office of Data Management is directed to issue a duplicate Letters Patent.

The $400 fee for the petition under 37 CFR 1.182 has been paid by petitioner's credit card account.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3208. Inquiries regarding the issuance of a duplicate Letters Patent may be directed to Niomi Farmer in the Office of Data Management at (571) 756-1556.

A copy of this decision is being faxed to the Office of Data Management for issuance of a duplicate Letters Patent.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

Cc: Kimberly Terrell, 2800 S. Randolph Street, Room D-33 (FAX 571-270-9958)

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

LAW OFFICES OF WILLIAM H. HOLT
UNIT 2 FIRST FLOOR
1423 POWHATAN STREET
ALEXANDRIA VA 22314

MAILED

DEC 15 2010

OFFICE OF PETITIONS

Paper No. 21

In re Patent No. 5,499,687
Issue Date : March 19, 1996
Application No. 07/839,015
Filed: November 18, 1991
Inventor: Paul B. Lee

DECISION ON PETITION

This is a decision on the petition for expungement of information, filed October 1, 2010, which is being treated as petitions under 37 CFR 1.182 to invalidate an assignment previously recorded against the above-identified application.

The petition is **Dismissed**.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing a petition under 37 CFR 1.182. In this instance, the fee required by law is $400. Petitioner provided no fees in the petition.

The petition in the above identified application was not accompanied by payment of the required fee. No consideration on the merits can be given to the petition until the required fee is received.

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 Carl Friedman at (571) 272-6842.

Carl Friedman
Petitions Examiner
Office of Petitions

Cc: Sutherland Asbill & Brennan LLP
999 Peachtree Street NE
Atlanta, GA 30309-3996

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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GTC BIOTHERAPEUTICS, INC.
C/O WOLF, GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

MAILED
MAR 14 2011
OFFICE OF PETITIONS

In re Application of Gordon et al. :
Application No. 07/839,194 : Decision on Petition
Filing Date: February 20, 1992 :
Attorney Docket No. G0744.70042US07 :

This is a decision on the petition under 37 C.F.R. § 1.182, filed March 7, 2011, which requests that the terminal disclaimer filed on August 16, 2010, be withdrawn. This is also a decision on the petition under 37 C.F.R. § 1.182 requesting expedited consideration of the previously identified petition.

The petition to withdrawn the August 16, 2010 terminal disclaimer is **granted**.

The petition requesting expedited consideration of the petition to withdraw the August 16, 2010 terminal disclaimer is **granted**.

A terminal disclaimer was filed on August 16, 2010 to overcome a double patenting rejection set forth in an Office action mailed August 5, 2009. The examiner's comments mailed with the Notice of Allowance state, "no terminal disclaimer is needed since upon further review no double patenting existed." Petitioner requests withdrawal of the terminal disclaimer. In view of the prior facts, the terminal disclaimer is hereby withdrawn.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FEB 28 2012

Christine S. Lee
Intellectual Property Counsel
GE Healthcare
101 Carnegie Center
Princeton, NJ 08540

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,310,912

Dear Ms. Lee:

An interim extension under 35 U.S.C. § 156(e)(2) is enclosed extending the term of U.S. Patent No. 5,310,912 for a period of one year. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates set forth in the Patent and Exclusivity Data Appendix of the Orange Book (Approved Drug Products with Therapeutic Equivalence Evaluations) or in the Patent Information set forth in the Green Book (FDA Approved Animal Drug Products). Effective August 18, 2003, patent submissions for publication in the Orange Book and Docket *95S-0117 need to be submitted on form FDA-3542 which may be downloaded from FDA's Electronic Forms Download Website: http://www.fda.gov/opacom/morechoices/fdaforms/default.html (http://www.fda.gov/opacom/morechoices/fdaforms/FDA-3542.pdf).

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

RE: DaTscan (Ioflupane I-123)
Docket No.: FDA-2011-E-0367

Attention: Beverly Friedman

UNITED STATES PATENT AND TRADEMARK OFFICE

In re GE Healthcare Ltd.	:	
Request for Patent Term Extension	:	ORDER GRANTING
U.S. Patent No. 5,310,912	:	INTERIM EXTENSION

GE Healthcare Ltd., the owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 5,310,912, filed an application for patent term extension under 35 U.S.C. § 156 on March 7, 2011. The original term of the patent is due to expire on February 25, 2012. The patent claims the active ingredient ioflupane, in the human drug product DaTscan®, which was approved by the Food and Drug Administration for commercial marketing or use on January 14, 2011. An extension of 5 years is requested.

The initial USPTO review of the application to date indicates that the subject patent is eligible for extension of the patent term under 35 U.S.C. § 156. A final determination of the length of the extension of the patent term and issuance of a patent term extension certificate cannot be made until a final determination of the length of the regulatory review period is made. Because the original term of the patent would expire before a certificate of patent term extension can be issued, an interim extension of the patent term is appropriate.

An interim extension under 35 U.S.C. § 156(e)(2) of the term of U.S. Patent No. 5,310,912 is granted for a period of one year from the original expiration date of the patent.

David J. Kappos

February 24, 2012

Date

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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

RONALD J. BARON ESQ.
HOFFMANN & BARON, LLP
6900 JERICHO TURNPIKE
SYOSSET, NY 11791

MAILED

JUL 08 2011

OFFICE OF PETITIONS

In re Patent No: 5,989,856 :
Issued: November 23, 1999 :
Application No. 07/849,420 : NOTICE
Filed: June 24, 1992 :
Attorney Docket No. 294-41 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed June 13, 2011.

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 **DISMISSED**.

The request under 37 CFR 1.28 cannot be accepted at this time since it appears that the petition is not signed by a person having authority to act in the above-identified patent.

Petitioner's attention is directed to 37 CFR 1.33(b), which states.

Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);
(2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;
(3) An assignee as provided for under §3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

Further, that part of the petition that is directed to the deficiency payment is not signed by the proper party. Accordingly, the request cannot be accepted until it is signed by all inventors, an attorney or agent registered to practice before the U.S. Patent and Trademark Office or the assignee of the entire interest under 37 CFR 3.73(b).

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: 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.

Additionally, the address given on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

/Joan Olszewski/
Joan Olszewski
Petitions Examiner
Office of Petitions

cc: GILL LENNON
DENNEMEYER & CO LTD
REGENT HOUSE HEATON LANE
STOCKPORT CHESHIRE
ENGLAND SK4 1BB

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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NOV - 1 2010

Brett S. Sylvester, Esq.
Sughrue Mion PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,258,510

Dear Mr. Sylvester:

An order granting interim extension under 35 U.S.C. § 156(e)(2) is enclosed extending the term of U.S. Patent No. 5,258,510 for a period of 1 year. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates set forth in the Patent and Exclusivity Data Appendix of the Orange Book (Approved Drug Products with Therapeutic Equivalence Evaluations) or in the Patent Information set forth in the Green Book (FDA Approved Animal Drug Products). Effective August 18, 2003, patent submissions for publication in the Orange Book and Docket *95S-0117 need to be submitted on form FDA-3542 which may be downloaded from FDA's Electronic Forms Download Website: http://www.fda.gov/opacom/morechoices/fdaforms/default.html (http://www.fda.gov/opacom/morechoices/fdaforms/FDA-3542.pdf).

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

RE: SAMSCA® (Tolvaptan)
Docket No.: FDA-2010-E-0037

Attention: Beverly Friedman

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Otsuka Pharmaceutical Co. Ltd.	:	
Request for Patent Term Extension	:	ORDER GRANTING
U.S. Patent No. 5,258,510	:	INTERIM EXTENSION

Otsuka Pharmaceutical Co. Ltd., the owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 5,258,510, filed an application for patent term extension under 35 U.S.C. § 156 on July 16, 2009. The original term of the patent is due to expire on November 2, 2010. The patent claims the active ingredient tolvaptan in the human drug product SAMSCA®, which was approved by the Food and Drug Administration for commercial marketing or use on May 19, 2009. An extension of 5 years is requested.

The initial USPTO review of the application to date indicates that the subject patent is eligible for extension of the patent term under 35 U.S.C. § 156. A final determination of the length of the extension of the patent term and issuance of a patent term extension certificate cannot be made until a final determination of the length of the regulatory review period is made. Because the original term of the patent would expire before a certificate of patent term extension can be issued, an interim extension of the patent term is appropriate.

An interim extension under 35 U.S.C. § 156(e)(2) of the term of U.S. Patent No. 5,258,510 is granted for a period of one year from the original expiration date of the patent.

October 29, 2010

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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NOV 22 2011

Brett S. Sylvester, Esq.
Sughrue Mion PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,258,510

Dear Mr. Sylvester:

An order granting interim extension under 35 U.S.C. § 156(e)(2) is enclosed extending the term of U.S. Patent No. 5,258,510 for an additional period of 1 year. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates set forth in the Patent and Exclusivity Data Appendix of the Orange Book (Approved Drug Products with Therapeutic Equivalence Evaluations) or in the Patent Information set forth in the Green Book (FDA Approved Animal Drug Products). Effective August 18, 2003, patent submissions for publication in the Orange Book and Docket *95S-0117 need to be submitted on form FDA-3542 which may be downloaded from FDA's Electronic Forms Download Website: http://www.fda.gov/opacom/morechoices/fdaforms/default.html (http://www.fda.gov/opacom/morechoices/fdaforms/FDA-3542.pdf).

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

RE: SAMSCA® (Tolvaptan)
Docket No.: FDA-2010-E-0037

Attention: Beverly Friedman

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Otsuka Pharmaceutical Co. Ltd.	:	
Request for Patent Term Extension	:	ORDER GRANTING
U.S. Patent No. 5,258,510	:	INTERIM EXTENSION

Otsuka Pharmaceutical Co. Ltd., the owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 5,258,510, filed an application for patent term extension under 35 U.S.C. § 156 on July 16, 2009. The extended term of the patent was due to expire on November 2, 2011. The patent claims the active ingredient tolvaptan in the human drug product SAMSCA®, which was approved by the Food and Drug Administration for commercial marketing or use on May 19, 2009. An extension of 5 years is requested.

The initial USPTO review of the application to date indicates that the subject patent is eligible for extension of the patent term under 35 U.S.C. § 156. A final determination of the length of the extension of the patent term and issuance of a patent term extension certificate cannot be made until a final determination of the length of the regulatory review period is made. Because the extended term of the patent was due to expire before a certificate of patent term extension could be issued, an interim extension of the patent term was appropriate.

An interim extension under 35 U.S.C. § 156(e)(2) of the term of U.S. Patent No. 5,258,510 was granted for an additional period of one year from the extended expiration date of the patent, i.e., until November 2, 2012.

November 22, 2011

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,958,784	1999-09-28	07/857,224	1992-03-25	ERGN.P0003US

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☒ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Travis M. Wohlers/	Date (YYYY-MM-DD)	2011-09-30
Name	Travis M. Wohlers	Registration Number	57423

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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In re Patent No. 5958784
Issue Date: September 28,1999
Application No. 07857224
Filed: March 25,1992
Attorney Docket No.

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed September 30,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 30,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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FEB - 6 2012

Thomas G. Rowan
JONES DAY
222 East 41st St.
New York, NY 10017

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,206,248

DENIAL OF PATENT TERM EXTENSION APPLICATION UNDER 35 U.S.C. 156 FOR U.S. PATENT No. 5,206,248

This is in response to the application for extension of the patent term of U.S. Patent No. 5,206,248 (the '248 patent) under 35 U.S.C. § 156 filed in the United States Patent and Trademark Office (USPTO) on December 17, 2010. The patent term extension application (PTE application) was filed by the Center for Neurologic Study (Applicant) the owner of record of the patent. Extension was sought based upon the premarket review under § 505 of the Federal Food, Drug, and Cosmetic Act (FFDCA) of a human drug product known by the tradename NUEDEXTA® and having the active ingredients dextromethorphan hydrobromide and quinidine sulfate. The application indicated that NUEDEXTA® (dextromethorphan hydrobromide and quinidine sulfate) had been approved for commercial use and sale by the Food and Drug Administration (FDA) on October 29, 2010.

A determination has been made that the '248 patent is **NOT** eligible for patent term extension based upon the regulatory review period of NUEDEXTA®. Therefore, Applicant's PTE application is **DENIED**.

PROCEDURAL BACKGROUND

(1) On April 27, 1993, the USPTO issued the '248 patent to Richard A. Smith. It is assigned to the Center for Neurologic Study.

(2) On October 29, 2010, FDA approved New Drug Application (NDA) No. 21-879, thereby granting permission for commercial marketing or use of NUEDEXTA® (dextromethorphan hydrobromide and quinidine sulfate).

(3) On December 17, 2010, Applicant filed a PTE application under § 156 to extend the term of the '248 patent based on FDA regulatory review of NUEDEXTA®. Applicant also filed a request for extension of the term of a separate patent, U.S. Patent No. RE38115, based on the same regulatory review period of NUEDEXTA® pursuant to the provisions of 37 C.F.R. 1.785.

(4) On March 29, 2011, pursuant to the Memorandum of Understanding Between the USPTO and the FDA, see 52 Fed. Reg. 17830, May 12, 1987, the USPTO requested assistance from the FDA ("First USPTO Letter to FDA") in determining eligibility of the '248 patent for patent term extension based on the regulatory review period of NUEDEXTA®. The USPTO indicated in its letter that "[s]ince each of the active ingredients in NUEDEXTA has

been previously approved by FDA in the NDAs listed above, it does not appear that the permission for the commercial marketing or use of NUEDEXTA meets the requirements of §156(a)(5)(A)." Nonetheless, the letter erroneously concluded that the application appears eligible.

(5) On May 31, 2011, the USPTO clarified the First USPTO Letter to FDA indicating therein that, "[o]ur review of the application to date indicates that the subject patent would NOT be eligible for extension of the patent term under § 156."

(6) On June 9, 2011 the FDA communicated their findings to the USPTO (FDA letter), the FDA indicated that NUEDEXTA® (dextromethorphan hydrobromide and quinidine sulfate) had been subject to regulatory review under new drug application (NDA) 21-879 in accordance with section 505 of the FFDCA, and confirmed that NDA 21-879 did not represent the first permitted commercial marketing or use of the active ingredients of NUEDEXTA® (dextromethorphan hydrobromide and quinidine sulfate).

(7) On November 16, 2011, Applicant filed a request for interim extension pursuant to the provisions of 35 U.S.C. 156(e)(2).

(8) On December 20, 2011, the USPTO dismissed Applicant's request for extension of the term of the '248 patent filed under the provisions of 35 U.S.C. 156(d)(1) and dismissed Applicant's request for interim extension under 35 U.S.C. 156(e)(2). Because Applicant had also filed a request for patent term extension for U.S. Patent No. RE38115, pursuant to the provisions of 37 C.F.R. 1.785, as noted *supra*, a notice of final determination in that companion application was also mailed on December 20, 2011. U.S. Patent No. RE38115 does not expire until January 26, 2016, and so no interim extension had been requested.

(9) On January 17, 2012, Applicant filed a Respone to the Notice of Final Determination of December 20, 2011 (Reconsideration Request) pursuant to the provisions of 37 C.F.R. 1.750. No request for reconsideration was filed in U.S. Patent No. RE38115.

DECISION

The USPTO has considered the arguments made by Applicant in its Reconsideration Request and finds each to be unpersuasive. The USPTO will address Applicant's arguments in turn.

A. Permission For Commercial Marketing Or Use of NUEDEXTA® Is Not The First Permitted Commercial Marketing Or Use As Required By 35 U.S.C. 156(a)(5)(A)

In order for the regulatory review of a drug product to give rise to patent term extension under the provisions of 35 U.S.C. 156, the permission for the commercial marketing or use of the product must be the first permitted commercial marketing or use of the product under the provision of law under which the regulatory review period occurred. Here, the permission for commercial

marketing or use of the active ingredients of NUEDEXTA® do not constitute the first permitted commercial marketing or use of dextromethorphan hydrobromide or quinidine sulfate. Thus, Applicant's PTE application must be denied.

1. Section 156(f) recites that an active ingredient of a new drug is, "as a single entity or in combination with another active ingredient"

Applicant argues that the drug product NUEDEXTA® contains a single active ingredient, dextromethorphan/quinidine. Reconsideration Request at 8. Applicant argues that the Federal Circuit in *Photocure ASA v. Kappos*, 603 F.3d 1372, 1376 (Fed. Cir. 2010) and *Glaxo Operations UK Ltd. V. Quigg*, 894 F.2d 392, 393-395 (Fed. Cir. 1990) indicated that section 156(f) defines "product" as the active ingredient of the new drug and explains that the active ingrediennt is the ingredient in the drug product administered. Applicant concludes that the active ingredient of NUEDEXTA® is dextromethorphan/quinidine. Reconsideration Request at 8-9. Applicant also argues that neither active ingredient alone could be used to treat pseudobulbar affect (PBA, the approved indication for NUEDEXTA®), but that in combination the two substances act effectively against the effects of PBA. Reconsideration Request at 9. Applicant admits that dextromethorphan is responsible for treating PBA, and that the addition of quinidine sulfate acts to prevent enzymatic metabolism of dextromethorphan hydrobromide. Reconsideration Request at 9.

First, Applicant's analysis of the language of section 156(f) is flawed. Applicant glosses over the clear language of section 156(f) which provides that the active ingredient of a new drug may exist as **a single entity or in combination with another active ingredient**. When Congress provided a definition of "product" for purposes of determining which kinds of products, when subject to a regulatory review period and claimed in a patent, would give rise to patent term extension, the definition indicated that a new drug had either an active ingredient as a single entity or multiple active ingredients which are in combination with one another. The language of section 156(f) recites that the term "product," means "a drug product," which in turn, means "the active ingredient of a new drug . . . as a single entity or in combination with another active ingredient." Applying the statutory language here, a drug product, NUEDEXTA®, means the active ingredient (dextromethorphan hydrobromide) of a new drug in combination with another active ingredient (quinidine sulfate). There is no escaping the plain language that the statute contemplates an active ingredient as a single entity in a new drug or an active ingredient in combination with another active ingredient in a new drug. To conclude that a single active ingredient can be a combination of two or more active ingredients would render superfluous the statutory language "or in combination with another active ingredient." Moreover, even though Applicant argues that section 156 is remedial in nature and thus should be liberally construed in its favor, Reconsideration Request at 3, such a rule of construction cannot overcome the clear language of the statute.

Second, Applicant stresses that no amount of either active ingredient alone can treat PBA, and that dextromethorphan/quinidine (as a single active ingredient) exhibits different pharmacological properties than either active ingredient alone. In fact, Exhibits 3-11 relate to studies conducted on the effectiveness of dextromethorphan hydrobromide in treating various

neurological or brain disorders. While such distinctions and information are perhaps relevant for patentability purposes, whether a drug product contains two active ingredients which might act in concert to achieve an additional pharmacological effect than either taken alone is not a relevant inquiry for patent term extension. Rather, the relevant inquiry for purposes of section 156 is whether the drug product represents the first commercial marketing or use of that product. When a drug product contains two active ingredients, at least one of those ingredients must not have been previously approved. Here, both dextromethorphan hydrobromide and quinidine sulfate had been previously approved. Applicant argues (Reconsideration Request at 9) that dextromethorphan had for years been only contemplated as a treatment for various neurological conditions. The problem was the inability to permit that active ingredient to cross the blood-brain barrier in order to effectively treat a neurological disease, such as PBA. But that apparently new treatment of a neurological disease aside, however, dextromethorphan hydrobromide had years earlier received approval for use as a cough suppressant. Likewise, quinidine sulfate had previously received approval for use to treat heart arrhythmias. In short, although Applicant may have invented a new use for dextromethorphan hydrobromide together with quinidine sulfate that does not mean that Applicant's patent drawn to that invention is entitled to an extension under section 156.

Third, Applicant attempts to rely on two cases which are unrelated to the present question that involves a drug product with multiple active ingredients. Both *Photocure* and *Glaxo* addressed a separate question, i.e., whether the active ingredient in a drug product is: (*i*) the underlying active chemical moiety, or (*ii*) the formulation of that active moiety, *e.g.*, as a salt or ester, as it actually exists in the approved drug product. Both cases confirmed that the active ingredient is not the underlying chemical moiety, but the actual formulation of that moiety as it appears in the approved drug product. Here, the drug administered is a combination drug product having as active ingredients dextromethorphan hydrobromide, which treats PBA, and quinidine sulfate, which permits sufficient drug delivery of dextromethorphan hydrobromide across the blood-brain barrier by inhibiting the liver enzyme CYP2D6. The active-moiety vs. formulation question addressed by *Glaxo* and *Photocure* would only be logically relevant, if at all, to those individual ingredients. But there is no underlying chemical moiety here that represents the combination of dextromethorphan hydrobromide and quinidine sulfate, nor is there a salt or ester that encompasses both of them. Thus, the issue addressed by the Federal Circuit in *Glaxo* and *Photocure* is simply not relevant here. Since each active ingredient here is performing its intended physiological function, as described by Applicant, the USPTO is not persuaded that the active ingredient of NUEDEXTA® is a single active ingredient of dextromethorphan/quinidine as Applicant urges. Reconsideration Request at 9.

2. Determining Compliance with 35 U.S.C. 156(a)(5)(A) Requires Analysis Of A Product On An Active Ingredient-By-Active Ingredient Basis

Applicant argues that the USPTO has viewed NUEDEXTA® as containing two active ingredients and that the USPTO has therefore erroneously relied on the Federal Circuit's decision in *Arnold P'ship v. Dudas*, 262 F.3d 1338 (Fed. Cir. 2004). Reconsideration Request at 10. Applicant claims support for the argument that NUEDEXTA® is a drug with a single active ingredient by reference to MPEP 2751 and states that the section supports treating a combination of two active ingredients as a single active ingredient where synergy can be shown. Reconsideration Request at

10. Lastly, Applicant argues that the active ingredients of VICOPROFEN®, the product for which patent term extension was denied in *Arnold P'ship v. Dudas*, were exhibiting their expected pharmacological functions, i.e., hydrocodone bitartrate was effective as a cough suppressant and ibuprofen was effective as an analgesic. Reconsideration Request at 11.

Applicant disclosed in their PTE application at page 2, "[t]he approved product NUEDEXTA® capsule, is an oral formulation that contains dextromethorphan hydrobromide and quinidine sulfate in a fixed dose composition and is indicated for the treatment of pseudobulbar Affect ("PBA")." Applicant further elucidated therein that "dextromethorphan hydrobromide is the pharmacological active agent that acts on the central nervous system while quinidine sulfate is a specific inhibitor of CYP2D6-dependent oxidative metabolism that increased bioavailability of dextromethorphan." PTE application at 2. Applicant's Reconsideration Request stated, "by inhibiting CYP2D6 enzyme, the quinidine [sulfate] prevents the rapid metabolism of dextromethorphan [hydrobromide]. This allows the dextromethorphan [hydrobromide] to pass through the blood-brain barrier and treat PBA." Applicant's characterization of the active ingredients of NUEDEXTA® in their Reconsideration Request directly tracks the presentation of arguments in *Arnold P'ship*. Specifically, the district court noted, footnote 1:

> Hydrocodone bitartrate is a cough suppressant, while ibuprofen is a pain reliever. PHYSICIANS DESK REFERENCE GENERICS 1441, 1489 (1st ed. 1995). In plaintiff's application for extension of the '252 patent, which comprises a binding part of the administrative record below, plaintiff clearly identified hydrocodone bitartrate and ibuprofen as discrete active ingredients. Aff. of Joseph E. Topmiller, Esq. in Supp. of Pl.'s Mot. for Summ. J. and Opp. to Def.'s Mot. for Summ. J. at A36, A38. In its pleadings, however, plaintiff characterizes these chemicals as the "therapeutic agents" of Vicoprofen. Plaintiff is bound by its admissions in the administrative process. . . .

See *Arnold P'ship v. Rogan*, 246 F. Supp. 460, 462 (E.D. Va. 2003) (emphasis added).

Here, Applicant identified in their application materials that NUEDEXTA® contains two discrete active ingredients, and then reiterated that each of the active ingredients of NUEDEXTA® performs a different physiological function in their PTE application and Reconsideration Request. Applicant's admissions and identification of the active ingredients of NUEDEXTA® as two separate discrete active ingredients is not rebutted by merely stating that the active ingredients of NUEDEXTA® are "a single active ingredient" dextromethorphan/quinidine. Representing the two active ingredients with a slash between each pharmacological active ingredient does not make them a single active ingredient. Contrary to Applicant's arguments, the Federal Circuit's decision in *Arnold Partnership v. Dudas*, 262 F.3d 1338 (Fed. Cir. 2004) *is* directly and succinctly on point. The facts here are analogous to those in *Arnold Partnership*. Like the active ingredients ibuprofen and hydrocodone bitartrate in the combination product VICOPROFEN® in *Arnold Partnership*, dextromethorphan hydrobromide

and quinidine sulfate each have been previously granted permission for commercial marketing or use prior to the approval of NUEDEXTA®. As a result, the use of dextromethorphan hydrobromide and quinidine sulfate in the product NUEDEXTA® does not constitute the first permitted commercial marketing or use of the NUEDEXTA® as required by 35 U.S.C. § 156(a)(5)(A), just as the use of ibuprofen and hydrocodone bitartrate in the combination product VICOPROFEN® did not constitute the first permitted commercial marketing of VICOPROFEN® in *Arnold Partnership*. *See id.* at 1342-43. Moreover, Applicant fails to acknowledge the language in *Arnold Partnership* that appears to cut off the synergy argument, even in those cases where synergy is shown, which it has not been here. *Id.*

Applicant's reliance on MPEP § 2751 is likewise misplaced. The statement in the MPEP pointed to by Applicant does not require that the USPTO treat an alleged synergistic combination drug product with two active ingredients as a single active ingredient made up of the two active ingredients for patent term extension purposes. Rather, MPEP § 2751 merely explains that a product having two active ingredients, without synergy, will not be treated as a single active ingredient. Contrary to Applicant's arguments, the MPEP is not authority for the converse. Furthermore, this section of the MPEP has not been updated to reflect the clarity in law provided by *Arnold Partnership v. Dudas*.

As discussed *supra*, just as each active ingredient in VICOPROFEN®, considered in *Arnold Partnership,* was found to be a discrete substance incorporated into a single dosage form, the same is said for NUEDEXTA®, each active ingredient described by Applicant many times over by reference to its function to treat PBA, is a discrete active ingredient performing a specific function and is contained in a single dosage form. Therefore, the '248 patent is not entitled to a patent term extension.

B. Regulatory Review of Dextromethorpham Under Section 505 of the Federal Food Drug and Cosmetic Act, As Amended in 1962, Is The Same "Provision of Law" As Section 505 Of The FFDCA Prior To The 1962 Amendments

As has been explained *supra*, NUEDEXTA® contains two discrete active ingredients, dextromethorphan hydrobromide and quinidine sulfate. Applicant argues that even though permission for commercial marketing or use for dextromethorphan hydrobromide was under the provision of law which governs approvals of new drugs, *i.e.,* section 505 of the FFDCA, and occurred in 1957, such an approval does not constitute the first permitted commercial marketing or use of dextromethorphan hydrobromide because section 505 of the FFDCA was amended in 1962 to require not only safety testing but also efficacy testing. Reconsideration Request 11-12.

Applicant argues that there is neither "review" nor "approval" under the pre-1962 version of the FFDCA. The pre-1962 language of 21 U.S.C. 355(a) did not recite "approval" of an application, rather it used the term "effective." However, the use of "effective" in pre-1962 section 355(a) and "approval" in post-1962 section 355(a) indicate, nonetheless, that a reviewable submission to FDA was required before commercial marketing or use of the new drug could commence under either version of the statute The pre-1962 language of 21 U.S.C.

355(b) required submission of an application containing (1) full reports of investigations which have been made to show whether or not such drug is safe for use; (2) a full list of the articles used as components of such drug; (3) a full statement of the composition of such drug; (4) a full description of the methods used in, and the facilities and controls used for, the manufacture, processing and packing of such drug; (5) such samples of such drug and of the articles used as components thereof as the Secretary may require; and (6) specimens of the labeling proposed to be used for such drug. *See* 21 U.S.C. 355(b)(1962). Section 355(c) indicates that the effective date of the application [NDA] is on the sixtieth day after the filing thereof unless there is a finding by the Secretary postponing the effective date. Although the pre-1962 Act does not explicitly refer to "review," there must necessarily have been regulatory review because (1) an application containing explicit information must have been submitted to FDA (before an application is effective and commercial marketing may commence) and (2) a mechanism is provided by statute where FDA could postpone the effective date of the new drug application thereby preventing the commencement of commercial marketing or use of the new drug. *See* 21 U.S.C. 355(c) (1962) (providing the basis for FDA authority to postpone the effective date of an application which had been reviewed by the agency).

The provision of law under which the regulatory review period occurred is Section 505 of the FFDCA (21 U.S.C. 355). Although the terms of this provisions were changed in the Drug Amendments of 1962 for products approved for commercial marketing after October 10, 1962 as opposed to drug products approved prior to enactment of that legislation, the provisions under which review by FDA occurred continue to be 21 U.S.C. 355. This has remained the applicable federal statute which regulated the grant of permission to commercially market or use a new drug by FDA in the United States. The human drug products containing dextromethorphan hydrobromide as the active ingredient were approved after a regulatory review under Section 505 of the FFDCA, 21 U.S.C. 355, both before and after 1962.

The conclusion that the provision of law under which the regulatory review occurred as used in section 35 U.S.C. 156(a)(5)(A) refers to the applicable federal statutes rather than the specific provisions of that statute is supported by the legislative history. According to a report by the House Committee on the Judiciary accompanying H.R. 3605, 98th Cong. 2d Sess. (1983)[1]:

> Paragraph (7)(A)[2] generally permits an extension if the approval after the regulatory review is the first approval for commercial marketing or use of that product under an applicable Federal law.

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[1]H.R. Rep. No. 857, Part 2, 98th Cong., 2d Sess., 22 (1984), reprinted in 1984 U.S. Code Cong. & Adm. News 2706.

[2]Now paragraph (5)(A).

Since product is defined in 35 U.S.C. 156(f)(2) as the active ingredient in a new drug—dextromethorphan hydrobromide in the case of NUEDEXTA® —and dextromethorphan hydrobromide has been approved for commercial marketing in several products prior to the grant of permission to commercially market or use NUEDEXTA® under the applicable Federal statute (21 U.S.C. 355), it cannot be concluded that the approval of NUEDEXTA® marked the first approval of dextromethorphan hydrobromide under applicable federal law. In each case that dextromethorphan hydrobromide has been approved for commercial marketing in a drug product, whether the drug product was approved before or after 1962, it was approved under the applicable federal law which governed regulatory review and grant of permission to commercially market or use a new human drug product—21 U.S.C. 355.

Further, there is no indication in the legislative history that Congress intended to create a new opportunity for patent term extension for an old active ingredient on the basis of a change, even a significant one, in the federal statute that governs regulatory review of a new drug product. The enactment of the Drug Price Competition and Patent Term Restoration Act of 1984 (hereinafter Hatch-Waxman Act) clearly indicated that Congress was aware of many of the differences between the approval process after 1962. According to a report by the House Committee on Energy and Commerce accompanying H.R. 3605, 98th Cong., 2d Sess. (1983)[3]:

> Prior to 1962, the Federal Food, Drug and Cosmetic Action (FFDCA) required that all drugs be approved as safe before they could be marketed. The 1962 amendments required that all new drugs, generic and pioneer, must be approved as safe and effective prior to marketing.
>
> As a result of the 1962 amendment, FDA did two things regarding pre-1962 drugs. First, the agency created the Drug Efficacy Study to determine if all pre-1962 drugs were effective. Second, FDA established a policy permitting the approval of a generic equivalent to a safe and effective pre-1962 pioneer drug.

The stated purpose of Congress in enacting Title I of the Hatch-Waxman Act was to change the approval process for generic equivalents of new drugs approved after 1962 as indicated in the following excerpt from the same House Report[4]:

> The purpose of Title I of the bill is to make available more low cost generic drugs by establishing a generic drug approval procedure for pioneer drugs first approved after 1962. Under current law, there is a

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[3]H.R. No. 857, Part 1, 98th Cong., 2d Sess. 16 (1984), reprinted in 1984 U.S. Cong. & Adm. News 2649.

[4]*Id.* At 2647, 2648.

> generic drug approval procedure for pioneer drugs approved before 1962, but not for pioneer drugs approved after 1962.
>
> Title I of the bill generally extended the procedures used to approve generic copies of pre-1962 drugs to post-1962 drugs. Generic copes of any drugs may be approved if the generic is the same as the original drug or so similar the FDA has determined the differences do not require safety and effectiveness testing.

Thus, while taking affirmative and explicit action in Title I of the Hatch-Waxman Act to alter an existing distinction between new drug products approved before 1962, Congress did not make nor even mention any distinction between drugs approved before or after 1962 in enacting the patent term restoration provisions to Title II. Under the circumstances, it cannot be concluded that Congress intended that new drugs approved before 1962 would be treated differently than new drugs approved after 1962 for purposes of eligibility for patent term extension.

Applicant also argues that the position that FDA took in 2007 in their communication to USPTO on the same "provision of law" issue raised by the patent term extension applicant for U.S. Patent No. 4,868,179, where extension was sought based on the regulatory review of BiDil, would be different today in light of the position that FDA took on interpretation of a separate provision of the Hatch-Waxman Act which has no relation to the present provision at issue. Applicant relies on a statement taken out of context from an FDA's decision on various citizens petitions questioning the availability of a 30-month stay of approval for an Abbreviated New Drug Applications (ANDAs) directed to "old" antibiotics in light of amendments to the FFDCA made by the Q1 Act, which potentially provide market exclusivities, permit patent listing in the Orange Book, and incorporate certain provisions of the Hatch-Waxman Act. The provisions regarding the 30-month stay (in response to suit by the pioneer to a paragraph iv certification by the ANDA filer) of the Hatch-Waxman Act were amended by the Medicare Modernization Act (MMA) of 2003. The petitioners to FDA would have FDA apply the 30-month stay provisions as contained within the original Hatch-Waxman Act, even though those provisions no longer exist due to the MMA. Application by FDA of an amended statute to a current proceeding is not the relevant question here. Rather, the relevant question is whether review of an NDA under section 505 of the FFDCA under pre-1962 standards prior to commercially marketing or use is considered a regulatory review and grant of permission to commercially market or use the NDA product under section 505 of the FFDCA in light of the post-1962 standard.

The *Westwood* court directly answered the inquiry. In *Westwood Pharmaceuticals Inc. v. Quigg*, 13 USPQ2d 2067, 2069 (D.D.C. 1989), the court stated, "[i]n fact, any approvals obtained prior to the 1962 Amendment are considered to be approved within the meaning of section 505 as amended." The footnote to that statement indicates that the 1962 amendments provided that, as of the enactment date of the 1962 amendments, that an application which was "effective" within the meaning of the FFDCA pre-1962 was deemed "approved" within the meaning of the FFDCA as amended by the 1962 amendments. *Id.*

Applicant also argues that *Westwood* was decided wrong, however, there has been no change in law generally or circumstances identified in the Reconsideration Request which would persuade the USPTO to reconsider the position taken in the original *Westwood* case. The eventual grant of patent term extension to the patent at issue in *Westwood* was directly related to the decision in *Glaxo Operations UK Ltd. v. Quigg,* 894 F.2d 392 (Fed. Cir 1990), see 55 Fed. Reg. 13194 (Apr. 9, 1990), the matter of law decided there is of no consequence to the present issue of law.

Applicant attempts to garner support for the argument that a regulatory review period is defined by 156(g)(1)(B), and because no such regulatory review period existed prior to the 1962 amendments to the FFDCA, any kind of regulatory review of a new drug pre-1962 did not involve the same type of regulatory review. Whether the level of review and NDA submission were different after the 1962 amendments is of no consequence to the present inquiry, which is, whether review of an NDA under section 505 of the FFDCA under pre-1962 standards prior to commercially marketing or use is considered a regulatory review and grant of permission to commercially market or use the NDA product under section 505 of the FFDCA in light of the post-1962 standard. As discussed *supra*, a regulatory review of the NDA application under the pre-1962 standards must have occurred or else FDA would never have been able to invoke the provisions of 21 U.S.C. 355(c) which provides a mechanism for FDA to delay the effective date of a NDA. Furthermore, in promulgating the 1962 amendments Congress specifically deemed an effective NDA to be an approved NDA. Thus, in accordance with the law, dextromethorphan hydrobromide was subject to regulatory review prior to its commercial marketing or use and the NDA for dextromethorphan hydrobromide was effective in 1957 (then deemed approved as per the 1962 amendments) such that the approval of NUEDEXTA® in 2010 does not constitute the first permitted commercial marketing or use of dextromethorphan hydrobromide as required by 35 U.S.C. 156(a)(5)(A).

Since NUEDEXTA® contains multiple active ingredients, and the statute and courts instruct the USPTO to analyze the eligibility on an active ingredient-by-active ingredient basis, and since each component has been previously approved under section 505 of the FFDCA (21 U.S.C. 355), the grant of permission for commercial marketing or use of NUEDEXTA® fails to comply with 35 U.S.C. 156(a)(5)(A) because it is not the first approval for either active ingredient. Furthermore, review of NUEDEXTA® occurred under section 505 of the FFDCA (21 U.S.C. 355) as did the prior approval of dextromethorphan hydrobromide in 1957. For these reasons as stated *supra,* the PTE application for the '248 patent must be denied.

C. The Request for Interim Extension of U.S. Patent No. 5,206,248 Is Denied

Applicant filed an interim extension application to extend the term of the '248 patent for a term of one year because the '248 patent is due to expire on March 27, 2012. Section 156(e)(2) provides for an interim patent term extension while an applicant's PTE application is pending before the Office:

> If the term of a patent for which an application has been submitted under

> subsection (d)(1) would expire before a certificate of extension is issued or denied under paragraph (1) respecting the application, the Director shall extend, until such determination is made, the term of the patent for periods of up to one year if he determines that the patent is eligible for extension.

35 U.S.C. § 156(e)(2) (emphases added).

The express language of § 156(e)(2) sets forth at least two conditions that must be satisfied in order for the Director to issue an interim extension: (i) the patent at issue "would expire before a certificate of extension is issued or denied," and (ii) the Director must determine "that the patent is eligible for extension." The Federal Circuit confirmed that § 156(e)(2) contains these two requirements for an interim extension. See *Somerset Pharms., Inc. v. Dudas*, 500 F.3d 1344, 1346 (Fed. Cir. 2007). Here, neither requirement is met.

The first requirement is not met because the '248 patent will not expire before a certificate of extension is issued or denied since the Director is herein denying Applicant's PTE application. See *supra*, § A-B. The second requirement is not met because the Director herein is issuing a negative eligibility determination, thus divesting him of authority to grant an interim extension. Id.; see *Somerset*, 500 F.3d at 1346 ("[T]he Director has denied Somerset's application for extension. Therefore, the Director has no statutory authority to issue the interim extension Somerset seeks."); see also *In re Alcon Labs. Inc.*, 13 USPQ2d 1115, 1123 (Comm'r Pat. & Trademarks 1989) (denying an interim extension application because the underlying patent term extension application was denied and because the patent was not eligible for extension). Accordingly, since neither requirement for an interim extension under § 156(e)(2) is satisfied, the Office must deny Applicant's pending interim extension request.

D. Conclusion

Because the approval of NUEDEXTA® fails to comply with the requirement of section 156(a)(5)(A), the application for patent term extension under 35 U.S.C. 156(d)(1) is **denied**. Additionally, since the underlying application is not eligible for extension, the USPTO is without authority to grant an interim extension, thus, the request for an interim extension under 35 U.S.C. 156(e)(2) is **denied**.

This is considered a final agency decision.

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

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

By FAX: (571) 273-7755

Telephone inquiries related to this determination should be directed to Mary C. Till Senior Legal Advisor, at (571) 272-7755.

Brian E. Hanlon
Director
Office of Patent Legal Administration
United States Patent and Trademark Office

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

Attention: Beverly Friedman

Re: NUEDEXTA®
(dextromethorphan hydrobromide and quinidine sulfate)
Docket No. FDA-2011-E-0269

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3-17-11

TO SPE OF : ART UNIT 1765

SUBJECT : Request for Certificate of Correction for Appl. No.: 12397976 Patent No.: 7887926

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 – 9D10-E
Palm Location 7580

Omega Lewis
Certificates of Correction Branch

703-756-1575

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: _____

_____

_____

_____

_____

Donna Sullivan — 1765

SPE — **Art Unit**

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Paper No. 29

JUDY JARECKI-BLACK; PH.D., J.D.
3239 SATELLITE BLVD. 3RD FLOOR
DULUTH GA 30096

MAILED
MAR 08 2011
OFFICE OF PETITIONS

In re Patent No. 5,747,063	:	
Issue Date: 05/05/1998	:	
Application Number: 07/896,905	:	ON PETITION
Filing Date: 06/11/1992	:	
Attorney Docket Number: MER NF09	:	

This is a decision is in response to the petition under 37 CFR 1.378(b),[1] filed on April 6, 2010, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is **dismissed**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f). 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.

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[1] A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);
(2) the surcharge set forth in §1.20(I)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The patent issued on May 5, 1998. The first maintenance fee was timely paid. The second maintenance fee could have been paid during the period from May 5 through November 7, 2005, or, with a surcharge, during the period from November 8, 2005, through May 5, 2006. Accordingly, this patent expired at midnight on May 5, 2006, for failure to timely remit the maintenance fee. On July 9, 2009, a petition under 37 CFR 1.378(c) was filed. On November 3, 2009, the petition was dismissed because the petition was filed more than 24 months after the expiration of the six month grace period specified in 35 U.S.C. 41(b).

Petitioners, assignees Merial SAS and Merial Ltd. (collectively "Merial") assert that the delay in payment was unavoidable because the previous attorneys responsible for the subject patent, Cabinet Lavoix (hereinafter "Lavoix") and Larson & Taylor (hereinafter "L&T") were instructed in 2003 by Merial to transfer all patent files and records to Merial's registered patent practitioners, the law firm of Frommer Lawrence and Haug LLP (hereinafter "FLH"). However "for reasons that petitioner cannot ascertain from the former US and French attorneys, the transfer did not occur as to the '063 patent."

Petitioners further state that because the files were not transferred, petitioners' US counsel, FLH, and the entity which petitioners intended to utilize for payment of the maintenance fees, CPI Patent Annuity Service (hereinafter "CPI") were never made aware that maintenance fees were due for the subject patent.

Lastly, petitioners state that the former attorneys, Lavoix and L&T (which was acquired in 2004 by the law firm of Stites & Harbison PLLC (hereinafter "S&H")), neither informed petitioners that the maintenance fee was due nor paid the maintenance fee.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks requirement (1).

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".[2]

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").[3] Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[4] In this regard:

> 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.[5]

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.[6] That is, an adequate showing that the

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[2] 35 U.S.C. § 41(c)(1).

[3] Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

[4] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

[5] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

[6] Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.[7]

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable.[8] Petitioners are reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.[9]

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.378(b):

(1) The delay in reply that originally resulted in expiration;
(2) The delay in filing an initial petition pursuant to § 1.378(b) to revive the application; and
(3) The delay in filing a *grantable* petition pursuant to § 1.378(b) to revive the application.[10]

This petition lacks the showing required by periods (1) and (3).

With regard to period (1), petitioners assert that the delay was unavoidable because the attorneys previously responsible for tracking and payment of the maintenance fee, Lavoix and S&H, failed to transfer the files and records for the patent to petitioners' current attorney, FLH, and that therefore the patent was not docketed for payment of the maintenance fees by FLH and the third party service responsible for payment of the maintenances fees, CPI.

The showing of record is that petitioners relied upon Lavoix and S&H to the extent that they were to transfer information concerning the patent to FLH and/or CPI such that the maintenance fees for the subject patent could be docketed for tracking.

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[7] Id.

[8] Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960)(35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing).

[9] See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991)(table), *cert. denied*, 502 U.S. 1075 (1992); Ray v. Lehman, supra.

[10] See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

While petitioners allegedly chose to rely upon Lavoix and S&H, such reliance *per se* does not provide petitioner with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 U.S.C. § 41(c).[11] Rather, such reliance merely shifts the focus of the inquiry from petitioners to whether the attorneys or agents acted reasonably and prudently.[12] As such, assuming that the agents had been so engaged, then it is incumbent upon petitioners to demonstrate, via a documented showing, that the attorneys or agents had docketed this patent for the second maintenance fee payment in a reliable tracking system.[13] If petitioners cannot establish that the agents had been so engaged, then petitioners will have to demonstrate what steps were established by petitioners to monitor and pay the maintenance fee.

Therefore, any showing of unavoidable delay must include a statement from the attorneys and other persons responsible for the transfer of the files and records from Lavoix and S&H to FLH, as well as any other attorney(s) of record during the period that payment of the maintenance fee was delayed, as to why Lavoix and L&T failed to timely inform FLH of the need to pay maintenance fees in the subject patent. Petitioners must provide an explanation as to why the delay in providing the relevant information to FLH such that payment of the maintenance fee could be timely made, was unavoidable.

The above paragraph notwithstanding, petitioners are reminded that the failure of communication between an applicant and counsel is not unavoidable delay.[14] Specifically, delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).[15] Moreover, the Office is not the proper forum for resolving a dispute as to the effectiveness of communications between parties regarding the responsibility for paying a maintenance fee.[16]

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[11] See California Med. Prod. v. Technol. Med. Prod., 921 F. Supp. 1219, 1259 (D. Del. 1995).

[12] Id.

[13] Id.

[14] In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

[15] See Ray v. Lehman, 55 F.3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1995).

[16] Id.

A delay resulting from a lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP does not constitute an "unavoidable" delay.[17] As the showing of record does not rise to the level of unavoidable delay, the petition will be dismissed.

Alternatively, if Lavoix and/or S&H believed they were still responsible for payment of the maintenance fee for the subject patent, and explanation much be provided as to why the delay in payment of the maintenance fee by Lavoix and/or S&H was unavoidable. Affidavits or declarations of facts by all persons with first-hand knowledge of the details containing the delay in payment of the maintenance fee must be provided.

With regard to period (3), the initial petition under 37 CFR 1.378(c) was dismissed on November 3, 2009. The subject petition under 37 CFR 1.378(b) was not filed until April 6, 2010, however, over five (5) months after the decision dismissing the initial petition had been mailed. As a grantable petition under 37 CFR 1.378(b) requires a showing that the ***entire*** period, from the date the maintenance fee was due until the date of filing of a grantable petition, was unavoidable, petitioners must explain why this over five (5) month delay should be considered unavoidable.

As petitioners have not met their burden of showing that the entire delay was unavoidable, the petition must be **dismissed**.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

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

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[17] See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

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

Telephone inquiries 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

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

DAVIS & BUJOLD, P.L.L.C.
112 PLEASANT STREET
CONCORD NH 03301

MAILED

FEB 28 2011

OFFICE OF PETITIONS

In re Patent No. 5,343,966 : Paper No. 18
Issue Date: September 06, 1994 :
Application No. 07/898,003 : DECISION ON PETITION
Filed: June 16, 1992 :
Attorney Docket No. **PROCHO-P40A-** :

This is a decision on the petition under 37 CFR 1.378(c), filed October 21, 2010, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

The above-identified patent issued on September 06, 1994. Therefore, the period set forth in 35 U.S.C. § 41(b) for paying the eleven and one-half year maintenance fee expired on September 06, 2006.

A petition under 37 CFR 1.378(c) must be filed within twenty-four months after the six month grace period specified in 35 USC 41(b). The six months grace period for the instant patent expired at midnight on September 06, 2006. Accordingly, an unintentional petition to reinstate the instant patent must have been submitted no later than September 06, 2008. Since the petition was not timely filed, the instant patent will not be considered for reinstatement under the unintentional provisions of 37 CFR 1.378(c).

35 U.S.C. § 41(c)(1) authorizes the Commissioner to accept a delayed maintenance fee payment within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) if the delay is shown to have been unintentional, and authorizes the Commissioner to accept a delayed maintenance fee payment at any time if the delay is shown to have been unavoidable. Thus, 35 U.S.C. § 41(c)(1) does not authorize the Commissioner to accept a delayed maintenance fee payment later than twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) unless the delay is shown to have been unavoidable. Since the instant petition was not filed within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b), the Commissioner cannot accept a delayed maintenance fee payment for the above-identified patent under 37 CFR 1.378(c).

Should petitioner wish to pursue reinstatement of the above-identified patent on the basis of unavoidable delay, petitioner should file a petition under 35 U.S.C. § 41(c) and 37 CFR 1.378(b), which must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the

patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

It is noted that the petitioner authorized charge of $9,210 to the deposit account. However, the Office has charged the Deposit Account an amount of $5750 that includes the maintenance fee due of $4110 and a surcharge of $1640.

If petitioner does not wish to pursue reinstatement of this expired patent, petitioner may request a refund of the $5750 charged to the deposit account. The request should be made in writing and addressed to: Mail Stop 16, Director of the U.S. Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of fee address (form PTO/SB/47) and a request for customer number (form PTO/SB/125) should be filed in accordance with Manual of Patent Examining Procedure, section 2540. A courtesy copy of this decision is being mailed to the address on the petition. However, the Office will mail all future correspondence solely to the address of record.

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

By Mail:
Mail Stop 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 Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Telephone inquiries should be directed to Tredelle Jackson at 571-272-2783.

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

cc: **VICTOR SEGURA**
7909 PARKWOOD CIRCLE DR.
HOUSTON TX 77036

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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VENABLE LLP
P.O. BOX 34385
WASHINGTON DC 20043-9998

MAILED
APR 19 2011
OFFICE OF PETITIONS

Paper No. 61

In re Patent No. 5,879,936
Issue Date: March 9, 1999
Application No. 07/898,165
Filed: June 12, 1992
Inventor: Christopher R. Bebbington et al.

: DECISION ON PETITION

This is a decision on the petition for expungement of information, filed September 28, 2010, which is being treated as petitions under 37 CFR 1.182 to invalidate an assignment previously recorded against the above-identified application.

The petition is **dismissed**. This is not a final agency action.

Petitioner indicates an assignment recorded on August 1, 2006 was erroneously filed for the above identified application and requests this assignment record be expunged from the file.

As discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or "expunge" assignment records are granted only if the petitioner can prove that:

(A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and
(B) the integrity of the assignment records will not be affected by granting the petition.

In regard to B, petitioner has not sufficiently explained how the removal of a document in its entirety will not affect the assignment records. The removal of a document in its entirety will affect the assignment records. The integrity of the records is recognized as separate from the chain of title, and the USPTO endeavors to maintain a complete history of claimed interests in a given property to permit, among other things, the review of matters like chain of title by a competent authority.

Moreover, petitioner seeks an extraordinary remedy, properly addressed under 37 CFR 1.182. The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982).

As set forth in MPEP 323, an error in a recorded assignment is not corrected by invalidating the previous document, but by simply submitting a "corrective document". The "corrective document" must include 1) a copy of the original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and 2) a new Recordation Form Cover Sheet (form PTO-1595). The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06. Petitioner should note that the "assignment documents" and "corrective documents" are not limited to assignments, but include any documents affecting title to a patent or application. See MPEP § 313.

Therefore, the rules of practice and the procedures before the USPTO provide an avenue for the requested relief without relying upon extraordinary measures. That is, the chain of title can be clarified in the assignment records through the recording of a corrective document. As a request for the Office to invalidate an assignment is both extraordinary and contrary to USPTO policy, this petition must be dismissed.

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 USC 261 and 37 CFR 3.11. However, the recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. Moreover, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment document will be retained, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992).

Furthermore, it is well settled that the Office is not the appropriate forum for resolving a dispute concerning the ownership of an application or patent, and, as such, the USPTO will not permit itself to become embroiled in ownership disputes, particularly as it does not have the means or the authority to resolve such disputes. Indeed, the USPTO has no authority to decide ownership issues. See Cedars-Sinai Medical Center v. Watkins, 11F.3d 1573, 1581 n.10, 29 USPQ 2d 1188, 1194 n.10 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. (1994). Rather, state law governs contractual obligations and transfers of property rights, including those relating to patents. See Regents of the University of New Mexico v. Knight, 66 USPQ2d 1001, 1008 (Fed. Cir. 2003). The USPTO cannot settle disputes as to title as a judicial tribunal is the appropriate forum to resolve such controversy. See Jim Arnold Corp. v. Hydrotech Sys., Inc., 109 F.3d 1567, 1572, 42 USPQ2d 1119, 1123 (Fed. Cir. 1997)("the question of who owns the patent right and on what terms typically is a question exclusively for state courts"); Roach v. Crouch, 24 N.W. 2d 400, 33

USPQ2d 1361 (Iowa 1994)(patent ownership issue properly triable in state court); In re Haines, 1900 C.D. 102, 103 (Comm'r Pat. 1900)(same).

If petitioner is successful in resolving this dispute, the proper documentation should be promptly submitted to the USPTO for recordation against the patent.

Also, Office records do not indicate that a change of address has been filed in this case, although the address given on the petition differs from the address of record. If appropriate, 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.

A petition to expunge assignment documents is properly addressed under 37 CFR 1.182 and a fee of $400.00 is required. The $400 petition fee has been charged to petitioner's deposit account.

Telephone inquiries concerning this communication should be directed to Carl Friedman at (571)272-6842.

Christopher Bottorff
Supervisor
Office of Petitions

Cc: Womble Carlyle Sandridge & Rice PLLC
P.O. Box 7037
Atlanta Georgia 30357-0037

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

MAR - 7 2011

William M. Blackstone
Akzo Nobel NV
903 St. Georges Rd
Baltimore, MD 21210

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,270,057

Dear Mr. Blackstone:

An interim extension under 35 U.S.C. § 156(e)(2) is enclosed extending the term of U.S. Patent No. 5,270,057 for a period of 193 days. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates set forth in the Patent and Exclusivity Data Appendix of the Orange Book (Approved Drug Products with Therapeutic Equivalence Evaluations) or in the Patent Information set forth in the Green Book (FDA Approved Animal Drug Products). Effective August 18, 2003, patent submissions for publication in the Orange Book and Docket *95S-0117 need to be submitted on form FDA-3542 which may be downloaded from FDA's Electronic Forms Download Website: http://www.fda.gov/opacom/morechoices/fdaforms/default.html (http://www.fda.gov/opacom/morechoices/fdaforms/FDA-3542.pdf).

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

RE: FOLLISTIM®
Docket No.: 95E-

Attention: Beverly Friedman

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Akzo Nobel N.V.	:	
Request for Patent Term Extension	:	ORDER GRANTING
U.S. Patent No. 5,270,057	:	INTERIM EXTENSION

Akzo Nobel N.V., the current owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 5,270,057, filed an application for patent term extension under 35 U.S.C. § 156 on November 25, 1997. The original term of the patent is due to expire on March 20, 2011. The patent claims the active ingredient, recombinant human follicle stimulating hormone (hFSH), in the human drug product FOLLISTIM® which was approved by the Food and Drug Administration for commercial marketing or use on September 29, 1997. An extension of 193 days is requested.

The initial USPTO review of the application to date indicates that the subject patent is eligible for extension of the patent term under 35 U.S.C. § 156. A final determination of the length of the extension of the patent term and issuance of a patent term extension certificate cannot be made until a final determination of the length of the regulatory review period is made. Because the original term of the patent would expire before a certificate of patent term extension can be issued, an interim extension of the patent term is appropriate.

An interim extension under 35 U.S.C. § 156(e)(2) of the term of U.S. Patent No. 5,270,057 is granted for a period of 193 days from the original expiration date of the patent.

March 4, 2011

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6332221	2001-12-25	07916072	1993-10-21	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	◉	7 ½ year	(2552)
○	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

◉ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Sole Patentee			
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 form of the signature.			
Signature	/By: Gracey D.A.R/	Date (YYYY-MM-DD)	2011-12-25
Name	Nicholas Dynes Gracey		

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 6332221
Issue Date: December 25,2001
Application No. 07916072
Filed: October 21,1993
Attorney Docket No.

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed December 25,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of December 25,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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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OCT - 1 2010

Philip S. Johnson, Esq.
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08816

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,254,556

Dear Mr. Johnson :

An order granting interim extension under 35 U.S.C. § 156(e)(2) is enclosed extending the term of U.S. Patent No. 5,254,556 for a period of one year from the previously extended expiration date. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates set forth in the Patent and Exclusivity Data Appendix of the Orange Book (Approved Drug Products with Therapeutic Equivalence Evaluations). As of August 18, 2003, patent information is required to be submitted on FDA Form 3542 depending on the approval status of the application. Form FDA 3542 is the only form that will be used for Orange Book publication the forms can be found at: http://www.fda.gov/downloads/AboutFDA/ReportsManualsForms/Forms/UCM048345.pdf

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

RE: Invega Sustenna®
FDA Docket No.:

Attention: Beverly Friedman

UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Ortho-McNeil-Janssen Pharmaceuticals, Inc.	:	
Request for Patent Term Extension	:	ORDER GRANTING
U.S. Patent No. 5,254,556	:	INTERIM EXTENSION

Ortho-McNeil-Janssen Pharmaceuticals, Inc., the owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 5,254,556, filed an application for patent term extension under 35 U.S.C. § 156 on August 6, 2009. The original term of the patent expired on October 27, 2009. The patent claims paliperidone palmitate, labeled as the active ingredient in the human drug product Invega Sustenna®, which was approved by the Food and Drug Administration for commercial marketing or use on July 31, 2009. An extension of 1,449 days is requested.

The initial USPTO review of the application to date indicates that the subject patent is eligible for extension under 35 U.S.C. § 156. Because the extended term of the patent would expire before a certificate of patent term extension can be issued, an additional interim extension of the patent term is appropriate.

A second interim extension under 35 U.S.C. § 156(e)(2) of the term of U.S. Patent No. 5,254,556 is granted for a period of one year from the extended expiration date of the patent, i.e., until October 27, 2011.

October 1, 2010

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

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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OCT 4 2011

Philip S. Johnson, Esq.
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08816

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,254,556

Dear Mr Johnson.:

An interim extension under 35 U.S.C. § 156(e)(2) is enclosed extending the term of U.S. Patent No. 5,254,556 for a period of one year from the extended expiration date. While a courtesy copy of this letter is being forwarded to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates set forth in the Patent and Exclusivity Data Appendix of the Orange Book (Approved Drug Products with Therapeutic Equivalence Evaluations) or in the Patent Information set forth in the Green Book (FDA Approved Animal Drug Products). Effective August 18, 2003, patent submissions for publication in the Orange Book and Docket *95S-0117 need to be submitted on form FDA-3542 which may be downloaded from FDA's Electronic Forms Download Website: http://www.fda.gov/opacom/morechoices/fdaforms/default.html (http://www.fda.gov/opacom/morechoices/fdaforms/FDA-3542.pdf).

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

RE: Invega Sustenna®
Docket No.: FDA-2009-E-0541

Attention: Beverly Friedman

UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Ortho-McNeil-Janssen Pharmaceuticals, Inc.	:	
Request for Patent Term Extension	:	ORDER GRANTING
U.S. Patent No. 5,254,556	:	INTERIM EXTENSION

Ortho-McNeil-Janssen Pharmaceuticals, Inc., the owner of record in the United States Patent and Trademark Office (USPTO) of U.S. Patent No. 5,254,556, filed an application for patent term extension under 35 U.S.C. § 156 on August 6, 2009. A second request for interim extension was filed on June 13, 2011. The extended term of the patent expires on October 27, 2011. The patent claims paliperidone palmitate, the active ingredient in the human drug product Invega Sustenna®, which was approved by the Food and Drug Administration for commercial marketing or use on July 31, 2009. An extension of 1,449 days is requested.

The USPTO review to date of the application to date indicates that the subject patent is eligible for extension of the patent term under 35 U.S.C. § 156. A final determination of the length of the extension of the patent term and issuance of a patent term extension certificate cannot be made until a final determination of the length of the regulatory review period is made. Because the extended term of the patent would expire before a certificate of patent term extension can be issued, a second interim extension of the patent term is appropriate.

A second interim extension under 35 U.S.C. § 156(e)(2) of the term of U.S. Patent No. 5,254,556 is granted for a period of one year from the extended expiration date of the patent, i.e., until October 27, 2012.

September 30, 2011

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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GTC BIOTHERAPEUTICS, INC.
C/O WOLF, GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON MA 02210-2206

MAILED
SEP 26 2011
OFFICE OF PETITIONS

In re Patent No. 7,045,676 :
Issued: May 16, 2006 :
Application No. 07/938,322 : ON PETITION
Filed: August 31, 1992 :
Attorney Docket Number: G0744.70042US03 :

This is a decision on the petition under 37 CFR 1.323 for a certificate of correction, filed August 18, 2011, to correct the assignees' names on the front of the Patent. The request is being treated as a request under 37 CFR 3.81(b)[1].

The petition is **GRANTED**.

Although the correct name of the assignee was not included on the Issue Fee Transmittal, PTOL-85B, petitioner states that the assignee is **Genzyme Corporation** and that the assignment was submitted for recordation before issuance in parent application Application No. 06/849,815. The instant application is a continuation of 07/426,464, which is a continuation of 07/109,922, which is a division of 06/849,815.

In view thereof, and since Office assignment records reflect that **Genzyme Corporation** is the assignee of record, the request complies with the provisions of 37 CFR 3.81(b) and it is therefore appropriate for a certificate of correction to issue.

The fee for the certificate of correction in the amount of $100 has been charged to the credit card provided. The petition fee in the amount of $130.00 has been charged to deposit account no. 23-2825 as authorized in the petition.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-3212. Any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

This file is being referred to the Certificates of Correction Branch for issuance of a certificate of correction.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SEP 26 2011

OFFICE OF PETITIONS

GTC BIOTHERAPEUTICS, INC.
C/O WOLF, GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON MA 02210-2206

In re Patent No. 7,045,676 :
Issued: May 16, 2006 :
Application No. 07/938,322 : ON PETITION
Filed: August 31, 1992 :
Attorney Docket No. G0744.70042US03 :

This is a decision on the "PETITION UNDER 37 C.F.R. § 1.182 TO WITHDRAW TERMINAL DISCLAIMER AND REPLACE WITH CORRECTED TERMINAL DISCLAIMER" filed August 18, 2011, requesting correction to the terminal disclaimer filed on October 24, 2005.

The petition is **DISMISSED** to the extent that the Terminal Disclaimer filed October 24, 2005 will not be removed from the record.

Any request for reconsideration must be filed within TWO (2) MONTHS. This 2-month period is governed by 37 CFR 1.181(f) and is not extendable under 37 CFR 1.136.

Application No. 07/938,322 was filed on August 31, 1992 and issued as U.S. Patent No. 7,045,676 on May 16, 2006.

Patentees state that a terminal disclaimer was originally filed on October 24, 2005. However, there was an inadvertent error in the originally filed Terminal Disclaimer with respect to the identified Assignee. Patentees request that the attached replacement Terminal Disclaimer be entered into the Official file in lieu of the Terminal Disclaimer filed on October 24, 2005, to correct the inadvertent error.

The Terminal Disclaimer filed October 24, 2005 disclaimed, "the terminal part of the statutory term of any patent granted on the Instant application which would extend beyond the expiration date of the full statutory term prior patent No. 6,727,405 as the term of said prior patent is defined in 35 U.S.C. 154 and 173, and as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the Instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned: This agreement runs with any patent granted on the instant app cat on and is binding upon the grantee, its successors or assigns."

The captioned application is a continuation of 07/426,464, which is a continuation of 07/109,922, which is a division of 06/849,815. The assignment for U.S. Serial No. 07/938,322 was not recorded until March 24, 2011, after the issuance of the instant application, however, the assignment of parent application 06/849,815 was recorded from inventors Katherine Gordon and Suzanne Groet to INTEGRATED GENETICS, INC., A CORP OF DELAWARE on April 8, 1986 at Reel 004538, Frame 0221. A subsequent assignment of parent application 06/849,815 from INTEGRATED GENETICS, INC., A CORP OF DELAWARE to GENZYME CORPORATION was recorded on March 13, 1990 at Reel 005251, Frame 0611. The assignments assigned the application underlying U.S. Serial No. 06/849,815, as well as, inter alia, all continuations and divisionals based upon that application. The Terminal Disclaimer filed October 24, 2005 is signed by Byron V. Olsen on behalf of assignee/owner BIOTHERAPEUTICS, INC.

The "replacement" Terminal Disclaimer however is signed by Richard D. Allison and lists the assignee/owner as GENZYME CORPORATION.

The two disclaimers are both signed by individuals empowered to act on behalf of the assignee/owner, the difference in the two disclaimers is the reference to the assignments. A review of Office records confirms that the assignments have all now been recorded.

Nonetheless, the Terminal Disclaimer filed October 24, 2005 was accepted and recorded by the examiner.

Moreover, assignment data printed on the patent is based solely on the information so supplied on the Issue Fee Transmittal Form (PTOL-85B). A review of the record indicates that the Issue Fee Transmittal Form (PTOL-85B) submitted December 23, 2005 identified the assignee as BIOTHERAPEUTICS, INC. and thus, the patent properly issued to assignee BIOTHERAPEUTICS, INC., with a Notice that:

> This patent is subject to a terminal disclaimer.

In view of the chain of title and the recordation of the assignment in parent application U.S. Serial No. 06/849,815 and in view of the request to correct the assignees' names on the front of the Patent, a certificate of correction will be issued.

However, patentees request for removal of the Terminal Disclaimer filed October 24, 2005 from the application record, to be replaced with the Terminal Disclaimer filed August 18, 2011 with the instant petition is inappropriate.

Placement of the Terminal Disclaimer filed August 18, 2011 (along with the petition and petition decision) in the record is sufficient to complete the record. The Terminal

Disclaimer filed August 18, 2011 is accepted and recorded. No further action will be undertaken.

The petition fee of $400 has been charged to the credit card provided.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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LYON & LYON LLP
633 WEST FIFTH STREET
SUITE 4700
LOS ANGELES CA 90071

MAILED
MAR 28 2011
OFFICE OF PETITIONS

In re Application of :
Petros Koutrakis, et al. :
Application No. 07/938,854 : NOTICE
Filed: September 1, 1992 :
Attorney Docket No. **199/128** :

This is a notice regarding your request filed February 9, 2011, for acceptance of a fee deficiency submission under 37 CFR 1.28.

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**.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Mr. Timothy J. Oyer appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. If, Mr. Timothy J. Oyer desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to Mr. Timothy J. Oyer, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

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

Inquiries related to this communication should be directed to the undersigned at (571) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Timothy J. Oyer
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, Massachusetts 02210-2206

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 17

RONALD S CHAMBERS
4 TONYS DRIVE
LITTLE EGG HARBOR NJ 08087

MAILED

NOV 09 2010

OFFICE OF PETITIONS

In re Patent No. 5,333,418 :
Issue Date: August 2, 1994 :
Application No. 07/939,134 : DECISION ON PETITION
Filed: September 2, 1992 :
Title: Recessed Smoke Detector :
:

This is a decision on the renewed petition under 37 CFR 1.378(b), filed July 16, 2010 (Certificate of Mailing dated July 8, 2010), to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED** as untimely filed.

Procedural History:

- The above-identified patent issued on August 2, 1994.
- The third maintenance fee could have been timely paid during the period from August 2, 2005 through February 2, 2006, or with a late payment surcharge during the period from February 3, 2006 through August 2, 2006.
- No maintenance fee having been received, the patent expired on August 3, 2006.
- The twenty-four month period for filing a petition to accept the unintentionally delayed payment of the maintenance fee expired on August 3, 2008.
- Patentee filed a petition to accept the unavoidably delayed payment of the maintenance fee under 37 CFR 1.378(b) on September 2, 2008.

- The petition was dismissed in a decision mailed on September 26, 2008. The decision set a two month period for response.

- Patentee filed the instant request for reconsideration nearly two years later on July 16, 2010.

Opinion:

37 CFR 1.2 states that business of the US Patent and Trademark Office is conducted in writing. The September 26, 2008 decision on petition set a two (2) month period to file a request for reconsideration. Patentee did not file the instant request for reconsideration until July 16, 2010, twenty months **after** the two month period set for response. As such, the instant request for reconsideration is considered untimely under 37 CFR 1.181(f).[1]

Conclusion:

The prior decision which refused to accept under 37 C.F.R. § 1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. For the above stated reasons, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 C.F.R. § 1.378(b). As stated in 37 C.F.R. § 1.378(e), no further reconsideration or review of this matter will be undertaken.

The $400 fee for filing the instant request for reconsideration is not refundable. The maintenance fee and surcharge were previously refunded to petitioner on February 23, 2010.

Telephone inquiries concerning this communication should be directed to Petitions Attorney Cliff Congo at (571)272-3207.

Anthony Knight
Director
Office of Petitions

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[1] 37 CFR 1.181(f) states that any petition "not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely."

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MAILED
SEP 08 2011
OFFICE OF PETITIONS

VEDDER PRICE P.C.
875 15TH STREET, NW
SUITE 725
WASHINGTON DC 20005

In re Patent No. 5,830,847 :
Issue Date: November 3, 1998 :
Application No. 07/968,953 : ON PETITION
Filed: October 30, 1992 :
Attorney Docket No. P-TE-9438 :

This is a decision on the petition under 37 CFR 1.378(c), filed March 1, 2011, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on November 4, 2010 for failure to pay the eleven and one-half year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. 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 the delay in paying the maintenance fee under 37 CFR 1.378(c) was intentional, petitioner must notify the Office.

Petitioner paid a fee amount of $1,620 on March 1, 2011, however, the surcharge fee as set forth in 37 CFR 1.20(i)(2), and the maintenance fee as set forth in 37 CFR 1.20(g) are $1,640 and $4,110, respectively. As such, the fee amount of $1,620 paid on March 1, 2011 will be credited towards the surcharge fee of $1,640, leaving a balance owed of $20, plus the maintenance fee of

$4,110, for a total of $4,130. The total amount owed of $4,130 will be charged to Deposit Account No. 22-0259, as authorized by Petitioner.

Telephone inquiries concerning this decision should be directed to Andre Boyce at (571) 272-6726, or in his absence, the undersigned at (571) 272-7099.

David A. Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 23 2010

OFFICE OF PETITIONS

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER CO 80202-5647

In re Patent No. 5,799,320 :
Issue Date: August 25, 1998 :
Application No. 07/975,905 : DECISION ON PETITION
Filed: November 12, 1992 :

This is a decision on the petition to reinstate an expired patent under 37 CFR 1.378(c), filed October 4, 2010.

The petition under 37 CFR 1.378(c) is **GRANTED**.

The above-identified patent issued August 25, 1998. Accordingly, the third maintenance fee could have been paid during the period from August 25, 2009 through February 25, 2010 without surcharge, or with a late payment surcharge during the period from February 26, 2010 through August 25, 2010. No maintenance fee having been received, the patent expired on August 26, 2010.

Since the instant petition was filed within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c). The maintenance fee in this case is accepted and the above-identified patent is hereby reinstated as of the mail date of this decision.

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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United States Patent and Trademark Office
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MAR 06 2012

OFFICE OF PETITIONS

Uniloc USA Inc.
2151 Michelson Ste. 100
Irvine CA 92612

Patent No. 5,579,222 :
Issued: November 26, 1996 :
Application No. 07/990,583 : RESPONSE TO PETITION
Filed: December 14, 1992 :
Attorney Docket No. UN-NP-SA-073 :

This is a response to the petition filed January 6, 2012, which is being treated as under 37 CFR 1.59(b) to expunge information from the above identified application.

The petition is dismissed.

Petitioner requests that a Complaint of Patent Infringement be expunged from the application file for the above identified patent. The petition submits that this information was unintentionally submitted in the above identified application due to scrivener's error.

However, the rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition to expunge a document from a patent application. In this instance, the fee required by law is $200.00.

The petition in the above-identified application was not accompanied by payment of the required fee. No consideration on the merits can be given to the petition until the required fee is received.

Also, petitioner should note that, as stated in 37 CFR 1.59, "any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided."

The standards for expunging information that is unintentionally submitted in an application, including the standards for establishing that the expungement of the information is appropriate, are discussed in MPEP section 724.05 II. This section states, among other things, that a petition may be filed under 37 CFR 1.59(b) provided that the Office can effect such expungement prior to the issuance of any patent on the application in issue. In this instance, the patent has already issued.

Furthermore, a review of the Official File for Application Serial No. 07/990,583 did not reveal the presence of the Complaint that petitioner requests the Office to expunge.

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

Christopher Bottorff
Petitions Examiner
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,965,086	1999-10-12	08/009,381	1993-01-27	008073-3052

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Annette S. Parent/	Date (YYYY-MM-DD)	2011-02-07
Name	Annette S. Parent	Registration Number	42058

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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
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In re Patent No. 5965086
Issue Date: October 12,1999
Application No. 08009381
Filed: January 27,1993
Attorney Docket No. 450-052B

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 7,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 7,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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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Paper No.

MELVIN K. SILVERMAN
SUITE 500
500 WEST CYPRESS CREEK ROAD
FT. LAUDERDALE FL 33309

MAILED

DEC 29 2011

OFFICE OF PETITIONS

In re Application of :
Shaw :
Application No. 08/017,063 :
Patent No.: 5,415,545 : DECISION ON PETITION
Filed: February 12, 1993 : PURSUANT TO
Issued: May 16, 1995 : 37 C.F.R. § 1.28(c)
Title: DENTAL IMPLANT SYSTEM :

This is a notice regarding your request for acceptance of a fee deficiency submission pursuant to 37 C.F.R. § 1.28, received on December 15, 2011. 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 fee that was erroneously paid as a small entity, when the small entity fee was actually paid, the small entity fee that was actually paid, the deficiency owed amount, and the total deficiency payment owed.

The deficiency payment in the amount of $2830 has been received.

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.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this patent, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to the address which appears on the petition. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this patent unless Change of Correspondence Address, Patent Form (PTO/SB/123) is submitted for the above-identified patent. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/123), may be found at http://www.uspto.gov/web/forms/sb0123.pdf.

If appropriate, a change of fee address (form PTO/SB/47) and a request for customer number (form PTO/SB/125) should be filed in accordance with Manual of Patent Examining Procedure, section 2540. A blank fee address form may be found at http://www.uspto.gov/web/forms/sb0047.pdf.

It is not apparent whether the person signing the statement which asserts that small entity status was established in good faith was in a position to have firsthand or direct knowledge of the facts and circumstances of the establishment of small entity status. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such establishment. 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 the establishment of small entity status was not made in good faith, Petitioner must notify the Office.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[1]

Paul Shanoski
Senior Attorney
Office of Petitions

cc: SHERIDAN K. SNEDDEN
Pillsbury Winthrop Shaw Pittman LLP
P.O. Box 10500
McLean, VA 22102

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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Alexandria, VA 22313-1450
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FAEGRE & BENSON LLP
PATENT DOCKETING - INTELLECTUAL PROPERTY
2200 WELLS FARGO CENTER
90 SOUTH SEVENTH STREET
MINNEAPOLIS MN 55402-3901

MAILED

OCT 07 2010

OFFICE OF PETITIONS

In re Patent No: 5,415,169 :
Issued: May 16, 1995 :
Application No. 08/018,805 : NOTICE
Filed: February 17, 1993 :
Attorney Docket No. 253020 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed August 12, 2010. 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 **DISMISSED**.

The request under 37 CFR 1.28 cannot be accepted at this time since it appears that the petition is not signed by a person having authority to act in the above-identified patent.

Petitioner's attention is directed to 37 CFR 1.33(b), which states.

Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);
(2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;
(3) An assignee as provided for under §3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

Petitioner has submitted an improper Statement Under 37 CFR 3.73(b). According to USPTO records, Fischer Imaging Corporation, is not the current assignee in the above-identified patent.

Accordingly, the request cannot be accepted until it is signed by all inventors, an attorney or agent registered to practice before the U.S. Patent and Trademark Office or the assignee of the entire interest under 37 CFR 3.73(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 Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Additionally, the address given on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

/Joan Olszewski/
Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Horst König
Siemens Aktiengesellschaft
P.O.B. 3260
91050 Erlangen
Germany

UNITED STATES PATENT AND TRADEMARK OFFICE

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BAKER & MCKENZIE LLP
1114 AVENUE OF THE AMERICAS
NEW YORK NY 10036

Paper No. 30

MAILED

FEB 23 2011

OFFICE OF PETITIONS

In re Patent 5,479,654 :
Issued: December 26, 1995 :
Application No. 08/039,702 : DECISION ON PETITION
Filed: March 30, 1993 :
Attorney Docket No. MEG01-008 :

This is a decision on the petition under 37 CFR 1.59(b), filed July 15, 2010, which is properly treated as a petition under 37 CFR 1.182 to expunge an assignment previously recorded at Reel/Frame 008639/0001 against the above-identified application.

The petition is **DISMISSED**. This is not a final agency action.

Petitioner contends that "[t]he Collateral Assignment, however, erroneously identifies the serial number for this application as U.S. 08/039,702. U.S. 08/039,702 (i.e., the above-captioned application) is an unrelated application, and is titled "An Apparatus and Method for Reconstructing a File From a Difference Signature and an Original File" and has a filing date of March 30, 1993. Further evidencing the fact that the Collateral Assignment was recorded in error against the above-captioned application is the fact that Squibb Data System, Inc., the assignee-of-record at the time, was not a party to the Collateral Assignment."

As an initial matter, petitioner should note that the referenced Reel/Frame 008639/0006, in the second paragraph on page one of the instant petition is incorrect. Furthermore, the statement in the petition "the Collateral Assignment references in no. 18 a patent application titled "Optical Approach to Measuring the Thickness of the Layer of Proprietary Material" having a filing date of February 13, 1997" is not clear.

The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982). Petitioner should note that, as discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or "expunge" assignment records are granted only if the petitioner can **prove** that:

(A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and

(B) the integrity of the assignment records will not be affected by granting the petition.

Petitioner has not proven item (A) above. Prior to submitting a renewed petition, petitioner is encouraged to consider the remedy available under MPEP §323.01(c).

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 USC 261 and 37 CFR 3.11. The recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. Such a determination must be made by a competent authority, like a court of appropriate jurisdiction. Moreover, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment document will be retained, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992). Accordingly, information will not be expunged from assignment records merely to present correct information in the records.

The required fee of $400.00 under 37 CFR 1.182 has been charged to Deposit Account 50-1349, as authorized.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this communication should be directed to Ramesh Krishnamurthy at (571) 272-4914.

Christopher Bottorff for
Christopher Bottorff
Supervisor,
Office of Petitions

CC: HOGAN LOVELLS US LLP
Columbia Square
555 Thirteenth Street, N.W.
Washington D.C. 20004

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6001340	1999-12-14	08039843	1993-03-30	ROSE-19122-P

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Todd E. Abanesi/	Date (YYYY-MM-DD)	2012-01-04
Name	Todd E. Abanesi	Registration Number	36426

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 6001340
Issue Date: December 14,1999
Application No. 08039843
Filed: March 30,1993
Attorney Docket No. ROSE-16218

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 4,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 4,2012 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

OCT 18 2010

Dechert LLP
c/o Ann M. Caviani Pease
2440 W. El Camino Real, Suite 700
Mountain View CA 94040-1499

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,407,914

Dear Ms. Pease:

An order granting interim extension under 35 U.S.C. § 156(d)(5) is enclosed extending the term of U.S. Patent No. 5,407,914 for a period of 1 year. A copy of the Federal Register notice, published on October 13,2010 at 75 Fed. Reg. 62766, regarding the issuance of the interim extension under 35 U.S.C. § 156(d)(5) is also enclosed. While a courtesy copy of this letter is being sent to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates which are pertinent to any filings before the FDA.

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

RE: SURFAXIN® (lucinactant)
FDA Docket No.:

Attention: Beverly Friedman

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Scripps Research Institute	:	
Request for Patent Term Extension	:	**ORDER GRANTING**
U.S. Patent No. 5,407,914	:	**INTERIM EXTENSION**

On September 22, 2010, Discovery Laboratories Inc., on behalf of patent owner Scripps Research Institute, timely filed an application under 35 U.S.C. § 156(d)(5) for an additional interim extension of the term of U.S. Patent No. 5,407,914. The patent claims the human drug product SURFAXIN® (lucinactant). The application indicates that a New Drug Application for the human drug product SURFAXIN® (lucinactant), having active ingredients sinapultide, colfosceril palmitate, palmitoyloleoylphosphatidyl glycerol sodium salt and palmitic acid, has been filed and is currently undergoing regulatory review before the Food and Drug Administration for permission to market or use the product commercially.

Review of the application indicates that, except for permission to market or use the product commercially, the subject patent would be eligible for an extension of the patent term under 35 U.S.C. § 156, and that the patent should be extended for one additional year as required by 35 U.S.C. § 156(d)(5)(B). Because it is apparent that the regulatory review period will continue beyond the extended expiration date of the patent, November 17, 2010, interim extension of the patent term under 35 U.S.C. § 156(d)(5) is appropriate.

A second interim extension under 35 U.S.C. § 156(d)(5) of the term of U.S. Patent No. 5,407,914 is granted for a period of one year from the extended expiration date of the patent, i.e., until November 17, 2011.

October 8, 2010

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

antidumping duties of 58.90 percent, the weighted-average percentage dumping margin we found for Alpanil Industries in the most recently completed review. *See Carbazole Violet Pigment 23 From India: Final Results of Antidumping Duty Administrative Review,* 75 FR 38076 (July 1, 2010).

Notification

This notice serves as a reminder to parties subject to the administrative protective order (APO) of their responsibility concerning the disposition of proprietary information disclosed under APO in accordance with 19 CFR 351.306. Timely written notification of the destruction of APO materials or conversion to judicial protective order is hereby requested. Failure to comply with the regulations and terms of an APO is a sanctionable violation.

This notice is published in accordance with sections 751(b)(1) and 777(i) of the Act and 19 CFR 351.216 and 19 CFR 351.221.

Dated: October 6, 2010.

Ronald K. Lorentzen,

Deputy Assistant Secretary for Import Administration.

[FR Doc. 2010–25777 Filed 10–12–10; 8:45 am]

BILLING CODE 3510–DS–P

DEPARTMENT OF COMMERCE

International Trade Administration

[A–570–908]

First Antidumping Duty Administrative Review of Sodium Hexametaphosphate From the People's Republic of China: Extension of Time Limit for the Final Results

AGENCY: Import Administration, International Trade Administration, Department of Commerce

DATES: *Effective Date:* October 13, 2010.

FOR FURTHER INFORMATION CONTACT: Paul Walker, AD/CVD Operations, Office 9, Import Administration, International Trade Administration, U.S. Department of Commerce, 14th Street and Constitution Avenue, NW., Washington, DC 20230; telephone: (202) 482–0413.

Background

On April 15, 2010 the Department of Commerce ("Department") published the *Preliminary Results* of the first administrative review of sodium hexametaphosphate From the People's Republic of China ("PRC"), covering the period September 14, 2007 through February 28, 2009. *See First Administrative Review of Sodium Hexametaphosphate From the People's Republic of China: Notice of Preliminary Results of the Antidumping Duty Administrative Review,* 75 FR 19613 (April 15, 2010) ("*Preliminary Results*"). On August 10, 2010 the Department extended the final results of review to October 5, 2010. *See First Antidumping Duty Administrative Review of Sodium Hexametaphosphate From the People's Republic of China: Extension of Time Limit for the Final Results,* 75 FR 48309 (August 10, 2010).

Extension of Time Limit for the Preliminary Results

As noted in the August 10 extension notice, section 751(a)(3)(A) of the Tariff Act of 1930, as amended ("the Act"), requires the Department to issue the final results of an administrative review within 120 days after the date on which the *Preliminary Results* have been published. If it is not practicable to complete the review within the time period, section 751(a)(3)(A) of the Act allows the Department to extend this deadline to a maximum of 180 days.

The Department determines that completion of the final results of this review by the current deadline is not practicable. The Department requires more time to analyze a significant amount of information pertaining to the respondent's corporate structure and ownership, sales practices and manufacturing methods. Therefore, given the number and complexity of issues in this case, and in accordance with section 751(a)(3)(A) of the Act, we are extending the time period for issuing the final results of review until October 12, 2010.

This notice is published pursuant to sections 751(1)(3)(A) and 777(i)(1) of the Act and 19 CFR 351.213(h)(2).

Dated: October 5, 2010.

Susan H. Kuhbach,

Acting Deputy Assistant Secretary for Antidumping and Countervailing Duty Operations.

[FR Doc. 2010–25770 Filed 10–12–10; 8:45 am]

BILLING CODE 3510–DS–P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO–P–2010–0079]

Grant of Interim Extension of the Term of U.S. Patent No. 5,407,914; SURFAXIN® (Lucinactant)

AGENCY: United States Patent and Trademark Office.

ACTION: Notice of Interim Patent Term Extension.

SUMMARY: The United States Patent and Trademark Office has issued an order granting interim extension under 35 U.S.C. 156(d)(5) for a second one-year interim extension of the term of U.S. Patent No. 5,407,914.

FOR FURTHER INFORMATION CONTACT: Mary C. Till by telephone at (571) 272–7755; by mail marked to her attention and addressed to the Commissioner for Patents, Mail Stop Hatch-Waxman PTE, P.O. Box 1450, Alexandria, VA 22313–1450; by fax marked to her attention at (571) 273–7755, or by e-mail to *Mary.Till@uspto.gov.*

SUPPLEMENTARY INFORMATION: Section 156 of Title 35, United States Code, generally provides that the term of a patent may be extended for a period of up to five years if the patent claims a product, or a method of making or using a product, that has been subject to certain defined regulatory review, and that the patent may be extended for interim periods of up to one year if the regulatory review is anticipated to extend beyond the expiration date of the patent.

On September 22, 2010, Discovery Laboratories Inc., on behalf of patent owner Scripps Research Institute, timely filed an application under 35 U.S.C. 156(d)(5) for an additional interim extension of the term of U.S. Patent No. 5,407,914. The patent claims the human drug product, SURFAXIN® (lucinactant) and a method of using SURFAXIN® (lucinactant). The application indicates that a New Drug Application, NDA No. 21–746, for the human drug product SURFAXIN® (lucinactant) has been filed, and is currently undergoing regulatory review before the Food and Drug Administration for permission to market or use the product commercially.

Review of the application indicates that except for permission to market or use the product commercially, the subject patent would be eligible for an extension of the patent term under 35 U.S.C. 156, and that the patent should be extended for an additional one year as required by 35 U.S.C. 156(d)(5)(B). Because it is apparent that the regulatory review period will continue beyond the extended expiration date of the patent, November 17, 2010, interim extension of the patent term under 35 U.S.C. 156(d)(5) is appropriate.

An interim extension under 35 U.S.C. 156(d)(5) of the term of U.S. Patent No. 5,407,914 is granted for a period of one additional year from the extended expiration date of the patent, *i.e.*, until November 17, 2011.

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

NOV 7 2011

Dechert LLP
c/o Ann M. Caviani Pease
2440 W. El Camino Real, Suite 700
Mountain View CA 94040-1499

In Re: Patent Term Extension
Application for
U.S. Patent No. 5,407,914

Dear Ms. Pease:

An order granting interim extension under 35 U.S.C. § 156(d)(5) is enclosed extending the term of U.S. Patent No. 5,407,914 for a third period of 1 year. A copy of the Federal Register notice, published on November 3, 2011 at 76 Fed. Reg. 68166, regarding the issuance of the interim extension under 35 U.S.C. § 156(d)(5) is also enclosed. While a courtesy copy of this letter is being sent to the Food and Drug Administration (FDA), you should directly correspond with the FDA regarding any required changes to the patent expiration dates which are pertinent to any filings before the FDA.

Inquiries regarding this communication should be directed to the undersigned by telephone at (571) 272-7755, or by e-mail at mary.till@uspto.gov.

Mary C. Till
Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

RE: SURFAXIN® (lucinactant)
FDA Docket No.:

Attention: Beverly Friedman

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Scripps Research Institute	:	
Request for Patent Term Extension	:	**ORDER GRANTING**
U.S. Patent No. 5,407,914	:	**INTERIM EXTENSION**

On September 29, 2011, Discovery Laboratories Inc., on behalf of patent owner Scripps Research Institute, timely filed an application under 35 U.S.C. § 156(d)(5) for an additional interim extension of the term of U.S. Patent No. 5,407,914. The patent claims the human drug product SURFAXIN® (lucinactant). The application indicates that a New Drug Application for the human drug product SURFAXIN® (lucinactant), having active ingredients sinapultide, colfosceril palmitate, palmitoyloleoylphosphatidyl glycerol sodium salt and palmitic acid, has been filed and is currently undergoing regulatory review before the Food and Drug Administration for permission to market or use the product commercially.

Review of the application indicates that, except for permission to market or use the product commercially, the subject patent would be eligible for an extension of the patent term under 35 U.S.C. § 156, and that the patent should be extended for one additional year as required by 35 U.S.C. § 156(d)(5)(B). Because it is apparent that the regulatory review period will continue beyond the extended expiration date of the patent, November 17, 2011, interim extension of the patent term under 35 U.S.C. § 156(d)(5) is appropriate.

A third interim extension under 35 U.S.C. § 156(d)(5) of the term of U.S. Patent No. 5,407,914 is granted for a period of one year from the extended expiration date of the patent, i.e., until November 17, 2012.

October 28, 2010

Date

David J. Kappos

David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office

Regardless of fishing region or species, each sector must be adequately represented, and the intent is to have a group that, as a whole, reflects an appropriate and equitable balance and mix of interests given the responsibilities of the HMS AP. Criteria for membership include one or more of the following: (1) Experience in the HMS recreational fishing industry; (2) experience in the HMS commercial fishing industry; (3) experience in fishery-related industries (*e.g.*, marinas, bait and tackle shops); (4) experience in the scientific community working with HMS; and/or (5) representation of a private, non-governmental, regional, national, or international organization representing marine fisheries; or environmental, governmental, or academic interests dealing with HMS.

Five additional members on the HMS AP include one member representing each of the following Councils: New England Fishery Management Council, the Mid-Atlantic Fishery Management Council, the South Atlantic Fishery Management Council, the Gulf of Mexico Fishery Management Council, and the Caribbean Fishery Management Council. The HMS AP also includes 22 ex-officio participants: 20 representatives of the coastal states and two representatives of the interstate commissions (the Atlantic States Marine Fisheries Commission and the Gulf States Marine Fisheries Commission).

NMFS will provide the necessary administrative support, including technical assistance, for the HMS AP. However, NMFS will not compensate participants with monetary support of any kind. Depending on availability of funds, members may be reimbursed for travel costs related to the HMS AP meetings.

Meeting Schedule

Meetings of the HMS AP will be held as frequently as necessary but are routinely held twice each year in the spring and fall. The meetings may be held in conjunction with public hearings.

Dated: October 31, 2011.

Steven Thur,

Acting Director, Office of Sustainable Fisheries, National Marine Fisheries Service.

[FR Doc. 2011–28553 Filed 11–2–11; 8:45 am]

BILLING CODE 3510–22–P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO–C–2011–0054]

Discontinuing the Mass Mailing of Paper Fee Schedules to Registered Attorneys, Agents, and Deposit Account Holders

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice.

SUMMARY: The United States Patent and Trademark Office (USPTO) is discontinuing the mass mailing of revised paper fee schedules to registered attorneys, agents, and deposit account holders when fees are adjusted due to enactment of legislation or fluctuations in the Consumer Price Index. Since a substantial majority of filings and fee payments are submitted on-line, and the most up-to-date fee schedule is always available and maintained on-line, the USPTO has discontinued the mass mailing of the paper fee schedules. The current fee schedule is essentially built into the on-line systems (e.g., EFS–Web, TEAS, accessible through the USPTO home page, etc.), which display the current fee amounts required at the time of submitting the payment.

DATES: *Effective Date:* November 3, 2011.

FOR FURTHER INFORMATION CONTACT: Matthew Lee, Office of Finance, Receipts Accounting Division, by telephone at (571) 272–6343; or by mail addressed to: Mail Stop 16, Director of the USPTO, P.O. Box 1450, Alexandria, VA 22313–1450.

SUPPLEMENTARY INFORMATION: The USPTO is discontinuing the mass mailing of revised paper fee schedules that have been sent to registered attorneys, agents, and deposit account holders since the early 1990s. Since 1998, the revised paper fee schedules have always indicated that the most up-to-date fee amounts and information are maintained on the USPTO Web site. This availability of the fee amounts and information renders paper fee schedules obsolete.

The purpose of the mass mailings was to provide the practitioners with advance notice of upcoming fee adjustments at a time when filings and fee payments were mainly submitted by mail. Due to the lead time needed for finalizing, bulk printing, and mass mailing of the paper fee schedules, the paper fee schedules have sometimes been mailed out weeks after the new fees are already in effect. Currently over 90 percent of patent applications are filed on-line via EFS–Web, and over 98 percent of trademark applications are filed on-line via TEAS.

The official, current USPTO fee schedule will continue to be available and maintained on the USPTO Web site at *http://www.uspto.gov/about/offices/cfo/finance/fees.jsp.* Additionally, those wishing to receive a paper copy of the current USPTO fee schedule can obtain this copy by calling the USPTO Contact Center at (571) 272–1000 or (800) 786–9199.

Dated: October 28, 2011.

Teresa Stanek Rea,

Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office.

[FR Doc. 2011–28536 Filed 11–2–11; 8:45 am]

BILLING CODE 3510–16–P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO–P–2011–0057]

Grant of Interim Extension of the Term of U.S. Patent No. 5,407,914; SURFAXIN® (Lucinactant)

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Notice of Interim Patent Term Extension.

SUMMARY: The United States Patent and Trademark Office has issued an Order Granting Interim Extension for a third one-year interim extension of the term of U.S. Patent No. 5,407,914.

FOR FURTHER INFORMATION CONTACT: Mary C. Till by telephone at (571) 272–7755; by mail marked to her attention and addressed to the Commissioner for Patents, Mail Stop Hatch-Waxman PTE, P.O. Box 1450, Alexandria, VA 22313–1450; by fax marked to her attention at (571) 273–7755, or by email to *Mary.Till@uspto.gov.*

SUPPLEMENTARY INFORMATION: Section 156 of Title 35, United States Code, generally provides that the term of a patent may be extended for a period of up to five years if the patent claims a product, or a method of making or using a product, that has been subject to certain defined regulatory review, and that the patent may be extended for interim periods of up to one year if the regulatory review is anticipated to extend beyond the expiration date of the patent.

On September 19, 2011, Discovery Laboratories Inc., on behalf of patent

owner Scripps Research Institute, timely filed an application under 35 U.S.C. 156(d)(5) for an additional interim extension of the term of U.S. Patent No. 5,407,914. The patent claims the human drug product, SURFAXIN® (lucinactant), and a method of using SURFAXIN® (lucinactant). The application indicates that a New Drug Application, NDA No. 21–746, for the human drug product SURFAXIN® (lucinactant) has been filed, and is currently undergoing regulatory review before the Food and Drug Administration for permission to market or use the product commercially.

Review of the application indicates that, except for permission to market or use the product commercially, the subject patent would be eligible for an extension of the patent term under 35 U.S.C. 156, and that the patent should be extended for an additional one year as required by 35 U.S.C. 156(d)(5)(B). Because it is apparent that the regulatory review period will continue beyond the extended expiration date of the patent, November 17, 2011, interim extension of the patent term under 35 U.S.C. 156(d)(5) is appropriate.

An interim extension under 35 U.S.C. 156(d)(5) of the term of U.S. Patent No. 5,407,914 is granted for a period of one additional year from the extended expiration date of the patent, *i.e.*, until November 17, 2012.

Dated: October 28, 2011.

Robert W. Bahr,

Acting Associate Commissioner for Patent Examination Policy, United States Patent and Trademark Office.

[FR Doc. 2011–28499 Filed 11–2–11; 8:45 am]

BILLING CODE 3510–16–P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO–C–2011–0069]

National Medal of Technology and Innovation Nomination Evaluation Committee Meeting

AGENCY: United States Patent and Trademark Office.

ACTION: Notice of closed meeting.

SUMMARY: The National Medal of Technology and Innovation (NMTI) Nomination Evaluation Committee will meet in closed session on Friday, November 18, 2011. The primary purpose of the meeting is to discuss the relative merits of persons, teams and companies nominated for the 2011 NMTI Medal.

DATES: The meeting will convene Friday, November 18, 2011, at approximately 9 a.m., and adjourn at approximately 5 p.m.

ADDRESSES: The meeting will be held at the United States Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22314.

FOR FURTHER INFORMATION CONTACT: Vikrum Aiyer, Program Manager, National Medal of Technology and Innovation Program, United States Patent and Trademark Office, 600 Dulany Street, Alexandria, VA 22314; telephone (571) 272–8818, or by electronic mail: *nmti@uspto.gov.*

SUPPLEMENTARY INFORMATION: Pursuant to the Federal Advisory Committee Act, 5 U.S.C. app. 2, notice is hereby given that the NMTI Nomination Evaluation Committee, chartered to the United States Department of Commerce, will meet at the United States Patent and Trademark Office campus in Alexandria, Virginia.

The Secretary of Commerce is responsible for recommending to the President prospective NMTI Medal recipients. The NMTI Nomination Evaluation Committee evaluates the nominations received pursuant to public solicitation and makes its recommendations for the Medal to the Secretary. Committee members are distinguished experts in the fields of science, technology, business and patent law drawn from both the public and private sectors and are appointed by the Secretary for three-year terms.

The NMTI Nomination Evaluation Committee was established in accordance with the Federal Advisory Committee Act (FACA). The Committee meeting will be closed to the public in accordance with FACA and 5 U.S.C. 552b(c)(4), (6) and (9)(B), because the discussion of the relative merit of the Medal nominations is likely to disclose information of a personal nature that would constitute a clearly unwarranted invasion of personal privacy; premature disclosure of the Committee's recommendations would be likely to significantly frustrate implementation of the Medal Program; and the meeting will include a Department of Commerce Ethics Division presentation and question and answer session which may be closed to protect the privileged and confidential personal financial information of Committee members.

The Chief Financial Officer and Assistant Secretary for Administration, United States Department of Commerce, formally determined on October 26, 2011, pursuant to Section 10(d) of the Federal Advisory Committee Act, that the meeting may be closed because Committee members are concerned with matters that are within the purview of 5 U.S.C. 552b(c)(4), (6) and (9)(B). Due to closure of this meeting, copies of any minutes of the meeting will not be available. A copy of the determination is available for public inspection at the United States Patent and Trademark Office.

Dated: October 28, 2011.

Teresa Stanek Rea,

Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office.

[FR Doc. 2011–28500 Filed 11–2–11; 8:45 am]

BILLING CODE 3510–16–P

COMMODITY FUTURES TRADING COMMISSION

Sunshine Act Meeting—Emergency Meeting Notice

This notice that an emergency meeting was held is published pursuant to the provisions of the Government in the Sunshine Act, Public Law 94–409, 5 U.S.C. 552b.

AGENCY HOLDING THE MEETING: Commodity Futures Trading Commission.

TIME AND DATE: The Commission held an emergency closed meeting on October 31, 2011 at 12 p.m. The Commission, by a recorded unanimous vote, determined that the agency business required that business of the agency required that the meeting be held at that time.

PLACE: Three Lafayette Center, 1155 21st St. NW., Washington, DC, 9th Floor Commission Conference Room.

STATUS: Closed.

MATTERS TO BE CONSIDERED: Registrant Financial Matters.

CONTACT PERSON FOR MORE INFORMATION: Sauntia S. Warfield, Assistant Secretary of the Commission, 202–418–5084.

Sauntia S. Warfield,

Assistant Secretary of the Commission.

[FR Doc. 2011–28607 Filed 11–1–11; 11:15 am]

BILLING CODE 6351–01–P

CONSUMER PRODUCT SAFETY COMMISSION

[CPSC Docket No. 12–C0003]

Spin Master, Inc. and Spin Master, Ltd., Provisional Acceptance of a Settlement Agreement and Order

AGENCY: Consumer Product Safety Commission.

ACTION: Notice.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6,644,224	2003-11-11	08/073,573	1993-06-08	250600-000012USPT

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	◉	7 ½ year	(2552)
○	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Stephen G. Rudisill, Reg. No. 20087/	Date (YYYY-MM-DD)	2012-01-10
Name	Stephen G. Rudisill	Registration Number	20087

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 6644224
Issue Date: November 11,2003
Application No. 08073573
Filed: June 8,1993
Attorney Docket No. 250600-000012USPT

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 10,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 10,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Patent No. : **7285537**
Ser. No. **08/078768**
Inventor(s) : **TULLIS, RICHARD H.**
Issued : **10/23/2007**
Title : **OLIGONUCLEOTIDE THERAPEUTIC AGENT AND METHODS OF MAKIN SAME**
Docket No. : **PMB9658**

Re: Request for Certificate of Correction

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

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

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

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

A. **the processing fee set forth in 37 CFR 1. 17(i) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

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

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

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

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

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

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

A Certificate of Correction will be issued for the remaining errors.

Omega Lewis
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703)756-1575 or (703) 756-1814

WOODCOCK WASHBURN LLP
2929 ARCH STREET
PHILADELPHIA, PA 19104

OL

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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ISIS PHARMACEUTICALS INC
2855 Gazelle Court
CARLSBAD CA 92010

MAILED
APR 16 2012
OFFICE OF PETITIONS

In re Patent No. 7,285,537 :
Issue Date: October 23, 2007 :
Application No. 08/078,768 : ON PETITION
Filed: March 2, 2012 :
Attorney Docket No. ISIS-4502/PMB9658 :

This is a decision on the petition filed March 2, 2012, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3215. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (703) 756-1814.

The address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition. However, the Office will mail all future correspondence solely to the address of record.

The 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.

Charlema Grant
Attorney Advisor
Office of Petitions

Cc: Woodcock Washburn LLP
Circa Centre
2929 Arch Street, 12th Street
Philadelphia, PA 19104-2891

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

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Commissioner for Patents
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P.O. Box 1450
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SAWYER LAW GROUP, P.C.
P.O. BOX 51418
PALO ALTO, CA 94303

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SEP 27 2010

OFFICE OF PETITIONS

In re Patent No. 5,351,223 :
Issue Date: September 27, 1994 :
Application No. 08/085, 022 : ON PETITION
Filed: June 30, 1993 :
Attorney Docket No. 1217P :

This is a decision in response to a petition filed July 27, 2010, under 37 CFR 1.378(c), to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

A petition under 37 CFR 1.378(c) must be filed within twenty-four months after the six month grace period specified in 35 USC 41(b). The patent issued on September 27, 1994. The six month grace period for the 7 ½ year maintenance fee expired at midnight on September 27, 2006. Accordingly, an unintentional petition to reinstate the instant patent must have been submitted no later than September 27, 2008. Since the original petition was filed on July 27, 2010, it was not timely filed and the instant patent will not be reinstated under the unintentional provisions of 37 CFR 1.378(c).

Patentee may wish to pursue reinstatement of the patent under the unavoidable provisions of 37 CFR 1.378(b). A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

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 Window located at:
U.S. Patent and Trademark Office
Customer Service Window 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) 272-6059. Any questions directly concerning a petition under 37 CFR 1.378(b) may be directed to the Office of Petitions Helpdesk at (571) 272-3282.

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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SAWYER LAW GROUP, P.C.
P.O. BOX 51418
PALO ALTO, CA 94303

MAILED
MAY 04 2011
OFFICE OF PETITIONS

In re Patent No. 5,351,223 :
Issue Date: September 27, 1994 :
Application No. 08/085,022 : ON PETITION
Filed: June 30, 1993 :
Attorney Docket No. 1217P :

This is a decision on the petition under 37 CFR 1.378(b), filed September 17, 2010, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f). 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, the Commissioner will undertake no further reconsideration or review of the matter.

The patent issued September 27, 1994. The third (11 ½ year) maintenance fee window opened September 27, 2005, and could have been paid from September 27, 2005 through March 27, 2006, or with a surcharge during the period from March 28, 2006 through September 27, 2006. Accordingly, the patent expired at midnight September 27, 2006, for failure to timely submit the 11 ½ year maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1) above.

Petitioner asserts that: (1) the Patentee asked Sawyer Law Group (SLG) to file a power of attorney as well as a statement under 37 CFR 3.73(b) in the Office to take over representation of the patent on or about July 2007 and the Lead Paralegal/ Office Manager, Ms. Nikia McNillion (McNillon) was the responsible party for filing as well as docketing the items for SLG; (2) McNillion's actions affected the present patent in that she intentionally and maliciously altered successful existing procedures without authority or approval, specifically, McNillion stopped docketing items in SLG in February 2007; and (3) McNillion did not enter the due date of the maintenance fee for the above-identified patent into the docketing system, therefore, neither the Patentee nor the attorney realized that the maintenance fee was due and/had not been paid.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995). That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the maintenance fee for this patent. Id.

Petitioner should note that the patent expired prior to SLG taking over payment of the maintenance fee. Accordingly, neither SLG nor McNillon were the party responsible for ensuring timely payment of the maintenance fee at the time payment of the maintenance fee was due. As such, petitioner may not rely upon the action or inactions of McNillon to support a showing of unavoidable delay in the payment of the maintenance fee due.

Currently, USPTO records indicate that either the assignee of record, Digital Video Systems, Inc or their representative was the party responsible for payment of the maintenance fee due. Petitioner is required to indicate who was responsible for payment of the maintenance fee and provide a statement from the responsible party showing: (1) the steps that were in place to ensure timely payment of the maintenance fee, (2) a complete explanation of how the system worked, (3) an explanation as to why the system failed in this instance, and (4) a documented showing that this party was in fact obligated to track the fee on behalf of petitioner.

Petitioner is advised, however, that the USPTO is not the forum for resolving a dispute between a patent owner and his representative as to who bore the responsibility for paying a maintenance fee. See Ray, 55 F. 3d at 610, 34 USPQ2d at 1789.

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

By Mail:
Mail Stop PETITION
Commissioner for Patents
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By Hand: U. S. Patent and Trademark Office
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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 Alicia Kelley-Collier at (571) 272-6059.

/dab/
David Bucci
Petitions Examiner
Office of Petitions

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DIW Jan-12

KLAUBER & JACKSON
411 HACKENSACK AVE.
HACKENSACK NJ 07601

MAILED
JAN 26 2012
OFFICE OF PETITIONS

Patent Number: 5,478,579	:	
Issue Date: 12/26/1995	:	
Application Number: 08/095,738	:	DECISION ON PETITION
Filing Date: 07/21/1993	:	
Attorney Docket Number: 9911001CIP	:	

This is a decision on the petition filed on December 29, 2011 (certificate of mailing date March 25, 2011), which is treated as a petition under 37 CFR 1.378(c),[1] to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(h). 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.

[1] 37 CFR 1.378(c) provides that a petition to accept an unintentionally delayed payment of a maintenance fee must be filed within twenty-four months of the six-month grace period provided in § 1.362(e) and must include:
(1) The required maintenance fee set forth in § 1.20(e) through (g);
(2) The surcharge set forth in § 1.20(I)(2); and
(3) A statement that the delay in payment of the maintenance fee was unintentional.

On December 26, 1995, the patent issued. The first and second maintenance fees were timely paid. The third maintenance could have been paid from December 26, 2006 through June 26, 2007, or, with a surcharge, during the period from June 27 through December 26, 2007. Accordingly, the present patent expired at midnight on December 26, 2007, for failure to timely submit the third maintenance fee.

35 U.S.C. § 41(c)(1) authorizes the Director to accept a delayed maintenance fee payment within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) if the delay is shown to have been unintentional, and authorizes the Director to accept a delayed maintenance fee payment at any time if the delay is shown to have been unavoidable. Thus, 35 U.S.C. § 41(c)(1) does not authorize the Director to accept a delayed maintenance fee payment later than twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) unless the delay is shown to have been unavoidable. Since the instant petition was not filed within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b), the Director cannot accept a delayed maintenance fee payment for the above-identified patent under 37 CFR 1.378(c).

Should petitioner wish to pursue reinstatement of the above-identified patent on the basis of unavoidable delay, petitioner should file a petition under 35 U.S.C. § 41(c) and 37 CFR 1.378(b), which must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

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

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

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

A reply may also be filed via EFS-Web.

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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DIW Nov-10

Paper No. __

CURTIS N. KNOWLES
15114 DUNDEE AVENUE
APPLE VALLEY, MN 55124

MAILED

NOV 22 2010

OFFICE OF PETITIONS

In re Patent No. 5,613,264 :
Issue Date: 25 March, 1997 :
Application Number: 08/102,047 :
Filing Date: 4 August, 1993 : ON PETITION
Attorney Docket No.: (None) :

This is a decision on the petition filed on 29 July, 2009, request under 37 C.F.R. §1.377 to accept and record a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 C.F.R. §1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. An extension of this time limit may be requested pursuant to 37 C.F.R. §1.136(a). The petition for reconsideration shall include an exhaustive attempt to provide the lacking item(s) noted below

This is **not** a final agency action within the meaning of 5 U.S.C.§704.

A grantable petition pursuant to 37 C.F.R. §1.377 requires: (1) petition and fee; (2) the petition must be filed within two months of the action complained of (i.e., the refusal of the Office to accept the fee); (3) submission of the maintenance fee in question; and (4) a showing the entire maintenance fee payment, including any necessary surcharge, was filed (i.e., received by the Office) prior to expiration of the patent.

Once again, Petitioner has failed to satisfy the showing described above (Items 2 and 4)—as to the timeliness of the request for relief and the showing as to the filing of the entire maintenance fee, including any necessary surcharge prior to the expiration of the patent—and set forth in the regulation (below). Petitioner acknowledges, inter alia, that he attempted to pay the fee at the wrong time and that the Office Noticed his Counsel of the refusal of the payment but that he "no longer dealt with her ...." It is noted that Petitioner misstates the filing of his original petition as

"September 24, 2004," (emphasis supplied) however, Office records reflect that the petition was not filed until 25 September 2008—and then without the required fee.

The regulations at 37 C.F.R. §1.377 provide:

> **§ 1.377 Review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of patent.**
>
> (a) Any patentee who is dissatisfied with the refusal of the Patent and Trademark Office to accept and record a maintenance fee which was filed prior to the expiration of the patent may petition the Director to accept and record the maintenance fee.
>
> (b) Any petition under this section must be filed within two months of the action complained of, or within such other time as may be set in the action complained of, and must be accompanied by the fee set forth in § 1.17(g). The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.
>
> (c) Any petition filed under this section must comply with the requirements of §1.181(b) and must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.
>
> [49 FR 34725, Aug. 31, 1984, added effective Nov. 1, 1984; para. (c) revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (b) revised, 69 FR 56481, Sept. 21, 2004, effective Nov. 22, 2004]

The guidance in the Commentary at MPEP §2580 provides in pertinent part:

> **2580 Review of Decision Refusing to Accept and Record Payment of a Maintenance Fee Filed Prior to Expiration of Patent [R-5]**
>
> ***
>
> 37 C.F.R. §1.377 provides a mechanism for review of a decision refusing to accept and record payment of a maintenance fee filed prior to the expiration of a patent. 37 C.F.R. §1.377(a) permits a patentee who is dissatisfied with the refusal of the Office to accept and record a maintenance fee which was filed prior to the expiration of the patent to petition the Director to accept and record the maintenance fee. This petition may be used, for example, in situations where an error is present in the identifying data required by 37 C.F.R. §1.366(c) with the

maintenance fee payment, i.e., either the patent number or the application number is incorrect. See MPEP §2515 and §2530. A petition under 37 C.F.R. §1.377 would not be appropriate where there is a complete failure to include at least one correct mandatory identifier as required by 37 C.F.R. §1.366(c) for the patent since no evidence would be present as to the patent on which the maintenance fee was intended to be paid. If the maintenance fee payment with an incorrect mandatory identifier was made near the end of the grace period, the patent might expire since the Office would not credit the fee to the patent. A petition under 37 C.F.R. §1.377 would not be appropriate where the patentee paid a maintenance fee on one patent when the patentee intended to pay the maintenance fee on a different patent but through error identified the wrong patent number and application number. Likewise, a petition under 37 C.F.R. §1.377 would not be appropriate where the entire maintenance fee payment, including any necessary surcharge, was not filed prior to expiration of the patent.

Any petition filed under 37 C.F.R. §1.377 must be filed within 2 months of the action complained of, or within such other time as may be set in the action complained of. The petition must be accompanied by the proper petition fee >(37 C.F.R. §1.17(g))<. The petition may include a request that the petition fee be refunded if the refusal to accept and record the maintenance fee is determined to have resulted from an error by the Office.

Any petition filed under 37 C.F.R. §1.377 must comply with the requirements of 37 C.F.R. §1.181(b) and must be signed by an attorney or agent registered to practice before the Office, or by the patentee, the assignee, or other party in interest. A person or organization whose only responsibility insofar as the patent is concerned is the payment of a maintenance fee is not a party in interest for purposes 37 C.F.R. §1.377. If the petition is signed by a person not registered to practice before the Office, the petition must indicate whether the person signing the petition is the patentee, assignee, or other party in interest. An assignee must comply with the requirements of 37 C.F.R. §3.73(b) which is discussed in MPEP §324.

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BACKGROUND

The instant patent issued on 14 April, 1998. The second maintenance fee could have been paid without a surcharge from 14 April through 14 October, 2005, and with surcharge from 15 October, 2005, through 14 April, 2006. (Thereafter the second maintenance fee could have been paid (with the surcharge for acceptance) as unintentionally delayed pursuant to 37 C.F.R.

§1.378(c) from 15 April, 2006, through 15 April, 2008.) Petitioner averred that an attempt was made to pay the second maintenance fee, and that the fee (in the form of a credit card authorization in the amount of $415.00) was mailed to the Office on 14 September, 2004, and received by the Maintenance Fee Office (P.O. Box 371611, Pittsburg, PA 15250-1611) on 17 September, 2004. Petitioner provides no documentary support for the averment, however, in any case it appears that whatever fees/fee authorization might have been submitted were wholly insufficient. Thereafter, Petitioner failed to take any action on the instant matter until Petitioner filed the original petition on 25 September, 2008. The petition was dismissed on 3 June, 2009, and therein the decision stated, *inter alia*, that:

> It is noted that:
>
> - As indicated above, the window did not open for payment of the maintenance fee until 14 April, 2005—Petitioner appears to have attempted to pay the fee some seven (7) months before the window for payment opened and, therefore, before the fee could be accepted;
>
> - The maintenance fee submitted by Petitioner was an incorrect fee (and appears to have approximated not the second maintenance fee, but the first and so would have been insufficient even if submitted at the proper time).
>
> - Petitioner has failed to submit the petition fee for the instant petition—the petition fee is jurisdictional—and, thus, the Office cannot consider the substantive aspect of the petition in the absence of the petition fee.
>
> - Petitioner failed to address the instant matter timely under the Rule—i.e., within two (2) months of the act complained of (the refusal to accept the maintenance fee).

Further, the decision stated:

> **Therefore, the second the maintenance fee was not timely submitted and could not be accepted; the fee was not the proper fee; and the Petitioner delayed too long in seeking relief under the Rule—however, as indicated above, the substantive aspect of the petition could not be considered in the absence of the jurisdictional petition fee.** (Emphasis, the original.)

Petitioner's entire statement/showing herein is as follows:

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> I thought I had paid the second maintenance fee on September 14, 2004. This was received by the Maintenance Fee Office, [P.O. Box] 371611, Pittsburgh, PA. 15250-1611 on September 17, 2004, but refused by the Patent Office as untimely (I mistakenly paid the fee to (sic) early) and of insufficient amount. However I was unaware of this refusal. The mailing address that had been given the Patent Office was that of my attorney. She knew that the maintenance fee had been refused but I didn't. I no longer dealt with her, as she had previously let the application go abandoned once before during the prosecution of the case. *I didn't discover the refusal to accept the maintenance fee until I happened to make a telephone inquiry to the Patent Office on September 22, 2008[,] with respect to the next maintenance fee and was informed as to what happened to the last one. My subsequent written inquiry dated September 24, 2004 (sic), was retreated by the Patent Office as a petition to accept payment of a maintenance fee and was dismissed in part because the petition fee was lacking. That is now remedied. A sincere attempt has been made to overcome all objections and is (sic) respectfully requested that the petition be granted.* (Emphasis the original.)

***

Petitioner acknowledges that he:

- submitted the wrong payment at the wrong time;
- provided to the Office the mailing/correspondence address of his Counsel;
- was not in communication with his Counsel;
- did not timely seek relief under the Rule.

While Petitioner avers that his Counsel knew that the Office refused the payment as untimely and insufficient, there is no documentary evidence/showing in support of that averment, and the clear statement by Petitioner is that—for whatever reason—he "no longer dealt with her"—i.e., his Counsel. Thus, while the general rule does not apply in those cases in which there is a showing of diligence on the applicant/patentee but that deception by Counsel caused a delay in action,[1] there is no such showing here. It is noted that Petitioner's payments again were incorrect. Thus, as with the earlier decision, Petitioner's attentions are directed to the fee schedule at the Office website at http://www.uspto.gov/main/howtofees.htm .

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[1] *See*: e.g., *In re Lonardo*, 17 USPQ2d 1455 (Comm'r Pat. 1990): delay caused by deception of applicant by applicant's representative.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[2]

CONCLUSION

The petition under 37 C.F.R. §1.377 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

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

Patent No. 5,613,264
Application Number: 08/102,047

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[3]) 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

[3] 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

Fred Weil
Arts for Fitness, LLC
3545 Mary Ader Avenue
Charleston, SC 29414

MAILED
DEC 08 2011
OFFICE OF PETITIONS

In re Patent No. 5,363,752 :
Issue Date: November 15, 1994 : DECISION ON PETITION
Application No. 08/115,426 :
Filed: August 31, 1993 :
Title: COOKING GRILL :

This is a decision in response to the petition under 37 CFR 1.378(b), filed October 31, 2011, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(b) is **dismissed**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive attempt to provide the lacking item(s) noted below because the Director will not undertaken any further reconsideration or review of the matter after a decision on the petition for reconsideration.

The patent issued on November 15, 1994. The second maintenance fee could have been paid during the period from November 15, 2001 through May 15, 2002, or with a surcharge during the period from May 16, 2002 through November 15, 2002. Accordingly, this patent expired on November 16, 2002, for failure to timely remit the second maintenance fee.

Petitioner, Fred Weil, asserted that the delay in paying the maintenance fee in the present patent was unavoidable to the "gross negligence" of his former attorney and petitioner's lack of proficiency in the English language. Petitioner provided the following explanation in support of showing of unavoidable delay:

I initially sought counsel from Mr. B. Craig Killough regarding my patent application since I had no knowledge of the process and spoke relatively little English in 1993, the year I hired Mr. Killough to file my patent application. I entrusted him with all matters pertaining to my patent. Moreover, Mr. Killough was listed as both the correspondence addressee for further communications with your office and the addressee for "fee purposes" due to his handling of my case and my language deficiency. On November 15, 1994, my patent was granted, and Mr. Killough notified me of our success.

On October 8, 1997, I received a letter from Mr. Killough informing me that my first series of maintenance fees was due on May 15, 1998. On February 4, 1998, Mr. Killough sent yet another letter to me addressing the issue that the maintenance fee was due the following May. Per his letter, I sent a check for the maintenance fee to his office, which he paid to your office on my behalf on May 15, 1998. Because Mr. Killough began the practice of regular communication with me regarding the payment of the patent maintenance fees, I came to rely upon his counsel with regard to this matter, as I was still transitioning into my new life in the United States and began a business of my own. Never during his representation of me, did Mr. Killough ever explain the nature of the maintenance fees, that they would be recurring, that failure to pay them would cause my patent to be terminated, or that I had to make any payments to the patent office without first being notified to do so by Mr. Killough.

I never received further communication from Mr. Killough addressing any other maintenance fees that were required for my patent. As such, I was not even aware that my patent expired because of failure to pay the maintenance fees until June of this year when I actively began soliciting business with manufacturing companies to manufacturer the grill protected by my patent. As you might imagine, I was in complete shock that my patent expired due to the failure to pay maintenance fees because I came to depend upon the communication established by Mr. Killough for those matters. It is because of my reliance upon Mr. Killough's representation that my failure to timely pay the maintenance fee was unavoidable.

Later in June, I learned that Mr. Killough did, in fact, receive notice from your office regarding my second maintenance fee and patent expiration notice. Mr. Killough forwarded to me what he has acknowledged to be the complete file in this matter. In fact, the last two documents contained in that file are notices he received from your office concerning the maintenance fees and the patent termination. I have enclosed these documents for your office's review. Until I requested the complete file, I never saw these notices and to date, Mr. Killough cannot provide me with any documentation that he sent them to me. Upon learning this information, I took the reasonable steps necessary to begin the feat of reinstating my patent because of these unavoidable circumstances. Upon learning that my patent had expired, I acted quickly on my own behalf to address this issue.

Secondly, at the time I sought counsel to file my patent application and to provide an explanation of the patent process, I was newly arrived in the United States from my home

country of Argentina. English is not my native language; suffice it to say that my English language skills were imperfect at that time. While it was ultimately my responsibility to ensure that my maintenance fees were paid in a timely manner, because of my English language deficiency, I was even more dependent on my former counsel for assistance with this matter - resulting in an unavoidable failure to pay the fees in a timely fashion. As I already described above, I came to rely upon his constant communication with me regarding the patent's maintenance fees because of my lack of English language skills. In fact, this was my primary reasoning in allowing my former counsel to file my patent application with his name and address as the recipients of all of your office's communications.

Statement pp. 1-2.

A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include the following:

> (1) the required maintenance fee set forth in § 1.20(e) through (g);
>
> (2) the surcharge set forth in § 1.20(i)(1); and
>
> (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

This petition lacks requirement (3).

As 35 U.S.C. 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995). That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. This is a very stringent standard. 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.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987). Moreover, patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988).

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol Medical Prods., 921 F. Supp. 1219 (D. Del. 1995). Moreover, the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of an applicant, and an applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992). Specifically, delay caused by the actions or inactions of a voluntarily chosen representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130 (D. Ind. 1987) ("If that attorney somehow breached his duty of care to plaintiff, then plaintiff may have certain other remedies available to him against his attorney. He cannot, however, ask the court to overlook [the attorney's] action or inaction with regard to the patent application. [Plaintiff] hired [the attorney] to represent him; [the attorney's] actions must be imputed to him.").

In this instance, petitioner was the patent owner at the time of the expiration of the patent, and therefore, he alone had an obligation to ensure the timely payment of the maintenance fee. While the Office can appreciate petitioner's lack of proficiency in the English language and it is regrettable that petitioner was not aware that the maintenance fees were due, any delay caused by the negligence or mistakes of petitioner's voluntarily chosen legal representatives does not constitute unavoidable delay.

Haines v. Quigg, 673 F. Supp. at 317; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981). Furthermore, the Office reminds petitioner that under the statutes and regulations, the USPTO has no duty to notify a patent owner of the requirement to pay maintenance fees or to notify the patentee when the maintenance fee is due. While the Office mails maintenance fee reminders strictly as a courtesy, it is solely the responsibility of the patent owner to ensure that the maintenance fee is paid timely to prevent expiration of the patent. The failure to receive a maintenance fee reminder (or Notice of Patent Expiration) does not relieve the patentee of the obligation to timely pay the maintenance fee, nor will it constitute unavoidable delay if the patentee seeks reinstatement under the regulation. Rydeen v. Quigg, 748 F. Supp. 900, 905 (D.D.C. 1990). Moreover, a patentee who is required by 35 U.S.C. 41(c)(1) to pay a maintenance fee within 3.5, 7.5 and 11.5 years of the patent grant or face expiration of the patent, is not entitled to any notice beyond that provided by publication of the statute. Rydeen, 748 F. Supp. at 906.

A delay resulting from a lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ 1130, 1132 (N.D. Ind. 1987); Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981). Moreover, a patentee's lack of knowledge of the need to pay the maintenance fee does not constitute unavoidable delay. See In re Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988), aff'd Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990); aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir. 1991), cert. denied, 60 U.S.L.W. 3520 (January 27, 1992). Therefore, a lack of awareness of a patentee that maintenance fees were required does not serve to excuse a delay in timely paying them, or relieve a patentee of his duty to show that he had steps in place to track and timely pay the maintenance fees. In the absence of a showing that patentee was (1) aware of need to pay the maintenance fees and (2) he took steps to ensure timely payment, 37 CFR 1.378(b) precludes acceptance of the payment.

The Office notes that the Letters Patent contain a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. While it is unclear from the record whether petitioner received a copy of the issued patent, his failure to read the Notice does not vitiate the Notice, nor does the delay resulting from such failure to read the Notice establish unavoidable delay. See Ray v. Lehman, 55 F. 3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1995). Petitioner asserts that Mr. Killough did not explain the need to pay maintenance fees at specific intervals and the consequence for failing to make timely payment. Nevertheless, it does not appear that petitioner made any attempts to ascertain for himself the legal requirements for maintaining the patent upon its issuance. Petitioner could have easily contacted the USPTO or accessed information from its website as to the need, timing and payment of the maintenance fees. Rather, the showing of record is that petitioner relied solely on his attorney and did not take any further steps to ensure that the maintenance fee was paid timely.

Lastly, petitioner did not submit any evidence that he had an ongoing contractual agreement with his attorney to track the due dates for the second and third maintenance fee for this patent on petitioner's behalf. Moreover, petitioner did not show that he provided any money to his attorney to cover the amount due for the maintenance fees, any surcharges, and the attorney's services for tracking the due dates of the second and third maintenance fees. Again, the Office reminds petitioner that he is bound

by the consequences of the actions or inactions of his duly authorized and voluntarily chosen representative, Mr. Killough. Therefore, any delay caused by the negligence or mistakes of petitioner's voluntarily chosen legal representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. at 317; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981). The burden remains on the patent owner to educate himself as to the legal requirements for maintaining a patent, to track the maintenance fee due dates, and make certain that the maintenance fees are paid in a timely manner.

In summary, petitioner has not made as sufficient showing that the delay in paying the maintenance fee was unavoidable. Accordingly, the petition under 37 CFR 1.378(b) is **dismissed**.

The Office notes that the address indicated on the petition differs from the address of record. As a one-time courtesy the Office will mail this communication to the address listed in the petition. However, if petitioner wishes to receive future correspondence concerning this patent, petitioner should submit a change of correspondence address. The appropriate form (Form PTO/SB/123) accompanies this decision for petitioner's convenience.

Petitioner should note that if this petition under 37 CFR 1.378(b) is not renewed, or if renewed and not granted, petitioner may obtain a refund of the maintenance fee and post-expiration surcharge. The $400.00 petition fee for seeking further reconsideration is not refundable

Any request for refund should be in writing to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

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 Services Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquires regarding this matter may be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Form PTO/SB/123

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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OFFICE OF PETITIONS

Uniloc USA Inc.
2151 Michelson Ste. 100
Irvine CA 92612

In re Patent No. 5,490,216	:	
Issue Date: February 6, 1996	:	
Application No. 08/124,718	:	DECISION ON PETITION
Filed: September 21, 1993	:	
Attorney Docket No. UN-NP-SA-216	:	

This is a decision on the petition under 37 CFR 1.182, filed October 6, 2011, requesting issuance of duplicate Letters Patent for the above-identified patent.

The petition is **GRANTED**.

The Office of Data Management is directed to issue duplicate Letters Patent.

As authorized, the $400 fee for the petition under 37 CFR 1.182 has been assessed to petitioner's deposit account.

Telephone inquiries concerning this decision may be directed to Terri Johnson at (571) 272-2991. Inquiries regarding the issuance of duplicate Letters Patent may be directed to Ollie Person in the Office of Data Management at (703) 756-1555.

A copy of this decision is being sent to Office of Data Management for issuance of duplicate Letters Patent.

/Terri Johnson/
Terri Johnson
Petitions Examiner
Office of Petitions

cc: Ollie Person, Randolph Square, 9th Floor, Room D30-A (Fax No. 571- 270-9764)

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte JOHN P. HALL and RONALD B. BECKMAN

Application 08/130,634
Appeal No. 2010-006334
Technology Center 3600

DECISION ON PETITION

This is a decision on the "Petition Under 37 C.F.R. § 1.181 in Response to Second Notice of Hearing", filed December 8, 2010 ("Petition"). The Petition requests that:

1. "Notification of Oral Hearing be rescinded, that the appeal be reinstated forthwith and that a decision on the appeal be rendered without further delay".

FINDINGS

1. Appellants filed an Appeal Brief on September 29, 2003.
2. The Examiner entered an Examiner's Answer on September 29, 2004.
3. Appellants filed a Reply Brief and a Request for Oral Hearing on December 2, 2004.
4. On May 24, 2006 a Docketing Notice, giving an Appeal Number of 2006-2058 was mailed to appellants.

5) On July 28, 2006 a Notification of Oral Hearing was mailed to appellants, setting the date of the Oral Hearing as September 13, 2006.

6) On August 17, 2006, appellants filed a confirmation of Oral Hearing.

7) On September 13, 2006, the Oral Hearing was held.

8) On January 3, 2007 the Panel remanded the application to the Examiner to consider the appropriate obvious-type double patenting rejections.

9) On December 11, 2008, the Examiner mailed a Supplemental Examiner's Answer in response to the Remand of January 3, 2007.

10) On April 12, 2010, the application was returned to the Board for processing.

11) On April 23, 2010, the Board mailed a Docketing Notice, giving the application a second Appeal Number, 2010-006334.

12) On November 17, 2010 a Notice of Oral Hearing was mailed, setting the date of an Oral Hearing for January 13, 2011.

13) Appellants file their petition entitled Petition Under 37 C.F.R. § 1.181 in Response to Second Notice of Hearing.

DISCUSSION

In view of the fact that the Oral Hearing was already held, the petition is granted.

DECISION

In view of the foregoing, the Petition is GRANTED.

James T. Moore
Acting Chief Administrative Patent Judge

Stout, Uxa, Buyan & Mullins LLP
4 Venture, Suite 300
Irvine, CA 92618

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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www.uspto.gov

PILLSBURY WINTHROP SHAW PITTMAN LLP
PO BOX 10500
MCLEAN VA 22102

MAILED
JAN 12 2012
OFFICE OF PETITIONS

In re
Naiman, et al.
Application No. 08/146,718
Filed: November 1, 1993
Patent No. 5,645,740
Issued: July 8, 1997

DECISION

This is a decision on the fee deficiency submission under 37 CFR 1.28(c), filed December 15, 2011.

The fee deficiency submission under 37 CFR 1.28 of $2,775 for the 11.5 year maintenance fee is hereby accepted.

The change of status to large entity has been entered.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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OCT 12 2011

OFFICE OF PETITIONS

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

In re Patent No. 5,480,424
Issue Date: January 2, 1996
Application No. 08/146,938
Filed: November 1, 1993
Attorney Docket No. JLC931

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed September 22, 2011.

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

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

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

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. If appropriate the proper power attorney documents should also be submitted.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3215.

Charlema Grant
Petitions Attorney
Office of Petitions

Cc: Sterne Kessler Goldstein Fox
1100 New York, N.W.
Washington, D.C. 20005-3934

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,569,038	1996-10-29	08/148,626	1993-11-08	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

◉ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

A Joint Patentee and I certify that I am authorized to sign this submission on behalf of all the other patentees			
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 form of the signature.			
Signature	/Louis Tubman/	Date (YYYY-MM-DD)	2010-10-28
Name	Louis Tubman		

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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 Patent No. 5569038
Issue Date: October 29,1996
Application No. 08148626
Filed: November 8,1993
Attorney Docket No. PA3003

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 28,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 28,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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Paper No.

FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON TX 77010-3095

MAILED
OCT 12 2011
OFFICE OF PETITIONS

In re Application of :
Stech :
Application No. 08/154,066 :
Patent No.: 5,377,736 : DECISION ON PETITION
Filed: November 18, 1993 : PURSUANT TO
Issued: January 3, 1995 : 37 C.F.R. § 1.28(c)
Attorney Docket No.: D5590 :
Title: DRIVEN AXLE VEHICLE :
INFLATION SYSTEM :

This is a notice regarding your request for acceptance of a fee deficiency submission pursuant to 37 C.F.R. § 1.28, received on September 21, 2011. 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 in the amount of $3680.00 has been received.

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.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this patent, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to the address which appears on the petition. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this patent unless Change of Correspondence Address, Patent Form (PTO/SB/123) is submitted for the above-identified patent. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/123), may be found at http://www.uspto.gov/web/forms/sb0123.pdf. If appropriate, a change of fee address (form PTO/SB/47) and a request for customer number (form PTO/SB/125) should be filed in accordance with Manual of Patent Examining Procedure, section 2540. A blank fee address form may be found at http://www.uspto.gov/web/forms/sb0047.pdf.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

cc: Derrick A. Pizarro
Cox Smith Matthews Incorporated
112 East Pecan Street
Suite 1800
San Antonio, Texas 78205-1536

UNITED STATES PATENT AND TRADEMARK OFFICE

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COLEMAN SUDOL, LLP
708 THIRD AVENUE, 14TH FLOOR
NEW YORK, NY 10017

MAILED

MAR 21 2011

OFFICE OF PETITIONS

In re Patent No. 5,840,285 :
Issue Date: November 24, 1998 :
Application No. 08/154,562 : ON PETITION
Filed: November 19, 1993 :
Patentee(s) Arnold W. Fogel :

This is a decision on the petition under 37 CFR 1.378(c), filed February 4, 2011, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Henry D. Coleman
714 Colorado Avenue
Bridgeport, CT 06605

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MAR 23 2012
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VYSIS, INC
PATENT DEPARTMENT
1300 E TOUHY AVENUE
DES PLAINES IL 60018

In re Patent No. 6,004,826 :
Issue Date: December 21, 1999 :
Application No. 08/155,938 : ON PETITION
Filed: October 27, 1993 :
Attorney Docket No. SEG1CPC :

This is a decision on the petition under 37 CFR 1.378(c), filed February 7, 2012 to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on December 22, 2011, for failure to pay the eleven and one-half year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

A petition under 37 CFR 1.378(c) requires a surcharge fee of $1,640. As authorized this fee will be charged to petitioner's deposit account.

The surcharge fee of $150 will be refunded to petitioner's deposit account.

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

The patent file is being forwarded to Files Repository.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5734792	1998-03-31	08161796	1993-12-06	ID004612

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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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 displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/SMG/	Date (YYYY-MM-DD)	2012-01-31
Name	Steven M. Gruskin	Registration Number	36818

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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 Patent No. 5734792
Issue Date: March 31,1998
Application No. 08161796
Filed: December 6,1993
Attorney Docket No. 0348682

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 31,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 31,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent No. 5828695
Issue Date: October 27,1998
Application No. 08162016
Filed: February 18,1994
Attorney Docket No. 36686

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed March 1,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of March 1,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
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Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,828,695	1998-10-27	08/162,016	1994-02-18	40765-US-PCT (4214-30700)

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/J. Robert Brown, Jr./	Date (YYYY-MM-DD)	2011-03-01
Name	J. Robert Brown, Jr.	Registration Number	45438

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

MAILED
JAN 12 2012
OFFICE OF PETITIONS

PILLSBURY WINTHROP SHAW PITTMAN LLP
PO BOX 10500
MCLEAN VA 22102

In re
Leon Shaw
Application No. 08/172,702
Filed: December 27, 1993
Patent No. 5,964,766
Issued: October 12, 1999

DECISION

This is a decision on the fee deficiency submission under 37 CFR 1.28(c), filed December 15, 2011.

The fee deficiency submission under 37 CFR 1.28 of $1,150 for the 7.5 year maintenance fee, $2,365 for the 11.5 year maintenance fee, and $75 for the late payment surcharge is hereby accepted.

The change of status to large entity has been entered.

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

Cliff Congo
Petitions Attorney
Office of Petitions

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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MICHAEL E. ZALL
197 W. SPRING VALLEY AVENUE
P.O. BOX 927
MAYWOOD NJ 07607

MAILED

SEP 26 2011

OFFICE OF PETITIONS

In re Patent No. 5,434,276 :
Issue Date: July 18, 1995 :
Application No. 08/173,574 : NOTICE
Filed: December 27, 1993 :
Attorney Docket No. FINETEX3024 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed September 8, 2011. 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. The petition is **GRANTED**.

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.

This file is being forwarded to Files Repository.

Telephone inquiries related to this decision should be directed to the Kimberly Inabinet at (571) 272-4618.

/Kimberly Inabinet/
Kimberly Inabinet
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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ROPES & GRAY LLP
IPRM - Floor 43
PRUDENTIAL TOWER
800 BOYLSTON STREET
BOSTON MA 02199-3600

MAILED
SEP 21 2011
OFFICE OF PETITIONS

In re Application of	:	
Ingham et al.	:	
Application No. 08/176427	:	
Filing or 371(c) Date: 12/30/1993	:	ON PETITION
Patent No. 5789543	:	
Issue Date: 08/04/1998	:	
Title of Invention:	:	
VERTEBRATE EMBRYONIC PATTERN-	:	
INDUCING PROTEINS AND USES	:	
RELATED THERETO	:	

This is a notice regarding 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.

A review of the petition reveals that the address appearing on the petition differs from the correspondence address of record. Applicant is advised that, in patented files: requests for changes of correspondence address, powers of attorney, revocations of powers of attorney, withdrawal of attorney and submissions under 37 CFR 1.501: Designation of, or changes to, a fee address, should be addressed to Mail Stop M Correspondence.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods
Attorney
Office of Petitions

CC: ANNE CRAIG
DIRECTOR OF INTELLECTUAL PROPERTY
PRESIDENT AND FELLOWS OF HARVARD COLLEGE
17 QUINCY STREET
CAMBRIDGE, MA 02138

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON DC 20005

MAILED
AUG 16 2011
OFFICE OF PETITIONS

In re Patent No. 5,417,975	:	
Issue Date: May 23, 1995	:	
Application No. 08/178,431	:	NOTICE
Filed: January 4, 1994	:	
Attorney Docket No. 1181220A	:	

This is a notice regarding your request, July 13, 2011, 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.**

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MICHEAL R. HENSON
SUITE 200
9250 W. FIFTH AVENUE
LAKEWOOD CO 80226

MAILED
MAR 20 2012
OFFICE OF PETITIONS

In re Application of
Kea BARDEEN
Application No. 08/182,409
Filed: January 14, 1994
Patent No. 6,093,446
Issue Date: July 25, 2000
Attorney Docket No. DN1389

NOTICE UNDER 37 CFR. 1.28(c)

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue 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.

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

Inquiries related to this communication should be directed to Michelle R. Eason at (571) 272-4231.

Thurman K. Page
Petitions Examiner
Office of Petitions

Cc: **LANCE LIEBERMAN**
COZEN O'CONNOR
277 PARK AVENUE
NEW YORK, NY 10172

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED
MAR 20 2012
OFFICE OF PETITIONS

MICHEAL R. HENSON
SUITE 200
9250 W. FIFTH AVENUE
LAKEWOOD CO 80226

In re Application of
Kea BARDEEN :
Application No. 08/182,409 :
Filed: January 14, 1994 : NOTICE UNDER 37 CFR. 1.28(c)
Patent No. 6,093,446 :
Issue Date: July 25, 2000 :
Attorney Docket No. DN1389

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

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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.

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

Inquiries related to this communication should be directed to Michelle R. Eason at (571) 272-4231.

Thurman K. Page
Petitions Examiner
Office of Petitions

CC: **LANCE LIEBERMAN**
COZEN O'CONNOR
277 PARK AVENUE
NEW YORK, NY 10172

Attorney Ref.: 308043.000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Kea Bardeen
Assignee:	Pumpkin Ltd.
Application No.:	08/182,409
Filed:	01/14/94
Patent No.:	6,093,446
Issued:	July 25, 2000
For:	Method for Decorating Surfaces with Transfer Patterns

Fee already been charged

January 13, 2012

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS AND PETITION TO EXCUSE ERRORS IN SMALL ENTITY STATUS AND ACCEPT PAYMENT OF FEES AS A LARGE ENTITY UNDER 37 C.F.R. § 1.28(c)

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

SIR:

Pursuant to 37 C.F.R. §1.27(g)(2), the Patent Owner hereby informs the USPTO that the above-identified patent is no longer eligible for small entity status.

Additionally, this is a petition under 37 C.F.R. § 1.28(c) to excuse errors in the inadvertent assertion of small entity status and to accept the payment of fees as a large entity for the above-identified patent.

The present Patent Owner converted to a large entity in April 2006. Notification of Loss of Entitlement was inadvertently not filed in the USPTO and the Second Maintenance Fee was inadvertently paid on November 7, 2007 as a small entity.

The required payment deficiency of $1240.00 owed in connection with the Second Maintenance Fee as set forth in 37 C.F.R. § 1.20(f) **should be charged to USPTO Deposit Account No. 50-3111.**

The Patent Owner has paid in the USPTO's online system, concurrently herewith on this date, the Third Maintenance Fee in connection with the subject patent. Because the Patent Owner is currently identified in the USPTO records as a small entity, the only option available was to pay the Third Maintenance Fee as a small entity. Accordingly, the payment deficiency of $2365.00 owed in connection with the Third Maintenance Fee as set forth in 37 C.F.R. § 1.20(g) **should be charged to USPTO Deposit Account No. 50-3111.**

The Commissioner is hereby authorized to charge any additional fees required in connection with this Petition, or to credit any overpayment, to USPTO Deposit Account No. 50-3111.

Respectfully submitted,
Cozen O'Connor
/Lance J. Lieberman/

January 13, 2012

By:_____
Lance J. Lieberman
Attorney for Patent Owner
Registration No. 28,437

Cozen O'Connor
277 Park Avenue
New York, New York 10172
Telephone: 212.883.4900
Facsimile: 212.972.5487
eMail: llieberman@cozen.com

1923346

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5627800	1997-05-06	08/188,311	1994-01-28	068880/00001H

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/Michael T. Smith/	Date (YYYY-MM-DD)	2010-12-21
Name	Michael T. Smith	Registration Number	47099

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5627800
Issue Date: May 6,1997
Application No. 08188311
Filed: January 28,1994
Attorney Docket No. A6195

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed December 21,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of December 21,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5759791	1998-06-02	08/188,426	1994-01-24	P02293-11

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Guido J. Galvez/	Date (YYYY-MM-DD)	2012-02-06
Name	Guido J. Galvez	Registration Number	52933

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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 Patent No. 5759791
Issue Date: June 2,1998
Application No. 08188426
Filed: January 24,1994
Attorney Docket No. 1107.45253

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 6,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 6,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5583972	1996-12-10	08/192,492	1994-02-07	Miller

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/J M GILBRETH/	Date (YYYY-MM-DD)	2010-12-09
Name	J. M. GILBRETH	Registration Number	33388

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent No. 5583972
Issue Date: December 10,1996
Application No. 08192492
Filed: February 7,1994
Attorney Docket No.

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed December 9,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of December 9,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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In re Patent No. 5608791
Issue Date: March 4,1997
Application No. 08192668
Filed: February 7,1994
Attorney Docket No. 024002

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5608791	1997-03-04	08192668	1994-02-07	024002

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-06
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

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Organogenesis, Inc.
150 Dan Road
Canton, MA 02021

MAILED
AUG 26 2010
OFFICE OF PETITIONS

In re Patent No. 5,536,656 :
Issue Date: July 16, 1996 :
Application No. 08/193,809 : ON PETITION
Filed: February 9, 1994 :
Patentee(s): Paul Kemp, et. al. :

This is a decision on the petition under 37 CFR 1.378(c), filed on August 5, 2010, to accept the delayed payment of a maintenance fee for the above-identified patent.

Since petitioner has demonstrated to the satisfaction of the Commissioner that the delay in timely paying the maintenance fee was unintentional, the petition under 37 CFR 1.378(c) is hereby **GRANTED**.

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

This patented file is being forwarded to Files Repository.

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

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Organogenesis, Inc.
150 Dan Road
Canton, MA 02021

MAILED

JAN 04 2011

OFFICE OF PETITIONS

In re Patent No. 5,536,656
Issue Date: July 16, 1996
Application No. 08/193,809
Filed: February 9, 1994
Patentee(s): Paul Kemp, et. al.

ON PETITION

This is a decision on the petition under 37 CFR 1.378(b), filed on August 25, 2010, to accept the delayed payment of a maintenance fee for the above-identified patent. This is also a decision on the petition under 37 CFR 1.182 for expedited handling of the present petition.

The present petition is not signed by an attorney of record. However, in accordance with 37 CFR 1.34(a), the signature of Ravi Dipali 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 under 37 CFR 1.182 is **granted**.

A review of the record shows that petitioner filed a petition under 37 CFR 1.378(c) on August 5, 2010. A decision was rendered on August 26, 2010, which accepted the delayed payment of the maintenance fee and reinstated the above patent. However, since the patent expired on July 16, 2008 and the unintentional petition under 37 CFR 1.378(c) was not filed until August 5, 2010, the petition under 37 CFR 1.378(c) should have been dismissed as untimely.

In view of the above, the decision rendered on August 26, 2010 is hereby **vacated**[1].

With respect to the petition under 37 CFR 3.78(b), the petition is hereby **dismissed** for the reason stated below.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1) above.

[1] The undersigned sincerely apologizes for any inconvenience caused to petitioner by this error. Since the decision mailed on August 26, 2010 is vacated and petitioner paid the 11 ½ year maintenance as large entity on August 25, 2010, the maintenance fee and surcharge of $3,695 submitted on August 5, 2010, will be refunded by Treasury Check, in due course. Additionally, finance records reveal that a credit card payment in the amount of $4,810 was submitted on August 12, 2010. Since this fee is unnecessary, it will also be refunded to petitioner by Treasury Check.

Petitioner (the current assignee of the entire interest, Organogenesis) asserts that a clerical error at the firm of Kramer, Levin, Naftalis & Frankel LLP ("KLN&F") involving a failure to add this application to their docket records after it was transferred from Hale & Dorr, LLP ("H&D") to KLN&F in 2006 was the cause of the delay.

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that: (1) the error was the cause of the delay at issue; (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; (3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

Specifically, petitioner asserts that failure of the failure of the docketing department at KLN&F to docket the case was caused by a note placed on the file, purportedly by the firm of Edwards & Angel, LLP ("E&A") prior to transfer of the file to H&D, that stated "Hale & Dorr to handle maint. fees (4.6 & 11.6)" was the cause of the delay.

An adequate showing requires statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts, as they know them. Petitioner must supply a thorough explanation of the docketing and call up system in use and must identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledger, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed in this instance to provide adequate notice that a reply was due. Petitioner must also supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

Petitioner has failed to meet his burden of proof in showing to the satisfaction of the Director that the delay in payment of the maintenance fee was unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3).

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995). That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the maintenance fee for this patent. Id.

As the patent holder at the time of expiration, it was incumbent on petitioner to have itself docketed this patent for payment of the maintenance fee in a reliable system as would be employed by a prudent and careful person with respect to his most important business, or to have engaged another for that purpose. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). Even where another has been relied upon to pay the maintenance fees, such asserted reliance per se does not provide a petitioner with a showing of unavoidable delay within the meaning of 37 CFR § 1.378(b) and 35 USC § 41(c). Id. Rather, such reliance merely shifts the focus of the inquiry from the petitioner to whether the obligated party acted reasonably

and prudently. Id. Nevertheless, a petitioner is bound by any errors that may have been committed by the obligated party. Id.

However, the record fails to show that adequate steps within the meaning of 37 CFR 1.378(b)(3) were taken by or on behalf of petitioner to schedule or pay the maintenance fee; in fact there were no steps taken by or on behalf of petitioner to pay the fee after the transfer of the file from H&D to KLN&F in 2006. Petitioner is reminded that 37 CFR 1.378(b)(3) is a validly promulgated regulation, as is the requirement therein for petitioner's showing of the steps taken to pay the fee. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. In the absence of a showing of the steps taken by or on behalf of petitioner, 37 CFR 1.378(b)(3) precludes acceptance of the maintenance fee.

In fact, at the time the maintenance fee fell due the showing of record is that neither KLN&F, H&D, E&A, nor anyone at Organogenesis, had any steps in place to ensure payment of the maintenance fee. This is because: (1) H&D were no longer handling the case, (2) KLN&F believed that H&D was handling the maintenance fee payments as the file indicated such, and (3) Organogenesis, upon transferring the case from H&D to KLN&F, never thereafter obligated KLN&F, or any other party, to track the fee, and did not then undertake to track the fee on its own. However delay resulting from the failure of the patent holder to have any steps in place to pay the fee by either obligating a third party to track and pay the fee, or by itself assuming the obligation to track and pay the fee, is not unavoidable delay. See R.R. Donnelley & Sons Co. v. Dickinson, 123 F.Supp.2d 456, 460, 57 USPQ2d 1244, 1247 (N.D. Ill. 2000); Ray, supra; California, supra; Femspec v. Dudas, 2007 U.S. Dist. LEXIS 8482 (N.D.Ca 2007).

Rather, a prudent and careful person with respect to his or her most important business, would not have relieved H&D of its responsibility to track and pay the fees for this patent until that person had himself obligated another or initiated its own steps to track and pay the fee. See California, supra (noting that "if [the patent attorney] had ceased representing [the patent owner] for some reason, [the patent owner] would have been obligated at that time to either familiarize himself with the maintenance fee requirements or retain new counsel..."); Femspec, at * 26-*27 (quoting California).

Thus, the contention that the delay results from a clerical error is simply not convincing, as long prior to expiry, Organogenesis, was aware that KLN&F had possession of this file, had communicated with H&D regarding this patent, but did not then or thereafter inform KLN&F that KLN&F was to track and pay the maintenance fee for this patent. Rather, KLN&F remained under the incorrect impression that H&D was to handle the payment of the maintenance fee. It is strictly due to Organogenesis's failure to act diligently in this matter that this state of affairs existed. It is not clear how Organogenesis was "unavoidably" prevented from communicating with KLN&F that they were being relied upon to track and pay the maintenance fee for the now expired Organogenesis patent. Delay resulting from a lack of proper communication between an applicant and his representative as to the responsibility for timely filing a communication with the USPTO does not constitute unavoidable delay. See In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988); Ray at 610, 34 USPQ2d at 1789. That all parties failed to take adequate steps to ensure that each fully understood the other party's meaning, and thus, their own obligation in this matter, does not reflect the due care and diligence of prudent and careful persons with respect to their most important business.

As noted in MPEP 711.03(c) §(II)(2), a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee(s) was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See In re Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), *rev'd on other grounds sub nom.*, Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

However, the showing of record is that conditions (a) and (c) *supra* were not met. That is, as noted above, the cause of the delay was Organogenesis's failure, after informing H&D that the file was being transferred to KLN&F, to obligate another to track the fee, or itself track and pay the fee. Additionally, petitioner has yet to: (1) identify the employee responsible for the docketing error; (2) show that there was in place a business routine for performing the clerical docketing function that could be reasonably relied upon to avoid errors in its performance; and (3) show that the employee was sufficiently trained and experienced with regard to the function and routine so that reliance upon such employee represented the exercise of due care.

Accordingly, to the extent that the error in recording the maintenance fee due date in the KLN&F docketing system may have had had any effect on the expiry of this patent, it cannot provide an adequate basis for showing to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).

Decisions on reviving abandoned applications 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.

In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887). Here, the failure of the KLN&F system and its administering personnel was not an unforeseeable event. KLN&F received the file which stated "Hale & Dorr to handle maint. fees (4.6 & 11.6)" and Organogenesis failed to obligate KLN&F to track and pay the fees. This simply does not demonstrate to the satisfaction of the Director an unforeseeable failure in a normally reliable and diligently administered system (and its personnel) as contemplated by Mattullath and Pratt that may properly be said to be unavoidable within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). In any event, there is no "sliding scale" based upon the care given to this patent *vis-a-vis* the maintenance in force *vel non* of other patents by the assignee; the issue is solely whether the maintenance of this patent was actually conducted with the care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business. The record fails to show that anyone was adequately trained and

supervised in such a manner, or that the assignee obligated another or itself undertook to track and pay the maintenance fee.

It is unfortunate that KLN&F failed to track and pay the maintenance fee. If KLN&F overlooked any duty that he may have owed petitioner in this matter, then petitioner is reminded that the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987); California, supra. Specifically, petitioner's delay caused by the mistakes or omissions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 41(c).. See Haines v. Quigg, supra; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). Nevertheless, any error(s) due to KLN&F are trumped by Organogenesis's subsequent failure to obligate another to track and pay the fee, or itself track and pay the fee.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within **TWO (2) MONTHS** from the mail date of this decision. No extension of this two month 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 above, since, after a decision on the petition for reconsideration, the Director will undertake no further reconsideration or review of the matter.

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 Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Telephone inquiries should be directed to Andrea Smith at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

David Bucci
Petitions Examiner

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

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Organogenesis, Inc.
150 Dan Road
Canton, MA 02021

In re Patent No. 5,536,656 :
Issue Date: July 16, 1996 :
Application No. 08/193,809 : ON PETITION
Filed: February 9, 1994 :
Patentee(s): Paul Kemp, et. al. :

This is a decision on the petition under 37 CFR 1.378(e), filed on March 4, 2011, requesting reconsideration of a prior decision which refused to accept under 37 CFR 1.378(b) the delayed payment of a maintenance fee for the above-identified patent.

The request to accept the delayed payment of the maintenance fee under 37 CFR 1.378(b) is **DENIED**.

BACKGROUND

The above patent issued July 16, 1996. The third maintenance fee was not timely paid. However, a petition to reinstate the expired patent under the provisions of 37 CFR 1.378(c) was filed on August 5, 2010. On August 12, 2010 and on August 25, 2010, a petition under 1.378(b) was filed. On August 26, 2010, a decision granting the petition under 37 CFR 1.378(c) was granted[1]. In the decision mailed on January 4, 2011, the decision granting the petition under 37 CFR 1.378(c) was vacated since the petition was filed more than twenty-four (24) months after expiration; the petition under 37 CFR 1.378(b) was dismissed for failure to provide an adequate showing of unavoidable delay. On March 4, 2011, the present request for reconsideration was filed.

The third year maintenance fee could have been paid during the period from July 16, 2007 through January 16, 2008, or with a surcharge during the period from July 17, 2008 through July 16, 2008. This patent expired at midnight on July 16, 2008, for failure to pay the third maintenance fee.

[1] This decision crossed with the filing of the petition under 37 CFR 1.378(b) filed on August 25, 2010.

STATUTE AND REGULATION

35 U.S.C. § 41(c)(1) states that:

> "The Commissioner may accept the payment of any maintenance fee required by subsection (b) of this section... after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable."

37 CFR 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include:

> "A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date, and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly."

OPINION

Petitioner requests that the decision of January 4, 2011, be reconsidered, given that the delay was unavoidable in that a docketing error and a "mailing error by the USPTO contributed to the docketing error that led to the unavoidable failure of KLN&F to pay the 11.6 [sic:11.5] year maintenance fee payment."

Petitioner has not met his burden of proving to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b).

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, *i.e.*, "unavoidable" delay. Ray v. Lehman, 55 F.3d 606, 608 09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications 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.

In re Mattullath, 38 App. D.C. 497, 514 15 (D.C. Cir. 1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32 33 (Comm'r Pat. 1887) see also Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account. Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960)(35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee is unavoidable. See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff'd* 937 F.2d 623 (Fed. Cir. 1991)(table), *cert. denied*, 502 U.S. 1075 (1992); Ray v. Lehman, *supra*.

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995). That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the maintenance fee for this patent. Id.

As the patent holder at the time of expiration, it was incumbent on petitioner to have itself docketed this patent for payment of the maintenance fee in a reliable system as would be employed by a prudent and careful person with respect to his most important business, or to have engaged another for that purpose. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). Even where another has been relied upon to pay the maintenance fees, such asserted reliance per se does not provide a petitioner with a showing of unavoidable delay within the meaning of 37 CFR § 1.378(b) and 35 USC § 41(c). Id. Rather, such reliance merely shifts the focus of the inquiry from the petitioner to whether the obligated party acted reasonably and prudently. Id. Nevertheless, a petitioner is bound by any errors that may have been committed by the obligated party. Id.

Petitioner asserts KLN&F: (1) was obligated to track and pay the maintenance fee; (2) had a system in place to track and pay the maintenance fee due; and (3) had an employee sufficiently trained and experienced with regard the function and routine for its performance.

Petitioner further asserts that had the USPTO properly mailed the Maintenance Fee Reminder and the Notice of Patent Expiration to KLN&F, the docketing error would not have occurred.

Petitioner has not carried his burden of proof to establish to the satisfaction of the Commissioner that the delay was unavoidable.

A review of the petition and evidence presented on March 4, 2011, fails to provide a showing of any steps that Organogenesis or KLN&F had in place to ensure timely submission of the maintenance fee, as required by 37 CFR 1.378(b)(3), after the files were transferred from Hale & Dorr, LLP ("H&D") to KLN&F in 2005. Petitioner has failed to provide a documented showing of the steps in place to ensure timely payment of the third maintenance fee. As stated in the decision mailed January 4, 2011, in the absence of a showing of the steps taken by or on behalf of petitioner, 37 CFR 1.378(b)(3) precludes acceptance of the maintenance fee.

Additionally, it is noted that "Exhibit C," which is a letter from H&D to KLN&F and Organogenesis dated September 19, 2005, states that once the files are transferred from H&D, each file will have its own docket and the enclosed dockets are for courtesy and should not be used to enter dates and deadlines into the database. It also states that since there is a large volume of cases they will transfer them without jeopardizing response due dates. The letter further states that a review of the docket through October has been made and that H&D would handle several items prior to the transfer, but suggests a conference call to organize the transfer. There is no evidence that the conference call between H&D and KLN&F and/or Organogenesis took place. Nor is there any evidence of any discussions with regards to steps to ensure timely payment of the maintenance fee for the above-referenced patent. Based on the letter, it appears as though, KLN&F would use their own docketing system for tracking payment of the maintenance fees for the above-referenced patent. There is nothing in the letter that suggests that H&D would handle payment of the maintenance fee for the above-referenced patent.

The record further does not support a finding of unavoidable delay, as petitioner has not shown adequate diligence in this matter. As early as September 19, 2005, Organogenesis was aware that maintenance fees were required in this patent. Organogenesis knew that fees were required and that H&D were relieved of their duties. Organogenesis should have made an inquiry with H&D and/or KLN&F to ascertain that the transfer of responsibilities regarding this patent occurred properly. There is no evidence that Organogenesis made any effort to ascertain that the transfer of the patent portfolio and especially, the responsibilities with respect to this patent occurred. A reasonably prudent person in relation to their most important business would have made such an inquiry. The record fails to document any activity by patentee (Organogenesis) with respect to ascertaining the filing of the third maintenance fee payment. Even if the Office assumes that H&D and/or KLN&F were engaged to track the fee payment for this patent that does not relieve Organogenesis from their obligation to show diligence. Diligence on the part of the patentee is essential to show unavoidable delay. As such, patentee's lack of diligence precludes a finding of unavoidable

delay. That is, a showing of diligence in matters before the USPTO on the part of the party in interest is essential to support a finding of unavoidable delay herein. See Futures Technology, Ltd. v. Quigg, 684 F. Supp. 430, 431, 7 USPQ2d 1588 (E.D. Va. 1988)(applicant's diligent inquiries into the status of the application coupled with affirmative misrepresentations by its fiduciary as to its true status which prevented more timely action showed unavoidable delay); Douglas v. Manbeck, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991), *aff'd,* 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992) (even representation by counsel does not relieve the applicant from his obligation to exercise diligence before the USPTO; applicant's lack of diligence extending two and one half years overcame and superseded any omissions by his duly appointed representative); R.R. Donnelley & Sons v. Dickinson, 123 F.Supp.2d 456, 460, 57 USPQ2d 1244 (N.D. Il. 2000)(failure of patent owner to itself track or obligate another to track the maintenance fee and its failure to exercise diligence for a period of seven years, precluded acceptance of the maintenance fee); MMTC v. Rogan, 369 F.Supp2d 675 (E.D. Va 2004)(passive reliance on reminder notice resulting in failure to take any steps to ensure payment of the maintenance fee is not unavoidable delay); Femspec v. Dudas, 2007 U.S. Dist. LEXIS 8482 (N.D.Ca 2007)(lack of any steps in place to maintain patent in force by estate executor unfamiliar with patent law is not unavoidable delay); Burandt. v. Dudas, supra (delay not unavoidable where no steps shown to be employed to remind responsible party to timely pay maintenance fees, no inquiry by patent holder of responsible party or Patent and Trademark Office as to whether maintenance fees would, or already had been paid). The delay was not unavoidable, because had patent holder exercised the due care of a reasonably prudent person by verifying with KLN&F which maintenance fees it was tracking, petitioner would have been able to act to correct the situation in a more timely fashion. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987); Douglas, supra; Donnelley, supra; Burandt, supra.

The record does not recount a situation where any person or firm, on and after the alleged transfer in 2006 of this patent to KLN&F: falsely represented to Organogenesis that the maintenance fee was being tracked by that entity on Organogenesis's behalf; or falsely represented to Organogenesis that the maintenance fee had been paid on Organogenesis's behalf; or falsely represented to Organogenesis that this patent had been maintained in force on Organogenesis's behalf, such that Organogenesis was "unavoidably" prevented from taking more timely action in this matter. Cf. Futures, supra. Rather the record shows that on and after the alleged transfer in 2006 of this patent to KLN&F, Organogenesis was and remained able to freely communicate with e.g., H&D and KLN&F, as to whether this or any of the Organogenesis patents was being tracked, whether the fee had been paid, or whether the patent was in force, and even the USPTO as to whether the fee had been paid, or whether the patent was in force. However, Organogenesis took no further action after the alleged transfer in 2006 of this patent to KLN&F, with respect to tracking, paying, or checking the status of this patent until August 2010. The record showing of this protracted absence of due care and diligence by Organogenesis is inconsistent with the actions of a prudent and careful person with respect to his most important business, and as such precludes a reasonable and rational finding that the delay in payment of the maintenance fee was unavoidable.

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that: (1) the error was the cause of the delay at issue; (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; (3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

In the initial petition, petitioner asserted that KLN&F failed to docket the maintenance fee due because of a note, made by Edwards & Angell, on the outer panel of the patent file that stated Hale & Dorr will handle the 7.6 [sic:7.5] and 11.6 [sic:11.5] year maintenance fees. In the instant renewed petition, however, petitioner now makes unsubstantiated assertions as to the docketing system of KLN&F.

An adequate showing requires statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts, as they know them. This showing must include copies of mail ledger, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed in this instance to provide adequate notice that a reply was due. Petitioner must also supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

In support of the assertion of docketing error as the cause for the delay petitioner states that KLN&F had a system in place to track and pay the maintenance fee due; and had an employee sufficiently trained and experienced with regard the function and routine for its performance. Specifically, petitioner refers page 4 of the "PROPOSAL" from KLN&F which describes KLN&F's IP group as having a "...docket system [that] is state of the art and we are capable of electronic filing at the US Patent and Trademark Office. We have many thousands of patents and patent applications under management." as evidence that petitioner had a reliable docket system in place to track and pay the maintenance fee due. Furthermore, as evidence that there was an employee sufficiently trained and experienced with regard the function and routine for its performance petitioner again refers to pages 4 and 6 of the "PROPOSAL" which notes: (1) "(t)he IP group has a dedicated infrastructure of experienced and highly qualified paralegals, docket clerks and secretaries."; (2) "(t)he audit will be conducted under the supervision of a senior partner. One or two associates and at least one paralegal will be assigned initially to review each matter to determine its status, whether or not any action need be taken in response to an official communication or otherwise, whether maintenance fees have been paid or not in pending matters or in issued patents."; and (3) "When the audit is complete, all matters will have been entered on our master docket system."

Unfortunately, petitioner has failed to provide statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts, as they know them. Petitioner failed to answer the factual inquiries set forth in the petition decision mailed February 4, 2011, *i.e.,* petitioner failed to: (1) identify the employee responsible for the docketing error; (2) provide any explanation of the docketing system in use; (3) any evidence of the reliability of a docketing system; and (4) provide any evidence of employee training. Despite petitioner's assertions, the statements in the "PROPOSAL" do not identify the employee responsible for the docketing error nor are they evidence of the reliability of a docketing system or employee training.

Accordingly, it follows that neither H&D, KLN&F, nor Organogenesis had any means of tracking and paying the maintenance fee. However delay resulting from the failure of the patent holder to have any steps in place to pay the fee by either obligating a third party to track and pay the fee, or by itself assuming the obligation to track and pay the fee, is not unavoidable delay. See R.R. Donnelley & Sons Co. v. Dickinson, 123 F.Supp.2d 456, 460, 57 USPQ2d 1244, 1247 (N.D. Ill. 2000); Ray, supra; California, supra; Femspec v. Dudas, 2007 U.S. Dist. LEXIS 8482 (N.D.Ca 2007).

Moreover, upon issuance, the patent grant ordinarily includes a reminder notice that maintenance fees will be due by the day of the 4th, 8th, and 12th year anniversary of the grant of the patent. At the same time, the law is clear that maintenance fees are required to maintain in force all patents based on applications filed on or after December 12, 1980. See 35 U.S.C. 41(b). No further written notice is required for patentees to be aware of this obligation. Whether a maintenance fee reminder, or even a Notice of Patent Expiration, was ever received, it remained the ultimate responsibility of petitioner to ensure that the maintenance fee was paid and timely received to prevent expiration of the patent.

The issue at hand is solely whether the maintenance of the instant patent was actually conducted with the care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business. Here, the delay was not unavoidable, because had petitioner exercised the due care of a reasonably prudent person, petitioner would have been able to act to correct the situation in a more timely fashion. See Haines v. Quigg, *supra*; Douglas v. Manbeck, *supra* (unavoidable delay not shown where no diligence for over 30 months); R.R. Donnelley & Sons v. Dickinson, *supra* (N.D. Il. 2000)(a showing of diligence is essential to demonstrate unavoidable delay).

DECISION

Petitioner has failed to meet his burden of proving to the satisfaction of the Director the entire delay in submission of the maintenance fee herein was unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b). Accordingly, the maintenance fee will not be accepted, this patent will not be reinstated, and this patent remains expired. The petition is **denied**.

The USPTO will not further consider or reconsider this matter. See 37 CFR 1.378(e). This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

Telephone inquiries related to this decision should be directed to Petitions Examiner Andrea Smith at (571) 272-3226.

Anthony Knight
Director, 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

Sheridon K. Snedden
Pillsbury Winthrop Shaw Pittman, LLP (NV)
PO Box 10500
McLean VA 22102

MAILED
JAN 13 2012
OFFICE OF PETITIONS

In re Patent No. 5,447,434 :
Issued: September 5, 1995 :
Application No. 08/194,851 : NOTICE
Filed: February 14, 1994 :
For: MICROMECHANICAL SEAL :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue 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**.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, practitioner's signature appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. If practitioner desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to practitioner, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the correspondence address of record.

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

Inquiries related to this communication should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown
Attorney Advisor
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

ATTN: MICHAEL S. MARCUS
MORGAN & FINNEGAN, L.L.P.
345 PARK AVENUE
NEW YORK NY 10154

MAILED
FEB 17 2011
OFFICE OF PETITIONS

In re Patent No. 7,122,381
Issue Date: October 17, 2006
Application No. 08/199,300
Filed: May 5, 1994
Attorney Docket No. 003300307

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 submitted on October 13, 2010. This is also a decision on the communication filed February 27, 2006, entitled "Request To Withhold Additional Fees Due To Large Entity Status.

The Office apologizes for the delay in replying to the communication filed February 27, 2006.

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

Your fee deficiency submission on October 13, 2010, under 37 CFR 1.28 is hereby **ACCEPTED**.

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

As to the communication submitted on February 27, 2006, the **proper** itemization of the fee deficiency was not provided. Therefore, the request is **dismissed** at this time. Applicant is encouraged to comply with 37 CFR 1.28(c)(2)(ii).

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

Inquiries related to this communication should be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

Cc:

MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK, NY 10281-2101

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 19

J. Gerald O'Connor
P.O. Box 2515
Winter Park, Florida 32790-2515

MAILED

FEB 04 2011

OFFICE OF PETITIONS

In re Patent No. 6,060,074 :
Issued: May 9, 2000 : REQUEST FOR INFORMATION
Application No.: 08/209,268 :
Filing Date: March 14, 1994 :
Attorney Docket No. **P602524018** :

This is a request for information in response to the petition under 37 CFR 1.378(b), filed October 5, 2010, to reinstate the above-cited patent.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed October 5, 2010. No additional fees are due.

The patent issued May 9, 2000. The 7.5 year maintenance fee could have been paid from May 9, 2007, through November 10, 2007, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from November 11, 2007, to May 9, 2008. Petitioner did not do so. Accordingly, the patent expired at midnight on May 10, 2008.

Petitioner is required to address the following points:

- A successful petition under 37 CFR 1.378(b) must affirmatively identify the cause of the delay in paying the maintenance fee and provide a statement from every person with first-hand knowledge of the circumstances surrounding the delay in paying the maintenance fee. Petitioner must provide statements from any person who may have been charged with paying the maintenance fee and statements from any person with first-hand knowledge of the circumstances surrounding the failure to pay the maintenance fees.

- 37 CFR 1.378(b)(3) sets forth that a petition submitted under this portion of the Code of Federal Regulations must include a showing which is described as follows:

  A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the

expiration of the patent, and the steps taken to file the petition promptly.

Petitioner must, therefore, describe the steps that were in place to ensure that the maintenance fee was timely paid. This showing would include an explanation of who was responsible for paying tracking and paying the maintenance fee and the method this person, or entity, used for tracking the maintenance fee

- Petitioner must describe when petitioner became aware that the patent was expired and the steps petitioner took to reinstate the patent

- The Statement under 37 CFR 3.73(b) filed October 5, 2010, is noted, but is defective in that it does not provide the reel/frame number where the assignment document can be found. Office records note an assignment document as having been recorded at reel/frame number 006923/0971. However, petitioner must file a properly completed 3.73(b) statement that includes the reel/frame number of the assignment document that conveys the assignee the power to take action in the patent or provide a copy of the assignment document for recordation that conveys this power to the assignee.

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

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petition Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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AUG 02 2011
OFFICE OF PETITIONS

J. Gerald O'Connor
P.O. Box 2515
Winter Park, Florida 32790-2515

In re Patent No. 6,060,074 :
Issued: May 9, 2000 : ON PETITION
Application No.: 08/209,268 :
Filing Date: March 14, 1994 :
Attorney Docket No.: **P602524018** :

This is responsive to the Response to Request for Information filed April 4, 2011, and a decision on the petition under 37 CFR 1.378(b), filed October 5, 2010, to reinstate the above-cited patent.

The petition is **dismissed**.

The patent issued May 9, 2000. The 7.5 year maintenance fee could have been paid from May 9, 2007, through November 10, 2007, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from November 11, 2007, to May 9, 2008. Petitioner did not do so. Accordingly, the patent expired at midnight on May 10, 2008.

A grantable petition under 37 CFR 1.378(b) must be accompanied by a showing to the satisfaction of the Commissioner that the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable. The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.378(b).

Opinion

Petitioner must establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.[1]

[1]The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard. 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee . . . at any time . . .if the delay is shown *to the satisfaction of the Commissioner* to have been unavoidable." (emphasis added).

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference." Rydeen v. Quigg, 748 F. Supp. 900, 904, 16 U.S.P.Q2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion Rule 36), 937 F.2d 623 (Fed Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d agencys' interpretation of a statute it administers is entitle to deference"); see also Chevron U.S.A. Inc, v. Natural Resources Defense Counsil, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute s silent or

However, "[t]he question of whether an applicant's delay in prosecuting an application was unavoidable [will]be decided on a case-by-case basis, taking all of the facts and circumstances into account."[2] Nonawarness of the content of, or misunderstanding of PTO statutes, PTO rules, the MPEP, or the Official Gazette notices does not constitute unavoidable delay.[3] The statute requires a "showing" by petitioner, therefore; petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Petitioner is responsible for possessing knowledge of the need to pay maintenance fees and the due dates for such fees, Petitioner is responsible for instituting a reliable docketing system to remind him or her when maintenance fees become due.

Petitioner is responsible for having knowledge of the need to pay maintenance fees and knowing when the fees are due.[4] The Office has no duty to notify a patentee of the requirement to pay maintenance fees or to notify patentee when a maintenance fee is due.[5] Even if the Office were required to provide notice to

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ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F. 3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1781 (Fed Cir. 1995) (Citing In re patent No. 4,409, 763, 7 U.S.P.Q.2d BNA) 1798, 1800 (Comm'r Pat. 1990; Smith v. Mossinghoff, 671 F. 2d 533, 538, 213 U.S.P. Q. (BNA) 977 (D.C. Cir. 1982). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which "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." In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat 31, 32-33 (1887)).

[2]Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

[3]See Smith v. Mossinghoff, 671 F. 2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable " delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (plaintiffs, through their counsel's action, or their own, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

[4]Nonawarness of PTO statutes, PTO rules, the MPEP, or Official Gazette notices, which state maintenance fee amounts and dates they are due does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. *BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable" delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (Plaintiffs, through their counsel's actions, or their own must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

Petitioner must act as a reasonable and prudent person in relation to his most important business. Upon obtaining the patent, a reasonable and prudent person, in relation to his most important business, would become familiar with the legal requirements of that business, in this case, the requirement to pay maintenance fees. In addition, a reasonable and prudent individual would read the patent itself and thereby become aware of the need to pay maintenance fees and the fact that such fee amounts are sometimes changed by law or regulation.

[5]Congress expressly conditioned §§ 133 and 151 [of the United States Code] on a specific type of notice, while no such notice requirements are written into § 41(c) . . . [T]he Commissioner's no timely-notice interpretation." Ray v. Comer, 1994 U.S. Dist. LEXIS 21478, 8-9 (1994), *aff'd on other grounds* Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995) (Citing

applicant of the existence of maintenance fee requirements, such notice is provided by the patent itself.[6]

A reasonable and prudent person, aware of the existence of maintenance fees, would not rely on maintenance fee reminders or on memory to remind him or her when payments would fall due several years in the future. Instead, such an individual would implement a reliable and trustworthy tracking system to keep track of the relevant dates.[7] The individual would also take steps to ensure that the patent information was correctly entered into the tracking system.

Application of the unavoidable standard to the present facts

In the instant petition, petitioner argues that the above-cited patent should be reinstated because the delay in paying the 7.5-year maintenance fee was unavoidable and resulted from the ill health of the late Dr. Irwin S. Morse, who was a joint inventor on the patent and a principal of Morse Enterprises Limited, Inc. ("MEL) (the assignee for the subject patent). Petitioner states that Dr. Morse suffered a series of health problems and, despite selling off most of his interests in MEL, retained control over the intellectual property matters of MEL, including the tracking and payment of maintenance fees for the subject patent. Petitioner maintains that Dr. Morse kept both a manual and computer calendar wherein important dates for the intellectual property matters were docketed, and Dr. Morse's wife served as a secretary and administrative assistant. Notwithstanding, because of Dr. Morse's ill health, petitioner concludes that Dr. Morse did not recognize the importance of paying the maintenance fee or could not effectively respond to the approaching deadline for paying the maintenance fee. Petitioner concludes that delay in paying the 7.5-year maintenance fee was unavoidable.

Rydeen v. Quigg, 748 F. Supp. 900, 905 (1990), Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 81 L. ed. 2d 694, 104 S. Ct. 2778 (1984)). "The Court concludes as it did in Rydeen, that as a constitutional matter, 'plaintiff was not entitled to any notice beyond publication of the statute." Id. at 3 (citing Rydeen v. Quigg, 748 F. Supp. at 906, Texaco v. Short, 454 U.S. 516, 536, 70 L. Ed. 2d 738, 102 S. Ct. 781 (1982)).

The Patent Office, as a courtesy tries to send maintenance fee reminders and notices of patent expiration to the address of record. However, the failure to receive the reminder notice, and the lack of knowledge of the requirement to pay the maintenance fee, will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. See MPEP 2575, 2540, 2590. Petitioner does not have a right to a personalized notice that this patent will expire if a certain maintenance fee is not paid, as the publication of the statute was sufficient notice. See Rydeen v. Quigg, 748 F. Supp. 900, 907 (1990). the ultimate responsibility for keeping track of maintenance fee states lies with the patentee, not the USPTO. Since the mailing of Notices by the Office is completely discretionary and not a requirement imposed by Congress, accepting an argument that failure to receive a Notice is unavoidable delay would result in all delays being unavoidable should the Office discontinue the policy. All petitions could allege non-receipt of the reminder, and therefore all petitions could be granted. This was clearly not the intent of Congress in the creation of the unavoidable standard.

[6]See Ray v. Lehman, 55 F.3d 606, 610; 34 USPQ2d 1786, 1789 (Fed. Cir. 1995). The Letters of Patent contain a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. While it is unclear as to who was and is in actual possession of the patent, petitioner's failure to read the Notice does not vitiate the Notice, nor does the delay resulting from such failure to read the Notice establish unavoidable delay.

[7] 37 CFR 1.378(b)(3) precludes acceptance of a late maintenance fee for a patent unless a petitioner can demonstrate that steps were in place to monitor the maintenance fee. The federal Circuit has specifically upheld the validity of this regulation. Ray v. Lehman, 55 F.3d 606, 609; 34 USPQ2d (BNA) 1786 (Fed.Cir. 1995). In Ray v. Lehman, petitioner claimed that he had not known of the existence of the maintenance fees and therefore had no steps in place to pay such fees. The petitioner therefore argues that the PTO's regulation, 37 CFR 1.37(b)(3), supra, arguing that it 'creates a burden that goes well beyond what is reasonably prudent." We disagree, The PTOs' regulation merely sets forth how one is to prove that he was reasonably prudent, i.e., by showing what steps he took to ensure that the maintenance fee would be timely paid, and the steps taken in seeking to reinstate the patent. We do not see these requirements additional to proving unavoidable delay, but as the very elements of unavoidable delay." Id.

The petitioner's argument and statements have been considered, but are not persuasive as petitioner has not made the "showing" that is required to satisfy the requirements of 37 CFR 1.378(b). Further to this point, Section 711.03(c)(2) provides, in pertinent part that:

> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).
>
> A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:
>
> > (A) the error was the cause of the delay at issue;
> > (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
> > (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

In addition to Dr. Morse's ill health, petitioner seems to intimate that there may have been some inadequacies in the docketing and tracking of the maintenance fee for the subject patent. Petitioner states that in early 2007 the principal offices of MEL were relocated from Dr. Morse's home to that of J. Gerald O'Connor to whom Dr. Morse sold most of his interest in MEL. Despite this relocation, Dr. Morse retained custody of the intellectual property files, including the matters related to the subject patent. Petitioner states that Dr. Morse kept a docketing system and that it was functional, but antiquated. Arguably, in treating the maintenance of the patent as its' most important business, Dr. Morse and/or J. Gerald O'Connor would have ensured that a business routine and docketing system was in place that could be reasonably relied upon to ensure timely payment of the maintenance fee. In this respect, the understanding of Mr. O'Connor becomes relevant in that Dr. Morse had sold most of interests in MEL to Mr. O'Connor which would presumably include the rights to the intellectual property assigned to MEL. It appears, however, that despite Dr. Morse's failing health, Mr. O'Connor failed to considered whether Dr. Morse was capable of ensuring the maintenance of the patent or considered whether it was prudent to rely on Dr. Morse, in view of his failing mental capacities, to ensure maintenance of the patent. The petition fails to establish that the entire delay of the relevant parties, i.e., Dr. Morse and Mr. O'Connor, was unavoidable as petitioner has not established that there was reliable business routine in place for tracking and paying the maintenance fee.

Further, it is noted that petitioner asserts that the ill health of Dr. Morse contributed greatly to the unavoidable delay in paying the maintenance fee. Petitioner has not provided any objective evidence of the condition of Dr. Morse during the relevant period during which Dr. Morse was alive. Petitioner is required to provide statements from treating physicians and or medical records that may substantiate petitioner's assertion that Dr. Morse's ill health contributed to the unavoidable delay in paying the maintenance fee.

Lastly, is noted that petitioner states that Dr. Morse succumbed to his conditions on December 29, 2007, which was prior to the expiration of the patent. Petitioner is required to explain at what point Mr. O'Conner assumed ownership of the subject patent by virtue of the sale of Dr. Morse's stock to Mr. Conner. Petitioner must also provide a statement from Mr. O'Connor as to his understanding and knowledge of the need to pay the 7.5-year maintenance fee and the steps he may have put in place to ensure timely payment of the same.

Petitioner's Current Options

I. Petitioner may file a request for reconsideration.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within TWO (2) MONTHS from the mail date of this decision.[8] The petition for reconsideration should be titled "Petition for Reconsideration under 37 CFR 1.378(b)." Any petition for reconsideration for this decision must be accompanied by a non-refundable petition fee of $400.00 as set forth in 37 CFR 1.17(h).

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. It is, therefore, extremely important that petitioner supply any and all relevant information and documentation with the request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence "to show" that the delay was unavoidable. If a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Refund Section. A copy of this decision should accompany petitioner's request.

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

By mail:
Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

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

A reasonable and prudent person would not rely on maintenance fee reminders from the Office for two reasons. First, the Office has indicated that such reminders are a mere courtesy and has reserved the right to discontinue such reminders at any time. second, such reminders may be lost in the mail. A reasonable and prudent person, in regard to his most important business would not rely solely on reminders that the Office may or may not send which may or may not be lost in the mail.

[8]No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is not a final agency action within the meaning of 5 U.S.C. § 704.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petition 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

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OFFICE OF PETITIONS

SALIWANCHIK, LLOYD & EISENSCHENK
A PROFESSIONAL ASSOCIATION
PO Box 142950
GAINESVILLE FL 32614

In re Patent No. 6,060,074 :
Issued: May 9, 2000 : ON PETITION
Application No.: 08/209,268 :
Filing Date: March 14, 1994 :
Attorney Docket No. **P602524018** :

This is a request for information in response to the petition under 37 CFR 1.378(e), filed October 3, 2011, to reinstate the above-cited patent.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed September 28, 2009. No additional fees are due.

The patent issued May 9, 2000. The 7.5 year maintenance fee could have been paid from May 9, 2007, through November 10, 2007, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from November 11, 2007, to May 9, 2008. Petitioner did not do so. Accordingly, the patent expired at midnight on May 10, 2008.

Petitioner is required to address the following points:

Petitioner has not adequately established that there was a business routine in place that was crafted to track the maintenance fee payment schedule for the subject patent and ensure that it was paid on time. The petition and accompanying statements indicate that Dr. Morse kept meticulous records and calendars. Further, the statement of Ms. Siobhan Morse indicates that Dr. Morse had, "...secretarial help that took over after [her] mother's retirement. He had computers with a calendaring "tickler" system and maintained manual calendars and a datebook." Petitioner is required to elaborate upon the docketing system that was employed by Dr. Morse and his assistants/employees. The health issues of Dr. Morse that may have contributed to failure to pay the maintenance fee are noted; however, petitioner must still establish that there was in place a business routine that could reasonably be relied upon to ensure timely payment of the maintenance fee. Previous statements regarding the Dr. Morse's business routine for docketing and tracking the maintenance fee payments consist of general statements relative to Dr. Morse's overall meticulous ways relative to handling his business affairs. The statements do not specifically describe the methods used to docket and track the maintenance fee payments. Petitioner should describe in detail the docketing/tracking method for payment of the maintenance fee employed by Dr. Morse and his assistants/employees.

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

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Fernando Morales
15 Cortez Ave.
Rancho Viejo, TX 78575

MAILED

AUG 04 2011

OFFICE OF PETITIONS

In re Patent No. 5,872,589 :
Issue Date: February 16, 1999 :
Application No. 08/214,414 : ON PETITION
Filed: March 18, 1994 :
Patentee(s): Fernando Morales :

This is a decision on the petition under 37 CFR 1.378(c), filed on June 3, 2011, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(c) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2). This petition lacks item (3) above.

A review of the record shows that full payment of the 11 ½ year maintenance fee, in the amount of $2,055, was received on June 28, 2011. However, petitioner failed to submit the unintentional late payment surcharge in the amount of $1,640. Therefore, this patent cannot be reinstated until the surcharge amount of $1640 has been submitted.

Since the address given in the present petition differs from the correspondence address of record, a courtesy copy of this decision is being mailed to the address given in the petition. Thereafter, all future communications from the Office will be mailed solely to the correspondence address of record.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within **TWO (2) MONTHS** from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Any petition for reconsideration of this decision must be accompanied by the petition fee of **$400** as set forth in 37 CFR 1.17(f). The petition for reconsideration must include the lacking item noted above, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

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 Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

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

Andrea Smith
Petitions Examiner
Office of Petitions

cc: Fernando Morales
56 Pizarro Avenue
Rancho Viejo, TX 78575

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

Fernando Morales
15 Cortez Ave.
Rancho Viejo, TX 78575

MAILED

DEC 14 2011

OFFICE OF PETITIONS

In re Patent No. 5,872,589 :
Issue Date: February 16, 1999 :
Application No. 08/214,414 : ON PETITION
Filed: March 18, 1994 :
Patentee(s): Fernando Morales :

This is a decision on the renewed petition under 37 CFR 1.378(c), filed on October 7, 2011, to accept the delayed payment of a maintenance fee for the above-identified patent.

Since petitioner has demonstrated to the satisfaction of the Commissioner that the delay in timely paying the maintenance fee was unintentional, the petition under 37 CFR 1.378(c) is hereby **GRANTED**.

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Since the address given in the present petition differs from the correspondence address of record, a courtesy copy of this decision is being mailed to the address given in the petition.

This patented file is being forwarded to Files Repository.

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

Andrea Smith
Petitions Examiner
Office of Petitions

cc: Fernando Morales
56 Pizarro Ave.
Rancho Viejo, TX 78575

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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Scott A. McCollister
The Halle Building 5th Floor
1228 Euclid Avenue
Cleveland, OH 44115-1843

MAILED

DEC 12 2011

OFFICE OF PETITIONS

In re Patent No. 5,501,597 :
Issued: March 26, 1996 :
Application No.: 08/236,494 : NOTICE
Filed: April 29, 1994 :
Attorney Docket No: **165750101** :

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 the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JACKSON WALKER L.L.P.
ATTN: INTELLECTUAL PROPERTY DEPT.
100 CONGRESS AVNUE
SUITE 1100
AUSTIN, TX 78701

MAILED

DEC 06 2010

OFFICE OF PETITIONS

In re Application of :
Gilbert M. DINKINS :
Application No. 08/240,147 : DECISION ON PETITION
Filed: May 10, 1994 : TO WITHDRAW
Attorney Docket No. EON001.C : 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, 2010.

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

A review of the file record indicates that the power of attorney to Raman N. Dewan and the attorneys of record associated with Customer No. 67942, has been revoked by the assignee of the patent application on November 4, 2010. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

Telephone inquires concerning this decision should be directed to undersigned at 571-272- 6735.

/Diane C. Goodwyn/
Diane C. Goodwyn
Petitions Examiner
Office of Petitions

Cc: DAFFER MCDANIEL LLP
P.O. BOX 684908
AUSTIN, TX 78768

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5666545	1997-09-09	08240953	1994-05-11	5222

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-08
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

Commissioner for Patents
United States Patent and Trademark Office
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In re Patent No. 5666545
Issue Date: September 9,1997
Application No. 08240953
Filed: May 11,1994
Attorney Docket No. 5222

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

Dunlap Codding, P.C.
P.O. Box 16370
Oklahoma City, OK 73113

MAILED
JAN 24 2011
OFFICE OF PETITIONS

In re Donald E. Weder :
Application No.: 08/242,477 : **DECISION**
Filed: May 13, 1994 : **GRANTING**
Patent No.: 5,974,736 : **PETITION**
Issued: November 2, 1999 :

This is a decision on the May 6, 2010 petition requesting the issuance of a corrected paten under 37 CFR 1.322(b) for U.S. Patent No. 5,974,736 ("the May 6, 2010 petition").

The May 6, 2010 petition is before the Office of Patent Legal Administration (OPLA) for consideration.

The May 6, 2010 petition is **granted**.

The Image for U.S. Patent No. 5,974,736 in the USPTO Patent Full-Text and Image Database maintained by the Office will be updated to include the corrected patent in the form of a second Certificate of Correction, in addition to the original, incorrectly printed patent. The Office will also provide a courtesy corrected reprint of U.S. Patent No. 5,974,736 for patent owner's records

Any inquiry concerning this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.

Brian E. Hanlon
Director
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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WATSON, COLE, GRINDLE & WATSON
1400 K ST., N.W.
WASHINGTON, DC 20005-2477

MAILED
JUN 03 2011
OFFICE OF PETITIONS

In re Patent of Mezzalira :
Patent No. 5,477,888 :
Issue Date: December 26, 1995 : Decision on Petition
Application No. 08/243,483 :
Filing Date: May 13, 1994 :
Attorney Docket No. 676022 :

This is a decision on the "Petition to Add Inventor" filed by Attorney Richard Tushin on February 16, 2011, which is being treated as a petition to add an inventor pursuant to 37 C.F.R. § 1.324 and a petition under 37 C.F.R. 1.183 requesting waiver of 37 C.F.R. § 1.324(b)(2).

The petition under 37 C.F.R. § 1.324 is **dismissed**.

The petition under 37 C.F.R. § 1.183 is **dismissed**.

Any request for reconsideration 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 NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.324 and 37 C.F.R. § 1.183."

The sole inventor of record is Rinaldo Mezzalira.

Petitioner seeks to add Valentino Vigolo as an inventor.

37 C.F.R. § 1.324 states,

> (a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Commissioner may, on petition, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 1.634.

(b) Any petition pursuant to paragraph (a) of this section must be accompanied by:
(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;
(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;
(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and
(4) The fee set forth in § 1.20(b).

The petition does not include a statement from Mezzalira agreeing to the change of inventorship or stating he has no disagreement with regard to the requested change of inventorship. Therefore, the requirement set forth in 37 C.F.R. § 1.324(b)(2) has not been satisfied.

Petitioner requests the requirement for a statement from Mezzalira "be waived because he has died." The request for waiver of the requirement for statement from Mezzalira is being treated as a petition under 37 C.F.R. § 1.183 requesting waiver of the requirement under 37 C.F.R. § 1.324(b)(2) for a statement from each inventor, excluding any inventor(s) being added or deleted, which agrees to the change of inventorship or states the inventor has no disagreement with the change of inventorship.

37 C.F.R. § 1.183 only provides the Office with the authority to waive a requirement "which is not a requirement of the statutes." In other words, the Office does not have the authority to waive a statutory requirement.

35 U.S.C. § 256 states, with emphasis added,

> Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, *on application of all the parties and assignees*, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error.

M.P.E.P. § 1481.02 addresses the impact 35 U.S.C. § 256 has on the Office's ability to waive requirements set forth in 37 C.F.R. § 1.324. M.P.E.P. § 1481.02 states, with emphasis added,

> The statutory basis for correction of inventorship in a patent under 37 CFR 1.324 is 35 U.S.C. 256. It is important to recognize that 35 U.S.C. 256 is stricter than 35 U.S.C. 116, the statutory basis for corrections of inventorship in applications under 37 CFR 1.48. 35 U.S.C. 256 requires "on application of all the parties and assignees," while 35 U.S.C. 116 does not have the same requirement. Under 35 U.S.C. 116 and 37 CFR 1.48, waiver requests under 37 CFR 1.183 may be submitted (see, e.g., MPEP § 201.03, under the

> heading "Statement of Lack of Deceptive Intention"). This is not possible under 35 U.S.C. 256 and 37 CFR 1.324. In correction of inventorship in a nonprovisional application under 37 CFR 1.48(a), the requirement for a statement by each originally named inventor may be waived pursuant to 37 CFR 1.183; however, *correction of inventorship in a patent under 37 CFR 1.324 requires petition of all the parties*, i.e., originally named inventors and assignees, in accordance with statute (35 U.S.C. 256) and thus the *requirement cannot be waived.*

As recognized in M.P.E.P. § 1481.02, the requirement for a statement from each inventor is a statutory requirement. Therefore, the Office cannot waive the requirement for a statement from Mezzalira and the petition under 37 C.F.R. § 1.183 is dismissed.

A statement from Mezzalira has not been filed and the requirement for a statement from Mezzalira has not been waived. Therefore, the petition under 37 C.F.R. § 1.324 is dismissed.

Petitioner may wish to note a reissue application can be used to correct an inventorship error. As stated in M.P.E.P. § 1481.02,

> If an inventor is not available, or refuses, to submit a statement, the assignee of the patent may wish to consider filing a reissue application to correct inventorship, because the inventor's statement is not required for a non-broadening reissue application to correct inventorship. See MPEP § 1412.04.

The $130 fee for the petition under 37 C.F.R. § 1.324 and the $400 fee for the petition under 37 C.F.R. § 1.183 have been charged to Deposit Account No. 04-2223 pursuant to the general fee authorization set forth in the petition.

The petition is signed by Attorney Richard Tushin. The record fails to indicate Attorney Tushin has been given a power of attorney and the address on the petition is different than the address of record. While a courtesy copy of this decision is being mailed to Attorney Tushin at the address set forth on the petition, all future correspondence will be directed solely to the address of record absent receipt of appropriate instructions to the contrary.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.[1] Document Code "PET.OP" should be used if the request is filed electronically.

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

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

[1] General Information concerning EFS Web can be found at http://www.uspto.gov/patents/process/file/efs/index.jsp.

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

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Anthony Knight
Director
Office of Petitions

cc: Richard Tushin
Franklin Square, Third Floor West
1300 I Street NW
Washington, DC 20005-3353

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

Patent No. : 5,527,149
Ser. No. : 08/253,543
Inventor(s) : Moss et al.
Issued : Jun. 18, 1996
Title : EXTENDED RANGE REGENERATIVE PUMP WITH MODIFIED IMPELLER AND/OR HOUSING
Docket No. : CID136A
Re: Request for Certificate of Correction

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

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

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

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

A. **the processing fee set forth in 37 CFR 1. 17(i) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

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

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

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

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

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

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

Ennis Young
For Mary Diggs
Decisions & Certificates
of Correction Branch
(571) **272-3435** or (703) 756-1814

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5619556	1997-04-08	08259853	1994-06-15	210210031

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-06
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5619556
Issue Date: April 8,1997
Application No. 08259853
Filed: June 15,1994
Attorney Docket No. 210210031

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

Altera Law Group, LLC
220 S 6 St Suite 1700
Minneapolis MN 55402

MAILED

SEP 27 2010

OFFICE OF PETITIONS

In re Application of :
Emad Y. ABED :
Application No. 08/259,859 : DECISION ON PETITION
Filed: June 15, 1994 :
Attorney Docket No. **4455.2-US-AA** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 02, 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, July 14, 1995, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on October 15, 1995.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $810, and (3) a proper statement of unintentional delay. Accordingly, the reply to the non-final Office action of July 14, 1994 is accepted as having been unintentionally delayed.

The terminal disclaimer is accepted and has been made of record.

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

The power of attorney filed with the petition is accepted and has been made of record.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $555 extension of time fee submitted with the petition on March 02, 2010 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's credit card.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at (571) 272-2783.

This application is being referred to Technology Center AU 2606 for appropriate action on the concurrently filed amendment.

Ramesh Krishnamurthy
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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APR 11 2011

OFFICE OF PETITIONS

WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA PA 19104-2891

In re Patent No. 5,835,616
Issue Date: November 10, 1998
Application No. 08/261,947
Filed: June 17, 1994
Attorney Docket No. **QN-0010

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed February 28, 2011.

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

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

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

The $130.00 petition fee is not required and will be refunded to deposit account no. 23-3058.

Inquiries related to this communication 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
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MR. MICHAEL FOGARTY
MCDERMOTT, WILL & EMERY
600 13TH STREET NW
WASHINGTON, DC 20005-3096

MAILED

APR 13 2011

OFFICE OF PETITIONS

In re Patent No. **5,959,628**
Issue Date: September 28, 1999
Application No. 08/267,868
Filed: June 28, 1994
Attorney Docket No. **93901**

NOTICE UNDER 37 CFR 1.28(c)

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.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Mr. Brian Haslam appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. If, Mr. Haslam desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to Mr. Haslam, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

Inquiries related to this communication should be directed to the undersigned at (571) 272-7253.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

cc: **BRIAN HASLAM**
MICROSOFT CORPORATION
ONE MICROSOFT WAY
REDMOND, WA 98057

DOCKET NUMBER: 312135.01
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
FEB 09 2011
OFFICE OF PETITIONS

Applicant:	ALBERT B. P. CECCHINI
Patent No.:	5959628
Issued:	September 28, 1999
Serial No.:	08/267,868
For:	METHOD FOR PROVIDING MAXIMUM SCREEN REAL ESTATE IN COMPUTER CONTROLLED DISPLAY SYSTEMS
Maintenance Fee:	8th Year – March 2, 2007

CERTIFICATE OF FACSIMILE TRANSMISSION UNDER 37 CFR §1.8(a)

The undersigned hereby certifies that this document is being sent via facsimile to 571-273-6500. ATTN: Maintenance Fees, Receipts Accounting Div./Office of Finance, United States Patent & Trademark Office, on the 2nd day of February, 2011.

Eric R Matt

VIA FACSIMILE: 571-273-6500
ATTN: Maintenance Fees
Receipts Accounting Division
Office of Finance
U.S. Patent and Trademark Office

02/07/2011 MBANGURA 00000015 500463 5959628
01 FC:1599 1330.00 DA

CORRECTION OF ERROR IN SMALL ENTITY STATUS PURSUANT TO 37 C.F.R. §1.28(c)

Sir:

In the above-identified case, it was discovered that, through error, the 8th year maintenance fee was paid inadvertently as a small entity.

Accordingly, Patentee submits herewith the deficiency payment of $1330.00 for the 8th year maintenance fee. Pursuant to 37 C.F.R. §§ 1.28(c)(1), 1.28(c)(2)(i) and 1.28(c)(2)(ii), the itemization of the deficiency payment is as follows:

Type of fee erroneously paid as small entity	Current fee amount for non-small entity	Small entity fee actually paid and date paid	Deficiency Owed Amount
8th Year Maintenance Fee	$2480.00	$1150.00 paid on 3/2/07	$1330.00
Total Deficiency Owed			**$1330.00**

In view of compliance with 37 C.F.R. §§ 1.28(c)(1), 1.28(c)(2)(i) and 1.28(c)(2)(ii), Patentee respectfully requests that the error in small entity status be excused.

Additionally, pursuant to 37 C.F.R. §1.28(d), it is requested that the submission of the deficiency payment be treated under 37 C.F.R. §1.27(g)(2) as a notification of a loss of entitlement to small entity status.

Please charge the deficiency of $1330.00 to Deposit Account No. 50-0463 under Ref. No. 312135.01, so that the 8th year maintenance fee payment reflects non-small entity status.

Respectfully submitted,

By: Brian Haslam

Brian Haslam, Reg. No. 56,372
Microsoft Corporation
One Microsoft Way
Redmond, WA 98057
Telephone: (425) 722-5749

Date: February 2, 2011

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5624265	1997-04-29	08269492	1994-07-01	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☒ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

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○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

◉ The assignee of record of the entire interest

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The Assignee of record of the entire interest			
Under 37 CFR 3.71 an assignee becomes of record by filing a statement in compliance with 37 CFR 3.73(b). Signature requirements are set forth in 37 CFR 1.4(d), and the undersigned certifies that he / she is empowered to act on behalf of the assignee of the entire interest			
Signature	/Peter M. Redford/	Date (YYYY-MM-DD)	2010-09-13
Name	Peter M. Redford		
Enter Reel and Frame Number		Remove	
Reel Number	007120	Frame Number	0225
Enter Reel and Frame Number		Remove	
Reel Number	013552	Frame Number	0313
Enter Reel and Frame Number		Remove	
Reel Number	022939	Frame Number	0383
Click ADD for additional Reel Number and Frame Number		Add	

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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).

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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www.uspto.gov

In re Patent No. 5624265
Issue Date: April 29,1997
Application No. 08269492
Filed: July 1,1994
Attorney Docket No. M2726US

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed September 20,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5666129	1997-09-09	08271111	1994-07-06	30019.28US01

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☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

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☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

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Small Entity

	Fee	Code
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MAINTENANCE FEE (37 CFR 1.20(e)-(g))

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-08
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5666129
Issue Date: September 9,1997
Application No. 08271111
Filed: July 6,1994
Attorney Docket No. 30019.28US01

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

RICHARD R. MYBECK
P.O. BOX 5540
SCOTTSDALE AZ 85261-5540

MAILED
OCT 2 1 2010
OFFICE OF PETITIONS

In re Patent No. 5,490,924 :
Issue Date: February 13, 1996 :
Application No. 08/277,619 : REQUEST FOR :INFORMATION
Filed: July 20, 1994 :
Attorney Docket No. 4847 :

This request for information is mailed in response to the petition under 37 CFR 1.378(b), filed July 30, 2010 and supplemented on August 13, 2010 (certificate of mailing date August 10, 2010), to accept the delayed payment of a maintenance fee for the above-identified patent.

Please respond within TWO (2) MONTHS from the mail date of this request for information. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The merits of this petition will not be addressed because the person signing the petition has not established his authority to file the petition. As stated in MPEP 2590,, "If the petition is signed by a person not registered to practice before the Office, the petition must indicate that the person signing the petition is the patentee, assignee, or other party in interest. An assignee must comply with the requirements of 37 CFR 3.73(b) which is discussed in MPEP § 324." (emphasis added) Pursuant to 37 CFR 3.73(b), a party must be established as the assignee by satisfying the requirements of that subsection, in order to be recognized as an owner or part owner, for purposes of taking action in patent matters before the Office

Petitioner has not complied with the requirements of 37 CFR 3.73(b). For petitioner's convenience a form "STATEMENT UNDER 37 CFR 3.73(b)" is enclosed. Please complete and file the form.

In addition, the request for change of correspondence address embedded within the July 30, 2010 correspondence will not be entered because petitioner has not complied with 37 CFR 3.73(b). It appears that petitioner and his attorney have parted ways. Therefore, when petitioner submits a statement under 37 CFR 3.73(b), petitioner should complete and submit the enclosed form "PATENT – POWER OF ATTORNEY OR REVOCATION OF POWER OF ATTORNEY WITH A NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE

ADDRESS." By completing and filing this form, petitioner will update the Office as to individuals empowered to take action in this patent, as well as provide a current correspondence address for patent matters.

A courtesy copy of this decision is being mailed to the address on the petition. However, the Office will mail all future correspondence solely to the address of record.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

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
By internet:	EFS-Web www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)

Telephone inquiries should be directed to the undersigned at (571) 272- 3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

ENCLOSURES: STATEMENT UNDER 37 CFR 3.73(b)

PATENT – POWER OF ATTORNEY OR REVOCATION OF POWER OF ATTORNEY WITH A NEW POWER OF ATTORNEY AND CHANGE OF CORRESPONDENCE ADDRESS

PRIVACY ACT STATEMENT

CC: NARCISO F. MACIA
CONTROL SYSTEMS INNOVATION, INC.
P.O. BOX 1908
19225 S. SOSSAMAN RD.
QUEEN CREEK AZ 85142

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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AUG 12 2011
OFFICE OF PETITIONS

NARCISO F. MACIA
19225 S.SOSSAMAN ROAD
QUEENCREEK AZ 85142

In re Patent No. 5,490,924 :
Issue Date: February 13, 1996 :
Application No. 08/277,619 : ON PETITION
Filed: July 20, 1994 :
Attorney Docket No. 4847 :

This is a decision on the petition under 37 CFR 1.378(b), filed July 30, 2010 and supplemented on August 13, 2010 (certificate of mailing date August 10, 2010) and on December 28, 2010 to accept unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400. The petition for reconsideration should include an exhaustive attempt to provide the lacking item 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.

The patent issued February 13, 1996. The 11 ½ year maintenance fee could have been paid from February 13, 2007 through August 13, 2007, or with a surcharge during the period from August 14, 2007 through February 13, 2008. The 11 ½ year maintenance fee was not timely paid. Accordingly, the patent expired on February 14, 2008.

Statute and Regulation

37 CFR 1.378(a) provides that the Director may accept the payment of any maintenance fee due on a patent based on an expiration of the patent, if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable or unintentional. The appropriate surcharge set forth in § 1.20(i) must be paid as a condition of accepting payment of the maintenance fee. The surcharges set at 37 CFR 1.20(i) are established pursuant to 35 U.S.C. 41(c) and, therefore, are not subject to small entity provisions of 35 U.S.C. 41(h). No separate petition fee is required for this petition. If the Director accepts payment of

41(h). No separate petition fee is required for this petition. If the Director accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired but will be subject to the intervening rights and provisions of 35 U.S.C. 41(c)(2).

The patent statute at 35 U.S.C. 41(c)(1) provides as follows:

> "The Director may accept the payment of any maintenance fee required by subsection (b) of this section... at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable."

The statute's promulgating rule, 37 CFR 1.378(b), provides that any petition to accept the delayed payment of a maintenance fee must include the following:

> (1) the required maintenance fee set forth in 37 CFR 1.20(e) - (g);
>
> (2) the surcharge set forth in 37 CFR 1.20(i)(1); and
>
> (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Such as statement must be verified if made by a person not registered to practice before the Patent and Trademark Office. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

Opinion

In the instant petition, assignee, Control Systems Innovation, Inc. asserts that the delay in payment of the 11 ½ year maintenance fee was unavoidable because of a lack of communication between patentee and patentee's attorneys. Patentee relied upon their attorneys to timely inform them of the necessity to pay the maintenance fee payments appropriate for the patent. One of their attorneys, Mr. Richard Mybeck passed away and the other patent attorney is speculated to have moved to a different firm. (August 13, 2010 petition p. 4) Therefore, patentee did not receive notification of the due date for the 11 ½ year maintenance fee.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Petitions for the delayed payment of maintenance fees under 35 U.S.C. 41(c)(1) are treated under the same standard as petitions for revival of abandoned applications under 35 U.S.C. 133 because both statutory provisions use the same language, i.e., "unavoidable" delay. Ray v. Leyman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd, Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable as follows:

> 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 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.

In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-168 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Massinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). The requirement in 35 U.S.C. 133 for a showing of unavoidable delay requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable (or expiration of the patent as it applies to 35 U.S.C. 41(c)(1)), but also a showing of unavoidable delay from the time an applicant becomes aware of the abandonment of the application until the filing of a petition to revive (or a petition under 37 CFR 1.378(b) to reinstate the patent under 35 U.S.C. 41(c)(1)). See In re Application of Takao, 17 USPQ2d 1155 (Comm'r Pat. 1990). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-317, 5 USPQ2d 1130, 1131-1132 (N.D. Ind. 1987).

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F.3d at 609-609, 34 USPQ2d at 1787. The party whose delay is relevant is the party in interest at the time action is needed to be taken. In Re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988). On February 13, 2008, which is the last day the 11 ½ year maintenance fee could be timely paid, Control Systems Innovation, Inc.. was the party in interest. Narciso F. Macia is the president of the company.

It was incumbent upon the party in interest to undertake the obligation to pay the fee or to engage a third party to monitor and track the second maintenance fee payment. Reliance *per se* on a third party for tracking a maintenance fee does not provide a patent holder with a showing of

unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 U.S.C. 41(c). Rather, such reliance merely shifts the focus of the inquiry to whether that third party acted reasonably and prudently.

It is incumbent upon petitioner to demonstrate, via a documented showing, that Control Systems Innovation, Inc. or its representative(s) had docketed this patent for the third maintenance fee payment in (a) reliable tracking system(s).

The record fails to show that patentee or his representatives took adequate steps to ensure timely payment of the maintenance fees. In re Patent No. 4,461,759, 16 USPQ2d 1883, 1884 (Comm'r Pat. 1990).

Petitioner must demonstrate, via a documented showing, that despite reasonable care by the patentee and/or the patentee's agents to implement reasonable steps to ensure the timely payment of the maintenance fee, the maintenance fee was nevertheless, unavoidably not paid.

Patentee asserts Mr. Mybeck passed away, presumably before the 11 ½ year maintenance fee was due. However, patentee has not provided any evidence as to the date Mr. Mybeck passed away. Please provide such evidence. However, it is noted that two attorneys were representing assignee – Mr. Mybeck and Peter Schull. Thus, even if Mr. Mybeck had passed away by the time the 11 ½ year maintenance fee was due, Mr. Schull was practicing law. Was Mr. Schull tracking the maintenance fee due dates for the patent? Did Mr. Schull attempt to timely contact patentee regarding the maintenance fee due date?

Because petitioner was represented by a registered practitioner, the Office must rely on the actions or inactions of the duly authorized and voluntarily chosen representative of the applicant, and the applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962). If the attorney made any errors, petitioner is bound by such errors.[1]

An attorney must act reasonably and prudently.

If [the] attorney somehow breach[es] his duty of care to plaintiff, then plaintiff may have certain other remedies available to him against his attorney. He cannot, however, ask the court to overlook [the attorney's] action or inaction with regard to the patent application. He hired the [attorney] to represent him. [The attorney's] actions must be imputed to him.[2]

---

[1] See California Med. Products v. Technol Med. Products, 921 F. Supp. 1219, 1259 (D. Del. 1995) (citing Smith v. Diamond, 209 U.S.P.Q. 1091, 1093 (D.D.C. 1981) (citing Link v. Walbash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734, 82 S. Ct. 1386 (1962))).

[2] Haines v. Quigg, 673 F. Supp. 314, 317, 5 U.S.P.Q. 2d (BNA) 1130 (citing Link v. Walbash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734, 82 S. Ct. 1386 (1962) ("Petitioner voluntarily chose his attorney as his representative in the action and he cannot now avoid the consequences of the acts or omissions of this freely selected agent ... Each party is deemed bound by the acts of his lawyer-agent and is considered to have 'notice of all facts, notice of which can be charged upon the attorney.'" (emphasis added); Inryco, Inc. v. Metropolitan Engineering Co., Inc., 708 F.2d 1225, 1233 (7th Cir. 1983) ("Courts hesitate to punish a client for its lawyers gross negligence, especially when the lawyer affirmatively misled the client" but "if the client freely chooses counsel, it should be bound to counsel's actions."); see also Wei v. State of Hawaii, 763 F. 2d 370, 372 (9th Cir.

Petitioner is reminded that the U.S. Patent and Trademark Office is not the proper forum for resolving disputes between applicants and their representatives. *See* Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995).

Petitioner is advised that delay resulting from a failure in communication between a client and a registered practitioner is not unavoidable delay. In Re Kim, 12 U.S.P.Q.2d 1595 (Comm'r Pat. 1988). Delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 U.S.C. 1.378(b). See Ray, at 610, 34 U.S.P.Q.2d at 1789.

The record fails to disclose that the patentee or patentee's representatives took reasonable steps to ensure timely payment of the maintenance fee. The record indicates that no steps were taken by Control Systems Innovation, Inc. to ensure timely payment of the 11 ½ year maintenance fee. Mr. Schull has not provided a statement of facts describing his responsibilities and actions with respect to docketing and payment of maintenance fees for the patent.

In short, petitioner has not demonstrated, via a documented showing, that there was a reliable tracking system in place to monitor the due dates of maintenance fees and that a responsible party had docketed this patent in that system. Evidence should be submitted which demonstrates that despite reasonable care by the patentee and/or the patentee's agent to implement reasonable steps to ensure the timely payment of the maintenance fees, the 11 ½ year maintenance fee was nevertheless, unavoidably not paid.
If petitioner does not wish to file a reconsideration petition, petitioner may, **in writing**, request a refund of the $2,755.00 submitted with the instant petition.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

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

By internet: EFS-Web
www.uspto.gov/ebc/efs_help.html
(for help using EFS-Web call the
Patent Electronic Business Center
at (866) 217-9197)

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
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OCT 18 2011

OFFICE OF PETITIONS

NARCISO F. MACIA
19225 S. SOSSAMAN ROAD
QUEENCREEK AZ 85142

In re Patent No. 5,490,924	:	
Issue Date: February 13, 1996	:	
Application No. 08/277,619	:	DECISION ON REQUEST FOR REFUND
Filed: July 20, 2994	:	
For: NOVEL FILTRATION SYSTEM	:	

This is a decision on the Request For Refund filed September 6, 2011.

The request is **GRANTED**.

Applicant files the above request for refund and states that "... After some reflection that took into consideration all aspects associated with this patent, I have decided to drop the effort to re-instate the patent. Consequently, I respectfully ask you and the United States Patent and Trademark Office to refund our previous payment of $2,755.00."

In view of the above, the payment of $2,755.00 submitted on July 30, 2010, is being refunded by check as it is the method in which the fee was paid.

Further, applicant is encouraged to note MPEP 502(a) when submitting papers to the USPTO.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

A31 PTO/SB/66
Approved for use through 04/30/2009. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,613,909	1997-03-25	08/278,946	1994-07-21	30103-0003001

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

Patent Practitioner			
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 form of the signature			
Signature	/Geoffrey P. Shipsides, Reg. No. 55,617/	Date (YYYY-MM-DD)	2011-02-18
Name	Geoffrey P. Shipsides	Registration Number	55617

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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 Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5613909
Issue Date: March 25,1997
Application No. 08278946
Filed: July 21,1994
Attorney Docket No. STELVP1

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 18,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 18,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

DR GEORGE A BROOKS
1501 EVERETT AVENUE
OAKLAND CA 94602

MAILED
FEB 04 2011
OFFICE OF PETITIONS

In re Patent No. 5,420,107	:	
Issue Date: May 30, 1995	:	
Application No. 08/279,829	:	DECISION ON PETITION
Filed: July 25, 1994	:	
Attorney Docket No. 01098-32767	:	
	:	

This is a decision on the petition under 37 C.F.R. §1.378(b), filed July 26, 2010.

The petition under 37 C.F.R. § 1.378(b) is **DISMISSED**.

Background:

The above-identified patent issued on May 30, 1995. Accordingly, the third maintenance fee could have been timely paid during the period from May 30, 2006 through November 30, 2006, or with a late payment surcharge during the period from December 1, 2006 through May 30, 2007. No maintenance fee having been received, the patent expired on May 31, 2007. Patentee filed the instant petition to accept the unavoidably delayed payment of the maintenance fee pursuant to 37 C.F.R. 1.378(b) on July 26, 2010.

With the instant petition, petitioner states that he was not reminded by his counsel of the twelve year maintenance fee. According to petitioner, his counsel not only prosecuted the application, but tracked and payed the four year and eight year maintenance fees for petitioner.

Relevant Statutes and Regulations:

35 U.S.C. § 41(c)(1) states that:

> The Commissioner may accept the delayed payment of any maintenance fee required ... after the six month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable.

37 C.F.R. § 1.378(b) provides that:

> Any petition to accept an unavoidably delayed payment of a maintenance fee must include:
>
> (1) The required maintenance fee set forth in §1.20(e) through (g);
>
> (2) The surcharge set forth in §1.20(i)(1); and
>
> (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

§ 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. This is a very stringent standard. 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. In

> addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32 (N.D. Ind. 1987).

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960)(35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee is unavoidable. See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991), cert. denied, 502 U.S. 1075 (1992); Ray v. Lehman, 55 F. 3d 606, 608 - 609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

Analysis:

Petitioner has not demonstrated unavoidable delay within the meaning of 35 U.S.C. §41(c)(1) and 37 C.F.R. § 1.378(b).

While it is unfortunate that petitioner's counsel did not remind him of the twelve year maintenance fee when it became due, petitioner is bound by any errors or negligence that may have been committed by his voluntarily chosen counsel. See Link v. Wabash, 370 U.S. 626, 633-34 (1962). Petitioner's recourse lies against his counsel.

Conclusion:

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision. Anysuch petition for reconsideration **must be accompanied by the $400** petition fee set forth in § 1.17(f). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that petitioner supply **any** and **all** relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with

direct knowledge of the cause of the delay, setting forth the facts as they know them.

If on request for reconsideration, the delayed payment of the maintenance fee is not accepted, then the maintenance fee and the surcharge set forth in §1.20(i) are subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. (Petitioner may request a refund of the maintenance fee and surcharge by writing to the Mail Stop 16, Director of the USPTO, P.O. Box 1450, Alexandria VA 22313-1450). A copy of the last decision rendered should accompany the request for refund).

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

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

By FAX: (703) 872-9306
Attn: Office of Petitions

Telephone inquiries concerning this communication should be directed to the undersigned at 571-272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DR GEORGE A BROOKS
1501 EVERETT AVENUE
OAKLAND CA 94602

MAILED

MAY 13 2011

OFFICE OF PETITIONS

In re Patent No. 5,420,107	:	
Issue Date: May 30, 1995	:	
Application No. 08/279,829	:	REQUEST FOR INFORMATION
Filed: July 25, 1994	:	
Attorney Docket No. 01098-32767	:	

This is a request for information in response to the letter filed April 1, 2011.

Procedural History:

- The above-identified patent issued on May 30, 1995.
- The third maintenance fee could have been timely paid during the period from May 30, 2006 through November 30, 2006, or with a late payment surcharge during the period from December 1, 2006 through May 30, 2007.
- No maintenance fee having been received, the patent expired on May 31, 2007.
- The 2 year time period for filing a petition under 37 C.F.R. § 1.378(c) expired on May 30, 2009.
- Patentee filed a petition to accept the unavoidably delayed payment of the maintenance fee pursuant to 37 C.F.R. 1.378(b) on July 26, 2010.
- The petition was dismissed in a decision mailed on February 4, 2011.

Upon further review of your letter dated July 26, 2010 and February 4, 2011, it is unclear what party was responsible for tracking and paying the maintenance fee in this patent. In accordance with the law, a patent will expire if the maintenance fee is not paid on time and thus no action is required on the part of the USPTO since it is patentee's burden to keep the patent in force. The maintenance fee may be accepted by the Director of the USPTO if it is shown that the delay in submission of the maintenance fee was unavoidable. In this regard, it is unclear from the record whether patentee or patentee's attorney was responsible for tracking and paying the maintenance fee. Included with the July 26, 2010 letter was an e-mail from patentee's then counsel, Karyn F. Massic, "confirming your instructions that you do not want us to continue prosecuting the 'Glycerol-lactate estero for use as an energy supplement during exercise and recovery' patent application". The e-mail is not specific as to any other matters that may be pending with the attorney. It is required that petitioner state the name of the party responsible for tracking and paying the maintenance fee for this patent.

Either petitioner or another must be engaged in tracking and paying the maintenance fee. While petitioner may employ another to track and pay the maintenance fee, this does not end the inquiry. It is required that petitioner provide evidence on the record that the party responsible for tracking and paying the maintenance fee had a system in place for this purpose and this patent was entered into that system. Further, it is required that petitioner show that despite having this system in place, petitioner was unavoidably delayed in making the maintenance fee payment.

In summary, petitioner is required to answer the following questions:

1). What was the name of the party responsible for tracking and paying the maintenance fee?

2). What evidence does petitioner have to show that the present patent was entered into a system for tracking and paying the maintenance fee?

Petitioner is given **TWO (2) MONTHS** from the date of this letter in which to file a response. Petitioner is cautioned to be as complete and thorough as possible, since no further reconsideration or review of this matter will be undertaken by the Director of the USPTO. Accordingly, it is extremely important that petitioner supply any and all relevant information

and documentation in order to meet the burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them.

Telephone inquiries concerning this communication should be directed to Petitions Attorney Cliff Congo at (571)272-3207.

Anthony Knight
Director
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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MAILED
AUG 23 2011
OFFICE OF PETITIONS

DR GEORGE A BROOKS
1501 EVERETT AVENUE
OAKLAND CA 94602

In re Patent No. 5,420,107 :
Issue Date: May 30, 1995 :
Application No. 08/279,829 : DECISION ON PETITION
Filed: July 25, 1994 :
Attorney Docket No. 01098-32767 :

This is a decision in response to the letters filed July 25, 2011 and April 1, 2011, which are being treated as a renewed petition under 37 C.F.R. § 1.378(b).

The petition under 37 C.F.R. § 1.378(b) is **DENIED**. This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

Procedural History:

- The above-identified patent issued on May 30, 1995.
- The third maintenance fee could have been timely paid during the period from May 30, 2006 through November 30, 2006, or with a late payment surcharge during the period from December 1, 2006 through May 30, 2007.

- No maintenance fee having been received, the patent expired on May 31, 2007.
- The 2 year time period for filing a petition under 37 C.F.R. § 1.378(c) expired on May 30, 2009.
- Patentee filed a petition to accept the unavoidably delayed payment of the maintenance fee pursuant to 37 C.F.R. 1.378(b) on July 26, 2010.
- The petition was dismissed in a decision mailed on February 4, 2011.
- Patentee filed a letter in response on April 1, 2011, together with the $400 fee for requesting reconsideration.
- In reply, the Office mailed a "Request for Information" on May 13, 2011.

Relevant Statutes and Regulations:

35 U.S.C. § 41(c)(1) states that:

> The Commissioner may accept the delayed payment of any maintenance fee required ... after the six month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable.

37 C.F.R. § 1.378(b) provides that:

> Any petition to accept an unavoidably delayed payment of a maintenance fee must include:
>
> (1) The required maintenance fee set forth in §1.20(e) through (g);
>
> (2) The surcharge set forth in §1.20(i)(1); and
>
> (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent,

and the steps taken to file the petition promptly.

§ 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. This is a very stringent standard. 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. In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith, 671 F.2d at 538, 213 U.S.P.Q. at 982. Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32 (N.D. Ind. 1987).

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960)(35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee is unavoidable. See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991), cert. denied, 502 U.S. 1075 (1992); Ray v. Lehman, 55 F. 3d 606, 608 - 609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

July 26, 2010 Petition and February 4, 2011 Decision:

With his petition filed July 26, 2010, petitioner stated that he was not reminded by his counsel of the twelve year maintenance fee. According to petitioner, his counsel not only prosecuted the application, but tracked and payed the four year and eight year maintenance fees for petitioner.

On or about May 30, 2002, petitioner filed another patent application through his counsel. However, on or about

May 20, 2003, petitioner informed his counsel that he would prosecute the application pro-se. In support, petitioner included a copy of an e-mail from his counsel, confirming the cessation of representation. It was petitioner's understanding that his counsel would continue to track and monitor the payment of the maintenance fees for the instant patent.

The February 4, 2011 decision explained that petitioner had not demonstrated unavoidable delay within the meaning of 35 U.S.C. §41(c)(1) and 37 C.F.R. § 1.378(b). The decision noted that while it was unfortunate that petitioner's counsel did not remind him of the twelve year maintenance fee when it became due, petitioner is bound by any errors or negligence that may have been committed by his voluntarily chosen counsel. See Link v. Wabash, 370 U.S. 626, 633-34 (1962). Petitioner's recourse lies against his counsel.

Renewed Petition filed April 1, 2011 and July 25, 2011:

On renewed petition filed April 1, 2011, petitioner presented no new arguments as to why the delayed payment of the maintenance fee was unavoidable. Rather, petitioner argued in favor of acceptance of delayed payment of maintenance fees by alluding to the commercial value and efficacy of his patent. However, under the "unavoidable" standard, the PTO cannot apply the patent statutes and rules selectively, based on commercial success or efficacy of a patent. It would be appropriate, however, for petitioners or those acting on their behalf to exercise extraordinary care to insure that so valuable a property not be lost through failure to follow laws and regulations. Similarly, evidence establishing the commercial value of the patent, and investment of resources towards commercialization of the invention, while potentially probative of whether a delay was unintentional, is simply not probative of whether the delay was unavoidable. See In re Patent No. 4,409,763, at 1800.

In addition, petitioner argued for "fair treatment" and "protection" from the PTO after he was harmed by the inaction of his prior counsel. However, the Office is not the proper forum for resolving a dispute between a patent owner and his representative as to who bore the responsibility for paying a maintenance fee. Ray, 55 F.3d at 610, 34 USPQ2d at 1789. In any event, delay resulting from a failure of communication between a patent owner and his representative as to the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). See id. That both parties failed to take adequate steps to

ensure that each fully understood the other party's meaning, and thus their own obligation in the matter of payment of maintenance fees, does not reflect the due care and diligence of prudent and careful persons with respect to their most important business.

In the "Request for Information" mailed May 13, 2011, the Office requested that patentee states which party (patentee or patentee's counsel) was responsible for tracking and paying the maintenance fee. In addition, patentee was requested to supply evidence that the instant patent was entered into a system for tracking and paying the maintenance fee.

With his response filed July 25, 2011, patentee states that his counsel was the responsible party for tracking and paying the maintenance fee. Moreover, patentee has explained that he has no evidence to show that the instant patent was entered into his counsel's system for tracking and paying the maintenance fee.

As there has been no showing of the steps taken by patentee's counsel to ensure timely payment of the maintenance fee, the petition must be dismissed. Petitioner is bound by any errors or negligence that may have been committed by his voluntarily chosen counsel. See Link v. Wabash, 370 U.S. 626, 633-34 (1962).

Conclusion:

The prior decision which refused to accept under 37 C.F.R. § 1.378(b) the delayed payment of a maintenance fee for the patent has been reconsidered. For the above stated reasons, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 C.F.R. § 1.378(b). As stated in 37 C.F.R. § 1.378(e), no further reconsideration or review of this matter will be undertaken.

Since this patent will not be reinstated, the $2055 maintenance fees and the $700 surcharge fee submitted by petitioner on July 26, 2010 are being refunded to petitioner under separate cover. The $400 fee for requesting reconsideration is not refundable.

Telephone inquiries concerning this communication should be directed to Petitions Attorney Cliff Congo at (571)272-3207.

Anthony Knight
Director
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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Paper No.

KINNEY & LANGE, P.A.
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS MN 55415-1002

MAILED

OCT 11 2011

OFFICE OF PETITIONS

In re Application of :
Deac :
Application No. 08/291,717 :
Patent No.: 5,500,015 : DECISION ON PETITION
Filed: August 17, 1994 : PURSUANT TO
Issued: March 19, 1996 : 37 C.F.R. § 1.28(c)
Attorney Docket No.: :
M638.120004 :
Title: CARDIAC VALVE :
:

This is a notice regarding your request for acceptance of a fee deficiency submission pursuant to 37 C.F.R. § 1.28, received on September 23, 2011. 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 in the amount of $2220.00 has been received.

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.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this patent, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to the address which appears on the petition. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this patent unless Change of Correspondence Address, Patent Form (PTO/SB/123) is submitted for the above-identified patent. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/123), may be found at http://www.uspto.gov/web/forms/sb0123.pdf.

If appropriate, a change of fee address (form PTO/SB/47) and a request for customer number (form PTO/SB/125) should be filed in accordance with Manual of Patent Examining Procedure, section 2540.

A blank fee address form may be found at http://www.uspto.gov/web/forms/sb0047.pdf.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

cc: Kyle. E. Conklin
1100 New York Avenue, N.W.
Washington, DC 20005-3934

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5668940	1997-09-16	08292209	1994-08-19	35GS2777

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-08
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5668940
Issue Date: September 16,1997
Application No. 08292209
Filed: August 19,1994
Attorney Docket No. 35GS2777

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

MYRON AMER
114 OLD COUNTRY RD STE 310
MINEOLA NY 11501

MAILED
MAR 24 2011
OFFICE OF PETITIONS

ON PETITION

In re Patent No. 5,390,912 :
Issue Date: February 21, 1995 :
Application No. 08/292,250 :
Filed: August 18, 1994 :
For: BASKETBALL SHOOTING TARGET FOR GAME CONDITION USE :

This is a decision on the petition under 37 CFR 1.378(b), filed November 2, 2010, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f). 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, the Director will undertake no further reconsideration or review of the matter. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts, as they know them. If a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

The patent issued February 21, 1995. The 11.5 year (third) maintenance fee could have been paid from February 21, 2006 through August 20, 2006 or with a surcharge during the period from August 21, 2006 through February 21, 2007. Accordingly, the patent expired on February 22, 2007, for failure to timely submit the 11.5 year maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1) above.

A petition under 37 CFR 1.378(b) for the acceptance of an unavoidably delayed payment of maintenance fee is considered under the same standard as that for reviving an application unavoidably abandoned under 37 CFR 1.137(a) because 35 U.S.C. § 41(c)(1) uses the identical language, *i.e.*, "unavoidable" delay.[2] Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[3] In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."[4] Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.[5]

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.[6] However, "the question of whether an applicant's delay in prosecuting an application was unavoidable [will] be decided on a case by case basis, taking all of the facts and circumstances into account".[7] Nonawareness of the content of, or misunderstanding of PTO statutes, PTO rules, the MPEP or Official Gazette notices, do not constitute unavoidable delay.[8] The statue requires a "showing" by petitioner. Therefore, petitioner has the burden of proof.

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. [9]

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[2] Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)).

[3] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "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 man in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

[4] Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute unavoidable delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. Lexis 23119, 13 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (Plaintiffs through their counsel's actions or their own must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications).

[5] Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

[6] The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee...at any time...if the delay is shown to the *satisfaction of the Commissioner* to have been unavoidable (emphasis added).

[7] Smith v. Mossinghoff, 671 F.2d at 533.

[8] Id. at 538.

[9] 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 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

PETITIONER'S ARGUMENT

- Patentee contends that due to physical, mental and emotional incapacitation the patentee was unable to pay the 11.5 year maintenance fee.

- Patentee hired Myron Amer to draft, file prosecute and maintain the instant patent. The 11th year maintenance fee reminder was mailed to patent counsel on September 6, 2006.

- On February 15, 2005, an echocardiogram revealed a mitral valve prolapse with partially flail leaflet and severe mitral regurgitation. The left ventricular function was 40% reduced.

- On December 29, 2005, patentee had open heart surgery to correct a failing mitral valve.

- As a result of the diagnosed condition, patentee became depressed. Patentee lost interest and could not focus on his business affairs which included his patent matters. Patentee contends he was unable to authorize his patent counsel to pay the 11.5 year maintenance fee.

- In support of the petition, patentee has provided medical records for the open heart surgery. Patentee has also provided a medical article titled "Open Heat Surgery and Consequences For Well-Being- the Perspective of Patients, Relatives and Health Care Professionals", which provides information as to how a person may become depressed after open heart surgery.

APPLICATION OF THE UNAVOIDABLE STANDARD

Petitioner's arguments have been considered but are not persuasive. In general a grantable petition under 37 CFR 1.378 (b) must show 1) petitioner knew of the need to make the maintenance fee payment, 2) implemented a reliable docketing system to track the relevant dates 3) treated the payment of the maintenance fee (and later the filing of a petition to reinstate) as his most important business 4) was prevented from making the payment and 5) must show the entire delay in making the payment and submitting a grantable petition was unavoidable.

In essence, petitioner must show that he was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment due. In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F3d at 608-609, 34 USPQ2D at 1787. It is incumbent upon

the patent owner to implement steps to schedule and pay the fee, or obligate another to do so. See California Medical Products v. Technol. Med. Prod., 921 F.Supp 1219, 1259 (D. Del. 1995). That is, 37 CFR 1.378(b)(3) requires a showing of the steps in place to pay the maintenance fee, and the record currently lacks a showing that any steps were emplaced by petitioner or anyone else. In the absence of a showing that petitioner or anyone else was engaged in tracking the maintenance fee due dates, and that party had in fact been tracking the due dates with a reliable tracking system, such as would be used by prudent and careful men in relation to their most important business, petitioner cannot reasonably show that the delay was unavoidable delay. In re Katrapat, 6 USPQ2d 1863, 1867-1868 (Comm'r Pat. 1988); California, supra.

The petition does not demonstrate that petitioner maintained a tracking system. To the extent petitioner contends he relied upon a system utilized by attorney Amer, no information has been provided to establish what if any system was utilized to track maintenance fees.

It is solely the responsibility of the patentee to ensure that the maintenance fee is paid timely to prevent expiration of the patent. Failure to monitor the status of a patent does not reflect the due care and diligence employed by a prudent and careful person with respect to their most important business and as such cannot demonstrate that the delay was unavoidable delay.

In the absence of a showing that any steps had been taken, then 37 CFR 1.378(b) precludes acceptance of the payment. In other words, if no steps were taken by petitioner to track the fee payment, then the concurrent and subsequent health problems of petitioner would be immaterial to the delay. The showing must be that when the system indicated the fee fell due, the health problems of petitioner was "unavoidably" prevented from taking any earlier action with respect to this patent.

Although patentee has provided evidence of the heart condition and subsequent heart surgery, which addressed the time period from February 21, 2006 until March 21, 2006 (12 weeks from the surgery as indicated is the common point of recovery). The period which is in question is the time period from February 21, 2006 until February 21, 2007. Patentee contends after the heart surgery he required extended recovery and suffered from depression. However, no evidence to substantiate patentee suffered from depression and required an extended recovery period to such an extent to render him incapable to authorize payment of the 11.5 year maintenance fee. Further, the medical article shows that it is possible to suffer from depression after open heart surgery; this is not conclusive evidence as it applies to patentee. Patentee has failed to provide any evidence to establish that patentee suffered depression/illness, which rendered him incapable of timely submitting the maintenance fee payment. Such a showing must be supported by medical records, a statement from petitioner's treating physician, and such statement must provide the nature of petitioner's incapacitation during the above-mentioned period. Patentee should discuss whether patentee was able to pay bills during this time such as rent, mortgage, insurance and utilities etc.

Petitioner should also provide information as to why there was a six month delay in filing the first petition after it is acknowledged that patentee had sufficient physical strength, ability and mental energy to understand the complexity of submitting the maintenance fee as of April 2010.

Further, that one may be preoccupied with other matters, as harsh as that may seem, does not excuse the delay in payment of a maintenance fee. The issue is solely whether the maintenance, or reinstatement, of the patent at issue was actually conducted with the care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business.

Accordingly, the facts presented do not allow for a finding of unavoidable delay.

When filing documentation in support of applications or petitions, please take steps to protect all personal information. "Personal information" includes social security, credit card and banking account numbers. This type of personal data is never required by the USPTO to support a petition or application. To protect your privacy, we suggest that you delete such information from any documentation you send the office.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Petitioner's current options

I. Petitioner may file a request for reconsideration.

Any request for reconsideration of this decision must be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the $400 petition fee set forth in §1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director. Accordingly, on request for reconsideration, it is extremely important the petitioner supply **any** and **all** relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. If a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Petitioner may a request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313. A copy of this decision should accompany petitioner's request.

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 Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

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

Charlema Grant
Petitions Attorney
Office of Petitions

Cc: Howard Silagy
Accu-net LLC, 185 S. Broad Street
Pawcatuck, CT 06379

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,570,643	1996-11-05	08/292,516	1994-08-18	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Steven B. Walmsley 48021/	Date (YYYY-MM-DD)	2010-10-20
Name	Steven B. Walmsley	Registration Number	48021

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5570643
Issue Date: November 5,1996
Application No. 08292516
Filed: August 18,1994
Attorney Docket No. 1513

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 25,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 25,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5659718	1997-08-19	08293015	1994-08-19	042390.P7531

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-08
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 5659718
Issue Date: August 19,1997
Application No. 08293015
Filed: August 19,1994
Attorney Docket No. 042390.P7531

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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Paper No. 13

MAILED

FEB 18 2011

OFFICE OF PETITIONS

Richard Greenberg
16795 Edgar Street
Pacific Palisades CA 90272

In re Patent No. 5,477,487
Issued: December 19, 1995
Application No.: 08/293,866
Filing Date: August 22, 1994
Attorney Docket No.

: REQUEST FOR INFORMATION

This is a request for information in response to the petition under 37 CFR 1.378(b), filed November 5, 2010, to reinstate the above-cited patent.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed November 5, 2010. No additional fees are due.

The patent issued December 19, 1995. The 11.5 year maintenance fee could have been paid from December 19, 2006, through June 19, 2007, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from June 20, 2007, to December 19, 2007. Petitioner did not do so. Accordingly, the patent expired at midnight on December 19, 2007.

Petitioner is required to address the following points:

- A successful petition under 37 CFR 1.378(b) must affirmatively identify the cause of the delay in paying the maintenance fee and provide a statement from every person with first-hand knowledge of the circumstances surrounding the delay in paying the maintenance fee. If there was an arrangement or understanding between patentee and a firm for tracking and paying the maintenance fees, petitioner should so state and provide documentary evidence and or statements that support the assertion. Petitioner must provide statements from any person who may have been charged with paying the maintenance fee and statements from any person with first-hand knowledge of the circumstances surrounding the failure to pay the maintenance fees. This may include a statement from Mr. Ira Schaeffer, and material persons from the firm of Norris McLaughlin.

- It is noted that petitioner states that petitioner discovered the patent was expired in June 2010. Yet, the patent expired in December 19, 2007. A grantable petition under 37 CFR 1.378(b) requires that petition establish that the entire delay—from the date the patent expired until the filing of a grantable petition—was unavoidable. 37 CFR 1.378(b)(3) sets forth that a petition

submitted under this portion of the Code of Federal Regulations must include a showing which is described as follows:

A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. Petitioner must, therefore, describe the steps that were in place to ensure that the maintenance fee was timely paid. This showing would include an explanation of who was responsible for paying tracking and paying the maintenance fee and the method this person, or entity, used for tracking the maintenance fee.

- Petitioner must describe the steps petitioner took to reinstate the patent after it was discovered that the patent was expired and explain any undue delay in filing a petition under 37 CFR 1.378.

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

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petition 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

Richard Greenberg
16795 Edgar Street
Pacific Palisades CA 90272

MAILED
JUN 30 2011
OFFICE OF PETITIONS

In re Patent No. 5,477,487 :
Issued: December 19, 1995 : REQUEST FOR INFORMATION
Application No.: 08/293,866 :
Filing Date: August 22, 1994 :
Attorney Docket No. :

This is a request for information in response to the petition under 37 CFR 1.378(b), filed April 15, 2011, to reinstate the above-cited patent.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed November 5, 2010. No additional fees are due.

The patent issued December 19, 1995. The 11.5 year maintenance fee could have been paid from December 19, 2006, through June 19, 2007, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from June 20, 2007, to December 19, 2007. Petitioner did not do so. Accordingly, the patent expired at midnight on December 19, 2007.

Consideration of the "Response to Request for Information" filed April 15, 2011, reveals that petitioner is asserting that the cause of the unavoidable delay in paying the 11.5-year maintenance fee was the failure of petitioner to receive a Maintenance Fee Reminder from Norris McLaughlin & Marcus, P.A. The instant petition and statement of Kurt Briscoe makes clear that the 11.5-year maintenance fee reminder was not sent to petitioner by Norris McLaughlin & Marcus, P.A. because Ms. Nancy Manfredi, docket clerk to Kurt Briscoe, had closed the file patent after receiving notification from the patentee not to pay the 7.5-year maintenance fee because he paid it himself. Apparently, Ms. Manfredi interpreted the "Do Not Pay" letter relative to the 7.5-year maintenance fee to mean no further maintenance fees should be paid, and she closed the file pursuant to this. Neither petitioner, nor Mr. Briscoe, state that the patentee expressed a desire to terminate the relationship between the parties relative to the tracking and payment of the maintenance fee. Rather, it appears that Ms. Manfredi acted unilaterally in closing out the file after receiving the "Do Not Pay" letter relative to the 7.5-year maintenance fee.

Petitioner is required to address the following points relative to this apparent clerical/docketing error of Ms. Manfredi:

- Section 711.03(c)(2) of the Manual of Patent Examining Procedure, provides, in pertinent part that:

> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).
>
> A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:
>
> (A) the error was the cause of the delay at issue;
>
> (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
>
> (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

A delay resulting from an error, such a docketing error, on the part of an employee in the performance of a clerical function may provide the basis for a showing of unavoidable delay. Such a showing should identify the specific error, the individual who made the error, and the business routine in place for performing the action which resulted in the error. The showing must establish that the individual who erred was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. The showing should include information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned task.

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

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petition Attorney
Office of Petitions

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

Richard Greenberg
16795 Edgar Street
Pacific Palisades CA 90272

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OFFICE OF PETITIONS

In re Patent No. 5,477,487 :
Issued: December 19, 1995 : ON PETITION
Application No.: 08/293,866 :
Filing Date: August 22, 1994 :
Attorney Docket No. :

This is in response to the "Petitioner's Response to Second Request for Information" filed August 26, 2011, and a decision on the petition under 37 CFR 1.378(b), filed November 5, 2010, to reinstate the above-cited patent.

The petition is **dismissed**.

The patent issued December 19, 1995. The 11.5 year maintenance fee could have been paid from December 19, 2006, through June 19, 2007, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from June 20, 2007, to December 19, 2007. Petitioner did not do so. Accordingly, the patent expired at midnight on December 19, 2007.

A grantable petition under 37 CFR 1.378(b) must be accompanied by a showing to the satisfaction of the Commissioner that the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable. The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.378(b).

Opinion

Petitioner must establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.[1]

[1]The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard. 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee . . . at any time . . .if the delay is shown *to the satisfaction of the Commissioner* to have been unavoidable." (emphasis added).

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference." Rydeen v. Quigg, 748 F. Supp. 900, 904, 16 U.S.P.Q2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion Rule 36), 937 F.2d 623 (Fed Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d agencys' interpretation of a statute it administers is entitle to deference"); see also Chevron U.S.A. Inc, v. Natural Resources Defense Counsil, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute s silent or

However, "[t]he question of whether an applicant's delay in prosecuting an application was unavoidable [will]be decided on a case-by-case basis, taking all of the facts and circumstances into account."[2] Nonawarness of the content of, or misunderstanding of PTO statutes, PTO rules, the MPEP, or the Official Gazette notices does not constitute unavoidable delay.[3] The statute requires a "showing" by petitioner, therefore; petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Petitioner is responsible for possessing knowledge of the need to pay maintenance fees and the due dates for such fees, Petitioner is responsible for instituting a reliable docketing system to remind him or her when maintenance fees become due.

Petitioner is responsible for having knowledge of the need to pay maintenance fees and knowing when the fees are due.[4] The Office has no duty to notify a patentee of the requirement to pay maintenance fees or to notify patentee when a maintenance fee is due.[5] Even if the Office were required to provide notice to

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ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F. 3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1781 (Fed Cir. 1995) (Citing In re patent No. 4,409, 763, 7 U.S.P.Q.2d BNA) 1798, 1800 (Comm'r Pat. 1990; Smith v. Mossinghoff, 671 F. 2d 533, 538, 213 U.S.P. Q. (BNA) 977 (D.C. Cir. 1982). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which "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." In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat 31, 32-33 (1887)).

[2]Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

[3]See Smith v. Mossinghoff, 671 F. 2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable " delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (plaintiffs, through their counsel's action, or their own, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

[4]Nonawarness of PTO statutes, PTO rules, the MPEP, or Official Gazette notices, which state maintenance fee amounts and dates they are due does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. *BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable" delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (Plaintiffs, through their counsel's actions, or their own must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

Petitioner must act as a reasonable and prudent person in relation to his most important business. Upon obtaining the patent, a reasonable and prudent person, in relation to his most important business, would become familiar with the legal requirements of that business, in this case, the requirement to pay maintenance fees. In addition, a reasonable and prudent individual would read the patent itself and thereby become aware of the need to pay maintenance fees and the fact that such fee amounts are sometimes changed by law or regulation.

[5]Congress expressly conditioned §§ 133 and 151 [of the United States Code] on a specific type of notice, while no such notice requirements are written into § 41(c) . . . [T]he Commissioner's no timely-notice interpretation." Ray v. Comer, 1994 U.S. Dist. LEXIS 21478, 8-9 (1994), *aff'd on other grounds* Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995) (Citing Rydeen v. Quigg, 748 F. Supp. 900, 905 (1990), Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S.

applicant of the existence of maintenance fee requirements, such notice is provided by the patent itself.[6]

A reasonable and prudent person, aware of the existence of maintenance fees, would not rely on maintenance fee reminders or on memory to remind him or her when payments would fall due several years in the future. Instead, such an individual would implement a reliable and trustworthy tracking system to keep track of the relevant dates.[7] The individual would also take steps to ensure that the patent information was correctly entered into the tracking system.

Application of the unavoidable standard to the present facts

By the instant petition, petitioner argues that the above-cited patent should be reinstated because the delay in paying the 11.5-year maintenance fee was unavoidable due to a docketing and clerical error that occurred in the offices of Norris McLaughlin & Marcus, P.A., the law firm charged with tracking and paying the maintenance fee for the subject patent. Specifically, petitioner surmises that Ms. Nanci Manfredi, a docketing clerk for Norris McLaughlin & Marcus, P.A., closed the patent file after receiving notification from the patentee not to pay the 7.5-year maintenance fee because he paid it himself. Apparently, Ms. Manfredi interpreted the "Do Not Pay" letter relative to the 7.5-year maintenance fee to mean no further maintenance fees should be paid, and she closed the file pursuant to this. Petitioner states Ms. Manfredi acted unilaterally in closing out the file after receiving the "Do Not Pay" letter relative to the 7.5-year maintenance fee.

837, 81 L. ed. 2d 694, 104 S. Ct. 2778 (1984)). "The Court concludes as it did in Rydeen, that as a constitutional matter, 'plaintiff was not entitled to any notice beyond publication of the statute." Id. at 3 (citing Rydeen v. Quigg, 748 F. Supp. at 906, Texaco v. Short, 454 U.S. 516, 536, 70 L. Ed. 2d 738, 102 S. Ct. 781 (1982)).

The Patent Office, as a courtesy tries to send maintenance fee reminders and notices of patent expiration to the address of record. However, the failure to receive the reminder notice, and the lack of knowledge of the requirement to pay the maintenance fee, will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. See MPEP 2575, 2540, 2590. Petitioner does not have a right to a personalized notice that this patent will expire if a certain maintenance fee is not paid, as the publication of the statute was sufficient notice. See Rydeen v. Quigg, 748 F. Supp. 900, 907 (1990). the ultimate responsibility for keeping track of maintenance fee states lies with the patentee, not the USPTO. Since the mailing of Notices by the Office is completely discretionary and not a requirement imposed by Congress, accepting an argument that failure to receive a Notice is unavoidable delay would result in all delays being unavoidable should the Office discontinue the policy. All petitions could allege non-receipt of the reminder, and therefore all petitions could be granted. This was clearly not the intent of Congress in the creation of the unavoidable standard.

[6]See Ray v. Lehman, 55 F.3d 606, 610; 34 USPQ2d 1786, 1789 (Fed. Cir. 1995). The Letters of Patent contain a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. While it is unclear as to who was and is in actual possession of the patent, petitioner's failure to read the Notice does not vitiate the Notice, nor does the delay resulting from such failure to read the Notice establish unavoidable delay.

[7] 37 CFR 1.378(b)(3) precludes acceptance of a late maintenance fee for a patent unless a petitioner can demonstrate that steps were in place to monitor the maintenance fee. The federal Circuit has specifically upheld the validity of this regulation. Ray v. Lehman, 55 F.3d 606, 609; 34 USPQ2d (BNA) 1786 (Fed.Cir. 1995). In Ray v. Lehman, petitioner claimed that he had not known of the existence of the maintenance fees and therefore had no steps in place to pay such fees. The petitioner therefore argues that the PTO's regulation, 37 CFR 1.37(b)(3), supra, arguing that it 'creates a burden that goes well beyond what is reasonably prudent." We disagree, The PTOs' regulation merely sets forth how one is to prove that he was reasonably prudent, i.e., by showing what steps he took to ensure that the maintenance fee would be timely paid, and the steps taken in seeking to reinstate the patent. We do not see these requirements additional to proving unavoidable delay, but as the very elements of unavoidable delay." Id.

The petitioner's argument and statements have been considered, but are not persuasive as petitioner has not made the "showing" that is required to satisfy the requirements of 37 CFR 1.378(b). Further to this point, Section 711.03(c)(2) provides, in pertinent part that:

> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).
>
> A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:
>
> (A) the error was the cause of the delay at issue;
>
> (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
>
> (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

Petitioner has not established that there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance. Petitioner explains that a notice was sent to the client six months before the maintenance fee was due. The notice gave the client the option of having Norris, McLaughlin & Marcus, P.A. pay the maintenance fee or instructing the maintenance fee not to be paid. In the present case, the instructed the 7.5 year maintenance fee not to be paid and paid the maintenance fee himself. In the statement provided by Ms. Manfredi, she concedes that she had encountered this circumstance before and, in response thereto, did not pay the 7.5-year maintenance fee and closed out the patent file preventing a reminder to pay the 11.5-year maintenance fee. Petitioner has not established that a business routine was in place for handling such a circumstance where the client instructs the firm not to pay the maintenance fee, but intends for the firm to continue to track any further maintenance fees that may due. Petitioner has not specifically indicated that kind of docketing system was used by Norris, McLaughlin & Marcus, P.A. in docketing and tracking the maintenance fees for the subject patent. In the renewed petition, petitioner is required to identify the docketing system used and address the following points:

- Provide additional information regarding the docketing system and its use in the industry and why it is a reliable system.
- Explain the procedures for handling the patent file once a "do not pay" instruction is received from a client. Specifically, does Norris McLaughlin & Marcus, P.A. contact the client to determine whether the client wishes for Norris McLaughlin & Marcus, P.A. to continue to track the maintenance fee for the patent.
- Explain the procedures for closing a patent file in the docketing system and any cross checks that may be in place.

Further, a grantable petition under 37 CFR 1.378(b) must establish that the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. The instant petition is

lacking in this regard. Section 2590 of the Manual of Patent Examining Procedure ("MPEP") provides, in pertinent part, that, "[a]s the language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., "unavoidable" delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. Further to this point, MPEP 711.03(c) provides, in pertinent part, that:

> [a] showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § 711.03(c), subsection II.C.2. In addition, a petition under 37 CFR 1.137(a) must establish that the delay was unavoidable, and not just that it was unintentional.

Petitioner states:

> Ms. Manfredi indicates that she has been a clerk since 1982 and she has never made the above described mistake before this instance...Accordingly, this shows that Ms. Manfredi was well versed in her job and her otherwise unblemished record indicates that allowing Ms. Manfredi to manage the docketing system at Norris McLaughlin & Marcus, P.A. was otherwise an exercise of due care.

Excerpt taken from "Petitioner's Response to second Request for Information Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent", filed August 26, 2011, p. 2.

In establishing unavoidable delay, it is not sufficient for Ms. Manfredi to state that she is sufficiently trained on the docketing system such that reliance on her represented the exercise of due care. Petitioner is required to provide an objective statement from a supervisor of Ms. Manfredi describing Ms. Manfredi's training and experience on the docketing system. Further, petitioner should provide a statement from Kurt Briscoe regarding his understanding of how Ms. Manfredi was to handle a patent file of one of his clients that comes in with a "do not pay" instruction, but has at least one maintenance fee payment remaining.

Petitioner's Current Options

I. Petitioner may file a request for reconsideration.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within TWO (2) MONTHS from the mail date of this decision.[8] The petition for reconsideration should be titled "Petition for Reconsideration under 37 CFR 1.378(b)." Any petition for reconsideration for this decision must be accompanied by a non-refundable petition fee of $400.00 as set forth in 37 CFR 1.17(h).

A reasonable and prudent person would not rely on maintenance fee reminders from the Office for two reasons. First, the Office has indicated that such reminders are a mere courtesy and has reserved the right to discontinue such reminders at any time. second, such reminders may be lost in the mail. A reasonable and prudent person, in regard to his most important business would not rely solely on reminders that the Office may or may not send which may or may not be lost in the mail.

[8]No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is not a final agency action within the meaning of 5 U.S.C. § 704.

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. It is, therefore, extremely important that petitioner supply any and all relevant information and documentation with the request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence "to show" that the delay was unavoidable. If a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Refund Section, Commissioner for Patents, Washington, DC 20231. A copy of this decision should accompany petitioner's request.

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

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petition Attorney
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5658797	1997-08-19	08295732	1994-11-28	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☒ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Ravi Dipali/	Date (YYYY-MM-DD)	2011-07-27
Name	Ravi Dipali	Registration Number	60553

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 5658797
Issue Date: August 19,1997
Application No. 08295732
Filed: November 28,1994
Attorney Docket No. 056001/02901

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed July 27,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 27,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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SUITE 300 EAST
1100 NEW YORK AVENUE NW
WASHINGTON DC 20005-3955

MAILED
APR 19 2011
OFFICE OF PETITIONS

Paper No. 47

In re Patent No. 5,591,639
Issue Date: January 7, 1997
Application No. 08/300,063
Filed: September 2, 1994
Inventor: Christopher R. Bebbington

: DECISION ON PETITION

This is a decision on the petition for expungement of information, filed September 28, 2010, which is being treated as petitions under 37 CFR 1.182 to invalidate an assignment previously recorded against the above-identified application.

The petition is **dismissed**. This is not a final agency action.

Petitioner indicates an assignment recorded on August 1, 2006 was erroneously filed for the above identified application and requests this assignment record be expunged from the file.

As discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or "expunge" assignment records are granted only if the petitioner can prove that:

(A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and
(B) the integrity of the assignment records will not be affected by granting the petition.

In regard to B, petitioner has not sufficiently explained how the removal of a document in its entirety will not affect the assignment records. The removal of a document in its entirety will affect the assignment records. The integrity of the records is recognized as separate from the chain of title, and the USPTO endeavors to maintain a complete history of claimed interests in a given property to permit, among other things, the review of matters like chain of title by a competent authority.

Moreover, petitioner seeks an extraordinary remedy, properly addressed under 37 CFR 1.182. The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982).

As set forth in MPEP 323, an error in a recorded assignment is not corrected by invalidating the previous document, but by simply submitting a "corrective document". The "corrective document" must include 1) a copy of the original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and 2) a new Recordation Form Cover Sheet (form PTO-1595). The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06. Petitioner should note that the "assignment documents" and "corrective documents" are not limited to assignments, but include any documents affecting title to a patent or application. See MPEP § 313.

Therefore, the rules of practice and the procedures before the USPTO provide an avenue for the requested relief without relying upon extraordinary measures. That is, the chain of title can be clarified in the assignment records through the recording of a corrective document. As a request for the Office to invalidate an assignment is both extraordinary and contrary to USPTO policy, this petition must be dismissed.

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 USC 261 and 37 CFR 3.11. However, the recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. Moreover, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment document will be retained, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992).

Furthermore, it is well settled that the Office is not the appropriate forum for resolving a dispute concerning the ownership of an application or patent, and, as such, the USPTO will not permit itself to become embroiled in ownership disputes, particularly as it does not have the means or the authority to resolve such disputes. Indeed, the USPTO has no authority to decide ownership issues. See Cedars-Sinai Medical Center v. Watkins, 11F.3d 1573, 1581 n.10, 29 USPQ 2d 1188, 1194 n.10 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. (1994). Rather, state law governs contractual obligations and transfers of property rights, including those relating to patents. See Regents of the University of New Mexico v. Knight, 66 USPQ2d 1001, 1008 (Fed. Cir. 2003). The USPTO cannot settle disputes as to title as a judicial tribunal is the appropriate forum to resolve such controversy. See Jim Arnold Corp. v. Hydrotech Sys., Inc., 109 F.3d 1567, 1572, 42 USPQ2d 1119, 1123 (Fed. Cir. 1997)("the question of who owns the patent right and on what terms typically is a question exclusively for state courts"); Roach v. Crouch, 24 N.W. 2d 400, 33

USPQ2d 1361 (Iowa 1994)(patent ownership issue properly triable in state court); In re Haines, 1900 C.D. 102, 103 (Comm'r Pat. 1900)(same).

If petitioner is successful in resolving this dispute, the proper documentation should be promptly submitted to the USPTO for recordation against the patent.

Also, Office records do not indicate that a change of address has been filed in this case, although the address given on the petition differs from the address of record. If appropriate, 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.

A petition to expunge assignment documents is properly addressed under 37 CFR 1.182 and a fee of $400.00 is required. The $400 petition fee has been charged to petitioner's deposit account.

Telephone inquiries concerning this communication should be directed to Carl Friedman at (571)272-6842.

Christopher Bottorff
Supervisor
Office of Petitions

Cc: Womble Carlyle Sandridge & Rice PLLC
P.O. Box 7037
Atlanta Georgia 30357-0037

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WASHINGTON DC 20005-3955

MAILED
APR 19 2011
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Paper No. 43

In re Patent No. 5,770,359 :
Issue Date: June 23, 1998 :
Application No. 08/302,241 : DECISION ON PETITION
Filed: September 8, 1994 :
Inventor: Richard H. Wilson et al. :

This is a decision on the petition for expungement of information, filed September 28, 2010, which is being treated as petitions under 37 CFR 1.182 to invalidate an assignment previously recorded against the above-identified application.

The petition is **dismissed**. This is not a final agency action.

Petitioner indicates an assignment recorded on August 1, 2006 was erroneously filed for the above identified application and requests this assignment record be expunged from the file.

As discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or "expunge" assignment records are granted only if the petitioner can prove that:

(A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and
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In regard to B, petitioner has not sufficiently explained how the removal of a document in its entirety will not affect the assignment records. The removal of a document in its entirety will affect the assignment records. The integrity of the records is recognized as separate from the chain of title, and the USPTO endeavors to maintain a complete history of claimed interests in a given property to permit, among other things, the review of matters like chain of title by a competent authority.

Moreover, petitioner seeks an extraordinary remedy, properly addressed under 37 CFR 1.182. The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982).

As set forth in MPEP 323, an error in a recorded assignment is not corrected by invalidating the previous document, but by simply submitting a "corrective document". The "corrective document" must include 1) a copy of the original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and 2) a new Recordation Form Cover Sheet (form PTO-1595). The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06. Petitioner should note that the "assignment documents" and "corrective documents" are not limited to assignments, but include any documents affecting title to a patent or application. See MPEP § 313.

Therefore, the rules of practice and the procedures before the USPTO provide an avenue for the requested relief without relying upon extraordinary measures. That is, the chain of title can be clarified in the assignment records through the recording of a corrective document. As a request for the Office to invalidate an assignment is both extraordinary and contrary to USPTO policy, this petition must be dismissed.

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Furthermore, it is well settled that the Office is not the appropriate forum for resolving a dispute concerning the ownership of an application or patent, and, as such, the USPTO will not permit itself to become embroiled in ownership disputes, particularly as it does not have the means or the authority to resolve such disputes. Indeed, the USPTO has no authority to decide ownership issues. See Cedars-Sinai Medical Center v. Watkins, 11F.3d 1573, 1581 n.10, 29 USPQ 2d 1188, 1194 n.10 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. (1994). Rather, state law governs contractual obligations and transfers of property rights, including those relating to patents. See Regents of the University of New Mexico v. Knight, 66 USPQ2d 1001, 1008 (Fed. Cir. 2003). The USPTO cannot settle disputes as to title as a judicial tribunal is the appropriate forum to resolve such controversy. See Jim Arnold Corp. v. Hydrotech Sys., Inc., 109 F.3d 1567, 1572, 42 USPQ2d 1119, 1123 (Fed. Cir. 1997)("the question of who owns the patent right and on what terms typically is a question exclusively for state courts"); Roach v. Crouch, 24 N.W. 2d 400, 33

USPQ2d 1361 (Iowa 1994)(patent ownership issue properly triable in state court); In re Haines, 1900 C.D. 102, 103 (Comm'r Pat. 1900)(same).

If petitioner is successful in resolving this dispute, the proper documentation should be promptly submitted to the USPTO for recordation against the patent.

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A petition to expunge assignment documents is properly addressed under 37 CFR 1.182 and a fee of $400.00 is required. The $400 petition fee has been charged to petitioner's deposit account.

Telephone inquiries concerning this communication should be directed to Carl Friedman at (571)272-6842.

Christopher Bottorff
Supervisor
Office of Petitions

Cc: Womble Carlyle Sandridge & Rice PLLC
P.O. Box 7037
Atlanta Georgia 30357-0037

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5816372	1998-10-06	08/304,005	1994-09-09	IR-2241

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Edward F. Murphy, III/	Date (YYYY-MM-DD)	2011-04-27
Name	Edward F. Murphy, III	Registration Number	38251

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5816372
Issue Date: October 6,1998
Application No. 08304005
Filed: September 9,1994
Attorney Docket No. IR2241(MC)

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed April 27,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 27,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5648982	1997-07-15	08304091	1994-09-09	206299

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-08
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 5648982
Issue Date: July 15,1997
Application No. 08304091
Filed: September 9,1994
Attorney Docket No. 206299

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5660276	1997-08-26	08318912	1994-10-05	SWIN:1016

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Chainey P. Singleton/	Date (YYYY-MM-DD)	2011-04-29
Name	Chainey P. Singleton	Registration Number	53598

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5660276
Issue Date: August 26,1997
Application No. 08318912
Filed: October 5,1994
Attorney Docket No. P2

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed April 29,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 29,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110121

DATE : January 21, 2011

TO SPE OF : ART UNIT 1631

SUBJECT : Request for Certificate of Correction on Patent No.: 7,223,833

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - ST (South Tower) 9A22
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriated box.

☐ **Approved** All changes apply.

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

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

Comments:

No declaration under 37 CFR 1.63 has been filed by the new inventor, Mr. Berg, therefore the request fails to comply with 37 CFR 1.48(c).

/Marjorie Moran/
Supervisory Patent Examiner.Art Unit 1631

S RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110121

DATE : January 21, 1

TO SPE OF : ART UNIT 1

SUBJECT : Request for ification of Correction on Patent No.: 7,223,833

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

Please complete this form a return with file, within **7** days to:
Certificates of Correction nch - **ST (South Tower) 9A22**
Palm location **7590** - Tel. N 703) 305-8309

With respect to the change(s) ested, correcting Office and/or Applicant's errors, should the patent read as shown in the certifica correction? No new matter should be introduced, nor should the scope or meaning of the claims be chang

Thank You For Your Assi ce

Certificates of Correction Branch

The request for issuin bove-**identified correction(s) is hereby:**

Note your decision on the appropriate

☐ **Approved** — All changes apply.

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

☒ **Denied** — State the reasons for denial below.

Comments:

No declaration under 37 C .63 has been filed by the new inventor, Mr. Berg, therefore the request fails to comply with CFR 1.48(c).

/Marjorie Moran/
Supervisory Patent Examiner.Art Unit 1631

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

KINNEY & LANGE, P.A.
THE KINNEY & LANGE BUILDING
312 SOUTH THIRD STREET
MINNEAPOLIS, MN 55415-1002

MAILED

JUN 30 2011

OFFICE OF PETITIONS

In re Patent No. 5,915,641 :
Issue Date: June 29, 1999 :
Application No. 08/325,549 : ON PETITION
Filed: October 18, 1994 :
Patentee: Daniel A. Barberg :

This is a decision in response to a petition under 37 CFR 1.378(c) to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent. The delay in responding is regretted; however, a copy of the petition was recently referred to the Office of Petitions by a letter filed May 24, 2011. While the original petition cannot be located it is noted that the petition includes a Certificate of Mailing under 37 CFR 1.8(a) dated June 16, 2009. Further, USPTO finance records confirm receipt on the requisite maintenance fee and surcharge on June 22, 2009.

The petition is GRANTED.

This patent expired on June 29, 2007 for failure to pay the second maintenance fee. While the original petition cannot be located it is noted that the copy of the petition includes a Certificate of Mailing under 37 CFR 1.8(a) dated June 16, 2009. Further, USPTO finance records confirm receipt on the requisite maintenance fee and surcharge on June 22, 2009. Accordingly, it is conceded that the petition was filed on June 22, 2009 and subsequently lost in the USPTO. As the petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition is timely filed under the provisions of 37 CFR 1.378(c).

The 7 ½ year maintenance fee in this case is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

It is noted that the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition.

It is also noted that a fee payment of $2,055 was paid on May 24, 2011 for the 11 ½ year maintenance fee payment; however, since the payment was submitted after the six (6) month grace period, a $65 surcharge is required.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3204.

/SDB/

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: DANIEL A. BARBERG
11084 15TH ST. SW
COKATO, MN 55321

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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312 SOUTH THIRD STREET
MINNEAPOLIS, MN 55415-1002

MAILED
FEB 09 2012
OFFICE OF PETITIONS

In re Patent No. 5,915,641
Issue Date: June 29, 1999
Application No. 08/325,549
Filed: October 18, 1994
Patentee: Daniel A. Barberg

LETTER

This is in response to a communication filed December 7, 2011, including a surcharge under 37 CFR 1.20(h).

A review of the record indicates that this patent expired on June 29, 2007 for a failure to pay the second maintenance fee. On June 22, 2009, using a Certificate of Mailing under 37 CFR 1.8(a) dated June 16, 2009, a petition under the provisions of 37 CFR 1.378(c) was filed. On May 24, 2011, petitioner submitted the fee required for the 11 ½ year maintenance and apparently discovered that, since there was no decision on the petition filed June 22, 2009, the patent remained expired. On May 31, 2011, a copy of the petition was filed and the patent was reinstated by a decision mailed June 30, 2011.

Since the 11 ½ year maintenance fee was paid during the grace period on May 24, 2011, (the maintenance fee could have been paid June 29, 2010 through December 29, 2010 without a surcharge and December 30, 2010 through June 29, 2011 with a surcharge) a surcharge was required. Receipt is acknowledged of the requisite surcharge on December 7, 2011. Finance records will be updated accordingly.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3204.

/SDB/

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: DANIEL A. BARBERG
11084 15TH ST. SW
COKATO, MN 55321

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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DTW Feb-11

Paper No. 22

DAVID A JACKSON
KLAUBER & JACKSON
411 HACKENSACK AVENUE
HACKENSACK NJ 07601

MAILED
FEB 01 2011
OFFICE OF PETITIONS

In re Patent No. 5,800,552 :
Issue Date: 09/01/1998 :
Application Number: 08/327092 : DECISION ON PETITION
Filing Date: 10/21/1994 :
Attorney Docket Number: :
6811013A :

This is a decision on the petition under 37 CFR 1.378(b),[1] filed on November 15, 2010, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f).

---

[1] A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);
(2) the surcharge set forth in §1.20(I)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

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.

The patent issued on September 1, 1998. The first maintenance fee was timely paid. The second maintenance fee could have been paid during the period from September 1, 2005, through March 1, 2006, or, with a surcharge, during the period from March 2 through September 1, 2006. The patent expired at midnight on September 1, 2006, for failure to timely pay the second maintenance fee.

Petitioner, Mark E. Forte, on behalf of assignee Implantology, LLC, states that the inventor is his father, Mark R. Forte, and that the patent was transferred to the assignee on June 30, 2010.

Petitioner further states that he recently discovered that the maintenance fee had not been paid. Petitioner further avers:

> The transfer of Patent 5,800,552 ("Mechanically Linked Hinged Total Knee Prosthesis") to Imnplantology LLC occurred on June 30, 2010. The previous owner of the patent was my father, Mark Robert Forte. Transfer of this (and other patents) was initiated from an Estate Asset Plan that occurred within our family this year.
>
> My father never disclosed to me the status of this or any other of his Patents, neither before or after the transfer. From my own due diligence, I very recently discovered a requirement of payments of maintenance fees that was not fulfilled.
>
> A medical situation arose and continues to exist that caused an inadvertent and unavoidable delay of payment of these fees.
>
> My father has recently been diagnosed with a moderate to severe level of Dementia relating to a form of Alzheimer's disease. The slow, degenerative nature of this condition lends credence to the fact that this disorder actually started some years ago and has been getting progressively worse since.
>
> This condition has been the cause of his mental capabilities being affected for some time. This

> includes his ability to remember recent events and a decreased and/or absence of ability to plan or organize.
>
> Because of his condition, my father was not able to remember to make the required payments, or comprehend the seriousness of events that lack of payments would trigger. He had owned eight other patents, in which maintenance fees were also not made in a timely mater. However this is the only patent that has a suitable, remaining life span which makes reinstatement a serious consideration.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".[2] A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."[3] This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."[4] Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.[5] Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[6] However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.[7] In view of In re Patent No. 4,409,763,[8] this same standard will be

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[2] 35 U.S.C. § 41(c)(1).

[3] Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

[4] Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

[5] In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

[6] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "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"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

[7] Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

[8] 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable.[9] 35 U.S.C. § 133 does not require the Director to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.[10]

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.[11] That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the second maintenance fee for this patent.[12]

At the outset, there are three periods to be considered during the evaluation of a petition under 37 CFR 1.378(b):

(1) The delay in reply that originally resulted in expiration;
(2) The delay in filing an initial petition pursuant to § 1.378(b) to revive the application; and
(3) The delay in filing a *grantable* petition pursuant to § 1.378(b) to revive the application.[13]

The petition lacks the showing required by items (1) and (2).

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[9] See Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

[10] See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991)(table), *cert. denied*, 502 U.S. 1075 (1992); Ray v. Lehman, supra.

[11] Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

[12] Id.

[13] See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

With regard to period (1), while physical or mental incapacitation can be a cause of delay, a showing of "unavoidable" delay based upon incapacitation must establish that petitioner's incapacitation was of such a nature and degree as to render petitioner unable to conduct business (e.g. correspond with the Office) during the period between September 1, 2006, and the date of filing of the subject petition.

Such a showing must be supported by a statement from petitioner's treating physician, and such statement must provide the nature of petitioner's incapacitation during the above-mentioned period.

Additionally, petitioner must explain whether his father had sole responsibility for the payment of the maintenance fee, or if any other parties were involved in tracking and paying the maintenance fee. Statements from all individuals who had responsibility for tracking and paying the subject maintenance fee, setting forth the facts as they know them, are required with any renewed petition. If any other individual(s) in petitioners' family or business were aware that the maintenance fee was due in the subject patent, statement(s) from that individual(s) setting forth the facts as they know them are also required.

With regard to period (2), petitioner Mark E. Forte must explain when he learned that the patent had become expired. Petitioner must provided a documented showing that the delay between when petitioner learned that the patent had become expired, and the filing of the subject petition, was unavoidable.

Lastly, if the petition is being signed on behalf of the assignee, the person signing the petition must show that they are authorized to act on behalf of the assignee. 37 CFR 3.71(c). Accordingly, the attached Statement Under 37 CFR 3.73(b) must be completed and returned with any renewed petition.

Petitioner is cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes), petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the

public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

The address in the petition is different than the correspondence address. A courtesy copy of this decision is being mailed to the address in the petition. All future correspondence, however, will be mailed solely to the address of record. A change of correspondence address must be submitted if the correspondence address needs to be updated.

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 should be directed to the undersigned at 571-272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Cc: MARK E. FORTE
IMPLANTOLOGY LLC
11 OAK LANE
PINE BROOK NJ 07058

Encl: PTO/SB/96
PTO/SB/123

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5822742	1998-10-13	08331554	1995-02-24	40399/276/NI

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/TIMOTHY J. LORENZ, REG. NO. 41954/	Date (YYYY-MM-DD)	2011-04-07
Name	Timothy J. Lorenz	Registration Number	41954

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5822742
Issue Date: October 13,1998
Application No. 08331554
Filed: February 24,1995
Attorney Docket No. 40399/276/NI

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed April 7,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 7,2011 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

James M. Duncan
Klein, DeNatale, Goldner
4550 California Avenue 2nd Floor
Bakersfield CA 93309

MAILED
SEP 27 2010
OFFICE OF PETITIONS

In re Patent No. 5,713,595 :
Issue Date: February 3, 1998 :
Application No. 08/332,415 : ON PETITION
Filed: October 31, 1994 :
Attorney Docket No. 4575 :

This decision is mailed in response to the correspondence, filed April 9, 2010, which is being treated as a petition under 37 CFR 1.377 to accept and record a maintenance fee for the above-identified patent.

The petition is **dismissed**.

Any reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. This is **not** a final agency action within the meaning of 5 U.S.C.§ 704.

The merits of this petition will not be addressed because the person signing the petition has not established his authority to file the petition. As stated in MPEP 2580,, "If the petition is signed by a person not registered to practice before the Office, the petition must indicate that the person signing the petition is the patentee, assignee, or other party in interest. An assignee must comply with the requirements of 37 CFR 3.73(b) which is discussed in MPEP § 324." (emphasis added). For petitioner's convenience, a blank form, "STATEMENT UNDER 37 CFR 3.73(b)" is enclosed.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

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

By internet: EFS-Web
www.uspto.gov/ebc/efs_help.html
(for help using EFS-Web call the
Patent Electronic Business Center
at (866) 217-9197)

Telephone inquiries should be directed to the undersigned at (571) 272- 3230.

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

CC: JAN L. HAUHE
HI-SHEAR TECHNOLOGY CORPORATION
24225 GARNIER STREET
TORRANCE, CA 90505-5101

ENCLOSURE: blank form, "STATEMENT UNDER 37 CFR 3.73(b)"

Privacy Act Statement

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

JAMES M. DUNCAN
KLEIN, DENATALE, GOLDNER
4550 CALIFORNIA AVENUE 2ND FLOOR
BAKERSFIELD CA 93309

MAILED
DEC 03 2010
OFFICE OF PETITIONS

In re Application of
Thomas Mooney et al
Application No. 08/332,415
Filed: October 31, 1994
Attorney Docket No. 4575

DECISION ON REQUEST FOR REFUND

This is a decision on the Request For Refund filed October 29, 2010.

The request is **DISMISSED**.

The request for refund is dismissed because USPTO regulations require that papers filed in the application be signed by a registered attorney or agent, by the applicants (inventors) or by the assignee of the entire interest who has taken action in the application in accordance with 37 CFR 3.71. The request for refund is signed Jan L. Hauhe. Note 37 CFR 1.33(b) which states:

> (b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:
> (1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);
> (2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;
> (3) An assignee as provided for under §3.71(b) of this chapter; or
> (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

In view of the above, the request for refund is dismissed at this time.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

hi-shear TECHNOLOGY CORP.

24225 GARNIER STREET • TORRANCE, CALIFORNIA 90505-5355 • U.S.A.
TELEPHONES: (310) 784-2100 • (800) 733-0321 • FAX: (310) 325-5354
Website: www.hstc.com

26 October 2010

Director
United States Patent & Trademark Office
MS16
P.O. Box 1450
Alexandria, VA 22313-1450

2010 OCT 29 PM 4:40
USPTO

RE: Patent #5713595

Hello:

Hi-Shear Technology Corporation received a notice of patent expiration dated 3/01/10 from the United States Patent and Trademark Office (USPTO) regarding patent #5713595. A copy of said notice is attached to this letter for reference.

On the 02 April 2010, Hi-Shear wrote a letter to the Office of Petitions within USPTO requesting the patent be re-instated. Attached to that letter requesting re-instatement was a check for the $2,320 that included the maintenance fees of the patent ($2,055) plus surcharge fees ($65) plus the petition request fees ($200). A copy of said letter and check is attached to this letter for reference.

Hi-Shear received a letter mailed 27 September from a Senior Petitions Attorney within the Office of Petitions communicating that our request for re-instatement had been dismissed. A copy of said letter is attached to this letter for reference.

After communicating via phone with the Senior Petitions Attorney, I respectfully request a refund of the maintenance and surcharge fees in the amount of $2,120. The attorney communicated that I would need to request of you in writing that our fees be refunded.

Thank you for mailing a check in the amount of $2,120 made payable to Hi-Shear Technology Corporation. Please address the refunded amount as follows:

Hi-Shear Technology Corporation
Attn: Jan L. Hauhe
24225 Garnier Street
Torrance, CA 90505

If you have questions or require further information, please do no hesitate to email me at jhauhe@hstc.com or telephone me at (310) 784-2185.

Best regards,

Jan L. Hauhe
Chief Financial Officer
Hi-Shear Technology Corporation

HI-SHEAR TECHNOLOGY CORP. UL REGISTERED FIRM
ISO 9001 A9813

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.
08/333,162	11/01/1994	FRANCIS E. PETER	A6515570US	5775

128 7590 03/12/2012

HONEYWELL INTERNATIONAL INC.
PATENT SERVICES
101 COLUMBIA ROAD
P O BOX 2245
MORRISTOWN, NJ 07962-2245

EXAMINER	
BAREFOOT, GALEN L	
ART UNIT	PAPER NUMBER
3613	

MAIL DATE	DELIVERY MODE
03/12/2012	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

MAR 1 2 2012

HONEYWELL INTERNATIONAL INC.
PATENT SERVICES
101 COLUMBIA ROAD
P O BOX 2245
MORRISTOWN NJ 07962-2245

In re Application of: Peter et al.
Application No.: 08/333,162
Filed: November 1, 1994
For: LEARNING AUTOPILOT

: DECISION ON PETITION
: FOR WITHDRAWAL OF
: FINALITY OF ACTION

This is in response to applicants' petition filed under 37 CFR 1.118 on July 14, 1997 for withdrawal of the finality of the Office action mailed 05/13/1997.

The petition is DISMISSED as Moot.

A review of the record shows that the examiner issued a final Office action on May 13, 1997. Applicant timely filed the instant petition on July 14, 1997, in which applicants alleged that the finality of the May 13, 1007 Office action was premature because applicants' request for reconsideration and amended claim 1 would not necessitate new grounds of rejection. Applicants contended that "*the amendment to claim 1 was made to overcome the rejection, relying on the application as filed, and thus, should reasonably have been expected to have been made.*" Applicants further argued that the finality of said Office action is improper because the examiner introduced a new ground of rejection in rejecting unamended claims 15 and 16 under 35 USC 103 over Fitzpatrick et al. which is a new prior art.

On March 03, 1998 a notice of allowance was mailed and the application subsequently issued into a patent. In light of this fact, the issue raised in the instant petition concerning the finality of the office action has been rendered moot.

Any question concerning this decision should be referred to SPE Timothy Collins at 571-272-6886.

Katherine Matecki

Katherine Matecki, Director
Technology Center 3600
(571) 272-5250

KM/TDC: 2/28/2012

LM

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5742583	1998-04-21	08334587	1994-11-03	200149

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-18
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 5742583
Issue Date: April 21,1998
Application No. 08334587
Filed: November 3,1994
Attorney Docket No. 200149

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 18,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 18,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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DYKEMA GOSSETT PLLC
39577 WOODWARD AVENUE
SUITE 300
BLOOMFIELD HILLS MI 48304-5086

MAILED

AUG 30 2011

OFFICE OF PETITIONS

In re Application of :
Teng et al. :
Application No. 08/337302 :
Filing or 371(c) Date: 11/10/1994 : ON PETITION
Patent No. 5,613,130 :
Issue Date: 03/18/1997 :
Title of Invention: :
CARD VOLTAGE SWITCHING AND :
PROT :

This is a notice regarding 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.

A review of the petition reveals that the address appearing on the petition differs from the correspondence address of record. Applicant is advised that, in patented files: requests for changes of correspondence address, powers of attorney, revocations of powers of attorney, withdrawal of attorney and submissions under 37 CFR 1.501: Designation of, or changes to, a fee address, should be addressed to Mail Stop M Correspondence.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods
Attorney
Office of Petitions

CC: RADER FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE
BLOOMFIELD HILLS, MI 48304

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Date Mailed : 07/22/11

Patent No. : 5858771
Patent Issued : 01/12/99
Docket No. : **PUC1215**

Re: Request for Certificate of Correction

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

Respecting the alleged errors in the documents filed on 06/08/10; please see attachments. **"Therefore, no correction(s) is in order here under United States Codes (U.S.C.) 254 and the Code of Federal Regulation (C.F.R.) 1322."**

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

Lamonte M. Newsome
For Mary Diggs, Supervisor
Decisions & Certificates
Of Correction Branch
(571) 272-3421 or (703) 305-8309

KILPATRICK TOWNSEND & STOCKTON LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

LMN

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/11/11

TO SPE OF : ART UNIT 1632

SUBJECT : Request for Certificate of Correction for Appl. No.: 08337855 Patent No.: 5858771

CofC mailroom date: 06/08/10

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
[redacted]

Lamonte Newsome

Certificates of Correction Branch

571-272-3421

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.
- X **Denied** — State the reasons for denial below.

Comments: The Certificate of Correction seeks to add two inventors, namely Theodore Friedmann and Jiing-Kuan Yee, but the necessary requirements for correction of inventorship have not been met. The necessary statements from the persons being added, the current named inventors, and all assignees and the fee required by 37 CFR 1.324 have not been submitted.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

/Peter Paras/ 1632

SPE Art Unit

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5698583	1997-12-16	08339747	1994-11-15	72012

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
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SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

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STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/Joshua B. Goldberg/	Date (YYYY-MM-DD)	2011-01-18
Name	Joshua B. Goldberg	Registration Number	44126

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

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In re Patent No. 5698583
Issue Date: December 16,1997
Application No. 08339747
Filed: November 15,1994
Attorney Docket No. DRC002

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 18,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 18,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5611814	1997-03-18	08340710	1994-11-16	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☒ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

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MAINTENANCE FEE (37 CFR 1.20(e)-(g))

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STATEMENT

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PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

◉ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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Sole Patentee			
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 form of the signature.			
Signature	/ZPL/	Date (YYYY-MM-DD)	2011-01-13
Name	Z. Paul Lorenc		

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent No. 5611814
Issue Date: March 18,1997
Application No. 08340710
Filed: November 16,1994
Attorney Docket No. 94304

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 14,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 14,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5583983	1996-12-10	08340835	1994-11-17	1046-0002US

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Richard A. Schafer/	Date (YYYY-MM-DD)	2010-09-28
Name	Richard A. Schafer	Registration Number	45078

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 5583983
Issue Date: December 10,1996
Application No. 08340835
Filed: November 17,1994
Attorney Docket No.

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed September 28,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 28,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
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DIW Feb-11

Paper No. 10

TREBA FAIRCHILD DOUGLAS
PO BOX 941144
ATLANTA GA 31141

MAILED

FEB 15 2011

OFFICE OF PETITIONS

In re Patent No. 5,513,392 :
Issue Date: 05/07/1996 :
Application Number: 08/342,883 : DECISION ON PETITION
Filing Date: 02/02/1995 :
For: SHOULDER PAD ACCESSORY :
:

This is a decision on the petition under 37 CFR 1.378(b),[1] filed on December 30, 2010, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is **dismissed**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f). 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

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[1] A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);

(2) the surcharge set forth in §1.20(I)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

reconsideration or review of the matter will be undertaken by the Director.

The patent issued on May 7, 1996. The first maintenance fee could have been paid during the period from May 7 through November 8, 1999, or, with a surcharge, during the period from November 9, 1999 through May 7, 2000. The patent expired at midnight on May 7, 2000, for failure to timely pay the first maintenance fee.

Petitioners, *pro se*, assert numerous financial hardships befell them during the period from 1997 until the present year.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".[2] A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."[3] This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."[4] Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.[5] Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[6] However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.[7] In view of In re Patent No. 4,409,763,[8] this same standard will be

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[2] 35 U.S.C. § 41(c)(1).

[3] Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

[4] Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

[5] In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

[6] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "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"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

[7] Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

[8] 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable.[9] 35 U.S.C. § 133 does not require the Director to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.[10]

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.[11] That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the second maintenance fee for this patent.[12]

Petitioners have not presented a sufficient showing of unavoidable delay resulting from financial hardship. A complete showing is required of petitioners', or the party responsible for payment of the maintenance fee's, financial condition including all income, expense, assets, credit, and obligations which made the delay from May 7, 2000, the date the maintenance fee was due, until the filing of a grantable petition, unavoidable. Petitioners must provide verified copies of any available documents or records (*e.g.*, copies of all bank statements and other documents as detailed below) covering the entire period between May 7, 2000, and the filing of a grantable petition, including the maintenance fee payment.

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[9] See Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

[10] See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991)(table), *cert. denied*, 502 U.S. 1075 (1992); Ray v. Lehman, supra.

[11] Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

[12] Id.

Petitioners may provide this documented showing by supplying copies of mortgage documents showing the monthly mortgage payment as well as the balance due, documentation of other loan payments (*i.e*, vehicle loans or credit card statements), other expenses (*i.e.*, utilities, food, and clothing), as well as a statement of all assets owned by petitioners (*e.g.*, petitioners' home(s), vehicles, investments, bank accounts, and personal property).

Any renewed petition must be explained by a thoroughly documented showing as listed above.

Likewise, petitioners should explain whether they had sufficient credit available to charge the maintenance fee during the period when it could have been timely paid. Petitioners should also explain whether any other sources of income, such as loans or gifts, were available that could have been used to timely pay the maintenance fee.

Additionally, any renewed petition must be accompanied by payment of the 7 ½ year maintenance fee, which was due with a surcharge not later than May 7, 2004, as well as the 11 ½ year maintenance fee, which was due with a surcharge not later than May 7, 2008.[13]

While the Office is mindful of the difficulties encountered by petitioners as described in the petition, a showing of unavoidable delay requires, nonetheless, that petitioners provide a documented showing that they exercised the level of care of a reasonably prudent person acting with respect to his most important business.

In this regard, a showing of diligence in matters before the USPTO is essential to support a finding of unavoidable delay herein.[14] There is no "sliding scale" based upon the priority given to this maintaining this patent in force, or more diligently seeking reinstatement, *vis-a-vis* other matters by

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[13] While the petition form indicates that the maintenance fee being submitted includes the 7 ½ and 11 ½ year fee amounts, a review of Office financial records indicates that only $1,190.00 ($490.00 for the 3 ½ year maintenance fee and $700.00 for the surcharge required by § 1.20(i)(1)) was received with the petition.

[14] See Futures Technology, Ltd. v. Quigg, 684 F. Supp. 430, 431, 7 USPQ2d 1588 (E.D. Va. 1988)(applicant's diligent inquiry into the status of the application is required to show unavoidable delay); Douglas v. Manbeck, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992) (even representation by counsel does not relieve the applicant from his obligation to exercise diligence before the USPTO; applicant's lack of diligence extending two and one half years overcame and superseded any omissions by his counsel).

petitioner; the issue is solely whether the maintenance, or reinstatement, of the patent at issue was actually conducted with the care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business. The record fails to adequately evidence that petitioners exercised the due care and diligence observed by prudent and careful persons, in relation to their most important business, which is necessary to establish unavoidable delay.[15]

Petitioners are cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes), petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Petitioners should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

Any renewed petition must be accompanied by evidence supporting a conclusion that the failure to timely pay the maintenance fee was unavoidable.

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[15] Pratt, supra.

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 should be directed to the undersigned at 571-272-3231.

DWood

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

TREBA FAIRCHILD DOUGLAS
PO BOX 941144
ATLANTA GA 31141

MAILED
APR 07 2011
OFFICE OF PETITIONS

In re Application of :
Treba F. Douglas et al :
Application No. 08/342,883 : DECISION ON REQUEST FOR REFUND
Filed: February 2, 1995 :
For: SHOULDER PAD ACCESSORY :

This is a decision on the Request For Refund filed, March 9, 2011.

The request is **GRANTED**.

Applicant files the above request for refund of the fees paid on December 28, 2010, associated with the filing of the Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent under 37 CFR 1.378(b), in the amount of $700.00 (surcharge fee), and the 3 1/2 year Maintenance Fee ($490.00).

The petition under 37 CFR 1.378(b) was dismissed on February 15, 2011. Therefore, a total of $1,190.00 ($700.00 + 490.00) is being credited to applicant's credit card account as it is the method in which the fees were paid.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

FRANK J. DACONTA
14 VALLEYWOOD COURT WEST
HEAD OF THE HARBOR, NY 11780

MAILED

NOV 22 2010

OFFICE OF PETITIONS

In re Patent No. 5,471,697 :
Issue Date: 12/05/1995 :
Application No. 08/349,327 : ON PETITION
Filed: 12/05/1994 :
Title: DISPOSABLE DISINTEGRATING :
CLEANING DEVICE :

This is a decision on the petition under 37 CFR 1.378(c), filed August 12, 2010, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is DISMISSED.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is not a final agency action within the meaning of 5 U.S.C. § 704. Any petition for reconsideration of this decision must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f). After a decision on the petition for reconsideration, the Director will not undertake any further reconsideration or review of the matter.

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(c) must be filed within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e) and include: (1) a statement that the delay was unintentional;

(2) payment of the appropriate maintenance fee, unless previously submitted; and, (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2).

The above-identified patent issued on December 5, 1995. The grace period for paying the first maintenance fee expired on December 6, 2007. Petitioner filed the present petition on August 12, 2010, more than twenty-four months after the six-month grace period provided in 37 CFR 1.362(e). That is, petitioner was required by statute to file a petition under 37 CFR 1.378(c) no later than December 5, 2009. Accordingly, the Office cannot accept the maintenance fee payment. The above-identified patent remains expired.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking further reconsideration is not refundable. Any request for refund should be in writing to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

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 Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax:
(571) 273-8300
Attention: Office of Petitions

Correspondence may also be submitted via the electronic filing system of the USPTO.

The patent file is being forwarded to the Office of Files Repository.

Telephone inquiries should 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
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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MAILED

MAR 31 2011

OFFICE OF PETITIONS

PATRICK J WALSH
400 MAIN STREET
STAMFORD, CT 06901

In re Patent No. 5,667,382 :
Issue Date: September 16, 1997 :
Application No. 08/355,536 : ON PETITION
Filed: December 14, 1994 :
Attorney Docket No. :

This is a decision on the petition under 37 CFR 1.378(c), filed March 11, 2011, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on September 16, 2009 for failure to pay the 11 ½ year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

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

/AMW/
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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DIW Aug-11

Paper No. 12

FINCHAM DOWNS, LLC
470 MAIN ST.
SUITE 303
RIDGEFIELD CT 06877

MAILED
AUG 30 2011
OFFICE OF PETITIONS

In re Patent No. 5,542,662 :
Issue Date: 08/06/1996 :
Application Number: 08/355,707 : DECISION ON PETITION
Filing Date: 12/14/1994 :
Attorney Docket Number: :
69200A756 :
:

This is a decision on the petition filed on June 22, 2011, under 37 CFR § 1.378(b) to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **dismissed**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f). 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.

The patent issued August 6, 1996. The first and second maintenance fees were timely paid. The third maintenance fee could have been paid from August 6, 2007, through February 6,

2008, or, with a surcharge during the period from February 7 through August 6, 2008. Accordingly, the patent expired at midnight August 6, 2008, for failure to timely submit the maintenance fee.

Petitioner asserts that registered patent practitioner Bonnie Drinkwater (hereinafter "Drinkwater"), via her law firm, the Drinkwater Law Offices (hereinafter "DLO") was responsible for payment of the third maintenance fee, and that the due dates for payment of the third maintenance fee were to have been entered into DLO's Microsoft Outlook calendaring system by DLO's then paralegal, Cindy Hill (hereinafter "Hill), who was responsible for entering the maintenance fee due dates in the calendaring system. However, the due dates for payment of the third maintenance fee for the subject patent were not entered into the calendaring system, and the maintenance fee was not timely paid.

Petitioner also asserts that no notice of patent expiration was received because the USPTO mailed the notice of patent expiration to the prior counsel of record, Darby & Darby. Petitioners further assert, through the declaration of Bonnie Drinkwater, that it is believed that the USPTO send the notice of renewal for the subject patent to DLO's old address.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

This petition lacks requirement (1).

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").[1] Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[2] In this regard:

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[1] Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

[2] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[3]

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".[4] A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."[5] This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."[6] Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.[7] Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[8] However,

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greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

[3] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

[4] 35 U.S.C. § 41(c)(1).

[5] Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

[6] Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

[7] In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

[8] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or

a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.[9] In view of In re Patent No. 4,409,763, this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

This petition does not satisfy the requirement of 37 CFR 1.378(b)(3). The statements presented in the petition fail to satisfy the showing required to establish unavoidable delay within the meaning of 37 CFR 1.378(b).

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.[10] That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.[11]

With regard to period (1), above, a delay resulting from an error (*e.g.*, a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(1) the error was the cause of the delay at issue;

(2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance;

(3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.[12]

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greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

[9] Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

[10] Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

[11] Id.

[12] See MPEP 711.03(c)(III)(C)(2).

An adequate showing requires:

(A) Statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them.

(B) Petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledgers, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.

(C) Petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

The present petition lacks the showing required by (1), (2), and (3) above.

At the outset, it is noted that petitioners have not provided a statement from Hill, the person who allegedly made the error in failing to docket the due dates for the third maintenance fee for the subject patent. Petitioner must obtain a statement or declaration of facts from Hill stating the facts as she knows them surrounding the entry of the due dates for the third maintenance fee for the subject patent into the docketing system utilized by DLO.

Further, petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

In this regard, while the petition and the declaration of Drinkwater both state that Drinkwater supervised Hill, petitioner has not supplied detailed information regarding the supervision of and checks on the described work which were used to assure proper execution of assigned tasks.

More to this point, it is noted that Drinkwater's declaration states, in pertinent part:

11. In about February 2005, Drinkwater Law Offices filed with the USPTO an assignment for the '662 patent on behalf of Tachikarao. The assignment was recorded and
included the address of the Drinkwater Law Offices at that time, which was 6490 S. McCarran Blvd, Suite B-15, Reno, NV 89509. Attached hereto is a true and correct copy of the Notice of Recordation of the Assignment of Patent (EXHIBIT B).

12. In September 2005, the Drinkwater Law Offices relocated to its current location, 5421 Kietzke Lane, Suite 100, Reno, NV 89511. As part of the move, Drinkwater Law Offices set up procedures designed to ensure that all files it had with the USPTO were updated with the new address information.

13, in September 2005, I verbally instructed Ms. Hill to file change of address forms with the USPTO to update Drinkwater Law Offices' new address for each file and to use the records saved in the Outlook calendaring and excel spreadsheet system to confirm that each file had been updated. Ms. Hill informed me that she had updated all of the files using the docketing systems. However, the assignment of the '662 patent does not appear to have made it into the docketing system. As a result, it does not appear that Ms. Hill filed a change of address form for the '662 patent. That is the only file Drinkwater Law Offices had with the USPTO that appears to not have been updated with Drinkwater Law Offices' new address.

14. Drinkwater Law Offices never received a notice of renewal for the '662 patent. I suspect this is because the USPTO had the old Drinkwater Law Offices' address, and by the time the notice was sent, no forwarding service was operating.

Petitioner's contention that they did not receive any notification from the USPTO that the maintenance fee was due is not well taken. A patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance

Fee Reminder do not constitute unavoidable delay.[13] Under the statute and regulations, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. The Office mailing of Maintenance Fee Reminders is carried out strictly as a courtesy. Accordingly, it is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and/or the failure to receive the Maintenance Fee Reminder (or a Notice of Patent Expiration) will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.[14]

Rather than unavoidable delay, the showing of record is that petitioner lacked a reliable system for tracking and paying maintenance fees. The showing of record suggests that petitioner relied upon the receipt of some type of correspondence from the USPTO (*i.e.*, an assignment recordation notice, a maintenance fee reminder, or a notice of patent expiration) in order to docket and track the maintenance fee payments. It is not understood why petitioner would rely upon the receipt of correspondence from the USPTO in order to docket the payment of the third maintenance fee. As the Office has no duty to notify patentee of the requirement to pay maintenance fees or to notify patentee when the maintenance fees are due, a showing of unavoidable delay requires a showing of a system to docket and pay the maintenance fees which does not rely upon receipt of a Maintenance Fee Reminder or other notice regarding payment of the maintenance fees received from the USPTO. Rather than an error on the part of a trusted and reliable employee, the showing of record suggests that the error occurred because petitioners awaited receipt of correspondence from the USPTO in order to docket and track the maintenance fee payments, and that when the expected correspondence did not arrive, petitioners lacked a process to docket the maintenance fee payment in the absence of the correspondence. Rather than unavoidable delay, the showing of record of a defect in the business routine in that petitioner relied upon the receipt of correspondence from the USPTO in order to docket and track the third maintenance fee for the subject patent.

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[13] *See* Patent No. 4,409,763, *supra; see also* "Final Rules for Patent Maintenance Fees" 49 Fed. Reg. 34716, 34722-34723 (August 31, 1984), *reprinted in* 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984).

[14] Rydeen v. Quigg, 748 F. supp. at 900.

Drinkwater's declaration states that "[t]here is no reason that the DLO law firm can find for the fact that the third maintenance fee for the '662 patent was not paid." However, a petition to reinstate a patent which has where payment of the maintenance fee was unavoidably delayed cannot be granted if the petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.[15] In this case, petitioner's inability to find a reason that the payment of the maintenance fee was delayed does not equate to an affirmative showing of unavoidable delay.

Lastly, it is noted that the petition states:

> Further, an outside party, Leason Ellis, after the dissolution of Darby and Darby, inexplicably made itself the fee address of record for the '662 patent in manner that could not have been detected by Tachikara or DLO law firm. Neither Darby and Darby nor Leason Ellis informed Tachikara or DLO law firm of the expiration of the '662 patent, and it is not clear that they knew.

This argument, too, is unpersuasive, for petitioner's argument is again that it relied upon receiving maintenance fee reminders or other correspondence from the USPTO in order to docket the maintenance fees. As stated above, the failure to receive maintenance fee reminders from the Office does not constitute unavoidable delay.[16] As such, no matter where the Office was sending the reminders, or if the Office sent no reminders at all, the failure of petitioners to receive them would not result in a showing of unavoidable delay. Still further, whether or not another party was aware that the patent had expired and failed inform petitioners is irrelevant, as the showing of record is that petitioners, not another party, were responsible for tracking and paying the maintenance fee, but failed so to do.

In summary, the showing of record is inadequate to establish unavoidable delay. Rather, the showing of record is that petitioner failed to take adequate precautions to ensure that maintenance fees were timely paid in the event of a failure to receive mailed correspondence from the USPTO. Petitioner's apparent reliance on the receipt of correspondence from the USPTO in order to docket and track the maintenance fee constitutes a lack of diligence, not unavoidable delay.[17] As petitioner has not

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[15] Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

[16] See note 14, supra.

[17] See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

shown that it exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.[18]

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

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: (703) 872-9306
Attn: Office of Petitions

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

Telephone inquiries should be directed to the undersigned at 571-272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

[18] See note 3, supra.

STATEMENT UNDER PARAGRAPH 8

Brief Summary

Despite (1) reliance on an industry-standard calendaring system; (2) a well-established and reliable procedure for processing docketing action items; and (3) oversight by a competent and reliable intellectual property attorney who had paid hundreds of fee payments, the third maintenance fee for U.S. Patent No. 5,542,662 ("the '662 patent") was not paid. Tachikara USA, Inc. ("Tachikara") and the Drinkwater Law Offices ("DLO") law firm exercised the care and diligence generally used and observed by prudent and careful men in relation to their most important business and relied on worthy and reliable employees. Further, the fee address for the '662 patent was incorrect at the time the third maintenance fee was due, as the firm then of record, Darby and Darby, had moved in 2007, and Darby and Darby apparently failed to update the USPTO when it moved and when it ultimately dissolved in 2010. A finding of unavoidable delay is necessary in order to avoid an inequitable loss of patent rights.

The detailed facts as set forth below are supported by Declarations of persons personally acquainted with them. Briefly, the DLO law firm was responsible for paying the third maintenance fee on the '662 patent as part of its consolidated handling of all intellectual property matters for Tachikara. From its inception, the DLO law firm has used the well-known Microsoft Outlook calendaring system (and a parallel Microsoft Excel spreadsheet system) for tracking fees due for maintaining intellectual property assets before the United States Patent and Trademark Office ("USPTO"). The DLO law firm also had a capable, trained employee that was responsible for creating and overseeing the docket and files. The employee followed established procedures for ensuring that items were properly entered in the docketing system, and that reminders for filing fees were distributed to the responsible attorney. The responsible attorney also ensured that action items and due dates were met.

In this case, the responsibility for paying the third maintenance fee for the '662 patent was, ultimately, that of Ms. Bonnie Drinkwater, the principal attorney for the '662 patent and other Tachikara intellectual property matters. The due date for the '662 patent's third maintenance fee payment was never entered into the calendaring system by Ms. Drinkwater's then paralegal, Ms. Cindy Hill. Ms. Hill had worked at the DLO law

firm since 2002 and was a competent and reliable employee. DLO filed with the USPTO an assignment for the '662 patent on behalf of Tachikara. The assignment was recorded and included the address of the DLO law firm at that time, which was 6490 S. McCarran Blvd., Suite B-15, Reno, NV 89509.

A current investigation of the records of the USPTO shows that the USPTO on September 1, 2008, sent a notice of patent expiration for the '662 patent to Darby and Darby at the address of 805 Third Avenue, New York, NY 10022 (EXHIBIT X). Darby and Darby, however, had moved to 7 World Trade Center, 250 Greenwich St., New York, NY 10007-0042 on May 28, 2007 (EXHIBIT Y). Darby and Darby subsequently dissolved as a law firm in 2010, within the twenty-four months from expiration during which a petition to accept delayed payment for unintentional could have been filed (EXHIBIT Z). Leason Ellis LLP, with whom Tachikara was not engaged for legal services, subsequently and inexplicably filed a change of fee address for the '662 patent with the USPTO on April 22, 2010 (still within the twenty-four month period), but apparently failed to recognize that the '662 patent was expired at the time, and failed to contact either DLO (the correspondence address of record) or Tachikara. Neither Tachikara nor DLO received any correspondence from either the USPTO, or Darby and Darby, or Leason Ellis, with respect to the expiration of '662 patent. Therefore, there was no reason for Ms. Drinkwater or for any other reasonably prudent person under these circumstances, to examine the '662 patent file itself to confirm payment of the third maintenance fee or otherwise question the status of that patent.

The first time Tachikara and the DLO law firm became aware of the missed payment was on March 24, 2011, when Ms. Drinkwater discovered the expiration of the '662 patent. Immediately, Tachikara sought counsel to investigate the non-payment.

Thus, despite (1) reliance upon a reliable computer calendaring system, (2) a well-established and reliable procedure for processing docketed action items, and (3) oversight by a competent and reliable intellectual property attorney who had paid hundreds of fee payments, the third maintenance fee for the '662 patent was not paid. Further, the failures of Darby and Darby and Leason Ellis to recognize the error in the fee address make the failure to provide the maintenance fee payment unavoidable under the appropriate USPTO standards. Ms. Drinkwater had no reason to doubt that the '662 patent had been

properly docketed in the DLO law firm's calendaring system and the USPTO did not generate reports or notices to DLO indicating otherwise.

Once Tachikara became aware of this issue, counsel was immediately consulted. After the matter was investigated and evidence gathered, this Petition was promptly prepared and submitted.

It is respectfully submitted that the present petition should be granted.

Applicable Legal Standards

Pursuant to 35 U.S.C. 41(c)(1):

> The Director may accept the payment of any maintenance fee required by subsection (b) of this section ... after the six-mother grace period if the delay is shown to the satisfaction if the Director to have been unavoidable.

Decisions on reviving abandoned applications, or reinstating patents, 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.

In re Mattullath, 38 App. D.C. 497,514-15 (1912)(quoting Ex pane Pratt, 1887 Dec. Com'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

Given the facts above and the definition of "unavoidable", the Petitioner respectfully submits that it has made a clear showing that the failure to pay the second maintenance fee for the '216 patent was unavoidable and therefore has met its burden. Initially, the DLO law firm has exercised great care and diligence consistent with how

"prudent and careful men [act] in relation to their most important business". The DLO law firm has an established and well run docketing system and has taken the due care necessary to insure that all maintenance fees were paid. The DLO law firm handled the payment of the second maintenance fee for the '216 patent in the same fashion as it does for other maintenance fees. Further, in accordance with its exercise of care, the DLO law firm relied upon a worthy and reliable employee who had not previously given any cause not to be trusted or to not perform her requisite duties in a proper manner. See, California Medical Product, Inc. v. Tecnol Medical Products, Inc., 921 F. Supp. 1219 (D. Del. 1995) (incorrect payment date docketed); Laerdal Medical Corp. v. Ambu., Inc., 87 F.Supp. 255 (D. Md. 1995) (secretary to patent attorney docketed an incorrect maintenance fee due date).

Remarks

There is no reason that the DLO law firm can find for the fact that the third maintenance fee for the '662 reissue patent was not paid. The matter was discussed between Ms. Drinkwater and Ms. Hill and Ms. Hill assured her that the DLO's files had been updated as requested by Ms. Drinkwater. Why Ms. Hill did not enter the third maintenance fee for the '662 patent is unknown. In any event, the third maintenance fee was not paid despite Tachikara's taking all reasonable and prudent steps to engage the DLO law firm to care for all of its intellectual property matters, including with the respect to the '662 patent that the DLO law firm helped Tachikara acquire, the DLO law taking all reasonable and prudent steps to make sure docketed items were recorded, noticed and taken care of, and having competent and trained staff to administer them.

Further, an outside party, Leason Ellis, after the dissolution of Darby and Darby, inexplicably made itself the fee address of record for the '662 patent in a manner that could not have been detected by Tachikara or DLO law firm. Neither Darby and Darby nor Leason Ellis informed Tachikara or DLO law firm of the expiration of the '662 patent, and it is not clear that they knew.

The failure to pay the third maintenance fee was thus unavoidable and the '662 patent should be reinstated. There was no reasonable way that the Petitioner, the DLO law firm, or any reasonable attentive and prudent person would have realized that the

third maintenance fee for the '662 patent had not been paid. Only through an unavoidable set of circumstances, beyond the Petitioner's control, was that third maintenance fee not paid. Further, only through an unavoidable set of circumstances, involving the dissolution and inexplicable involvement of outside law firms beyond the Petitioner's control, was the Petition unable to submit a petition to reinstate for unintentional delay within the required twenty-four month period for filing such. No one affiliated with the '662 patent could have learned of its expiration or had reason to question its status, until March 24, 2011.

Conclusion

The present situation is one where the expiration of the '662 patent was truly unavoidable. Thus, the Petitioner respectfully submits that its Petition to Accept the Late Maintenance Fee must be granted.

EXHIBIT X

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

P75M

DARBY AND DARBY
805 THIRD AVENUE
NEW YORK NY 10022

DATE PRINTED
09/01/08

NOTICE OF PATENT EXPIRATION

According to the records of the U.S. Patent and Trademark Office (USPTO), payment of the maintenance fee for the patent(s) listed below has not been received timely prior to the end of the six-month grace period in accordance with 37 CFR 1.362(e). THE PATENT(S) LISTED BELOW HAS THEREFORE EXPIRED AS OF THE END OF THE GRACE PERIOD. 35 U.S.C. 41(b). Notice of the expiration will be published in the USPTO Official Gazette.

Expired patents may be reinstated in accordance with 37 CFR 1.378 if upon petition, the maintenance fee and the surcharge set forth in 37 CFR 1.20(i) are paid, AND the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable or unintentional. 35 U.S.C. 41(c)(1).

If the Director accepts payment of the maintenance fee and surcharge upon petition under 37 CFR 1.378, the patent shall be considered as not having expired but would be subject to the intervening rights and conditions set forth in 35 U.S.C. 41(c)(2).

For instructions on filing a petition under 37 CFR 1.378 to reinstate an expired patent, customers should call the Office of Petitions Help Desk at 571-272-3282 or refer to the USPTO Web site at www.uspto.gov/web/offices/pac/dapp/petitionspractice.html. The USPTO also permits reinstatement under 37 CFR 1.378(c) by electronic petition (e-petition) using EFS-Web; e-petitions may be automatically granted if all the eligibility requirements are met. For further information on filing an e-petition, please call the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 571-272-4100 or refer to the EBC's e-petition guide at www.uspto.gov/ebc/portal/efs/petition_quickstart.pdf.

PATENT NUMBER	U.S. APPLICATION NUMBER	PATENT ISSUE DATE	APPLICATION FILING DATE	EXPIRATION DATE	ATTORNEY DOCKET NUMBER
5542662	08355707	08/06/96	12/14/94	08/06/08	69200A756

NOTE: This notice was automatically generated based on the amount of time that elapsed since the date a patent was granted. It is possible that the patent term may have ended or been shortened due to a terminal disclaimer that was filed in the application. Also, for any patent that issued from an application filed on or after June 8, 1995 containing a specific reference to an earlier filed application or applications under 35 U.S.C. 120, 121, or 365(c), the patent term ends 20 years from the date on which the earliest such application was filed, unless the term was adjusted or extended under 35 U.S.C. 154 or 156.

MA841D (11/2006)

EXHIBIT Y

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Darby & Darby move

Issue 2007/17 | Thursday, May 31st, 2007

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Andrew Baum

Managing Principal

DARBY & DARBY P.C.

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EXHIBIT Z

Darby & Darby Dissolving after 115 Years in Business

U.S. Patent Searches w/ Opinions
U.S. & International Patent Applications
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Intellectual Property Litigation
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Written by Gene Quinn
President & Founder of IPWatchdog, Inc.
Patent Attorney, Reg. No. 44,294
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Posted: March 12, 2010 @ 4:02 pm

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Earlier today Darby & Darby, one of the oldest intellectual property boutique firms in the United States, announced that they are dissolving. The announcement, which seems to have come without much warning, confirms rumors that started swirling last night that an abrupt end was near for the firm that has been in business since 1895. Darby & Darby has offices in New York, Seattle, Washington DC, Palm Beach Gardens and Frankfort. Details remain murky, and no one seems to know exactly when the doors will be shuttered, but here is the text of the announcement:

> *It is with a heavy heart that we announce that after more than 100 years in continuous operation, Darby & Darby will begin the process of winding down the firm in anticipation of an orderly dissolution. While we continue to have exceptional clients, from individual inventors to Fortune Global 500 Companies, and remain profitable, many of the factors frequently cited in demise of other firms' have made a similar impact on us.*

So why would Darby & Darby elect for an orderly dissolution when they have clients many firms and attorneys would love to have and they remain profitable? It is unclear, but the reference to the factors cited in the demise of other firms does provide some clues. Increasingly the IP boutique firm is disappearing. The first sign of trouble is the mass exodus of attorneys who leave to go to another large firm that has or wants to develop an intellectual property department.

It seems it is increasingly difficult for large IP boutiques to compete in a world where full service mega-firms

continue to grow and are capable of providing one-stop-shop services to meet all the needs of a client. This seems to be true of Darby & Darby as well, and if what they say can be taken at face-value, it seems that the decision to dissolve was made prior to the acceleration of a downward spiral. Perhaps Darby & Darby just wanted to go out on their own terms, rather than as a result of mounting financial pressure.

According to the homepage of Darby & Darby, the firm describes itself as follows:

> *Darby & Darby, P.C. is a full-service intellectual property law firm. As one of the oldest intellectual property firms in the world, we have long been an important player in pioneering and precedent-setting IP matters. Our attorneys hold advanced technical degrees and have distinguished academic credentials. We are intellectual property strategists, counseling our clients on how to maximize the value of their patents, trademarks, copyrights, and trade secrets.*

There is no doubt that Darby & Darby has been a major player in the intellectual property world for a very long time, and while it is never easy to see the dissolution of such a venerable name, and even harder to watch our friends and colleagues go through the associated stress of such a closing, in time the industry will absorb the attorneys and support staff and the industry will proceed onward. At a time with such economic upheaval, such a loss could find many looking for work longer than usual though.

Over the last 6 to 12 months there have been a variety of anecdotal reports that business is down everywhere all across the board. The industry-wide data in terms of patent filings at the United States Patent and Trademark Office do not bear out the level of industry decline that many speak of. I have no doubt that those who report such a decline are accurately reporting what they are seeing, but the numbers across the industry, at least on the patent side, do not tell the same story. In fact, fiscal year 2008 saw a record number of patent applications filed at the USPTO, and while down for fiscal year 2009, FY 2009 saw more patent applications filed than any other year except for FY 2008. Reports emanating from the campus of the USPTO suggest that so far FY 2010 is ahead of the predicted pace, and if Congress would allow the USPTO to keep all of its revenues in FY 2010 the $200 million hole may fill itself simply due to increased filings over projections. So something is not adding up.

It seems that there is a major reconfiguration within the patent law community. I know large firms that have patent departments that have an extraordinarily large amount of business that continues to grow despite what many might call exorbitant hourly rates. I also know many small firms that are also seeing a large increase in business, and some of the patent searchers I talk to tell me they see the same. So why then

are some reporting extraordinary decreases in business?

In the past I have opined that the days of the mahogany table, marble floor law firms is gone. I think that is too simplistic though. It seems that there is a growing tale of three sectors of the industry. There are those that cater to independent inventors primarily and offer extremely low price points. There are those that cater to entrepreneurs and small businesses primarily and offer a price point much higher than independent inventor prices, but substantially lower than large firm prices. Then there are those who primarily cater to well established corporations with large intellectual property portfolios. It seems that in this higher end segment the large IP boutique firms simply can no longer compete with the large mega-firms that can handle anything a Fortune 1000 clients walks in with as an issue. So it seems to me that where the squeeze is coming, and where the stories of dramatic decline are most prevalent, are in the once dominant large IP boutique firms, such as Darby & Darby.

Even this analysis, however, likely over-simplifies matters. One thing I have come to realize through my career is the legal IP industry is rarely constant. Yes, the longevity of the large IP boutiques masked the dynamic nature of the legal IP industry for a very long time, but attorneys are always on the move it seems. For some time there has been a revolving door at IP firms, particularly patent firms. Large firms work many associates like slaves and eventually they move on to greener pastures, whether that be in house or out on their own where they can make more money and work half the hours. Head hunters are always looking for candidates to serve up to large firms, at least before this last recession anyway. The calls from head hunters are a part of the industry and if you are looking out for yourself and your family you might just take a better offer, which is certainly anything but unheard of. So there has always been turmoil within the industry, but never before has it been so obvious in light of the number of old and well regarded IP boutiques that have gone under over the last decade.

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About the Author

Gene Quinn is a US Patent Attorney, law professor and the founder of **IPWatchdog.com**. He is also a principal lecturer in the **top patent bar review course in the nation**, which helps aspiring patent attorneys and patent agents prepare themselves to pass the patent bar exam. Gene's particular specialty

as a patent attorney is in the area of strategic patent consulting, patent application drafting and patent prosecution. As an electrical engineer by training his practice primarily focuses on software, computers and Internet innovations, as well as electrical and mechanical devices. Gene has been quoted in the Wall Street Journal, the New York Times, the LA Times, CNN Money and various other newspapers and magazines worldwide.

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Tags: darby and darby, dissolving, ip boutique, Law Firms, patent law firms

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6 comments
Leave a comment »

1. patent leather **March 13th, 2010 2:14 am**

   Those who previously predicted the demise of the small to mid sized IP boutiques were flat wrong. With companies cutting their legal budgets, the huge overhead at the big firms (both IP and general) means partners with billing rates of $400+. Darby & Darby is (was?) a great firm, but can they really write a better patent application than a competent lawyer at a smaller firm? My answer is, generally speaking, no. I already see lots of work being sent to smaller firms and I think the trend will continue.

2. old curmudgeon **March 13th, 2010 1:07 pm**

   It seems bizarre to have now outlived, just in the past few years, several of the most famous patent law firms of our patent law youth, the prestige leaders in IP litigation for so many generations. [Besides Darby & Darby, it has been Pennie & Edmonds; Fish & Neave; Morgan & Finnegan; and Kenyon & Kenyon, as I recall? All in NYC?]
   [Of course many [but by no means all] former partners and associates have been absorbed into giant GP law firms [which no longer refer any client IP work out to specialized IP firms unless the clients do it themselves].
   I believe that this is further exacerbating a great divide between PTO practice and patent litigation, in which fewer and fewer attorneys doing patent litigation seem to have ever had any working knowledge of what goes on in the PTO in obtaining patents, and don't care as long as they can produce enough litigation billing hours to meet the ravenous billing demands needed to retain their jobs in those giant impersonal businesses of 1000 or more attorneys. This trend of patent litigation by those who have never practiced before the PTO or even the CAFC does always not bode well for clients who need, for example, reexaminations, reissues, Board appeals, CAFC appeals, etc. While, on the other hand, most of those now preparing and prosecuting patent applications these days have not had any direct litigation experience and too often lack appreciation of how their PTO work may affect their patents if they are ever litigated, and are now often [unlike litigators] under severe cost constraints precluding adequate training, supervision or review. Many of the patents now being obtained as cheaply as possible will never be infringed or otherwise be fit for litigation, except from conciencious senior members of low overhead small firms.

3. Jerry Stanton **March 16th, 2010 4:13 pm**

   I'm not sure if I believe Darby was done in by competition from full service firms, which is the premise underlying Gene's conclusion of the beginning of the end of the boutique patent firms catering to corporate patent work. I recall reading of a large and storied general practice firm in San Francisco that closed up shop last year. They'd gotten into the habit of taking a loan to pay bonuses and oeprating expenses at the beginning of their fiscal year,

which in recent years took them 9+ months to pay off. As the economy tanked a few partners got cold feet and left, too many, which violated the terms of the loan. The bank called it in, even more partners left, the firm couldn't pay and had no choice but to close their doors. Now I have no idea whether Darby was so boneheaded as to pay bonuses out of a loan and my own bias is that a boutique patent firm is likely a bit more conservative cash-wise than the average large GP firm, but apparently partners have been leaving Darby over the past few years. The business of lawyering is relationship based and each partner has a good shot at taking his own clients and a few extras with them when they leave. A few of those defections and any firm would be in dire cash straights trying to manage high-dollar asssociate payroll while keeping some consistency for remaining clients.
Why those Darby parners left I think is the key to why Darby's closed up. I've seen Darby's NYC rates and they didn't leave because they could bill much higher from the offices of a general practice firm. Maybe the GP firms saw it was easier to expand by pirating talent with thier own book of business from Darby than by organically growing it themselves, or maybe the defecting partners saw some writing on the wall early on. Whatever the reason, I think the evidence is not in to conclude that Darby is closing because corporate America/Europe wants one stop legal shopping.

4. OldTimer **March 17th, 2010 5:59 pm**

   Darby is folding for the same reason that all the other Bigtiques have folded. The money in this business is in litigation, not prep/pros. Their litigators have been leaving to go to big GP firms where they can build a bigger empire and make more money. Every time a litigator leaves the high-margin litigation part of the pie shrinks and the low-margin prosecution part of the pie grows. The last time I checked Darby had 40 some lawyers and 20 some patent agents. You can't run a NY law firm with those kinds of numbers.

5. Another Old Timer **March 20th, 2010 4:08 pm**

   I agree fully with what Old Timer writes: "Darby is folding for the same reason that all the other Bigtiques have folded. The money in this business is in litigation, not prep/pros."
   I was in contact with Darby & Darby way back in 1984, when it had its offices at the prestigious Chrysler Building in Manhattan. I was then a patent attorney for a European corporation that entered the US markets that year through a joint-venture deal with a big consumer electronics outfit in the US. Darby's professionals helped us admirably in our search for possible patents infringements. I found their services helpful, while at the same time being very friendly and cordial. This old venerable IP boutique combined professionalism with a touch of warm personal service- a rare quality in present day mega-law firms, who are more interested in milking their clients with a $400+/hr rate, than in offering a warm human touch to the rather boring patents business.

   With an ongoing boom and explosion of patents litigation in the US- especially in the mobile phones business – it is a pity that old established names like Darby & Darby are vanishing from the scene. One would expect that this boom in patents litigation would provide more work for patent lawyers with experience in that particular area. Darby really had experience in this area.

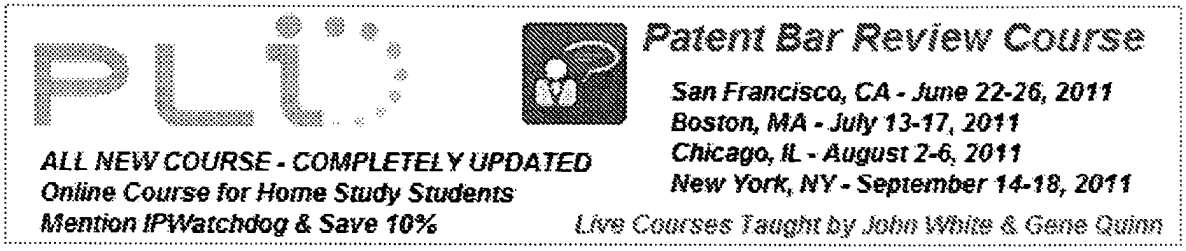
   Or has the business of patents litigation become so large in volume, that such IP boutiques like Darby & Darby simply cannot compete with those big law PLLs that have 1000+ staff?

Are law firms becoming some kind of "WalMart" department stores, that offer you everything you need in legal services but without that essential human and personal touch? What a pity!

6. screwedbylaywer **March 23rd, 2010 10:16 pm**

   this firm has left many people hanging and did not do a very good job in serving their clients near the end at the very least.

Leave Comment



DECLARATION OF BONNIE DRINKWATER

I, Bonnie Drinkwater, do hereby declare and state:

1. I am an attorney who has been the principal of Drinkwater Law Offices since July 2002. I have personal knowledge of the facts stated herein and can testify competently to them if called upon to do so.

2. Drinkwater Law Offices is a law firm that has been operating since July 2002 in the areas of business formation, trademark and copyright law, employment law and real estate law. Today, Drinkwater Law Offices handles hundreds of trademark prosecution files.

3. Tachikara U.S.A., Inc. ("Tachikara") has been a client of the Drinkwater Law Offices since about November 1, 2002, when Drinkwater Law Offices began prosecuting several trademark files for Tachikara.

4. In about July 2004, Tachikara entered into a Purchase and Sale Agreement whereby it acquired United States Patent No. 5,542,662 (the "'662 patent"), relating to a sports ball and (balloon bladder) production method, and several trademark assets. Drinkwater Law Offices prepared the Purchase and Sale Agreement.

5. Tachikara engaged Drinkwater Law Offices to handle Tachikara's intellectual property and other business matter needs.

6. Ms. Cindy Hill was the paralegal at Drinkwater Law Offices who was responsible for maintenance of the docketing systems used to ensure all United States Patent and Trademark Office ("USPTO") files were timely maintained. Ms. Hill began work at Drinkwater Law Offices on August 4, 2002 and had completed training for Microsoft® Outlook® prior to when she was hired. I directly supervised Ms. Hill on her work on the USPTO files. For five (5) years she conducted all docketing for Drinkwater Law Offices.

7. Drinkwater Law Offices has used two reliable docketing systems for calendaring and tracking all relevant dates related to intellectual property prosecution and maintenance with the USPTO, including the payment of any fees required to maintain assets in force: Outlook's calendar software as well as a Microsoft® Excel®-based spreadsheet system listing renewal dates for each USPTO file. Drinkwater Law Offices has used the Outlook calendaring system and the Excel spreadsheet system since 2002.

8. For calendaring on Outlook, Ms. Hill would type in all filing deadlines for each USPTO file, as well as reminders regarding the filing deadlines at the following time increments before each deadline: two months, 1 month, two weeks, one week, one day and the day of the deadline. Attached hereto is a true and correct copy of the Outlook calendar, including filing deadlines for USPTO files, for July 14, 2008 to October 12, 2008 (the oldest such calendar records currently available) (EXHIBIT A). Similarly, for the spreadsheet system, Ms. Hill would type in all filing deadlines for each USPTO file, as well as reminders regarding the filing deadlines at the same time increments as with Outlook.

9. In response to receiving a reminder from the Outlook system, Ms. Hill would cross check the action required with the spreadsheet system and then notify me of the action required. I would then take immediate action by contacting the client and informing the client of the action required to maintain the application or registration. With the client's permission, I would then timely file the renewal as required. During 2002-2005, I was responsible for and successfully carried out the timely filing of hundreds of renewals to the USPTO.

10. In accordance with firm practice, a file was created for the business transactions and individual trademark files for Tachikara. However, neither the assignment of the '662 patent to Tachikara nor a due date for payment of the third maintenance fee for the '662 patent appear to have made it into the docketing system.

11. In about February 2005, Drinkwater Law Offices filed with the USPTO an assignment for the '662 patent on behalf of Tachikara. The assignment was recorded and included the address of the Drinkwater Law Offices at that time, which was 6490 S. McCarran Blvd., Suite B-15, Reno, NV 89509. Attached hereto is a true and correct copy of the Notice of Recordation of the Assignment of Patent (EXHIBIT B).

12. In September 2005, the Drinkwater Law Offices relocated to its current location, 5421 Kietzke Lane, Suite 100, Reno, NV 89511. As part of the move, Drinkwater Law Offices set up procedures designed to ensure that all files it had with the USPTO were updated with the new address information.

13. In September 2005, I verbally instructed Ms. Hill to file change of address forms with the USPTO to update Drinkwater Law Offices' new address for each file and to use the records saved in the Outlook calendaring and excel spreadsheet system to confirm that each file had been updated. Ms. Hill informed me that she had updated all of the files using the docketing systems. However, the assignment of the '662 patent does not appear to have made it into the docketing system. As a result, it does not appear that Ms. Hill filed a change of address form for the '662 patent. That is the only file Drinkwater Law Offices had with the USPTO that appears to not have been updated with Drinkwater Law Offices' new address.

14. Drinkwater Law Offices never received a notice of renewal for the '662 patent. I suspect this is because the USPTO had the old Drinkwater Law Offices' address, and by the time the notice was sent, no forwarding service was operating.

15. On or about March 8, 2011, Dann Burke of Tachikara contacted Drinkwater Law Offices regarding assigning the '662 patent pursuant to a provision of the 2004 Purchase and Sale Agreement. It was at that time that I searched the USPTO records and discovered that the '662 patent had been abandoned for failure to pay maintenance fees. On March 24, 2011, I notified Dann Burke the '662 patent had been abandoned.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Dated: June 16, 2011

By: Bonnie Drinkwater

Bonnie Drinkwater

EXHIBIT A

July 14 - July 20

July 2008

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August 2008

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Monday, July 14

8:00am 8:30am TRADEMARK: Samantha Fleischer: TWO OF YOU SERVICES w/ DESIGN: Nevada Mark Renewal (08/14/08)

Tuesday, July 15

Wednesday, July 16

Thursday, July 17

Friday, July 18

8:00am 8:30am TM: Sinaps: 77100200 Statement of Use Due 4/20/9
8:30am 9:00am TRADEMARK: RetirementStreet: Retirementstreet.com (2687858): Federal Mark Renewal 5th (02/18/08) - 6th (02/18/09)

Saturday, July 19

Sunday, July 20

July 21 - July 27

July 2008

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Monday, July 21

Tuesday, July 22

Wednesday, July 23

8:00am 8:30am Annual Renewal: Carpediem
8:00am 8:30am Annual Renewal: Global Studio, Inc.
8:00am 8:30am Annual Renewal: R/A Profit$
8:30am 9:00am Annual Renewal: Mustang Memories, LLC
9:00am 9:30am TRADEMARK: Internet Auto: INTERNET AUTO RENT & SALES: Oregon Mark Renewal (09/03/08)
9:30am 10:00am Annual Renewal: Arizona PWP
10:00am 10:30am Annual Renewal: Movement Based Learning, Inc.
11:00am 11:30am Annual Renewal: Schaller Construction-Arizona

Thursday, July 24

Friday, July 25

Saturday, July 26

Sunday, July 27

October 27 - November 02

October 2008

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November 2008

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Monday, October 27

8:00am 8:30am TM: Black Rock Systems, LLC: BLACKROCK EVOLUTION (77/092152): Statement of Use Due (11/27/08)

Tuesday, October 28

Wednesday, October 29

8:00am 8:30am TRADEMARK: EICON: EACCESS LOGO (76264790/2645423): Federal Mark Renewal 6th (11/05/08)

8:30am 9:00am TRADEMARK: EICON: RISH SOURCE LOGO (76264793/2645424): Federal Mark Renewal 6th (11/05/08)

Thursday, October 30

8:00am 9:00am Sinaps: Statement of Use or 2nd Extension is due today

9:00am 9:30am TM: Sinaps: SINAPS, 77100200, Deadline 10/30/08, Specimens or 3rd Extension

Friday, October 31

8:30am 9:00am TRADEMARK: Care Network: EMPLOYERS OCCUPATIONAL HEALTH, INC. (2 Classes): State Mark Renewal (12/02/08)

Saturday, November 01

Sunday, November 02

October 20 - October 26

October 2008

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November 2008

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Monday, October 20

8:00am 8:30am TRADEMARK: EICON: E EMPLOYERS EMPLOYERS INSURANCE GROUP: Nevada Mark Renewal (04/20/09)

Tuesday, October 21

Wednesday, October 22

Thursday, October 23

8:00am 8:30am Annual Renewal: Carpediem - Utah
8:00am 8:30am Annual Renewal: Carrara Group
8:00am 8:30am Annual Renewal: N. NV Regional MLS
8:30am 9:00am Annual Renewal: PWP - Bakersfield
8:30am 9:00am Annual Renewal: PWP - Oregon
8:30am 9:00am Annual Renewal: SEMSA - CA
9:00am 9:30am Annual Renewal: Light+Space
9:00am 9:30am Annual Renewal: October Sun
9:00am 9:30am Annual Renewal: Robert J. Riley
9:30am 10:00am Annual Renewal: BSBG, Inc.
9:30am 10:00am Annual Renewal: ManFu Corp.
10:00am 10:30am Annual Renewal: Employer Success, Inc.
10:30am 11:00am Annual Renewal: JLH, Inc.
10:30am 11:00am Annual Renewal: Two Daughters LLC
11:00am 11:30am Annual Renewal: DA Squared
11:00am 11:30am Annual Renewal: Demolition Tool, Inc.
11:30am 12:00pm Annual Renewal: AGC Manufacturing, LLC
More Items...

Friday, October 24

8:00am 8:30am TRADEMARK: Mills Lane III: Let's Get It On (2220312): Federal Mark Renewal 9th (01/26/08) - 10th (01/26/09)

Saturday, October 25

Sunday, October 26

October 13 - October 19

October 2008

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Monday, October 13

Tuesday, October 14

Wednesday, October 15

Thursday, October 16

8:00am 8:30am TM: Sinaps: SINAPS, 77100200, Deadline 10/30/08, Specimens or 3rd Extension

Friday, October 17

TRADEMARK: Nothing To It: NOTHING TO IT (2218973): Federal Mark Ren

8:00am 8:30am TRADEMARK: Dog Gone Quilts: DOG GONE QUILTS (76365594/2697477): Federal Mark Renewal 5th (03/18/08) - 6th (03/18/09)

8:30am 9:00am TRADEMARK: EICON: EMPLOYERS INSURANCE GROUP (T2301223334): Montana Mark Renewal (04/19/09)

9:00am 9:30am TRADEMARK: EICON: EMPLOYERS INSURANCE GROUP (5639920-0190): Utah Mark Renewal (04/19/09)

9:30am 10:00am TRADEMARK: EICON: E EMPLOYERS EMPLOYERS INSURANCE GROUP W/DESIGN: Montana Mark Renewal (04/19/09)

10:00am 10:30am TRADEMARK: Neighborhood Mediation Center: GOLDEN CHOICES: Nevada Mark Renewal (11/17/08)

Saturday, October 18

Sunday, October 19

October 06 - October 12

October 2008

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Monday, October 06

Tuesday, October 07

8:00am 8:30am TRADEMARK: Tachikara: SENSI-TEC (76398397/2770968): Federal Mark Renewal 5th (10/07/08) - 6th (10/07/09)

Wednesday, October 08

8:00am 8:30am TRADEMARK: EICON: EMPLOYERS INSURANCE COMPANY OF NEVADA LOGO (76264791/2630934): Federal Mark Renewal 6th (10/08/08)

8:30am 9:00am TM: MLS: Statement of Use or Extension for the MLSTIMATE mark: January 8, 2009: Serial No. 77319904

Thursday, October 09

8:30am 9:00am TRADEMARK: EICON: E Logo (76264792/2671343): Federal Mark Renewal 5th (01/09/08) - 6th (01/09/09)

Friday, October 10

8:00am 8:30am TRADEMARK: Internet Auto Rent & Sales: INTERNET AUTO RENT & SALES (logo): California Mark Renewal (11/10/08)

Saturday, October 11

Sunday, October 12

EXHIBIT B

DRINKWATER LAW OFFICES
A PROFESSIONAL CORPORATION
6490 SOUTH MCCARRAN BLVD.
BUILDING B, SUITE 15
RENO NV 89509

February 8, 2005

Dann Burke
Tachikara U.S.A., Inc.
958 United Circle
Sparks, NV 89431

Re: Recordation

Dear Dann:

Enclosed is the United States Patent and Trademark Notice of Recordation for Patent No. 5542662, reflecting the assignment of the patent from Tachikara Co., Ltd. to Tachikara U.S.A., Inc.

If you have any questions regarding the recordation, please feel free to contact me.

Sincerely,

DRINKWATER LAW OFFICES

Bonnie Drinkwater

Bonnie Drinkwater, Esq.

Enclosure

TELEPHONE (775) 828-0800
FAX (775) 828-0858

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

FEBRUARY 01, 2005

PTAS

102805194A

DRINKWATER LAW OFFICES
BONNIE DRINKWATER
6490 S. MCCARRAN BLVD.
SUITE B-15
RENO, NV 89509

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 08/02/2004

REEL/FRAME: 015629/0245
NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
TACHIKARA CO., LTD.

DOC DATE: 07/01/2004

ASSIGNEE:
TACHIKARA U.S.A., INC.
958 UNITED CIRCLE
SPARKS, NEVADA 89431

SERIAL NUMBER: 08355707
PATENT NUMBER: 5542662
TITLE: SPORTS BALL AND PRODUCTION METHOD THEREOF

FILING DATE: 12/14/1994
ISSUE DATE: 08/06/1996

DIANE RUSSELE, PARALEGAL
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

Schedule 2.2(a)ii (TJ to sign)

08-04-2004

8.2.04

Form PTO-1595 (Rev. 10/02)
OMB No. 0651-0027 (exp. 6/30/2005)
Tab settings ⇨⇨⇨

102805194

U.S. DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

TACHIKARA CO., LTD.

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

Execution Date: JULY 1, 2004

2. Name and address of receiving party(ies)

Name: TACHIKARA U.S.A., INC.

Internal Address: _____

Street Address: 958 UNITED CIRCLE

City: SPARKS State: NV Zip: 89431

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s) _____

B. Patent No.(s) 5,542,662

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: BONNIE DRINKWATER

Internal Address: DRINKWATER LAW OFFICES

Street Address: 6490 S. McCARRAN Blvd. SUITE B-15

City: RENO State: NV Zip: 89509

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 3.41) $ 40.00

☒ Enclosed

☐ Authorized to be charged to deposit account

8. Deposit account number:

_____

DO NOT USE THIS SPACE

9. Signature.

Mr. Hirobumi Kaihoko, Pres. _____ July 01, 2004
Name of Person Signing Signature Date

Total number of pages including cover sheet, attachments, and documents: 8

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents & Trademarks, Box Assignments
Washington, D.C. 20231

08/03/2004 MGETACHE 00000069 5542662
01 FC:8021 40.00 OP

02 AUG -2 PM 8:00
OPR/FINANCE

Schedule 2.2(a)i

ASSIGNMENT OF PATENT

WHEREAS, Tachikara Co., Ltd., a corporation organized and existing under the laws of Japan ("Assignor"), owns that certain patent for a sports ball and (balloon bladder) production method thereof invented by Keiji Kouzai and Junichi Tanaka and filed in the United States Patent and Trademark Office on December 14, 1994 and which was assigned Patent Number 5,542,662 (the "Patent"); and

WHEREAS, Tachikara U.S.A., Inc., a Nevada corporation ("Assignee"), has entered into that certain Agreement of Purchase and Sale of Intellectual Property and Patent License with Assignor in which Assignor has agreed to sell the Patent to Assignee.

NOW, THEREFORE, for valuable consideration, receipt whereof is hereby acknowledged, Assignor hereby sells, assigns and transfers to Assignee, its successors and assigns, the entire right, title and interest for the United States and elsewhere throughout the world (where such rights may exist onto Assignor), in and to said Patent and inventions related thereto, including any and all divisions and continuations thereof, all rights of priority under the terms of the International Convention for the Protection of Industrial Property, and any and all Letters Patent which may be granted thereon, including any and all renewals, reissues and prolongations thereof, with all the rights, powers, privileges, and advantages in any way arising from or pertaining thereto, for and during the term or terms of any and all such Letters Patent when granted, including any and all renewals, reissues and prolongations thereof, for the use and benefit of said Assignee assigns and legal representatives, in as ample and as beneficial a manner for all intents and purposes as said Assignor might or could have held and enjoyed the same had this assignment not been made.

ASSIGNOR:

Tachikara Co., Ltd.

By: _____ Date: July 1, 2004

Name: Hirobumi Kaihoko

Title: President

DECLARATION OF DANN BURKE

I, Dann Burke, do hereby declare and state:

1. I have been the President and CEO of Tachikara USA, Inc. ("Tachikara") since April 6, 1993. I have personal knowledge of the facts stated herein and can testify competently to them if called upon to do so.

2. Tachikara has been operating since April 6, 1993 and imports and distributes inflatable sports balls.

3. Tachikara has been a client of Drinkwater Law Offices ("DLO") since about November 1, 2002, when DLO began prosecuting several trademark files for Tachikara.

4. In about July 2004, Tachikara entered into a Purchase and Sale Agreement whereby it acquired United States Patent No. 5,542,662 (the "'662 patent"), relating to a sports ball and (balloon bladder) production method, and several U.S. and Canadian trademark assets. DLO prepared the Purchase and Sale Agreement.

5. The '662 patent is the only patent that Tachikara has ever owned. I have never owned any patents and, with the exception of my involvement with the Purchase and Sale Agreement, I have had very little experience with patents.

6. On September 19, 2007, Tachikara engaged DLO to consolidate the handling of all of Tachikara's intellectual property, including the '662 patent and the trademark assets acquired in the Purchase and Sale Agreement. This is before the third maintenance fee was due by February 6, 2008, or due by August 6, 2008, with surcharge. The engagement letter with DLO states "Intellectual Property Matter" as the area of service provided. I understood patents were included in "Intellectual Property Matters." See the Engagement Letter (EXHIBIT A). See also the letter dated September 19, 2007, instructing the transfer of all of Tachikara's Intellectual Property files from Guild, Russell, Gallagher & Fuller, Ltd. to Drinkwater Law

Offices (EXHIBIT B). During my discussions with Bonnie Drinkwater of DLO about consolidating my Intellectual Property Matters with DLO, she told me that DLO had a calendaring system for monitoring IP renewals. I therefore understood that DLO was taking responsibility for tracking in the calendaring system any payments required to maintain in force the '662 patent and the trademark assets acquired in the Purchase and Sale Agreement.

7. In about July 2004, I authorized DLO to file with the United States Patent and Trademark Office ("USPTO") a copy of the Purchase and Sale Agreement assigning the '662 patent to Tachikara. See Recordation Letter from DLO addressed to me, reporting the successful recordation and including the Notice of Recordation (EXHIBIT C).

8. In September 2005, DLO notified me that it was relocating to its current location, 5421 Kietzke Lane, Suite 100, Reno, NV 89511 and all services would continue as expected.

9. In October 2006, DLO contacted me regarding the payment due for the second 10-year renewal of Tachikara's U.S. Trademark Registration No. 1067737 ("TACHIKARA") in International Classes 025 and 028, which Tachikara acquired in the Purchase and Sale Agreement. In or around October 2006 I authorized payment of the second 10-year renewal and DLO paid the fee. See attached email from Bonnie Drinkwater of DLO reporting the successful renewal of Registration No. 1067737 (EXHIBIT D). Please also see letter dated March 7, 2007, in which DLO states, with respect to the next renewal for Registration No. 1067737, due between June 2016 and June 2017: "We have calendared this renewal..." (EXHIBIT E). So it is clear that, prior to consolidating all of my Intellectual Property Matters with DLO, I was advised that DLO calendared as a way to maintain Intellectual Property for which it is responsible.

10. In May 2008, DLO contacted me regarding the payment due for the second 10-year renewal of Tachikara's U.S. Trademark Registration No. 1100821 ("TACHIKARA"

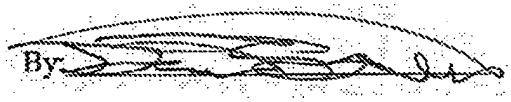
design) in International Classes 025 and 028, which Tachikara acquired in the Purchase and Sale Agreement. On or around May 13, 2008, I authorized the second 10-year renewal and DLO paid the fee on my behalf. See attached May 13, 2008, e-mail from Bonnie Drinkwater of DLO confirming the renewal and stating: "I've calendared the next renewal..." (EXHIBIT F).

11. On March 8, 2011, I sent an email to Bonnie Drinkwater at DLO about assigning the '662 patent, pursuant to a provision of the 2004 Purchase and Sale Agreement (EXHIBIT G). On March 24, 2011 I received a phone call from Bonnie Drinkwater stating the '662 patent had been abandoned for failure to pay the maintenance fee.

12. On March 24, 2011, I immediately consulted DLO about reviving the '662 patent. DLO recommended the assistance of an outside party. I was referred to Fincham Downs, LLC. On May 4, 2011, I engaged Fincham Downs, LLC to assist me with preparing a petition to accept delayed payment of the third maintenance fee for the '662 patent.

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Dated: June 16, 2011

By: 

Dann Burke, Pres. & CEO

TACHIKARA USA, Inc.

EXHIBIT A

DRINKWATER LAW OFFICES
A Professional Corporation
6490 South McCarran Blvd.
Building B, Suite 15
Reno NV 89509

November 5, 2002

Dann Burke
Tachikara U.S.A., Inc.
958 United Circle
Sparks, NV 89431

Re: Engagement Letter: Tachikara U.S.A., Inc. - Intellectual Property Matters

Dear Dann:

This letter serves to inform you that this firm is pleased to act as counsel in the above-referenced matter and to thank you for selecting us. We have performed a conflict check on our system and no conflict of interest was identified.

You have asked this firm to assist Tachikara U.S.A., Inc. with intellectual property matters.

This letter further serves to inform you what you can expect from us and what I hope we can expect from you during the course of this representation. I will provide legal services in connection with Tachikara U.S.A., Inc.'s intellectual property matters. We have agreed to a $200/hour fee, plus costs.

We reserve the right to increase or decrease our hourly rates at year-end, dependent upon market demands in existence at that time. Should we make changes to our rates, you will be informed in advance. A monthly billing will be sent to you from this firm. The billings will contain a detailed statement of services performed including the identity of the person who performed the work, the time spent and the hourly rate of that person together with expenses incurred. Please do not hesitate to ask any questions that you may have about any item on any bill. We will see that you are provided with answers to your questions and that billing errors, if any, are corrected immediately.

Telephone: (775) 828-0800
Fax: (775) 828-0858
bdrinkwater@drinkwaterlaw.com

Your assistance is essential to our proper representation of you, therefore, I will from time to time send you copies of papers which involve that matter and ask that you review each promptly and give me your comments, if you have any, as quickly as you can.

You retain the right to terminate our representation in this matter at any time by written notice to me. Similarly, we reserve the right to stop representing you in this or any other matter should we determine that we do not wish to continue. Should either of us terminate the representation, we will return your papers to you or as you direct.

At all times please feel free to ask any questions of me about the matters we are handling, about the things we may do in representing you, or about our billings. I find that continued and open communication and understanding between this firm and our clients is essential to effective representation. This letter is written in that spirit.

If this letter accurately reflects your understanding of our representation, would you please sign the enclosed copy of this letter and return it to me so we both may be sure that we have a correct understanding of our professional relationship.

Sincerely,

DRINKWATER LAW OFFICES,

Bonnie Drinkwater

Bonnie Drinkwater, Esq.

Client's Agreement to Terms and Conditions of Representation

The foregoing is accepted and correctly states our arrangement.

Dated this 7th day of November, 2002.

By: _____

Dann Burke, Pres. of Toshiba USA, Inc.

Telephone: (775) 828-0800
Fax: (775) 828-0858
bdrinkwater@drinkwaterlaw.com

EXHIBIT B

TACHIKARA

NV-W7089-0907
Wednesday, September 19, 2007

Mr. John K. Gallagher, Esq.
Guild, Russell, Gallagher & Fuller, Ltd.
100 West Liberty Street
Suite 800
P.O. Box 2838
Reno, Nevada 89505

Dear John:

We thank you for your past services.

Please transfer all Tachikara files to Drinkwater Law Offices. Their contact information is:

Mrs. Bonnie Drinkwater, Esq.
Drinkwater Law Offices
5421 Kietzke Lane
Suite 100
Reno, Nevada 89511
PH: 828-0800

Please contact Drinkwater Law Offices and they will arrange to pick-up the files. Thank you.

Wishing you many years of success and good health.

Sincerely Yours,
TACHIKARA

Dann Burke
President / CEO

cc: Mrs. Bonnie Drinkwater, Esq. / Mrs. Terry Moberly

TACHIKARA
100 Ireland Drive
McCarran, NV 89434
(775) 352-3500 • FAX (775) 352-3518

www.tachikara.com

TACHIKARA
8000 West 110th Street, Suite 150
Overland Park, KS 66210-2382
(913) 498-1881 • FAX (913) 498-1882

EXHIBIT C

DRINKWATER LAW OFFICES
A PROFESSIONAL CORPORATION
6490 SOUTH MCCARRAN BLVD.
BUILDING B, SUITE 15
RENO NV 89509

February 8, 2005

Dann Burke
Tachikara U.S.A., Inc.
958 United Circle
Sparks, NV 89431

Re: Recordation

Dear Dann:

Enclosed is the United States Patent and Trademark Notice of Recordation for Patent No. 5542662, reflecting the assignment of the patent from Tachikara Co., Ltd. to Tachikara U.S.A., Inc.

If you have any questions regarding the recordation, please feel free to contact me.

Sincerely,

DRINKWATER LAW OFFICES

Bonnie Drinkwater

Bonnie Drinkwater, Esq.

Enclosure

TELEPHONE (775) 828-0800
FAX (775) 828-0858

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

FEBRUARY 01, 2005

PTAS

102805194A

DRINKWATER LAW OFFICES
BONNIE DRINKWATER
6490 S. MCCARRAN BLVD.
SUITE B-15
RENO, NV 89509

UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 08/02/2004

REEL/FRAME: 015629/0245
NUMBER OF PAGES: 2

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
TACHIKARA CO., LTD.

DOC DATE: 07/01/2004

ASSIGNEE:
TACHIKARA U.S.A., INC.
958 UNITED CIRCLE
SPARKS, NEVADA 89431

SERIAL NUMBER: 08355707
PATENT NUMBER: 5542662
TITLE: SPORTS BALL AND PRODUCTION METHOD THEREOF

FILING DATE: 12/14/1994
ISSUE DATE: 08/06/1996

DIANE RUSSELE, PARALEGAL
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

Schedule 2.2(a)ii (TJ to sign)

08-04-2004

8.2.04

Form PTO-1595 (Rev. 10/02)
OMB No. 0651-0027 (exp. 6/30/2005)
Tab settings ⇨ ⇨ ⇨

102805194

U.S. DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

TACHIKARA CO., LTD.

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

Execution Date: JULY 1, 2004

2. Name and address of receiving party(ies)

Name: TACHIKARA U.S.A., INC.

Internal Address: _____

Street Address: 958 UNITED CIRCLE

City: SPARKS State: NV Zip: 89431

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s) _____

B. Patent No.(s) 5,542,662

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: BONNIE DRINKWATER

Internal Address: DRINKWATER LAW OFFICES

Street Address: 6490 S. McCARRAN Blvd. SUITE B-15

City: RENO State: NV Zip: 89509

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 3.41) $ 40.00

☒ Enclosed

☐ Authorized to be charged to deposit account

8. Deposit account number:

2004 AUG -2 AM 8:00
OPR/FINANCE

DO NOT USE THIS SPACE

9. Signature.

Mr. Hirobumi Kaihoko, Pres. _____ July 01,2004
Name of Person Signing Signature Date

Total number of pages including cover sheet, attachments, and documents: 2

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents & Trademarks, Box Assignments
Washington, D.C. 20231

08/03/2004 MGETACHE 00000069 5542662
01 FC:8021 40.00 OP

Schedule 2.2(a)i

ASSIGNMENT OF PATENT

WHEREAS, Tachikara Co., Ltd., a corporation organized and existing under the laws of Japan ("Assignor"), owns that certain patent for a sports ball and (balloon bladder) production method thereof invented by Keiji Kouzai and Junichi Tanaka and filed in the United States Patent and Trademark Office on December 14, 1994 and which was assigned Patent Number 5,542,662 (the "Patent"); and

WHEREAS, Tachikara U.S.A., Inc., a Nevada corporation ("Assignee"), has entered into that certain Agreement of Purchase and Sale of Intellectual Property and Patent License with Assignor in which Assignor has agreed to sell the Patent to Assignee.

NOW, THEREFORE, for valuable consideration, receipt whereof is hereby acknowledged, Assignor hereby sells, assigns and transfers to Assignee, its successors and assigns, the entire right, title and interest for the United States and elsewhere throughout the world (where such rights may exist onto Assignor), in and to said Patent and inventions related thereto, including any and all divisions and continuations thereof, all rights of priority under the terms of the International Convention for the Protection of Industrial Property, and any and all Letters Patent which may be granted thereon, including any and all renewals, reissues and prolongations thereof, with all the rights, powers, privileges, and advantages in any way arising from or pertaining thereto, for and during the term or terms of any and all such Letters Patent when granted, including any and all renewals, reissues and prolongations thereof, for the use and benefit of said Assignee assigns and legal representatives, in as ample and as beneficial a manner for all intents and purposes as said Assignor might or could have held and enjoyed the same had this assignment not been made.

ASSIGNOR:

Tachikara Co., Ltd.

By: _____ Date: July 1, 2004

Name: Hirobumi Kaihoko

Title: President

Subj: **FW: Received Your Combined Declaration of Use of Mark in Commerce and Application for Renewal of Registration of a Mark under Section 8 & 9 Form for registration number 1067737**
Date: 10/26/2006 10:21:52 AM Pacific Standard Time
From: bdrinkwater@drinkwaterlaw.com
To: DannBurke@aol.com
CC: chill@drinkwaterlaw.com

Dann,

I successfully filed the renewal of the Tachikara trademark. The next renewal will be due between June 14, 2016 and June 14, 2017. Please let me know if you have any questions. Thanks!

Bonnie

From: teas@uspto.gov [mailto:teas@uspto.gov]
Sent: Thursday, October 26, 2006 10:18 AM
To: bdrinkwater@drinkwaterlaw.com
Subject: Received Your Combined Declaration of Use of Mark in Commerce and Application for Renewal of Registration of a Mark under Section 8 & 9 Form for registration number 1067737

We have received your Combined Sections 8 and 9 Declaration/Application for registration number '1067737'. A summary of your submission is listed below. If you determine that you made an error in the information you entered, **DO NOT** request any changes by e-mail, because the TEAS Support Team cannot make corrections. You may submit a new document and new fees, if time remains in the statutory period; however, the USPTO will not refund any fees paid as part of this current submission. For further information, please contact the Post Registration Division at (571) 272-9500, and ask to speak to an Affidavit Renewal Examiner. Or, see Chapter 1600 of the Trademark Manual of Examining Procedure, at http://tess2.uspto.gov/tmdb/tmep/1600.htm

REGISTRATION NUMBER: 1067737
REGISTRATION DATE: 06/14/1977

MARK: TACHIKARA

The owner, TACHIKARA U.S.A., INC., having an address of 100 Ireland Dr., McCarran, Nevada US 89434, is filing a Combined Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9.

For International Class 025, the owner, or its related company, is using the mark in commerce on or in connection with all goods or services listed in the existing registration for this class; or, the owner is claiming excusable non-use for this entire class.

The owner is submitting one specimen showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) digital photographs of clothing items containing the trademark.

For International Class 028, the owner, or its related company, is using the mark in commerce on or in connection with all goods or services listed in the existing registration for this class; or, the owner is claiming excusable non-use for this entire class.

The owner is submitting one specimen showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) Digital photo of volleyball and packaging containing the trademark.

The registrant hereby appoints Bonnie Drinkwater to file this Combined Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9 on behalf of the registrant.

EXHIBIT E

DRINKWATER LAW OFFICES
A PROFESSIONAL CORPORATION
5421 KIETZKE LANE
SUITE 100
RENO, NEVADA 89511

March 7, 2007

Dann Burke
Tachikara U.S.A.
100 Ireland Drive
McCarran, NV 89434

Re: TACHIKARA (Registration No. 1067737)

Dear Dann:

The enclosed Notice of Acceptance/Notice of Acknowledgement was recently received from the United States Patent and Trademark Office. This document is confirmation that the above-referenced registration was maintained as required by the Trademark Act.

The mark will need to be renewed again between June 2016 and June 2017. We have calendared this renewal and we suggest that Tachikara U.S.A. note the renewal as well.

If you have any questions, please contact me.

Sincerely,

DRINKWATER LAW OFFICES

Bonnie Drinkwater

Bonnie Drinkwater, Esq.

Enclosure

TELEPHONE (775) 828-0800
FAX (775) 828-0858

EXHIBIT F

Subj: **FW: Received Your Combined Declaration of Use of Mark in Commerce and Application for Renewal of Registration of a Mark under Section 8 & 9 for registration number 1100821**
Date: 5/13/2008 2:01:51 P.M. Pacific Daylight Time
From: bdrinkwater@drinkwaterlaw.com
To: DannBurke@aol.com

Dann,

This is the confirmation of the renewal for the Tachikara logo in connection with balls. Please keep it for your records. I've calendared the next renewal in 10 years.

Bonnie

From: teas@uspto.gov [mailto:teas@uspto.gov]
Sent: Tuesday, May 13, 2008 1:58 PM
To: Bonnie Drinkwater
Subject: Received Your Combined Declaration of Use of Mark in Commerce and Application for Renewal of Registration of a Mark under Section 8 & 9 for registration number 1100821

We have received your Combined Sections 8 and 9 Declaration/Application for registration number '1100821'. A summary of your submission is listed below. If you determine that you made an error in the information you entered, **DO NOT** request any changes by e-mail, because the TEAS Support Team cannot make corrections. You may submit a new document and new fees, if time remains in the statutory period; however, the USPTO will not refund any fees paid as part of this current submission. For further information, please contact the Post Registration Division at (571) 272-9500, and ask to speak to an Affidavit Renewal Examiner. Or, see Chapter 1600 of the Trademark Manual of Examining Procedure, at http://tess2.uspto.gov/tmdb/tmep/1600.htm

REGISTRATION NUMBER: 1100821
REGISTRATION DATE: 08/29/1978

MARK: TACHIKARA (stylized and/or with design)

The owner, TACHIKARA U.S.A., INC., having an address of 100 Ireland Drive, McCarran, Nevada, United States 89434, is filing a Combined Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9.

For International Class 025, the owner, or its related company, is NOT using the mark in commerce on or in connection with any of the goods or services listed in the existing registration for this specific class, and is NOT claiming excusable non-use for any of the goods or services listed in the existing registration for this specific class. This entire class is to be **deleted** from the registration.

For International Class 028, the owner, or its related company, is using the mark in commerce on or in connection with all goods or services listed in the existing registration for this class; or, the owner is claiming excusable non-use for this entire class.

The owner is submitting one specimen showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) a digital photograph of a volleyball and its packaging that both contain the trademark.

EXHIBIT G

Subj: **Assignment of Patent**
Date: 3/8/2011 11:55:48 A.M. Pacific Daylight Time
From: DannBurke@aol.com
To: bdrinkwater@drinkwaterlaw.com

Dear Bonnie,

Please give me a call so we can celebrate on the phone. :)

Hard to believe it has been almost 7 years since we executed the "Agreement of Purchase and Sale of Intellectual Property and Patent License" agreement dated July 1, 2004.

Since we started the Agreement together, I thought you might enjoy helping me take some of the last few steps. This is a wonderful moment that I struggled and worried about reaching for many years...

On April 15, 2011, we will make our final payment for a total debt payoff of $4,096,685.97.

Please refer to section 7.3.3 of the July 1, 2004 Agreement (see attached). Once paid in full, we are to gladly transfer a patent right to Yuan Chi Overseas Ltd. & Oriental Spirit Ltd, a Taiwan Corporation.

Please prepare the following for my signature:

1) Assignment of Patent No. 5,542,662 dated April 15, 2011;

2) Filing of recordation of Assignment with the USPTO, Dated April 15, 2011.

Please date all paperwork for April 15, 2011 and send to me (Assignor) for signature.

On April 15, 2011, let's discuss to be sure final payment is completed by me. Then, please submit Assignment with the USPTO.

I'll then forward copies to Yuan Chi.

Here is the necessary information:

1) Patent No. 5,542,662.

2) Assignee: Yuan Chi Yuan Chi Overseas Ltd. & Oriental Spirit Ltd., a Taiwan Corporation.

3) Assignee Address:

Yuan Chi Overseas Ltd. & Oriental Spirit Ltd.
9F, No. 47, Lane 3, Jihu Road
Neihu Chiu
Taipei, Taiwan 114 R.O.C.

Also attached, please find a copy of the original assignment paperwork filed in 2004.

Thank you for your help.

Take care,
Dann

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

MAILED

SEP 21 2011

OFFICE OF PETITIONS

ROPES & GRAY LLP
IPRM - Floor 43
PRUDENTIAL TOWER
800 BOYLSTON STREET
BOSTON MA 02199-3600

In re Application of :
Ingham et al. :
Application No. 08/356060 :
Filing or 371(c) Date: 12/14/1994 : ON PETITION
Patent No. 5844079 :
Issue Date: 12/01/1998 :
Title of Invention: :
VERTEBRATE EMBRYONIC PATTERN- :
INDUCING PROTEINS, AND USES :
RELATED THERETO :

This is a notice regarding 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.

A review of the petition reveals that the address appearing on the petition differs from the correspondence address of record. Applicant is advised that, in patented files: requests for changes of correspondence address, powers of attorney, revocations of powers of attorney, withdrawal of attorney and submissions under 37 CFR 1.501: Designation of, or changes to, a fee address, should be addressed to Mail Stop M Correspondence.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods
Attorney
Office of Petitions

CC: ANNE CRAIG
DIRECTOR OF INTELLECTUAL PROPERTY
PRESIDENT AND FELLOWS OF HARVARD COLLEGE
17 QUINCY STREET
CAMBRIDGE, MA 02138

UNITED STATES PATENT AND TRADEMARK OFFICE

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NOV 30 2011

OFFICE OF PETITIONS

Ballard Spahr LLP
SUITE 1000
999 PEACHTREE STREET
ATLANTA GA 30309-3915

In re Application of :
Misch et al. :
Application No. 08/356597 :
Filing or 371(c) Date: 12/15/1994 : ON PETITION
Patent No. 5628630 :
Issue Date: 05/13/1997 :
Title of Invention: :
DESIGN PROCESS FOR SKELETAL :
IMPLANTS TO OPTIMIZE CELLULAR :
RESPONSE :

This is a notice regarding 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).

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Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods
Attorney
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5745340	1998-04-28	08358838	1994-12-19	LND 301

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/David S. D'Ascenzo/	Date (YYYY-MM-DD)	2011-03-01
Name	David S. D'Ascenzo	Registration Number	39952

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5745340 :
Issue Date: April 28,1998
Application No. 08358838 :DECISION GRANTING PETITION
Filed: December 19,1994 :UNDER 37 CFR 1.378(c)
Attorney Docket No. :

This is a decision on the electronic petition, filed March 1,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of March 1,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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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WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON MA 02210-2206

MAILED

MAY 06 2011

OFFICE OF PETITIONS

In re Patent No. 5,722,067
Issue Date: February 24, 1998
Application No. 08/364,479
Filed: December 23, 1994
Attorney Docket No. 200990001

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed February 28, 2011.

The petition is **DISMISSED**.

Petitioner is being provided with a non-extendable **one (1) month** period for reply to comply with the requirements of 37 CFR 1.28.

Petitioner has submitted authorization to charge the large entity for the 11.5 year maintenance fee. However, a review shows that a 6 month surcharge was also submitted on December 2, 2009. The 6 month surcharge was paid as a small entity. As such an additional $65.00 is required to make up the fee deficiency. Although petitioner has provided an authorization to charge the 11.5 year deficiency in the amount of $2,055, a general authorization to charge any additional fees has not been provided.

It is further noted that the request submitted contained the incorrect application number (08/364.476). The correct application number is 08/364,479.

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

Inquiries related to this communication 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

SEP 13 2011

Jeffrey P. Kushan
Sidley Austin LLP
Attn: Docketing Dept.
1501 K Street, NW
Washington, DC 20005

Re: Patent Term Extension
Application for
U.S. Patent No. 5,739,152

WITHDRAWAL OF APPLICATION FOR PATENT TERM EXTENSION

This is in response to the election of U.S. Patent No. 5,856,346, filed April 18, 2011, for patent term extension based on the regulatory review of CLEVIPREX® (clevidipine butyrate).

Because U.S. Patent No. 5,739,152 was NOT elected, the application is withdrawn.

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

By mail: Mail Stop Hatch-Waxman PTE
P.O. Box 1450
Alexandria, VA 22313-1450

Telephone inquiries related to this determination should be directed to the undersigned at (571) 272-7755. E-mail inquiries should be directed to mary.till@uspto.gov.

Mary C. Till
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

Attention: Beverly Friedman

RE: CLEVIPREX® (clevidipine butyrate)
Docket No.: FDA-2009-E-0017

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5797856	1998-08-25	08368871	1995-01-05	A-60223/HCH / 44755.10

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☒ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
◯	3 ½ year	(1551)	◯	3 ½ year	(2551)
◯	7 ½ year	(1552)	◯	7 ½ year	(2552)
◉	11 ½ year	(1553)	◯	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

◯ A sole patentee

◯ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

◯ A joint patentee; all of whom are signing this e-petition

◯ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Gregory P. Webb/	Date (YYYY-MM-DD)	2010-10-28
Name	Gregory P. Webb	Registration Number	59859

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5797856
Issue Date: August 25,1998
Application No. 08368871
Filed: January 5,1995
Attorney Docket No. A-60223/HCH

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 28,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 28,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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AUG 11 2010

OFFICE OF PETITIONS

HARRY I LEON
924 BOWEN STREET NW
ATLANTA GA 30318

In re Patent No. 5,506,424 : Paper No. 09
Issue Date: April 09, 1996 :
Application 08/369,417 : DECISION ON PETITION
Filed: January 06, 1995 :
:

This is a decision on the petition under 37 CFR 1.378(c), filed on May 17, 2010, with a certificate of mailing dated May 12, 2010, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

The above-identified patent issued on April 09, 1996. Therefore, the period set forth in 35 U.S.C. § 41(b) for paying the eleven and one-half year maintenance fee expired on April 09, 2008.

A petition under 37 CFR 1.378(c) must be filed within twenty-four months after the six month grace period specified in 35 USC 41(b). The six months grace period for the instant patent expired at midnight on April 09, 2008. Accordingly, an unintentional petition to reinstate the instant patent must have been submitted no later than April 09, 2010. Since the petition was not timely filed, the instant patent will not be considered for reinstatement under the unintentional provisions of 37 CFR 1.378(c).

35 U.S.C. § 41(c)(1) authorizes the Commissioner to accept a delayed maintenance fee payment within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) if the delay is shown to have been unintentional, and authorizes the Commissioner to accept a delayed maintenance fee payment at any time if the delay is shown to have been unavoidable. Thus, 35 U.S.C. § 41(c)(1) does not authorize the Commissioner to accept a delayed maintenance fee payment later than twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) unless the delay is shown to have been unavoidable. Since the instant petition was not filed within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b), the Commissioner cannot accept a delayed maintenance fee payment for the above-identified patent under 37 CFR 1.378(c).

Should petitioner wish to pursue reinstatement of the above-identified patent on the basis of unavoidable delay, petitioner should file a petition under 35 U.S.C. § 41(c) and 37 CFR 1.378(b), which must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

If petitioner does not wish to pursue reinstatement of this expired patent, petitioner may request a refund of the $3,695 submitted with the instant petition. The request should be made in writing and addressed to: Mail Stop 16, Director of the U.S. Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

Petitioner should note that 1.378(d) requires that the petition under 1.378 for delayed payment of maintenance fees must be signed by an attorney or agent registered to practice before the Office, or by the patentee, the assignee, or other party in interest. It is not clear from the record if the petitioner whose signature is on the instant petition is authorized to sign this petition under 1.378(d).

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of fee address (form PTO/SB/47) and a request for customer number (form PTO/SB/125) should be filed in accordance with Manual of Patent Examining Procedure, section 2540. A courtesy copy of this decision is being mailed to the address on the petition. However, the Office will mail all future correspondence solely to the address of record.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. 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 the delay in paying the maintenance fee under 37 CFR 1.378(c) was intentional, petitioner must notify the Office.

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

By Mail:	Mail Stop PETITIONS Commissioner for Patents Post Office Box 1450 Alexandria, VA 22313-1450
By Hand:	Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22314
By Fax:	(571) 273-8300 ATTN: Office of Petitions

Any questions concerning this matter may be directed to Tredelle Jackson at (571) 272-2783.

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

cc: **ROBERT L. BRYANT**
6991 PEACHTREE INDUSTRIAL BLVD.,
BLDG. 600
NORCROSS GA 30092

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

SPENCER FRANK AND SCHNEIDER
SUITE 300 EAST
1100 NEW YORK AVENUE NW
WASHINGTON DC 20005-3955

MAILED
APR 19 2011
OFFICE OF PETITIONS

Paper No. 26

In re Patent No. 5,891,693
Issue Date: April 6, 1999
Application No. 08/376,380
Filed: January 23, 1995
Inventor: Christopher R. Bebbington et al

DECISION ON PETITION

This is a decision on the petition for expungement of information, filed September 28, 2010, which is being treated as petitions under 37 CFR 1.182 to invalidate an assignment previously recorded against the above-identified application.

The petition is **dismissed**. This is not a final agency action.

Petitioner indicates an assignment recorded on August 1, 2006 was erroneously filed for the above identified application and requests this assignment record be expunged from the file.

As discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or "expunge" assignment records are granted only if the petitioner can prove that:

(A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and
(B) the integrity of the assignment records will not be affected by granting the petition.

In regard to B, petitioner has not sufficiently explained how the removal of a document in its entirety will not affect the assignment records. The removal of a document in its entirety will affect the assignment records. The integrity of the records is recognized as separate from the chain of title, and the USPTO endeavors to maintain a complete history of claimed interests in a given property to permit, among other things, the review of matters like chain of title by a competent authority.

Moreover, petitioner seeks an extraordinary remedy, properly addressed under 37 CFR 1.182. The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982).

As set forth in MPEP 323, an error in a recorded assignment is not corrected by invalidating the previous document, but by simply submitting a "corrective document". The "corrective document" must include 1) a copy of the original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and 2) a new Recordation Form Cover Sheet (form PTO-1595). The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06. Petitioner should note that the "assignment documents" and "corrective documents" are not limited to assignments, but include any documents affecting title to a patent or application. See MPEP § 313.

Therefore, the rules of practice and the procedures before the USPTO provide an avenue for the requested relief without relying upon extraordinary measures. That is, the chain of title can be clarified in the assignment records through the recording of a corrective document. As a request for the Office to invalidate an assignment is both extraordinary and contrary to USPTO policy, this petition must be dismissed.

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 USC 261 and 37 CFR 3.11. However, the recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. Moreover, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment document will be retained, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992).

Furthermore, it is well settled that the Office is not the appropriate forum for resolving a dispute concerning the ownership of an application or patent, and, as such, the USPTO will not permit itself to become embroiled in ownership disputes, particularly as it does not have the means or the authority to resolve such disputes. Indeed, the USPTO has no authority to decide ownership issues. See Cedars-Sinai Medical Center v. Watkins, 11F.3d 1573, 1581 n.10, 29 USPQ 2d 1188, 1194 n.10 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. (1994). Rather, state law governs contractual obligations and transfers of property rights, including those relating to patents. See Regents of the University of New Mexico v. Knight, 66 USPQ2d 1001, 1008 (Fed. Cir. 2003). The USPTO cannot settle disputes as to title as a judicial tribunal is the appropriate forum to resolve such controversy. See Jim Arnold Corp. v. Hydrotech Sys., Inc., 109 F.3d 1567, 1572, 42 USPQ2d 1119, 1123 (Fed. Cir. 1997)("the question of who owns the patent right and on what terms typically is a question exclusively for state courts"); Roach v. Crouch, 24 N.W. 2d 400, 33

USPQ2d 1361 (Iowa 1994)(patent ownership issue properly triable in state court); In re Haines, 1900 C.D. 102, 103 (Comm'r Pat. 1900)(same).

If petitioner is successful in resolving this dispute, the proper documentation should be promptly submitted to the USPTO for recordation against the patent.

Also, Office records do not indicate that a change of address has been filed in this case, although the address given on the petition differs from the address of record. If appropriate, 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.

A petition to expunge assignment documents is properly addressed under 37 CFR 1.182 and a fee of $400.00 is required. The $400 petition fee has been charged to petitioner's deposit account.

Telephone inquiries concerning this communication should be directed to Carl Friedman at (571)272-6842.

Christopher Bottorff
Supervisor
Office of Petitions

Cc: Womble Carlyle Sandridge & Rice PLLC
P.O. Box 7037
Atlanta Georgia 30357-0037

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5784403	1998-07-21	08383518	1995-02-03	201/081

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-18
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5784403
Issue Date: July 21,1998
Application No. 08383518
Filed: February 3,1995
Attorney Docket No. 201/081

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 18,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 18,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

In re Patent No. 5723584
Issue Date: March 3,1998
Application No. 08383753
Filed: February 3,1995
Attorney Docket No. 16528J-00391

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed March 1,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of March 1,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,723,584	1998-03-03	08/383,753	1995-02-03	(24114.001; Cust. 28381)

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/JEFFERY P. BERNHARDT/	Date (YYYY-MM-DD)	2012-03-01
Name	Jeffery P. Bernhardt	Registration Number	54997

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : /11/28/11

TO SPE OF : ART UNIT: 2827

SUBJECT : Request for Certificate of Correction for Appl. No.: 08/383767 Patent No. 5535171

CofC mailroom date 11/16/11

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

Ernest C. White, LIE

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: _____

_____

_____

_____

_____ 2827
SPE **Art Unit**

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5638964	1997-06-17	08/383,942	1995-02-06	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/james h walters/	Date (YYYY-MM-DD)	2011-03-11
Name	James H. Walters	Registration Number	35731

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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.

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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 Freedom 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.

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5638964
Issue Date: June 17,1997
Application No. 08383942
Filed: February 6,1995
Attorney Docket No.

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed March 11,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of March 11,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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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JAQUEZ & ASSOCIATES
6265 GREENWICH DRIVE
SUITE 100D
SAN DIEGO, CA 92122

MAILED
NOV 16 2011
OFFICE OF PETITIONS

In re Application of
Jerzy Lewak, et al.
Application No. 08/384,379
Filed: February 3, 1995
Attorney Docket No. SPEED-003-PAP

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed October 25, 2011.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Jaquez & Associates has been revoked by the assignee of the patent application on April 21, 2011. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

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

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

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5619952	1997-04-15	08384745	1995-02-07	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/bruce a jagger/	Date (YYYY-MM-DD)	2011-01-24
Name	Bruce A. Jagger	Registration Number	19968

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

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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

In re Patent No. 5619952
Issue Date: April 15,1997
Application No. 08384745
Filed: February 7,1995
Attorney Docket No.

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 24,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 24,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

In re Patent No. 5850755
Issue Date: December 22,1998
Application No. 08385334
Filed: February 8,1995
Attorney Docket No. 06525/002001

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed July 18,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 18,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,850,755	1998-12-22	08/385,334	1995-02-08	8164.3001.001

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☒ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/Richard W. Hoffmann, Reg. No. 33711/	Date (YYYY-MM-DD)	2011-07-18
Name	RICHARD W. HOFFMANN	Registration Number	33711

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON DC 20005

MAILED

OCT 26 2010

OFFICE OF PETITIONS

In re Application of	:	Paper No. 50
Boris Hoglund et al.	:	
Application No. 08/386,813	:	NOTICE
Patent No. 6,514,553	:	
Filed: February 08, 1995	:	
Attorney Docket No. **361427-2000**		

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

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

Your fee deficiency submission under 37 CFR 1.28 is hereby **NOT ACCEPTED**.

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.

It appears that the petition was not properly signed by a person having authority to prosecute in the above-identified patent. Therefore, the request can not be accepted at this time.

Petitioner's attention is directed to 37 CFR 1.33(b), which states.

(b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);

(2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;
(3) An assignee as provided for under §3.71(b) of this chapter; or
(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

Accordingly, the request cannot be accepted until it is signed by all inventors, an attorney /agent who is registered to practice before the U.S. Patent and Trademark Office, or the assignee of the entire interest. If the request is signed by an assignee, the assignee the assignee must comply with the requirements of 37 CFR 3.73(b).

Inquiries related to this communication should be directed to the undersigned at (571) 272-2783.

/Tredelle D. Jackson/
Paralegal Specialist
Office of Petitions

cc: **DENNEMEYER & CO LTD**
REGENT HOUSE HEATON LANE
STOCKPORT CHESHIRE
ENGLAND SK4 1BB

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.
08/386,813	02/08/1995	BORIS HOGLUND	3717-107	3093

6449 7590 04/26/2011

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

EXAMINER	
HON, SOW FUN	

ART UNIT	PAPER NUMBER
1772	

NOTIFICATION DATE	DELIVERY MODE
04/26/2011	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-PAT-Email@rfem.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

wk

Mailed: 4/26/11

In re application of
Hoglund et al.
Serial No. 08/386,813
Filed: February 8, 1995
For: **TUBING USED FOR ENCASING FOOD PRODUCTS AND A METHOD FOR MANUFACTURING THE TUBING**

DECISION ON PETITION

This is a decision on the PETITION FILED UNDER 37 CFR 1.181 on October 27, 1997 to withdraw the final status of the office action dated October 17, 1996.

A review of the file shows that the application has been allowed.

DECISION

The petition for withdrawal of finality is **DISMISSED.**

/Yvonne Eyler/

Yvonne L. Eyler, Director
Technology Center 1700
Chemical and Materials Engineering

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

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5640825	1997-06-24	08387136	1995-02-10	BUTL 10.01

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
◯	3 ½ year	(1551)	◯	3 ½ year	(2551)
◯	7 ½ year	(1552)	◯	7 ½ year	(2552)
◯	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

◯ A sole patentee

◯ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

◯ A joint patentee; all of whom are signing this e-petition

◯ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Quan Nguyen/	Date (YYYY-MM-DD)	2010-09-02
Name	Quan Nguyen	Registration Number	46957

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5640825
Issue Date: June 24,1997
Application No. 08387136
Filed: February 10,1995
Attorney Docket No. CIP-MREHS

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed September 2,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 2,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Alexandria, VA 22313-1450
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MAILED

MAR 3 0 2012

OFFICE OF PETITIONS

CONNOLLY AND HUTZ
PO BOX 2207
WILMINGTON DE 19899-2207

In re Patent No. 5,619,754 :
Issue Date: April 15, 1997 :
Application No. 08/387,341 : REQUEST FOR :INFORMATION
Filed: February 13, 1995 :
Attorney Docket No. FM-3 // 18241.2028 :

This request for information is mailed in response to the petition under 37 CFR 1.378(b), filed September 9, 2011 to accept the delayed payment of the 11 ½ year maintenance fee for the above-identified patent.

Please respond within TWO (2) MONTHS from the mail date of this request for information. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The merits of this petition will not be addressed at this time because Honeywell International Inc. ("Honeywell") has not established its relationship to the patent. Attorney Thomas R. Hipkins filed the petition on behalf of Honeywell.

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F.3d at 609-609, 34 USPQ2d at 1787. The party whose delay is relevant is the party in interest at the time action is needed to be taken. In Re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

Honeywell is requesting the delayed payment of the 11 ½ year maintenance fee be excused. However, no evidence that Honeywell owns the patent has been provided. A review of assignment records for the patent reveals the current assignee is North Safety Products L.L.C.. See reel/frame 019704/0962. Honeywell is requested to provide evidence of its ownership of the patent with any reconsideration petition. A redacted copy of pertinent document(s) would suffice. Documents should also be recorded in Assignments Branch.

It is not possible to properly decide the petition until it is established who was the party in interest on April 15, 2009, which was the last day the 11 ½ year maintenance fee could be timely paid.

It is noted the correspondence address/power of attorney is not current. Appropriate documents -- power of attorney/change of correspondence address/3.73(b) statement -- should be submitted. A courtesy copy of this decision is being mailed to the address on the petition. However, the Office will mail all future correspondence solely to the address of record.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

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
By internet:	EFS-Web www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)

Telephone inquiries should be directed to the undersigned at (571) 272- 3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

CC: THOMAS R. HIPKINS
FREDRIKSON & BYRON, P.A.
200 SOUTH SIXTH STREET, SUITE 4000
MINNEAPOLIS, MN 55402-1425

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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SEP 07 2011
OFFICE OF PETITIONS

THOMAS SWENSON
1118 13TH STREET
A-5
BOULDER CO 80302

In re
Wilber
Application No. 08/388,631
Filed: February 14, 1995
Patent No. 6,324,558
Issued: November 27, 2001

DECISION

This is a decision on the fee deficiency submission under 37 CFR 1.28(c), filed August 8, 2011.

The fee deficiency submission under 37 CFR 1.28 of $1240 for the 7.5 year maintenance fee is hereby accepted.

The change of status to large entity has been entered.

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

Cliff Congo
Petitions Attorney
Office of Petitions

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

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AUG 22 2011

OFFICE OF PETITIONS

In re Application of :
Frank H. Schaedlich et al. :
Application No. 08/388,924 : NOTICE
Filed: February 16, 1995 :
Attorney Docket No. **7783-003** :

This is a notice regarding your request filed December 24, 2010, for acceptance of a fee deficiency submission under 37 CFR 1.28.

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**.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Matthew J. Graff appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. If, Matthew J. Graff desires to be acknowledged as the attorney of record in the file, the appropriate power of attorney documents must be submitted.

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

Inquiries related to this communication should be directed to the undersigned at (571) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BAKER & DANIELS LLP
111 E. WAYNE STREET
SUITE 800
FORT WAYNE IN 46802

MAILED
APR 25 2011
OFFICE OF PETITIONS

In re Patent No. 5,829,057 :
Issued: November 3, 1998 :
Application No. 08/389,759 : ON PETITION
Filed: February 14, 1995 :
Attorney Docket No. WHT0072-02 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed March 10, 2011 and March 15, 2011.

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

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

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

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

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

/Joan Olszewski/
Joan Olszewski
Petitions Examiner
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,617,879	1997-04-08	08/390,490	1995-02-17	257310

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
◯	3 ½ year	(1551)	◯	3 ½ year	(2551)
◯	7 ½ year	(1552)	◯	7 ½ year	(2552)
◉	11 ½ year	(1553)	◯	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◯ An attorney or agent registered to practice before the Patent and Trademark Office

◯ A sole patentee

◯ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

◯ A joint patentee; all of whom are signing this e-petition

◉ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

The Assignee of record of the entire interest			
Under 37 CFR 3.71 an assignee becomes of record by filing a statement in compliance with 37 CFR 3.73(b). Signature requirements are set forth in 37 CFR 1.4(d), and the undersigned certifies that he / she is empowered to act on behalf of the assignee of the entire interest			
Signature	/Afzal Ali/	Date (YYYY-MM-DD)	2010-10-28
Name	Afzal Ali		
Enter Reel and Frame Number		Remove	
Reel Number	007385	Frame Number	0790
Click ADD for additional Reel Number and Frame Number		Add	

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5617879
Issue Date: April 8,1997
Application No. 08390490
Filed: February 17,1995
Attorney Docket No. 257310

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 28,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 28,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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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ARENT FOX KNITNER PLOTKIN & KAHN PLLC
1050 CONNECTICUT AVENUE
SUITE 600
WASHINGTON DC 20036-5339

MAILED
MAR 29 2012
OFFICE OF PETITIONS

In re Application of :
Tada, et al. :
U.S. Patent No. 6,034,579 : DECISION ON PETITION
Issue Date: March 7, 2000 :
Application No. 08/390,629 :
Filed: February 17, 1995 :
For: Dielectric Filter Of The Band Elimination Type

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term extension entitled "Request For Patent Term Extension," received on November 30, 1999. The petition is being treated under 37 CFR 1.181 and 37 CFR 1.701, as a petition for patent term extension.

The petition is dismissed.

Petitioner asserts the application is entitled to patent term extension under 35 U.S.C. 154(b)(1). Petitioner states that the Office failed to provide patent term extension for the two periods of delay due to an interference. Petitioner asserts the application is eligible for at least 483 days of patent term extension under 35 U.S.C. 154 and 37 CFR 1.701.

On February 17, 1995, the above identified application was filed.

35 U.S.C. § 154(b) (as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000. 35 U.S.C. § 154 was amended by the "American Inventors Protection Act of 1999," which was enacted on November 29, 1999 as part of Public Law 106-113 (Consolidated Appropriations Act for Fiscal Year 2000).

The above-identified application was filed on February 17, 1995. Accordingly it is not entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995.

The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000.

The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

Petitioner's deposit account has not been charged a petition fee.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON DC 20005

MAILED
AUG 16 2011
OFFICE OF PETITIONS

In re Patent No. 5,573,771 :
Issue Date: November 12, 1996 :
Application No. 08/391,247 : NOTICE
Filed: February 21, 1995 :
Attorney Docket No. 1194-0403 :

This is a notice regarding your request, July 13, 2011, 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**.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

RONALD P. KANANEN
MARKS & MURASE L.L.P.
2001 L STREET, NW
SUITE 750
WASHINGTON DC 20036

MAILED
SEP 22 2011
OFFICE OF PETITIONS

In re Patent of	:	
Elberto Berdut	:	
Patent No.: 5,586,505	:	
Issue Date: 12/24/1996	:	
Application No. 08/392247	:	
Filing or 371(c) Date: 02/22/1995	:	ON PETITION
Title of Invention:	:	
LEVITATION SYSTEM USING	:	
PERMANENT MAGNETS FOR USE : WITH	:	
TRAINS AND THE LIKE TYPE OF RIGHT-	:	
OF-WAY VEHICLES	:	

This is a decision on the petition under 37 CFR § 1.378(b), filed September 2, 2011, to reinstate the above-identified patent.

The petitions are **DISMISSED**.

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

Background

The patent issued December 24, 1996. Patentee could have paid the eleven and one half (3½) year maintenance fee between December 24, 2007, and June 24, 2008, without a surcharge, or within the six (6) month grace period between June 25, 2008 and December 24, 2008. Patentee failed to do so; accordingly, the patent became expired on December 25, 2008.

The present petition

Patentee files the instant petition and provides that in celebrating his latest allowance, the patent owner requested current counsel to check on his other patents, including the present patent, and

discovered that the present patent had expired fpr non-payment of the maintenance fee. Petitioner provides that the patent owner was born in Cuba and raised his family in Peurto Rico, and speaks no English. Petitioner acknowledges that under California Med. V. Tecnol Med. (D. Del 1995), a patent owner has to make some effort to educate him or herself; however, the reason that the delay in payment of the maintenance fee was unavoidable was because the patent owner speaks no English and thus would have been hard pressed to have a casual conversation with his previous representatives, and would also have been hard pressed to find information and incapable of reading most if not all USPTO documents.

Applicable Law, Rules and MPEP

Petition to reinstate under 37 CFR 1.378(b)

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

> (A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
> (B) the surcharge set forth in 37 CFR 1.20(i)(1); and
> (C) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The applicable law requires a showing that the delay in paying the maintenance fee was unavoidable despite reasonable care being taken to ensure that the maintenance fee would be timely paid. The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. (Emphasis supplied).

As language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., "unavoidable" delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. *See Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting *In re Patent No. 4,409,763*, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), *aff'd sub nom. Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd, 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992)). See MPEP § 711.03(c) for a general discussion of the "unavoidable" delay standard.

Because 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was

"unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. *See Patent No. 4,409,763*, supra. *See also* Final Rule entitled "*Final Rules for Patent Maintenance Fees*," published in the *Federal Register* at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the *Official Gazette* at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee's agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

Moreover, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). 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).

Opinion

Patentee files the instant petition and alleges that the reason for the delay in payment was because was because the patent owner speaks no English and thus would have been hard pressed to have a casual conversation with his previous representatives, and would also have been hard pressed to find information and incapable of reading most if not all USPTO documents.However, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminders does not constitute unavoidable delay. \

The law requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Here, Patentee was unaware of the need to pay the maintenance fee and has

not demonstrated that any steps were taken to ensure timely payment of the maintenance fee. The lack of knowledge of the requirement to pay a maintenance fee will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

Conclusion

Petitioner's arguments have been considered; however, Petitioner has failed to demonstrate that the failure to pay the maintenance fee was unavoidable. The petition is dismissed.

Petitioner's current options

I. Petitioner may file a request for reconsideration.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within TWO (2) MONTHS from the mail date of this decision. The petition for reconsideration should be entitled "Petition for Reconsideration under 37 CFR 1.378(b)." Any petition for reconsideration of this decision must be accompanied by a non-refundable petition fee of $400 as set forth in 37 CFR 1.17(h).

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Therefore, it is extremely important that petitioner supply **any** and **all** relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to 'show' that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Refund Section, Commissioner for Patents, Washington, DC, 20231. A copy of this decision should accompany petitioner's request.

A review of the petition reveals that the address appearing on the petition differs from the correspondence address of record. Applicant is advised that, in patented files: requests for changes of correspondence address, powers of attorney, revocations of powers of attorney, withdrawal of attorney and submissions under 37 CFR 1.501: Designation of, or changes to, a fee address, should be addressed to Mail Stop M Correspondence.

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/DLW/

Derek L. Woods
Attorney
Office of Petitions

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LEVITATION SYSTEM USING PERMANENT MAGNETS FOR USE : WITH TRAINS AND THE LIKE TYPE OF RIGHT-OF-WAY VEHICLES	:	

This is a decision on the petition under 37 CFR § 1.378(b), filed September 2, 2011, to reinstate the above-identified patent.

The petitions are **DISMISSED.**

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

Background

The patent issued December 24, 1996. Patentee could have paid the eleven and one half (3½) year maintenance fee between December 24, 2007, and June 24, 2008, without a surcharge, or within the six (6) month grace period between June 25, 2008 and December 24, 2008. Patentee failed to do so; accordingly, the patent became expired on December 25, 2008.

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Opinion

Patentee files the instant petition and alleges that the reason for the delay in payment was because was because the patent owner speaks no English and thus would have been hard pressed to have a casual conversation with his previous representatives, and would also have been hard pressed to find information and incapable of reading most if not all USPTO documents.However, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminders does not constitute unavoidable delay. \

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not demonstrated that any steps were taken to ensure timely payment of the maintenance fee. The lack of knowledge of the requirement to pay a maintenance fee will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

Conclusion

Petitioner's arguments have been considered; however, Petitioner has failed to demonstrate that the failure to pay the maintenance fee was unavoidable. The petition is dismissed.

Petitioner's current options

I. Petitioner may file a request for reconsideration.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within TWO (2) MONTHS from the mail date of this decision. The petition for reconsideration should be entitled "Petition for Reconsideration under 37 CFR 1.378(b)." Any petition for reconsideration of this decision must be accompanied by a non-refundable petition fee of $400 as set forth in 37 CFR 1.17(h).

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Therefore, it is extremely important that petitioner supply **any** and **all** relevant information and documentation with his request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to 'show' that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

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A review of the petition reveals that the address appearing on the petition differs from the correspondence address of record. Applicant is advised that, in patented files: requests for changes of correspondence address, powers of attorney, revocations of powers of attorney, withdrawal of attorney and submissions under 37 CFR 1.501: Designation of, or changes to, a fee address, should be addressed to Mail Stop M Correspondence.

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/DLW/

Derek L. Woods
Attorney
Office of Petitions

CC: LUIS FIGARELLA
27 TODD ROAD
NASHUA, NH 03064

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OF-WAY VEHICLES	:	

This is a decision on the petition under 37 CFR § 1.378(e), filed January 10, 2012, requesting reconsideration of a decision dismissing a petition to reinstate the above-identified patent.

The petition is **DENIED**.

This decision is a final agency action within the meaning of 5 U.S.C. §704 for purposes of seeking judicial review.

Background

The patent issued December 24, 1996. Patentee could have paid the eleven and one half (11½) year maintenance fee between December 24, 2007, and June 24, 2008, without a surcharge, or within the six (6) month grace period between June 25, 2008 and December 24, 2008. Patentee failed to do so; accordingly, the patent became expired on December 25, 2008.

The September 2, 2011 petition

Patentee filed a petition on September 2, 2011, to reinstate the above identified patent, wherein petitioner provided that in celebrating his latest allowance, the patent owner requested current

counsel to check on his other patents, including the present patent, and discovered that the present patent had expired for non-payment of the maintenance fee. Petitioner provided further that the patent owner was born in Cuba and raised his family in Puerto Rico, and speaks no English. Petitioner stated

> [w]hile we know that under California Med. V. Technol Med. (D. Del 1995) a patent owner has to make some effort to educate his/herself, Don Elberto speaks no English, and thus would have been hard pressed to have a casual conversation with his previous representatives. As with another of my "Boricua" clients (although Don Elberto was born in Cuba, he raised his family in PR), he would be hard pressed to find information and incapable of reading most if not all USPTO documents.

The November 3, 2011 Decision on petition

A Decision dismissing the petition was mailed on November 3, 2011. The Decision informed petitioner that a patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminders does not constitute unavoidable delay. The law requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Here, Patentee was unaware of the need to pay the maintenance fee and had not demonstrated that any steps were taken to ensure timely payment of the maintenance fee. The lack of knowledge of the requirement to pay a maintenance fee will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

The present request for reconsideration of petition

Petitioner files the present request for reconsideration of petition and clarifies his previous explanation regarding petitioner's failure to pay the maintenance fee. Petitioner explains that on previous occasions payment of the maintenance fee was done through Marks & Murase, LLP, who would notify petitioner of the need to pay, and send petitioner a bill. In this manner the fees for the patent (for the 4 and 8 year windows), were paid. Petitioner provides further that as recently as April 2005 the fees were paid in this manner.

During 2008 (for payment of the present maintenance fee), petitioner received no notification requesting the payment. However, since the system that worked for all other cases failed this time, the present petition is filed. Petitioner concludes that the inventor's interests are being harmed by the premature expiration of the present patent, particularly when the 4 and 8 year maintenance fees were already paid, thereby demonstrating the inventor's intent to assert his IP rights.

Applicable Law, Rules and MPEP

Petition to reinstate under 37 CFR 1.378(b)

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

(A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
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(C) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The applicable law requires a showing that the delay in paying the maintenance fee was unavoidable despite reasonable care being taken to ensure that the maintenance fee would be timely paid. The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. (Emphasis supplied).

As language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., "unavoidable" delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. See, Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff 'd sub nom. Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff 'd, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992)). See MPEP § 711.03(c) for a general discussion of the "unavoidable" delay standard.

Because 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. *See Patent No. 4,409,763*, supra. *See also* Final Rule entitled "Final Rules for Patent Maintenance Fees," published in the *Federal Register* at 49 Fed. Reg. 34716, 34722-23 (August 31, 1984), and republished in the Official Gazette at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are

due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee's agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

Moreover, the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Specifically, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133 or 37 CFR 1.137(a). Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (D. Ind. 1987); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). 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).

Finally, petitioner is advised that a breakdown of communication between petitioner and his representative is not considered to be grounds for granting a petition for late payment of the maintenance fee under the unavoidable standard. See, Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

Opinion

Patentee files the instant petition and clarifies that the reason for the delay in payment of the maintenance fee was because petitioner received no notification from Marks & Murase, LLP requesting the payment. However, petitioner's delay caused by the actions or inactions of his voluntarily chosen representative does not constitute unavoidable delay.

Moreover, a breakdown of communication between petitioner and his representative is not considered to be grounds for granting a petition for late payment of the maintenance fee under the unavoidable standard.

Decision

The instant petition under 37 CFR 1.378(e) is granted to the extent that the decision of June 15, 2009 has been reconsidered; however, the renewed petition to accept under 37 CFR 1.378(e) the delayed payment of a maintenance fee and reinstate the above-identified patent is **DENIED**.

This patent file is being forwarded to the Files Repository.

Telephone inquiries concerning this matter should be directed to Attorney Derek L. Woods at (571) 272-3232.

Anthony Knight
Director
Office of Petitions

CC: LUIS FIGARELLA
27 TODD ROAD
NASHUA, NH 03064

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5812185	1998-09-22	08394277	1995-02-24	Q37504

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/SMG/	Date (YYYY-MM-DD)	2011-07-11
Name	Steven M. Gruskin	Registration Number	36818

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5812185
Issue Date: September 22,1998
Application No. 08394277
Filed: February 24,1995
Attorney Docket No. Q37504

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed July 11,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 11,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

BRACEWELL & GIULIANI LLP
P.O. BOX 61389
HOUSTON, TX 77208-1389

MAILED

NOV 04 2010

OFFICE OF PETITIONS

In re Application of
Brian D. ZDeb, et al.
Application No. 08/395,551
Filed: February 28, 1995
Attorney Docket No. 064669.008028

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 13, 2010.

The request is **NOT APPROVED**.

The Office will not decide request to withdraw from representation as practitioner of record which are filed after the patent has issued. Sections 2540 and 2542 of the Manuel of Patent Procedures (MPEP explain that a practitioner does not have to request permission to withdraw as practitioner of record under 37 CFR 1.36 in order to change the address in a patented filed and to directed notices, receipts and other communications relating to maintenance fees. These requests will be placed in the application but will not be treated on their merits. The above mentioned sections of the MPEP recommend the designation of a fee address or submission of a change in correspondence address in the patented file for directing correspondence relating to maintenance fee payments and other correspondences after issuance. See Form PTO/SB/47, entitled, *"Fee Address" Indication Form* and Form PTO/SB/123, entitled, *Change of Correspondence Address, Patent*

Accordingly, the request to withdraw from record cannot be approved because the patent in this application has already been issued.

All future communications from the Office will continue to be directed to the address of record until otherwise notified by applicant.

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

/AMW/
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
www.uspto.gov

Paper No. 13

BANNER & WITCOFF, LTD.
TEN SOUTH WACKER DRIVE
SUITE 3000
CHICAGO IL 60606

MAILED
JUN 10 2011
OFFICE OF PETITIONS

In re Patent No. 5,595,018 :
Issue Date: January 21, 1997 :
Application No. 08/395,910 : ON PETITION
Filed: January 28, 1995 :
Attorney Docket No. :

This is a decision on the petition under 37 CFR 1.378(c), filed May 2, 2011, to accept the delayed payment of a maintenance fee for the above-identified patent.

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 1.378(c) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must so notify the Office.

The petition is **DISMISSED** as time barred.

This patent expired on September 9, 2005 for failure to pay the 11-½ year maintenance fee. Since this petition was not submitted within the twenty-four months after the six-month grace period provided in 37 CFR 1.362 (e), the petition was not timely filed under the provisions of 37 CFR 1.378(c).

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(c) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2). This petition lacks item (1) above.

35 USC 41(c)(1) states that:

"The Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable. Thus, 35 U.S.C. § 41(c)(1) does not authorize the Commissioner to accept a delayed maintenance fee payment later than twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) unless the delay is shown to have been unavoidable. Since the instant petition was not filed within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b), the Commissioner cannot accept a delayed maintenance fee payment for the above-identified patent under 37 CFR 1.378(c)."

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within **TWO (2) MONTHS** from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Any petition for reconsideration of this decision must be accompanied by **the petition fee of $400** as set forth in 37 CFR 1.17(f). The petition for reconsideration must include 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.

Should petitioner wish to pursue reinstatement of the above-identified patent on the basis of unavoidable delay, petitioner should file a petition under 35 U.S.C. § 41(c) and 37 CFR 1.378(b), which must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

The $3695 submitted with petition on May 2, 2011 will be refunded to the petitioner in due course.

Petitioner will not receive future correspondence related to maintenance fees for the patent unless a "Fee Address" Indication Form (see PTO/SB/47) and Request for Customer Number (see PTO/SB/125) are submitted.

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 Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Telephone inquiries regarding this decision should be directed to undersigned at (703) 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: MICHAEL J. COLITZ, JR.
640 DLUGLAS AVENUE
DUNEDIN, FL 34698

Attachment: Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in An Expired Patent (37 CFR 1.378(b))

PTO/SB/65 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PETITION TO ACCEPT UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(b))

Docket Number (Optional)

Mail to: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450
Fax: (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

Patent Number: _____ Application Number: _____

Issue Date: _____ Filing Date: _____

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number (or reissue patent number, if a reissue) and (2) the application number of the actual U.S. application (or reissue application) leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

Also complete the following information, if applicable:

The above-identified patent:

☐ is a reissue of original Patent No. _____ original issue date _____;
original application number _____,
original filing date _____

☐ resulted from the entry into the U.S. under 35 U.S.C. 371 of international application _____ filed on _____.

CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is

(1) being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 OR

(2) transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

_____ _____
Date Signature

_____
Typed or printed name of person signing Certificate

This collection of information is required by 37 CFR 1.378(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 8 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/65 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

1. SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27

2. LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

3. MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition, unless it was paid earlier.

NOT Small Entity			Small Entity		
Amount	Fee	(Code)	Amount	Fee	(Code)
☐ $ _____	3 ½ yr fee	(1551)	☐ $ _____	3 ½ yr fee	(2551)
☐ $ _____	7 ½ yr fee	(1552)	☐ $ _____	7 ½ yr fee	(2552)
☐ $ _____	11 ½ yr fee	(1553)	☐ $ _____	11 ½ yr fee	(2553)

MAINTENANCE FEE BEING SUBMITTED $ _____

4. SURCHARGE

The surcharge required by 37 CFR 1.20(i)(1) of $ _____ (Fee Code 1557) must be paid as a condition of accepting unavoidably delayed payment of the maintenance fee.

SURCHARGE FEE BEING SUBMITTED $ _____

5. MANNER OF PAYMENT

☐ Enclosed is a check for the sum of $ _____

☐ Please charge Deposit Account No. _____ the sum of $_____ .

☐ Payment by credit card. Form PTO-2038 is attached.

6. AUTHORIZATION TO CHARGE ANY FEE DEFICIENCY

☐ The Director is hereby authorized to charge any maintenance fee, surcharge or petition fee deficiency to Deposit Account No. _____ .

7. OVERPAYMENT

As to any overpayment made, please

☐ Credit to Deposit Account No. _____

OR

☐ Send refund check

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

8. SHOWING

The enclosed statement will show that the delay in timely payment of the maintenance fee was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that this petition is being filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The statement must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which the patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

9. PETITIONER(S) REQUESTS THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED.

_____ Signature(s) of Petitioner(s)

_____ Date

_____ Typed or printed name(s)

_____ Registration Number, if applicable

_____ Address

_____ Telephone Number

_____ Address

ENCLOSURES:

☐ Maintenance Fee Payment

☐ Statement why maintenance fee was not paid timely

☐ Surcharge under 37 CFR 1.20(i)(1) (fee for filing the maintenance fee petition)

☐ Other:

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

Signature	Date
Type or printed name	Registration Number, if applicable

STATEMENT

(In the space below, please provide the showing of unavoidable delay recited in paragraph 8 above.)

(Please attach additional sheets if additional space is needed)

Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DONALD G. RICHARDSON
503 ORENA STREET
SANTA BARBARA CA 93103

MAILED

JUL 07 2011

OFFICE OF PETITIONS

In re Patent No. 5,823,305 :
Issued: October 20, 1998 :
Application No. 08/396,558 : ON PETITION
Filed: March 1, 1995 :
Attorney Docket No. 27054/RDS/R2 :

This is a decision on the petition under 37 CFR 1.137(b), filed June 6, 2011, which will be treated as a petition under 37 CFR 1.378(c) to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Any petition for reconsideration of this decision must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f). The petition for reconsideration must include 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 Commissioner.

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(c) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2). This petition lacks item (1) listed above.

With regards to item (1), the petition must be signed by:

1) An attorney or agent of record appointed in compliance with § 1.34(b);
2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a);
(3) The assignee of record of the entire interest, if there is an assignee of record of the entire interest;
(4) An assignee of record of an undivided part interest, and any assignee(s) of the remaining interest and any applicant retaining an interest, if there is an assignee of record of an undividing part interest; or
(5) All of the applicants (§§ 1.42.1.43 and 1.47) for patent, unless there is an assignee of record of the entire interest and such assignee has taken action in the application in accordance with §§ 3.71 and 3.73.

Petitioner has submitted a petition under 37 CFR 1.378(c), however, the petition as signed cannot be accepted since Theodore G. Phelps is not authorized to sign the instant petition. Further, petitioner has not established that the person who signed the petition form is authorized to sign on behalf of the patentee(s), assignee, or other party of interest. Consequently, the petition under 37 CFR 1.378(c), cannot be accepted at this time. A renewed petition with the proper signature as listed above is required.

Further, it is noted that petitioner has indicated that this patent continues to claim large entity status, however petitioner has paid the $2055.00 eleven and a half small entity maintenance fee and not the large entity fee of $4,110.00.

If this petition is not renewed or if renewed and not granted, then petitioner may request a refund of the maintenance and surcharge fees paid. The fee for requesting reconsideration is not refundable.

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: 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 should be directed to the undersigned at (571)-272-7751.

/Joan Olszewski/
Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Theodore G. Phelps
515 S. Flower St., 36th Floor
Los Angeles, CA 90071

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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MCANDREWS, HELD & MALLOY, LTD.
500 WEST MADISON STREET - 34TH FLOOR
CHICAGO, IL 60661

MAILED
SEP 22 2011
OFFICE OF PETITIONS

In re Patent No. 5,848,438
Issued: December 8, 1998
Application No. 08/399,095
Filed: March 3, 1995
Attorney Docket No: **24097US01**

ON PETITION

This is a decision regarding your request for acceptance of a fee deficiency submission and loss of small entity status filed August 31, 2011 under 37 CFR 1.28.

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc.. 154 F.33d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

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

Your fee deficiency submission under 37 CFR 1.28 is hereby accepted and the petition is **GRANTED**. Status as a small entity has also been removed.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (571) 272-3282.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/399,535	03/07/1995	ERNST JANZEN	594V.42-CIP/	8378

530 7590 09/08/2010

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
JACKSON, GARY	

ART UNIT	PAPER NUMBER
3731	

MAIL DATE	DELIVERY MODE
09/08/2010	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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD NJ 07090

In re Patent No. JANZEN ET AL.
Issue Date: March 7, 2006
Appl No.: 08/399,535
Filed: March 07, 1995
For: Correction of Inventorship

DECISION GRANTING PETITION
37 CFR 1.324

This is a decision on the petition under 37 CFR 1.48, filed August 25, 2010. In view of the fact that the patent has already issued, the request under 37 CFR 1.48 has been treated as a petition to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

/Gary Jackson/

/Gary Jackson/
Supervisory Patent Examiner
Art Unit 3731
Patent Examining Group 3700

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE

Patent No. 7,008,439
Patented: March 7, 2006

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 U.S.C. 256, it has been found that the above identified patent, through error and without deceptive intent, improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

Ernst Janzen, Laren Netherlands

Gunter Ruttgers, Stolberg, Germany

Lawrence Saper, New York, New York

Sidney Wolvek (deceased),

/Gary Jackson/

/Gary Jackson/
Supervisory Patent Examiner
Art Unit 3731
September 7, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DATE: September 7, 2010
TO: Certificates of Correction Branch
FROM: Gary Jackson
SPE, Art Unit 3731
SUBJECT: REQUEST FOR CERTIFICATE OF CORRECTION

Please issue a Certificate of Correction in U. S. Letters Patent No. 7,008,439 as specified on the attached Certificate.

/Gary Jackson/

Gary Jackson, SPE
Art Unit 3731

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5696435	1997-12-09	08/399,742	1995-03-07	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/ Dr. Paul A. Maltseff /	Date (YYYY-MM-DD)	2011-06-15
Name	Paul August Maltseff	Registration Number	50329

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 5696435
Issue Date: December 9,1997
Application No. 08399742
Filed: March 7,1995
Attorney Docket No. 36599XZA

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed June 15,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 15,2011 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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VENABLE
PO BOX 34385
WASHINGTON DC 20043-9998

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FEB 27 2012

OFFICE OF PETITIONS

In re Patent No. 5,662,493 :
Issue Date: 2 September, 1997 :
Application No. 08/401,621 : DECISION
Filed: 9 March, 1995 :
Attorney Docket No. PETSG-0028

This is a decision on the petition filed on 28 December, 2011, under 37 C.F.R. §1.27(g)(2) requesting that status as a Small Entity be removed.

NOTE:

The address on the petition is other than that of record.

If Petitioner desires to receive future correspondence regarding this application, the appropriate Notice must be submitted.

A courtesy copy of this decision will be mailed to Petitioner.

However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary.

In view of their duty of candor to the Office to properly inquire to ascertain the accuracy of representations made before the Office (*see*: 37 C.F.R. §1.4, §10.18, MPEP §410), Petitioners always are reminded of the responsibility to review their records and submit accurate information to the Office.

Petitioners also are reminded to chart out the fees paid/fees due/balance due in their submission(s) to the Office. (*See, generally*: 37 C.F.R. §1.27, §1.28, MPEP §509.02 and 509-03.)

Patent No. 5,662,493
Application No. 08/401,621

Petitioner's submission is **ACCEPTED**.

In accordance with the request, status as a Small Entity will be removed, and Petitioner is required to pay fees at the schedule set forth for not-small entities. **The additional fees were charged as authorized.**

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 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 application is released to the IFW Files Repository 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

CC:
ANDREW WILFORD
311 EAST YORK STREET
SAVANNAH, GA 31401-3814

---

[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] 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
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Paper no. 14

MORGAN & FINNEGAN Transition Team
C/O Locke Lord Bissell & Liddell
3 WORLD FINANCIAL CENTER
NEW YORK NY 10281-2101

MAILED

JAN 13 2011

OFFICE OF PETITIONS

In re Patent No. 5651,330 :
Issue date: June 29, 1997 :
Application No. 08/404,514 : ON PETITION
Filed: March 15, 1995 :
Attorney Docket No. 1172-4024 //005-208 :
For: SHIPPING CONTAINER FOR SHIPPING LIVESTOCK

This is a decision on the petition under 37 CFR 1.378(b), filed September 15, 2010, to accept the unavoidably delayed payment of the 7 ½ year maintenance fee for the above-identified patent. In addition, petitioner filed a petition under 37 CFR 1.378(c) on September 15, 2010, to accept the unintentionally delayed payment of the 11 ½ year maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(b) is **DISMISSED**.

The petition under 37 CFR 1.378(c) is **DISMISSED** because the petition was not timely filed. The petition was not submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e).

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400. The petition for reconsideration should include an exhaustive attempt to provide the lacking item noted below, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner.

The patent issued July 29, 1997. The 7 ½ year maintenance fee could have been paid from July 29, 2004 through January 29, 2005, or with a surcharge during the period from January 30, 2005 through July 29, 2005. The Office has no record of timely receiving the 7 ½ year maintenance fee. Accordingly, the patent expired on July 30, 2005.

Statute and Regulation

37 CFR 1.378(a) provides that the Commissioner may accept the payment of any maintenance fee due on a patent based on an expiration of the patent, if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Commissioner to have been unavoidable or unintentional. The appropriate surcharge set forth in § 1.20(i) must be paid as a condition of accepting payment of the maintenance fee. The surcharges set at 37 CFR 1.20(i) are established pursuant to 35 U.S.C. 41(c) and, therefore, are not subject to small entity provisions of 35 U.S.C. 41(h). No separate petition fee is required for this petition. If the Commissioner accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired but will be subject to the intervening rights and provisions of 35 U.S.C. 41(c)(2).

The patent statute at 35 U.S.C. 41(c)(1) provides as follows:

> "The Commissioner may accept the payment of any maintenance fee required by subsection (b) of this section... at any time after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable."

The statute's promulgating rule, 37 CFR 1.378(b), provides that any petition to accept the delayed payment of a maintenance fee must include the following:

> (1) the required maintenance fee set forth in 37 CFR 1.20(e) - (g);
>
> (2) the surcharge set forth in 37 CFR 1.20(i)(1); and
>
> (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Such as statement must be verified if made by a person not registered to practice before the Patent and Trademark Office. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

Opinion

In the instant petition, patentee, ST Reproductive Technologies, LLC, asserts that the delay in payment of the 7 ½ year maintenance fee was unavoidable because former licensee, Atlantic-Allstar Genetics Ltd., did not pay the maintenance fees, as was purportedly required by an

exclusive licensing agreement between the former licensee and Larry Hayward Jewett, the inventor and original owner of the patent.

Mr. Jewett states that he granted an exclusive license of the patent to Atlantic-Allstar Genetics Ltd. (Jewett affidavit, p. 3). The license agreement required the company to take all steps necessary to preserve and maintain the patent, including payment of maintenance fees (Jewett affidavit, p. 4). It is noted that a copy of this agreement has not been supplied with the present petition. If reconsideration is attempted, please submit a copy of this agreement. Petitioner may redact the agreement, if desired. In 2004, Mr. Jewett purportedly directed notice that a maintenance fee payment for the patent was coming due to the company for payment in accordance with the licensing agreement (Jewett affidavit, p. 10). A copy of the notice/letter sent to the licensee has not been supplied with the present petition. If reconsideration is attempted, please submit a copy of this agreement. At some unspecified point afterwards, the business went under, the assets were liquidated to pay creditors, and the patent license was terminated (Jewett affidavit, p. 11). At some unspecified point after the patent license was terminated, Mr. Jewett began doing business using the shipping containers that he was able to salvage. In January 2010, he sold the remaining containers and the patent rights to petitioner (Jewett affidavit, p. 12). Mr. Jewett learned of the patent expiration only after the sale of the patent rights to petitioner.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Petitions for the delayed payment of maintenance fees under 35 U.S.C. 41(c)(1) are treated under the same standard as petitions for revival of abandoned applications under 35 U.S.C. 133 because both statutory provisions use the same language, i.e., "unavoidable" delay. Ray v. Leyman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd, Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable as follows:

> 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 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.

In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-168 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Massinghoff, 671 F.2d 533,

538, 213 USPQ 977, 982 (D.C. Cir. 1982). The requirement in 35 U.S.C. 133 for a showing of unavoidable delay requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable (or expiration of the patent as it applies to 35 U.S.C. 41(c)(1)), but also a showing of unavoidable delay from the time an applicant becomes aware of the abandonment of the application until the filing of a petition to revive (or a petition under 37 CFR 1.378(b) to reinstate the patent under 35 U.S.C. 41(c)(1)). See In re Application of Takao, 17 USPQ2d 1155 (Comm'r Pat. 1990). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-317, 5 USPQ2d 1130, 1131-1132 (N.D. Ind. 1987).

Responsibility for Paying the Maintenance Fees

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F.3d at 609-609, 34 USPQ2d at 1787. The party whose delay is relevant is the party in interest at the time action is needed to be taken. In Re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988). On July 29, 2005, which is the last day the 7 ½ year maintenance fee could be timely paid, Mr. Jewett appears to have been the party in interest.

It was incumbent upon the party in interest to undertake the obligation to pay the fee or to engage a third party to monitor and track the second maintenance fee payment. Reliance *per se* on a third party for tracking a maintenance fee does not provide a patent holder with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 U.S.C. 41(c). Rather, such reliance merely shifts the focus of the inquiry to whether that third party acted reasonably and prudently.

Mr. Jewett asserts that Atlantic-Allstar Genetics Ltd. was responsible for payment of the second maintenance fee. Mr. Jewett remains bound by the business decisions, actions, or inactions, of its agents. Cf. Winkler v. Ladd, 221 F.Supp 550,552, 138 USPQ 666, 667 (D.D.C. 1963).

Assuming that Atlantic-Allstar Genetics Ltd. was responsible for handling maintenance fees for the patent, then it is incumbent upon petitioner to demonstrate, via a documented showing, that Atlantic-Allstar Genetics Ltd. had docketed this patent for the second maintenance fee payment in a reliable tracking system.

Petitioner must demonstrate, via a documented showing, that there was a reliable tracking system in place to monitor the due dates of maintenance fees and that a responsible party had docketed this patent in that system. Atlantic-Allstar Genetics Ltd. must provide evidence that the maintenance fee due date was docketed in a reliable tracking system, and that due to some unforeseeable circumstances, that the 7 ½ year fee was not paid. Evidence should be submitted which demonstrates that despite reasonable care by the patentee's agent to implement reasonable steps to ensure the timely payment of the maintenance fee, the maintenance fee was nevertheless, unavoidably not paid. If financial trouble is asserted, documentary evidence is required.

Even assuming, *arguendo*, that Mr. Jewett were not bound by the mistakes or negligence of Atlantic-Allstar Genetics Ltd., diligence on the part of Mr. Jewett would still be essential to show

unavoidable delay. See, Douglas v. Manbeck, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991). Petitioner is further required to show what steps were taken by Mr. Jewett to inquire as to Atlantic-Allstar Genetics Ltd.'s efforts to timely pay the maintenance fees.

It appears that Mr. Jewett was aware that Atlantic-Allstar Genetics Ltd. was in financial difficulties due to "mad cow disease", but failed to inquire whether or not the patent was being maintained in force. Mr. Jewett was aware that Atlantic-Allstar Genetics Ltd.'s assets were liquidated to pay creditors and that the patent license was terminated, but Mr. Jewett did not make inquiries about whether or not the 7 ½ year maintenance fee was paid. Mr. Jewett failed to notice the third maintenance fee was not paid, as well, despite the fact that he was doing business in the U.S. using the shipping containers. It appears petitioner discovered the patent had lapsed after Mr. Jewett sold his patent rights to petitioner. Mr. Jewett did not exercise the level of due care generally used and observed by prudent and careful men in relation to their most important business.

Unfortunately, any delay resulting from the actions or inactions of the patentee is binding upon petitioner as the successor in title. See, Winkler v. Ladd, 221 F.Supp. 550, 552, 138 USPQ 666, 667 (D.D.C. 1963). While petitioner gained ownership of this patent in January 2010, such merely gave petitioner standing to file the instant petition on or after that date. Lastly, that one may have subsequently exercised diligence after their assumption of title and belated awareness of the need to pay the fee does not convert the preceding delay into unavoidable delay. See Kim v. Quigg, 718 F.Supp. 1280, 12 USPQ2d 1604 (E.D. Va 1989).

Regarding fees, the $2,480.00 7 ½ year maintenance fee, the $4,110.00 11 ½ year maintenance fee, and the $700.00 surcharge after expiration when late payment is unavoidable will be charged to petitioner's credit card.

If petitioner does not wish to file a reconsideration petition, petitioner may, **in writing**, request a refund of the $7,290.00 paid with the instant petition. The request should be made in writing and addressed to: Mail Stop 16, Director of the U.S. Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Mr. Miles appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. If, Mr. Miles desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to Mr. Miles. However, until otherwise instructed, all future correspondence regarding this patent will be directed solely to the above-noted correspondence address of record.

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

By internet: EFS-Web
www.uspto.gov/ebc/efs_help.html
(for help using EFS-Web call the
Patent Electronic Business Center
at (866) 217-9197)

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

CC: CR MILES, P.C.
405 MASON COURT, SUITE 119
FORT COLLINS CO 80524

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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www.uspto.gov

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CR MILES P.C.
405 Mason Court, Suite 119
Fort Collins CO 80524

In re Patent No. 5651,330
Issue date: June 29, 1997
Application No. 08/404,514
Filed: March 15, 1995
Attorney Docket No. 1172-4024 //005-208
For: SHIPPING CONTAINER FOR SHIPPING LIVESTOCK

DECISION ON PETITION
UNDER 37 CFR 1.378(e)

This is a decision on the reconsideration petition under 37 CFR 1.378(e), filed March 14, 2011, and supplemented on April 28, 2011 and May 11, 2011, to reinstate the above-identified patent.

The petition is **DENIED**.[1]

Background

The patent issued July 29, 1997. The 7 ½ year maintenance fee could have been paid from July 29, 2004 through January 29, 2005, or with a surcharge during the period from January 30, 2005 through July 29, 2005. The Office has no record of timely receiving the 7 ½ year maintenance fee. Accordingly, the patent expired on July 30, 2005.

A petition under 37 CFR 1.378(b), filed September 15, 2010, to accept the unavoidably delayed payment of the 7 ½ year maintenance fee and the 11 ½ year maintenance fee for the above-identified patent was dismissed on January 13, 2011.

Statute and Regulation

37 CFR 1.378(a) provides that the Commissioner may accept the payment of any maintenance fee due on a patent based on an expiration of the patent, if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Commissioner to have been unavoidable or unintentional. The appropriate surcharge set forth in § 1.20(i) must be paid as a condition of

[1] This decision may be viewed as a final agency action within the meaning of 5 USC § 704 for purposes of seeking judicial review. See MPEP 1002.02. The terms of 37 C.F.R. 1.137(d) do not apply to this decision.

accepting payment of the maintenance fee. The surcharges set at 37 CFR 1.20(i) are established pursuant to 35 U.S.C. 41(c) and, therefore, are not subject to small entity provisions of 35 U.S.C. 41(h). No separate petition fee is required for this petition. If the Commissioner accepts payment of the maintenance fee upon petition, the patent shall be considered as not having expired but will be subject to the intervening rights and provisions of 35 U.S.C. 41(c)(2).

The patent statute at 35 U.S.C. 41(c)(1) provides as follows:

"The Commissioner may accept the payment of any maintenance fee required by subsection (b) of this section... at any time after the six-month grace period if the delay is shown to the satisfaction of the Commissioner to have been unavoidable."

The statute's promulgating rule, 37 CFR 1.378(b), provides that any petition to accept the delayed payment of a maintenance fee must include the following:

(1) the required maintenance fee set forth in 37 CFR 1.20(e) - (g);

(2) the surcharge set forth in 37 CFR 1.20(i)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Such as statement must be verified if made by a person not registered to practice before the Patent and Trademark Office. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

Opinion

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Petitions for the delayed payment of maintenance fees under 35 U.S.C. 41(c)(1) are treated under the same standard as petitions for revival of abandoned applications under 35 U.S.C. 133 because both statutory provisions use the same language, i.e., "unavoidable" delay. Ray v. Leyman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd, Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd, 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable as follows:

> 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 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.

In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-168 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). The requirement in 35 U.S.C. 133 for a showing of unavoidable delay requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable (or expiration of the patent as it applies to 35 U.S.C. 41(c)(1)), but also a showing of unavoidable delay from the time an applicant becomes aware of the abandonment of the application until the filing of a petition to revive (or a petition under 37 CFR 1.378(b) to reinstate the patent under 35 U.S.C. 41(c)(1)). See In re Application of Takao, 17 USPQ2d 1155 (Comm'r Pat. 1990). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-317, 5 USPQ2d 1130, 1131-1132 (N.D. Ind. 1987).

In the instant petition, patentee, ST Reproductive Technologies, LLC, asserts that the delay in payment of the 7 ½ year maintenance fee was unavoidable because former licensee, Atlantic-Allstar Genetics Ltd. ("AAG"), did not pay the maintenance fees, as was purportedly required by an exclusive licensing agreement between the former licensee and Larry Hayward Jewett, the inventor and original owner of the patent. It is noted that a copy of the exclusive licensing agreement has not been submitted.

Mr. Jewett states that he granted an exclusive license of the patent to Atlantic-Allstar Genetics Ltd.. *First Jewett Aff.* at p. 3. The license agreement purportedly required the company to take all steps necessary to preserve and maintain the patent, including payment of maintenance fees. *First Jewett Aff.* at p. 4. Contrary to the *First Jewett Aff.* at p. 10, Mr. Jewett did not direct notice that a maintenance fee payment for the patent was coming due to the company for payment (*Second Jewett Aff.* at p. 4). In 2001, Mr. Jewett's new family partnership bought AAG's livestock shipping containers. *Second Jewett Aff.* at p. 6. The sale of the livestock shipping containers did not include sale of the purported exclusive licensing agreement between Mr. Jewett and AAG.

In early to mid-2004, before the 7.5 maintenance fee was due, AAG closed its farm office. *Second Jewett Aff.* at p. 9 and *Steeves Aff.* at p. 6. AAG disconnected its telephone and facsimile line. *Second Jewett Aff.* at p. 9.

From 2001 until AAG dissolved in 2006, Tara Steeves was the part-time bookkeeper. *Steeves Aff.* at p. 2. One of her responsibilities was to calendar the financial obligations and payment schedules for the company in Microsoft Outlook. This included the maintenance payment of the patent involving the company's livestock shipping containers. *Steeves Aff.* at p. 3. Ms. Steeves states that she did not make the maintenance fee payment on behalf of AAG because she believed that when the livestock shipping containers were sold, that the obligation to make the maintenance fee payment transferred with containers. *Steeves Aff.* at p. 5. While she anticipated receiving direction regarding who was to make payment, with all of the change and turmoil that was occurring at the time and the limited amount of work being done on the books for AAG, she simply did not remember to inquire about this. *Steeves Aff.* at p. 5

In 2006, AAG was formally dissolved. In January 2010, Mr. Jewett sold the remaining containers and the patent rights to petitioner *First Jewett Aff.* at p. 12. Mr. Jewett learned of the patent expiration only after the sale of the patent rights to petitioner.

In determining whether a delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray, 55 F.3d at 609-609, 34 USPQ2d at 1787. The party whose delay is relevant is the party in interest at the time action is needed to be taken. In Re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988). On July 29, 2005, which is the last day the 7 ½ year maintenance fee could be timely paid, Mr. Jewett appears to have been the party in interest.

It was incumbent upon the party in interest to undertake the obligation to pay the fee or to engage a third party to monitor and track the second maintenance fee payment. Reliance *per se* on a third party for tracking a maintenance fee does not provide a patent holder with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 U.S.C. 41(c). Rather, such reliance merely shifts the focus of the inquiry to whether that third party acted reasonably and prudently.

Mr. Jewett asserts that AAG was responsible for payment of the second maintenance fee. Mr. Jewett remains bound by the business decisions, actions, or inactions, of its agents. Cf. Winkler v. Ladd, 221 F.Supp 550,552, 138 USPQ 666, 667 (D.D.C. 1963). Especially in this case, as Mr. Jewett was president of AAG. Unfortunately, ST Reproductive Technologies, LLC stands in the shoes of Mr. Jewett and AAG, See In Re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

Mr. Jewett was aware of AAG's financial difficulties in 2001, as he was the president of the company. Mr. Jewett, doing business in a family partnership, Jewett Holsteins, decided to salvage what he could and purchased and utilized the assets of AAG. Jewett Holsteins was only a partnership set up to raise and sell cattle. There was no reason for it to acquire the patent license from AAG at the time it acquired the physical property. *Supplement to Request for Reconsideration under 37 CFR 1.378(e),* Facts, p. 3.

Petitioner has filed a statement of facts of Tara Steeves, who served as a part-time bookkeeper for AAG. The 7 ½ and 11 ½ year maintenance fees were docketed in a Microsoft Outlook calendar. However, when it was time to pay the 7 ½ year fee, Ms. Steeves assumed that since the livestock shipping containers were sold to Mr. Jewett's family partnership, Jewett Holsteins, that

Mr. Jewett's family partnership would be responsible for paying the maintenance fee on the patent.

A part-time bookkeeper made the decision to ignore the docket entry and did not request clarification from Mr. Jewett as to what entity bore the responsibility for payment of the maintenance fee.

Petitioner has not fully explained Ms. Steeves' duties with respect to payment of maintenance fees. She states she calendared financial obligations and payment schedules for AAG. *Steeves Aff.* at p. 3. However, there is no description of her degree of autonomy/level of supervision with respect to deciding whether or not to pay maintenance fees or the steps in place to ensure payment is made. Would a reasonably prudent person leave such an important decision as maintenance of a critical business asset to a part-time bookkeeper?

Being closely associated with the buyer, Jewett Holsteins, Mr. Jewett was aware that AAG had sold most of its assets in 2001 and closed its farm office, disconnected its telephone and fax lines, and moved what remained of the business to a new location in mid-2004. The maintenance fee was due July 25, 2005. A reasonably prudent person possessing knowledge of the lack of funds and turmoil experienced by AAG would have paid closer attention to his asset.

Mr. Jewett was closely associated with AAG and Jewett Holsteins. (At one point in late December 2001, AAG, Jewett Holsteins, and Larry Jewett himself were located at the same address – 479 Settlement Road, Keswick Ridge, NB, E6L 1W8. Larry Jewett signed a 2001 purchase agreement for AAG and Jewett Holsteins. In fact, Larry Jewett was president of AAG. *Second Jewett Aff.*, Exhibit E) Mr. Jewett should have provided clear instruction to the part-time bookkeeper and later inquired as to the status of payment of the maintenance fees for this patent, given his knowledge of the financial difficulties and dissolution of AAG.

AAG's counsel, Moffat & Company, unsuccessfully attempted to contact AAG in December 2004 via fax, telephone, and mail in order to obtain renewal instructions. The reconsideration petition argues the law firm's communication system failed to locate AAG and the law firm made an assumption about the status of the business after its employee noted that the telephone had been disconnected. Petitioner argues this is unavoidable delay.

It is noted Moffat & Company's reminder letter is addressed to Larry Jewett at AAG's former address. While Moffat & Company arguably had a reliable docketing system, it cannot be said that Mr. Jewett acted as a reasonably prudent person when he failed to inform Moffat & Company of an operational address/phone number/fax number. Counsel should have been notified of the change in address and lack of phone/facsimile service. A reasonably prudent and careful man taking care of his most important business would have informed his counsel of current contact information. Petitioner is advised that delay resulting from a failure in communication between a client and a registered practitioner is not unavoidable delay. In Re Kim, 12 U.S.P.Q.2d 1595 (Comm'r Pat. 1988). The failure to communicate was the direct result of Mr. Jewett failing to keep counsel informed of a way to contact him.

Diligence on the part of Mr. Jewett, the patentee, is essential to establish unavoidable delay. See, Douglas v. Manbeck, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991). Mr. Jewett's preoccupation with salvaging other aspects of his business took precedence over maintaining his patent. The showing of record is that the delay in taking action in the above-identified patent was the result of Mr. Jewett's preoccupation with other matters. Petitioner's preoccupation with other matters which took precedence over the above-identified patent does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

As president, Mr. Jewett was aware that AAG was in financial difficulties due to "mad cow disease", but failed to inquire whether or not the patent was being maintained in force. Mr. Jewett was aware that AAG's assets were sold in 2001 and that the patent license was terminated in 2006, but Mr. Jewett did not make inquiries about whether or not the 7 ½ year maintenance fee was paid. Mr. Jewett failed to notice the third maintenance fee was not paid, as well, despite the fact that he was doing business in the U.S. using the shipping containers. It is noted that by the time the final maintenance fee was due, it was solely Mr. Jewett's responsibility to monitor, docket, and pay it, since the purported exclusive license terminated in 2006 when AAG was dissolved. *Second Jewett Aff.*, p.7. It appears no one was tracking the 11 ½ year maintenance fee. The record, as it stands now, fails to show that patentee or his representatives took the due care of a reasonably prudent and careful person, in relation to his most important business. Pratt, supra.

It appears petitioner discovered the patent had lapsed after Mr. Jewett sold his patent rights to petitioner. Unfortunatley, Mr. Jewett did not exercise the level of due care generally used and observed by prudent and careful men in relation to their most important business.

Any delay resulting from the actions or inactions of the patentee is binding upon petitioner, ST Reproductive Technologies, LLC, as the successor in title. See, Winkler v. Ladd, 221 F.Supp. 550, 552, 138 USPQ 666, 667 (D.D.C. 1963). While petitioner gained ownership of this patent in January 2010, such merely gave petitioner standing to file the instant petition on or after that date. Lastly, that one may have subsequently exercised diligence after their assumption of title and belated awareness of the need to pay the fee does not convert the preceding delay into unavoidable delay. See Kim v. Quigg, 718 F.Supp. 1280, 12 USPQ2d 1604 (E.D. Va 1989).

Decision

The prior decision which refused to accept under 37 CFR 1.378(b) the delayed payment of two maintenance fees for the above-identified patent has been reconsidered. For the reasons herein and stated in the previous decision, the entire delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. 41(c)(1) and 37 CFR 1.378(b). Therefore, the petition is denied.

As stated in 37 CFR 1.378(e), the Office will not further consider or review the matter of the reinstatement of the patent.

In due course, the $2,480.00 7 ½ year maintenance fee, the $4,110.00 11 ½ year maintenance fee, and the $700.00 surcharge after expiration when late payment is unavoidable will be refunded to petitioner's credit card. The reconsideration fee of $400.00 will be retained.

Telephone inquiries may be directed to Petitions Attorney Shirene Willis Brantley at (571) 272-3230.

The patent file is being forwarded to Files Repository.

Anthony Knight
Director
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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ANTONELLI, TERRY, STOUT & KRAUS
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON VA 22209

In re Patent No. 6,442,527 :
Issue Date : August 27, 2002 :
Application No. 08/405,964 : ON PETITION
Filed: March 17, 1995 :
Attorney Docket No. :

This is a decision on the petition under 37 CFR 1.378(c), filed October 3, 2011, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(c) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2). This petition lacks items (2) and (3) above.

With respect to items (2) and (3): The Office is unable to charge the maintenance fee and surcharge as indicated in the petition filed October 3, 2011. In this regard, the attorney authorizing the payments, Kahlil Mitchell, is not an authorized user. To satisfy the requirement of 37 CFR 1.378(c) the current seven and one half year maintenance fee and surcharge must be submitted. No consideration on the merits can be given until the required fees are remitted.

Any petition for reconsideration of this decision must be accompanied by the **petition fee of $400** as set forth in 37 CFR 1.17(f). The petition for reconsideration must include the lacking item(s) noted above , since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within **TWO (2) MONTHS** from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

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

By Mail:
Mail Stop PETITION
Commissioner for Patents
Post Office 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 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

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

KATHY A. WORTHINGTON
10 GLEN AVON DRIVE
RIVERSIDE CT 06878

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DEC 15 2011
OFFICE OF PETITIONS

In re Patent No. 6,442,527 :
Issue Date : August 27, 2002 :
Application No. 08/405,964 : ON PETITION
Filed: March 17, 1995 :
Attorney Docket No. :

This is a decision on the renewed petition under 37 CFR 1.378(e), filed December 9, 2011, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on August 27, 2010, for failure to pay the seven and one-half year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. 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 the delay in paying the maintenance fee under 37 CFR 1.378(c) was intentional, petitioner must notify the Office.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted. While a courtesy copy of this decision is being mailed to the person signing the

petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

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

The patent file is being forwarded to Files Repository.

/Diane Goodwyn/
Diane Goodwyn
Petitions Examiner
Office of Petitions

cc: KAHLIL MITCHELL
GTC LAW GROUP LLP & AFFILIATES
C/O CPA GLOBAL
P.O. BOX 52050
MINNEAPOLIS, MN 55402

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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STEVEN D. RIEDEL
PRESIDENT AND CEO
ATRIX INTERNATIONAL, INC.
14301 EWING AVENUE SOUTH
BURNSVILLE, MN 55337

MAILED
FEB 27 2012
OFFICE OF PETITIONS

In re Patent No. 5,673,190 :
Issue Date: September 30, 1997 :
Application No. 08/408,563 : ON PETITION
Filed: March 22, 1995 :
Patentee(s): Curtis O. Kahleck, et. al. :

This is a decision in response to the renewed petition, filed on September 19, 2011, to accept the delayed payment of a maintenance fee for the above-identified patent under 37 CFR 1.378(e).

The petition is **DISMISSED** under the provisions of 37 CFR 1.181(f).

A review of the record shows that a decision was mailed on July 15, 2010, which set a response period of two months from the mail date of the decision. The decision also stated that no extension of the two month time limit can be granted. Accordingly, a renewed petition, including the $400 petition fee, was due on or before September 15, 2010. Since the present petition was filed on September 19, 2011, it is properly dismissed as untimely[1].

Petitioner should note that an appropriate petition under 37 CFR 1.378(c) must be filed within twenty-four months from the date of expiration; however, any new petition filed in response to this decision would be barred from filing under 37 CFR 1.378(c)[2], since it would be outside the twenty-four months provided.

However, the Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if the delay in filing a grantable petition under 37 CFR 1.378(b) is shown to the satisfaction of the Director to have been unavoidable. Any petition to accept an unavoidably delayed payment of a maintenance fee must include:

[1] *See* 37 CFR 1.181(f).

[2] This patent expired on September 30, 2009.

(1) the required maintenance fee set forth in §1.20 (e)-(g);
(2) the surcharge set forth in § 1.20(i)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

Petitioner is advised that the mere suggestion of a filing a petition under the unavoidable provisions of 37 CFR 1.378(b), does not necessarily mean the petition will be granted. All the requirements of 37 CFR 1.378(b) must be met.

In view of this decision, the maintenance fee and surcharge in the amount of $2,130 is being refunded to petitioner by Treasury Check, in due course.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

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
By Internet:	EFS-Web[3]

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

/Andrea Smith/
Andrea Smith
Petitions Examiner
Office of Petitions

[3] www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5640674	1997-06-17	08410901	1995-03-27	211/241

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-07
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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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P.O. Box 1450
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In re Patent No. 5640674
Issue Date: June 17,1997
Application No. 08410901
Filed: March 27,1995
Attorney Docket No. 211/241

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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JUL 11 2011

OFFICE OF PETITIONS

REED SMITH LLP
P.O. BOX 488 (NYC)
PITTSBURGH PA 15230-0488

In re Patent No. 5,628,758 :
Issue Datae: May 13, 1997 :
Application No. 08/413,357 : NOTICE
Filed: March 30, 1995 :
Attorney Docket No. GK-POR-728 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 on March 31, 2011.

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

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

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

Inquiries related to this communication should be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,679,945	1997-10-21	08414495	1995-03-31	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

◉ The assignee of record of the entire interest

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The Assignee of record of the entire interest			
Under 37 CFR 3.71 an assignee becomes of record by filing a statement in compliance with 37 CFR 3.73(b). Signature requirements are set forth in 37 CFR 1.4(d), and the undersigned certifies that he / she is empowered to act on behalf of the assignee of the entire interest			
Signature	/Thomas Corder/	Date (YYYY-MM-DD)	2011-08-16
Name	Thomas Corder, President, BridgePoint Systems, Inc		
Enter Reel and Frame Number			Remove
Reel Number	007539	Frame Number	0667
Enter Reel and Frame Number			Remove
Reel Number	007628	Frame Number	0860
Enter Reel and Frame Number			Remove
Reel Number	013258	Frame Number	0341
Enter Reel and Frame Number			Remove
Reel Number	013589	Frame Number	0664
Click ADD for additional Reel Number and Frame Number			Add

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

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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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In re Patent No. 5679945
Issue Date: October 21,1997
Application No. 08414495
Filed: March 31,1995
Attorney Docket No. 2555.49292

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed August 16,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of August 16,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,857,109	1999-01-05	08/419,835	1995-04-11	046301-121500

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Amanda Y. Baker, Reg. No. 68,846/	Date (YYYY-MM-DD)	2012-02-22
Name	Amanda Y. Baker	Registration Number	68846

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5857109
Issue Date: January 5,1999
Application No. 08419835
Filed: April 11,1995
Attorney Docket No. 18276.002.00

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 22,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 22,2012 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5638083	1997-06-10	08419843	1995-04-11	JAS167FWC/C

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-07
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5638083
Issue Date: June 10,1997
Application No. 08419843
Filed: April 11,1995
Attorney Docket No. JAS167FWC/C

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/09/10

TO SPE OF : ART UNIT 1600

SUBJECT : Request for Certificate of Correction for Appl. No.: 08420575 Patent No.: 5563175

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
571-272-3421

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: _____

_____

_____

_____

_____

Ardin H. Marschel
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER

_____ 1614
SPE **Art Unit**

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5894012	1999-04-13	08420848	1995-04-10	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/James F. Harvey, III/	Date (YYYY-MM-DD)	2011-10-11
Name	James F. Harvey, III	Registration Number	39706

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5894012
Issue Date: April 13,1999
Application No. 08420848
Filed: April 10,1995
Attorney Docket No. 87168-003

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 11,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 11,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20111212

DATE : December 12, 2011

TO SPE OF : ART UNIT 1621

SUBJECT : Request for Certificate of Correction on Patent No.: 6197819

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - ST (South Tower) 9A22
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

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

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

Comments:

/DANIEL SULLIVAN/
Supervisory Patent Examiner.Art Unit 1621

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

Sheridon K. Snedden
Pillsbury Winthrop Shaw Pittman, LLP (NV)
PO Box 10500
McLean VA 22102

MAILED
JAN 13 2012
OFFICE OF PETITIONS

In re Patent No. 5,622,499 :
Issued: April 22, 1997 :
Application No. 08/420,971 : NOTICE
Filed: April 10, 1995 :
For: METHOD OF MANUFACTURING A :
DENTAL ABUTMENT :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue 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**.

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, practitioner's signature appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. If practitioner desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to practitioner, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the correspondence address of record.

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

Inquiries related to this communication should be directed to the undersigned at (571) 272-3205.

/ALESIA M. BROWN/

Alesia M. Brown
Attorney Advisor
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

HARNESS DICKEY AND PIERCE
P.O. BOX 828
BLOOMFIELD HILLS MI 48303

MAILED

AUG 16 2010

OFFICE OF PETITIONS

In re Patent No. 5,664,811
Issue Date: September 9, 1997
Application No. 08/421,423
Filed: April 12, 1995
Attorney Docket No. 1203-00083

DECISION ON REQUEST FOR REFUND

This is a decision on the petition filed June 23, 2010, under 37 CFR 1.181(no fee), requesting refund of the maintenance fee paid in Patent No. 5,727,533. A copy of a request for refund to have been submitted on November 11, 2009 was also submitted.

The request is **DISMISSED**.

Petitioner asserts that the maintenance fee for Patent No. 5,727,533 in the amount of $4,110.00 was inadvertently paid on September 16, 2009.

Petitioner now files the above petition and states that, "After paying that fee, the error was discovered, and the maintenance fee was then properly paid for U.S. Patent 5,727,627.....When incorrectly paying the maintenance fee for U.S. Patent 5,727,533, the entry of the incorrect patent number apparently downloaded the serial number for '533 patent, but neither the error in the patent number nor the difference in the serial numbers were realized by the secretary paying the fee." In the copy of the request filed November 11, 2009, it states that, "The secretary paying the fee mistyped the last three digits of the patent number. We do not need the amount transferred to the captioned patent because we have paid the captioned patent's maintenance fee."

Petitioner is reminded that when paying the maintenance fee online, an error message will appear if the application and patent numbers don't match. Note EXAMPLE below:

***ERROR: There is a mismatch between the patent number and application number; verify both values and try again.**

Patent Number (exclude special characters; e.g. comas): 5,727,533
Application Number (must be 8 numeric digits – see NOTE): 08/421423

Petitioner is advised that 37 CFR 1.366(g) provides that maintenance fees and surcharges relating thereto will not be refunded except in accordance with 37 CFR 1.26 and 128(a). A

patentee cannot obtain a refund of a maintenance fee that was due and payable on the patent. Any duplicate payment will be refunded to the fee submitter.

As the maintenance fee paid in U.S. Patent No. 5,727,533 was due and payable at the time that petitioner submitted the fee, the fee is not subject to refund. This is not a situation wherein there has been a duplicate payment made.

Further, finance records show that the same account number was used in paying the second maintenance fee for patent number 5,727,533.

Thus, in accordance with 37 CFR 1.366(g), it is not deemed appropriate to refund the maintenance fee paid in U.S. Patent No. 5,727,533.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,619,451	1997-04-08	08/421,671	1995-04-12	93-RO-140

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/et/	Date (YYYY-MM-DD)	2011-03-24
Name	Edwin H. Taylor	Registration Number	25129

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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
P.O. Box 1450
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In re Patent No. 5619451
Issue Date: April 8,1997
Application No. 08421671
Filed: April 12,1995
Attorney Docket No. S1022/7247

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed March 24,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of March 24,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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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.
08/422,187	04/13/1995	SHMUEL CABILLY	22338-10232/P0150C2	7010

33694 7590 12/08/2010

SIDLEY AUSTIN LLP
717 N. Harwood
Suite 3400
Dallas, TX 75201

EXAMINER	
GAMBEL, PHILLIP	

ART UNIT	PAPER NUMBER
1644	

NOTIFICATION DATE	DELIVERY MODE
12/08/2010	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):

pair@sidley.com
ipdocketing@sidley.com

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DEC 0 8 2010

SIDLEY AUSTIN LLP
717 N. Harwood
Suite 3400
Dallas TX 75201

In re Application of: :
Cabilly et al. :
Serial No.: 08/422,187 : PETITION DECISION
Filed: April 13, 1995 :
Attorney Docket No.: **22338-10232/P0150C2**

This is in response to the letter of November 22, 2010 regarding the petition under 37 CFR § 1.59(b), filed September 9, 2004, to expunge information from the above identified application.

Applicants note that the basis of the petition filed on September 9, 2004 no longer exists as the material is no longer confidential. Accordingly, applicants withdraw the Petition to Expunge filed on September 9, 2004.

The petition is **DISMISSED** as moot.

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, 571-273-8300.

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,702,709	1997-12-30	08423099	1995-04-18	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/Lynn Schwenning/	Date (YYYY-MM-DD)	2010-09-01
Name	Lynn Schwenning	Registration Number	37233

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

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In re Patent No. 5702709
Issue Date: December 30,1997
Application No. 08423099
Filed: April 18,1995
Attorney Docket No. 16171-00003

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed September 1,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 1,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent No. 5638512
Issue Date: June 10,1997
Application No. 08424299
Filed: April 19,1995
Attorney Docket No. P7293X

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5638512	1997-06-10	08424299	1995-04-19	P7293X

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-07
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

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DIW Jun-11

Paper No. 13

MICHAEL G. MARINANGELL
SUITE 23
244 EAST 86TH STREET
NEW YORK NY 10028

MAILED

JUN 15 2011

OFFICE OF PETITIONS

In re Patent No. 5,545,456 :
Issue Date: 08/13/1996 :
Application Number: 08/425,382 : ON PETITION
Filing Date: 04/20/1995 :
For: WASH-CLOTH THAT CLEANS AND MASSAGES :

This is a decision is in response to the petition under 37 CFR 1.378(b),[1] filed on May 9, 2011, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f). 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.

The patent issued on August 13, 1996. The first maintenance fee was timely paid. The second maintenance fee could have been paid during the period from August 13, 2003, through February 13,

[1] A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);
(2) the surcharge set forth in §1.20(I)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

2004, or, with a surcharge, during the period from February 14, 2004, through August 13, 2004. Accordingly, this patent expired at midnight on August 13, 2004, for failure to timely remit the maintenance fee.

Petitioner, *pro se*, asserts, in pertinent part, that she has been suffering from severe depression due to the death of her daughter and grandson in 2004. Petitioner further asserts that she had entrusted her attorney to timely pay the second and third maintenance fees from an escrow account, but the attorney failed to timely pay the maintenance fees.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks requirement (1).

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".[2]

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").[3] Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[4] In this regard:

> 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

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[2] 35 U.S.C. § 41(c)(1).

[3] Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

[4] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

> 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.[5]

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.[6] That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.[7]

With regard to petitioner's assertion of severe depression, petitioner is informed that depression alone is not a basis for unavoidable delay. However, if the depression results in incapacitation of the petitioner, such incapacitation may constitute a showing unavoidable delay. A showing of "unavoidable" delay based upon incapacitation must establish that petitioner's incapacitation was of such nature and degree as to render petitioner unable to conduct business (*e.g.*, correspond with the Office) during the period between August 13, 2004 and May 9, 2011. Such a showing must be supported by a statement from petitioner's treating physician, and such statement must provide the nature and degree of petitioner's incapacitation during this above-mentioned period.

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[5] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

[6] Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

[7] Id.

The petition must be dismissed at this time because further information is needed in order to determine whether the circumstances surrounding the delay in payment constitute unavoidable delay. While it is noted that petitioner has provided a statement from petitioner's treating physician, the information provided does not adequately describe the nature and degree of petitioner's incapacitation during the period from when the maintenance fee was due until the filing of the present petition. Specifically, petitioner must provide a statement from the treating physician which establishes that petitioner's incapacitation was of such nature and degree as to render petitioner unable to conduct business (*e.g.*, correspond with the Office) during the period between August 13, 2004 and May 9, 2011.

While the Office is mindful petitioner's circumstances, nonetheless, a renewed petition providing a detailed discussion of the nature and degree of petitioner's incapacitation, if any, during the period from when the maintenance fee was due until the filing of the present petition, is required.

Petitioner is cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes), petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

With regard to petitioner's assertion that she relied on her attorney, while petitioner alleged chose to rely upon a registered patent practitioner, such reliance *per se* does not provide petitioner with a showing of unavoidable delay within the

meaning of 37 CFR 1.378(b) and 35 U.S.C. § 41(c).[8] Rather, such reliance merely shifts the focus of the inquiry from petitioner to whether the attorney or agent acted reasonably and prudently.[9] As such, assuming that the agent had been so engaged, then it is incumbent upon petitioner to demonstrate, via a documented showing, that the attorney or agent had docketed this patent for the second maintenance fee payment in a reliable tracking system.[10] If petitioner cannot establish that agent had been so engaged, then petitioner will have to demonstrate what steps were established by petitioner to monitor and pay the maintenance fee.

Therefore, any showing of unavoidable delay must include a statement from petitioner's registered patent practitioner, as well as any other attorney(s) of record during the period that payment of the maintenance fee was delayed, as to why action was not taken to timely submit the required maintenance fee while the patent was under that agent's control. Petitioner should send a letter (accompanied by a copy of this decision) to the registered patent practitioner by registered or certified mail, return receipt requested, indicating to the agent that the USPTO is requesting his assistance in determining the circumstances surrounding the expiration of this patent, and is specifically requesting the patent practitioner to provide a statement as to: (1) whether, and when, he first became aware that the first maintenance fee for this patent was due, and (2) why the maintenance fee was not timely submitted. Such statements should be accompanied by copies of any documents relevant to payment of the maintenance fee. In the event that the registered patent practitioner fails to provide a statement within a person (e.g. within one (1) month) specified in such letter, petitioner should submit a copy of such letter and the return receipt indicating its delivery to the patent attorney or agent with any petition for reconsideration under 37 CFR 1.378(e).

The above paragraph notwithstanding, petitioner is reminded that the failure of communication between an applicant and counsel is not unavoidable delay.[11] Specifically, delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 U.S.C. § 41(c) and 37 CFR

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[8] See California Med. Prod. v. Technol. Med. Prod., 921 F. Supp. 1219, 1259 (D. Del. 1995).

[9] Id.

[10] Id.

[11] In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

1.378(b).[12] Moreover, the Office is not the proper forum for resolving a dispute as to the effectiveness of communications between parties regarding the responsibility for paying a maintenance fee.[13]

A delay resulting from a lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP does not constitute an "unavoidable" delay.[14] As the showing of record does not rise to the level of unavoidable delay, the petition will be dismissed.

The showing of record does not support a finding of unavoidable delay. A delay resulting from a lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP does not constitute an "unavoidable" delay.[15] Additionally, petitioners' preoccupation with other matters which took precedence over the above-identified maintenance fee does not constitute unavoidable delay.[16]

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

The address of record is different from the address in the petition. If the registered patent practitioner of record is no longer representing applicant, a revocation of power of attorney should be filed. Furthermore, a courtesy copy of this decision will be mailed to the address in the petition, but all future correspondence will be mailed solely to the address of record. A change of correspondence address form is enclosed for petitioner's convenience. If the change of correspondence address is to be filed by an assignee, the assignee must establish its right to take action in accordance with 37 CFR 3.73. If petitioner desires to receive future correspondence regarding any

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[12] See Ray v. Lehman, 55 F.3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1995).

[13] Id.

[14] See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

[15] See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

[16] See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

Maintenance Fee Reminder which **may** be mailed concerning this patent, a Fee Address should be submitted to Maintenance Fee Division.

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 should be directed to the undersigned at 571-272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: PTO/SB/123

cf: TERESA SUIDA
459 WOODWARD AVE
RIDGEWOOD NY 11385

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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DIW Oct-11

MICHAEL G. MARINANGELL
SUITE 23
244 EAST 86TH STREET
NEW YORK NY 10028

MAILED

OCT 11 2011

OFFICE OF PETITIONS

In re Patent No. 5,545,456 :
Issue Date: 08/13/1996 :
Application Number: 08/425,382 : REQUEST FOR INFORMATION
Filing Date: 04/20/1995 :
For: WASH-CLOTH THAT CLANS AND MASSAGES :

This is a decision on the petition, filed on September 19, 2011, under 37 CFR 1.378(e), requesting reconsideration of the petition under 37 CFR 1.378(b) to accept the unavoidably delayed payment of maintenance fees for the above-referenced patent.

The petition is again **dismissed**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). No further fee is due for seeking reconsideration.

The patent issued on August 13, 1996. The first maintenance fee was timely paid. The second maintenance fee could have been paid during the period from August 13, 2003 through February 13, 2004, or, with a surcharge, during the period from February 14, 2004, through August 13, 2004. Accordingly, this patent expired at midnight on August 13, 2004, for failure to timely remit the maintenance fee. The petition under 37 CFR 1.378(b) filed on May 9, 2011, was dismissed on June 15, 2011. On September 19, 2011, the subject request for reconsideration under 37 CFR 1.378(e) was filed.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".[1] A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if

[1] 35 U.S.C. § 41(c)(1).

the patent owner "exercised the due care of a reasonably prudent person."[2] This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."[3] Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.[4] Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[5] However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.[6] In view of In re Patent No. 4,409,763,[7] this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

This petition does not satisfy the requirement of 37 CFR 1.378(b)(3). The statements presented in the petition fail to satisfy the showing required to establish unavoidable delay within the meaning of 37 CFR 1.378(b).

The subject request for reconsideration is accompanied by a letter from petitioner's physician, Janette Yap-Marcelo, stating that petitioner has been suffering from depression since 2004, and due to her severe depression, petitioner has been unable to handle paying of bills in a timely manner.

While petitioner has provided a statement from her physician in regard to the assertion of unavoidable delay due, petitioner has not provided any additional information in regards to her attorney. In the original petition, petitioner stated that she entrusted her attorney to calendar the due dates and to pay the maintenance fees.

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2 Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

3 Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

4 In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

5 Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "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"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

6 Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

7 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

The decision mailed on June 15, 2011, stated that any showing of unavoidable delay must include a statement from petitioner's registered patent practitioner, as well as any other attorney(s) of record during the period that payment of the maintenance fee was delayed, as to why action was not taken to timely submit the required maintenance fee while the patent was under that agent's control.

As such, petitioner must show what efforts were made to contact the attorney who docketed the maintenance fee payment. Petitioner must explain whether the attorney attempted to pay the maintenance fee, and whether his docketing system was working properly. Petitioner must further explain what actions the attorney took to pay the maintenance fee, and whether he communicated with patentee regarding payment of the maintenance fee.

Petitioner should send a letter (accompanied by a copy of this decision) to the registered patent practitioner by registered or certified mail, return receipt requested, indicating to the agent that the USPTO is requesting his assistance in determining the circumstances surrounding the expiration of this patent, and is specifically requesting the patent practitioner to provide a statement as to: (1) whether, and when, he first became aware that the first maintenance fee for this patent was due, and (2) why the maintenance fee was not timely submitted. Such statements should be accompanied by copies of any documents relevant to payment of the maintenance fee. In the event that the registered patent practitioner fails to provide a statement within a person (e.g. within one (1) month) specified in such letter, petitioner should submit a copy of such letter and the return receipt indicating its delivery to the patent attorney or agent with any petition for reconsideration under 37 CFR 1.378(e).

In the absence of a documented showing of any attempts to contact petitioner's attorney and obtain an explanation from him as to why the maintenance fee was not timely paid, the Office is precluded from finding that the entire delay was unavoidable. As such, petitioner must provide a documented showing of the efforts made, as stated above, to contact the attorney and obtain a statement from him regarding the docketing and payment, or lack thereof of the maintenance fee.

A reply to this communication should be filed within TWO (2) MONTHS to be considered timely. **No extensions of time are permitted under 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 FAX: (571) 273-8300
Attn: Office of Petitions

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

A reply may also be filed via EFS-Web.

The address in the petition is different than the correspondence address of record. A courtesy copy of this decision will be sent to the address in the petition. All future correspondence, however, will be mailed solely to the address of record. **A change of correspondence address should be filed if the correspondence address needs to be updated** (form attached).

Telephone inquiries should be directed to the undersigned at 571-272-3231.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: PTO/SB/123

Cc: TERESA SUIDA
459 WOODWARD AV
RIDGEWOOD NY 11385

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5736619	1998-04-07	08426245	1995-04-21	70265-00006

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-08-11
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5736619
Issue Date: April 7,1998
Application No. 08426245
Filed: April 21,1995
Attorney Docket No. 70265-00006

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed August 11,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of August 11,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

MAILED

DEC 07 2010

OFFICE OF PETITIONS

In re Application of :
Masato OKABE :
Application No. 08/428,325 : DECISION GRANTING PETITION
Filed: April 25, 1995 : UNDER 37 CFR 1.313(c)(3)
Attorney Docket No. **2122-4028** :

This is a decision on the petition, filed December 3, 2010, 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.

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

/Monica A. Graves/
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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MARSH, FISCHMANN & BREYFOGLE LLP
8055 East Tufts Avenue
Suite 450
Denver CO 80237

MAILED

JAN 07 2011

OFFICE OF PETITIONS

Paper No. 19

In re Patent No. 5,803,912 :
Issue Date: September 8, 1998 :
Application No. 08/428,563 : ON PETITION
Filed: April 25, 1995 :
Attorney Docket No. 2530-20-2 :

This is a decision on the petition under 37 CFR 1.378(b), filed June 22, 2010, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within **TWO (2) MONTHS** from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f). 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, the Director will undertake no further reconsideration or review of the matter.

The patent issued on September 8, 1998. The second (7½ year) maintenance fee was due March 8, 2006 and could have been paid from September 8, 2005 through March 8, 2006 or with a surcharge during the time period from March 9, 2006 through September 8, 2006. Accordingly, the patent expired at midnight September 8, 2006, for failure to timely submit the first maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1) above.

The petition asserts that failure of the previous assignee, Hologic Inc. (Hologic), to meet their contractual agreement to pay the maintenance fee was the reason the maintenance fee was not paid in a timely manner. Petitioner avers that despite reasonable care and reasonable steps in place to ensure timely payment by the current assignee, Siemens AG (Siemens), the failure to pay the maintenance fee in a timely manner was unavoidable. As discussed below, Siemens had, in fact, no steps in place to track the timely payment of the second maintenance fee in this patent.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, i.e. "unavoidable delay". Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard in determining if the delay in responding to an Office action was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "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"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In essence, petitioner must show that he was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment due to his financial condition until the petition was filed.

As the patent holder at the time of expiration, it was incumbent on petitioner to have itself docketed this patent for payment of the maintenance fee in a reliable system as would be employed by a prudent and careful person with respect to his most important business, or to have engaged another for that purpose. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). Even where another has been relied upon to pay the maintenance fees, such asserted reliance per se does not provide a petitioner with a showing of unavoidable delay within the meaning of 37 CFR § 1.378(b) and 35 USC § 41(c). Id. Rather, such reliance merely shifts the focus of the inquiry from the petitioner to whether the obligated party acted reasonably and prudently. Id. Nevertheless, a petitioner is bound by any errors that may have been committed by the obligated party. Id.

However, the record fails to show that adequate steps within the meaning of 37 CFR 1.378(b)(3) were taken by or on behalf of petitioner to schedule or pay the maintenance fee. Petitioner is reminded that 37 CFR 1.378(b)(3) is a validly promulgated regulation, as is the requirement therein for petitioner's showing of the steps taken to pay the fee. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. In the absence of a showing of the steps taken by or on behalf of petitioner, 37 CFR 1.378(b)(3) precludes acceptance of the maintenance fee.

As set out in the petition, Siemens acquired the above identified patent from Hologic in June of 2006. As noted in the declaration of Dieter Mausolf, paragraph 9, Siemens was responsible for payment of maintenance fees only from the date forward of the contract between Hologic and Siemens which was June 26, 2006. However, with a surcharge, the second maintenance fee could have been paid no later than September 8, 2006. The window to pay the second maintenance fee for this patent bridged the time period from when Hologic owned the patent and when Siemens owned the patent. Thus Siemens had the

responsibility to pay the maintenance fee at the time of expiration of the patent, and more importantly, the time window to pay the maintenance fee. Paragraph 10 of this same declaration indicates that Siemens' docketing system "automatically suppresses the payment reminder when the payment is made by another entity." This system would appear flawed at best in a situation such as this where the responsibility to pay the maintenance fee was the responsibility of another entity, Hologic, at the beginning of the payment window but is the responsibility of Siemens at the end of the window. Further, a docketing system that suppresses the payment reminder removes the ability of Siemens to track payment of maintenance fees, a key requirement for any grantable petition for unavoidable delay in payment of maintenance fees.

The record to date indicates petitioner had no steps in place to track and pay the second maintenance fee and thus without any such plan in place, the failure to pay the second maintenance fee in a timely manner cannot be said to be unavoidable. As noted in the petition, Siemens was not aware the second maintenance fee had not been paid until such time as the third maintenance fee was due. How can petitioner track and pay maintenance fees if they do not maintain a complete history of maintenance fee payments, regardless of who actually is responsible to pay them?

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee does not constitute unavoidable delay. For this reason, the petition is dismissed.

Petitioner is advised, however, that the USPTO is not the forum for resolving a dispute between a patent owner and his representative as to who bore the responsibility for paying a maintenance fee. See Ray, 55 F. 3d at 610, 34 USPQ2d at 1789.

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 Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Telephone inquiries should be directed to Carl Friedman at (571) 272-6842.

David Bucci
Petitions Examiner
Office of Petitions

cc: Ursula B. Day
798 Third Avenue, Suite 1501
New York, NY 10017

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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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OFFICE OF PETITIONS

HENRY M FEIEREISEN, LLC
HENRY M FEIEREISEN
708 THIRD AVENUE
SUITE 1501
NEW YORK NY 10017

Paper No. 19

In re Patent No. 5,803,912 :
Issue Date: September 8, 1998 :
Application No. 08/428,563 : ON PETITION
Filed: April 25, 1995 :
Attorney Docket No. 2530-20-2 :

This is a decision on the petition under 37 CFR 1.378(b), filed June 22, 2010, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within **TWO (2) MONTHS** from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f). 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, the Director will undertake no further reconsideration or review of the matter.

The patent issued on September 8, 1998. The second (7½ year) maintenance fee was due March 8, 2006 and could have been paid from September 8, 2005 through March 8, 2006 or with a surcharge during the time period from March 9, 2006 through September 8, 2006. Accordingly, the patent expired at midnight September 8, 2006, for failure to timely submit the first maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1) above.

The petition asserts that failure of the previous assignee, Hologic Inc. (Hologic), to meet their contractual agreement to pay the maintenance fee was the reason the maintenance fee was not paid in a timely manner. Petitioner avers that despite reasonable care and reasonable steps in place to ensure timely payment by the current assignee, Siemens AG (Siemens), the failure to pay the maintenance fee in a

timely manner was unavoidable. As discussed below, Siemens had, in fact, no steps in place to track the timely payment of the second maintenance fee in this patent.

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

Acceptance of late payment of a maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, i.e. "unavoidable delay". Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard in determining if the delay in responding to an Office action was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "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"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

In essence, petitioner must show that he was aware of the need to pay the maintenance fee, and to that end was tracking it, or had engaged someone to track it before the expiration, but when the fee came due, was "unavoidably" prevented from making the maintenance fee payment due to his financial condition until the petition was filed.

As the patent holder at the time of expiration, it was incumbent on petitioner to have itself docketed this patent for payment of the maintenance fee in a reliable system as would be employed by a prudent and careful person with respect to his most important business, or to have engaged another for that purpose. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). Even where another has been relied upon to pay the maintenance fees, such asserted reliance per se does not provide a petitioner with a showing of unavoidable delay within the meaning of 37 CFR § 1.378(b) and 35 USC § 41(c). Id. Rather, such reliance merely shifts the focus of the inquiry from the petitioner to whether the obligated party acted reasonably and prudently. Id. Nevertheless, a petitioner is bound by any errors that may have been committed by the obligated party. Id.

However, the record fails to show that adequate steps within the meaning of 37 CFR 1.378(b)(3) were taken by or on behalf of petitioner to schedule or pay the maintenance fee. Petitioner is reminded that 37 CFR 1.378(b)(3) is a validly promulgated regulation, as is the requirement therein for petitioner's showing of the steps taken to pay the fee. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. In the absence of a showing of the steps taken by or on behalf of petitioner, 37 CFR 1.378(b)(3) precludes acceptance of the maintenance fee.

As set out in the petition, Siemens acquired the above identified patent from Hologic in June of 2006. As noted in the declaration of Dieter Mausolf, paragraph 9, Siemens was responsible for payment of maintenance fees only from the date forward of the contract between Hologic and Siemens which was June 26, 2006. However, with a surcharge, the second maintenance fee could have been paid no later

than September 8, 2006. The window to pay the second maintenance fee for this patent bridged the time period from when Hologic owned the patent and when Siemens owned the patent. Thus Siemens had the responsibility to pay the maintenance fee at the time of expiration of the patent, and more importantly, the time window to pay the maintenance fee. Paragraph 10 of this same declaration indicates that Siemens' docketing system "automatically suppresses the payment reminder when the payment is made by another entity." This system would appear flawed at best in a situation such as this where the responsibility to pay the maintenance fee was the responsibility of another entity, Hologic, at the beginning of the payment window but is the responsibility of Siemens at the end of the window. Further, a docketing system that suppresses the payment reminder removes the ability of Siemens to track payment of maintenance fees, a key requirement for any grantable petition for unavoidable delay in payment of maintenance fees.

The record to date indicates petitioner had no steps in place to track and pay the second maintenance fee and thus without any such plan in place, the failure to pay the second maintenance fee in a timely manner cannot be said to be unavoidable. As noted in the petition, Siemens was not aware the second maintenance fee had not been paid until such time as the third maintenance fee was due. How can petitioner track and pay maintenance fees if they do not maintain a complete history of maintenance fee payments, regardless of who actually is responsible to pay them?

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee does not constitute unavoidable delay. For this reason, the petition is dismissed.

Petitioner is advised, however, that the USPTO is not the forum for resolving a dispute between a patent owner and his representative as to who bore the responsibility for paying a maintenance fee. See Ray, 55 F. 3d at 610, 34 USPQ2d at 1789.

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Telephone inquiries should be directed to Carl Friedman at (571) 272-6842.

David Bucci
Petitions Examiner
Office of Petitions

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OFFICE OF PETITIONS

HENRY M FEIEREISEN, LLC
HENRY M FEIEREISEN
708 THIRD AVENUE
SUITE 1501
NEW YORK NY 10017

In re Patent No. 5,803,912
Issue Date: September 8, 1998
Application No. 08/428,563
Filed: April 25, 1995
Attorney Docket No. SICZEK

ON PETITION

This is a decision on the petition for reconsideration, filed March 30, 2011, which is being treated as a petition under 37 CFR 1.378(e), to reconsider the decision refusing to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition under 37 CFR 1.378(e) is **DENIED.**

BACKGROUND

The patent issued on September 8, 1998. The second (7½ year) maintenance fee was due March 8, 2006 and could have been paid from September 8, 2005 through March 8, 2006 or with a surcharge during the time period from March 9, 2006 through September 8, 2006. Accordingly, the patent expired at midnight September 8, 2006.

A petition to accept to accept the seven and one-half year maintenance fee as unavoidably delayed under 37 CFR 1.378(b) was filed June 22, 2010 and was dismissed in a decision mailed February 1, 2011.

The instant request for reconsideration was filed March 30, 2011.

Petitioner requests reconsideration of the decision mailed February 1, 2011. Petitioner states that the delay in paying the maintenance fee was unavoidable due to some form of human error.

STAUTE AND REGULATION

35 U.S.C. § (2)(B)(2) provides, in part, that:

> The Office-- may, establish regulations, not inconsistent with law, which
>
> (A) shall govern for the conduct of proceedings in Office.

35 U.S.C. § 41(c)(1) provides that:

> The Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

37 CFR 1.378(b) provides that:

> (b) Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:
>
> (1) The required maintenance fee set forth in §1.20 (e) through (g);
>
> (2) The surcharge set forth in §1.20(i)(1); and
>
> (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

37 CFR 1.378(e) provides that:

> Reconsideration of a decision refusing to accept a maintenance fee upon petition filed pursuant to paragraph (a) of this section may be obtained by filing a petition for reconsideration within two months of, or such other time as set in the decision refusing to accept the delayed payment of the maintenance fee. Any such petition for reconsideration must be accompanied by the petition fee set forth in § 1.17(f). After the decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director. If the delayed payment of the maintenance fee is not

> accepted, the maintenance fee and surcharge set forth in § 1.20(i) will be refunded following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed. Any petition fee under this section will not be refunded unless the refusal to accept and record the maintenance fee is determined to result from an error by the Patent and Trademark Office.

OPINION

Petitioner has not met the burden of proving to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b).

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses the identical language, i.e., "unavoidable" delay. Ray v. Lehman, 55 F.3d 606, 608 09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)).

Decisions on reviving abandoned applications 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.

In re Mattullath, 38 App. D.C. 497, 514 15 (D.C. Cir. 1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32 33 (Comm'r Pat. 1887) see also Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case by case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960)(35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee is unavoidable. See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876

(D.D.C. 1990), *aff'd* 937 F.2d 623 (Fed. Cir. 1991)(table), *cert. denied*, 502 U.S. 1075 (1992); Ray v. Lehman, *supra*.

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995). That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the maintenance fee for this patent. Id.

Petitioner requests reconsideration of the previous adverse decision on the petition filed under 37 CFR 1.378(b). Petitioner references a paragraph in the adverse decision in regard to financial condition being a possible form of unavoidable delay in timely paying a maintenance fee. This paragraph was cited merely to exemplify a possible cause of unavoidable delay. However, financial condition has no bearing on petitioner's particular situation, the non-timely payment of the second maintenance fee being caused by a failure in the tracking system.

As the patent holder at the time of expiration, it was incumbent on Siemens to have itself docketed this patent for payment of the maintenance fee in a reliable system as would be employed by a prudent and careful person with respect to his most important business, or to have engaged another for that purpose. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). During the fee payment period from September 8, 2005 through June 25, 2006, Hologic was responsible for tracking and paying the maintenance fee. However, even where another has been relied upon to pay the maintenance fees, such asserted reliance per se does not provide a petitioner with a showing of unavoidable delay within the meaning of 37 CFR § 1.378(b) and 35 USC § 41(c). Id. Rather, such reliance merely shifts the focus of the inquiry from the petitioner to whether the obligated party acted reasonably and prudently. Id. Nevertheless, a petitioner is bound by any errors that may have been committed by the obligated party. Id. Nonetheless, the fee was not due until March 8, 2006, and could have been paid with a surcharge until September 8, 2006. From June 26, 2006 to September 8, 2006, Hologic was not responsible for payment of the fee as this patent was assigned to Siemens. Rather, during this period, responsibility for paying the fee fell to Siemens.

Despite petitioner's arguments to the contrary, there is no evidence that Hologic was responsible for paying the maintenance fee per the agreement. Even assuming, *arguendo*, that Hologic was responsible prior to June 26, 2006, Siemens was responsible for tracking and paying the maintenance fee at the time of expiry of the patent and it was incumbent upon Siemens to have steps in place for tracking and paying the maintenance fee.

However, the record fails to show that adequate steps within the meaning of 37 CFR 1.378(b)(3) were taken by or on behalf of petitioner to schedule or pay the maintenance fee due September 8, 2006; in fact there were no steps taken by or behalf of petitioner to pay the fee after the June 26,

2006 agreement between Siemens and Hologic. Petitioner is reminded that 37 CFR 1.378(b)(3) is a validly promulgated regulation, as is the requirement therein for petitioner's showing of the steps taken to pay the fee. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. In the absence of a showing of the steps taken by or on behalf of petitioner, 37 CFR 1.378(b)(3) precludes acceptance of the maintenance fee. See also Korsinsky v. Godici, 2005 US Dist. LEXIS 20850 at *13 (S.D. N.Y. 2005), *aff'd sub nom* Korsinsky v. Dudas, 2007 US Dist. LEXIS 7986 (Fed. Cir. 2007); R.R. Donnelley & Sons v. Dickinson, 123 F.Supp.2d 456, 460, 57 USPQ2d 1244 (N.D. Il. 2000)(failure of patent owner to itself track or obligate another to track the maintenance fee precluded acceptance of the maintenance fee); California, supra; MMTC v. Rogan, 369 F.Supp2d 675 (E.D. Va 2004)(passive reliance on USPTO reminder notice resulting in failure to take any steps to ensure payment of the maintenance fee is not unavoidable delay); Femspec v. Dudas, 2007 U.S. Dist. LEXIS 8482 (N.D.Ca 2007)(lack of any steps in place to maintain patent in force by estate executor unfamiliar with patent law is not unavoidable delay); Burandt. v. Dudas, 496 F.Supp.2d 643 at 650 (E.D. Va 2007)(delay not unavoidable where no steps shown to be employed to remind responsible party to timely pay maintenance fees.)

In fact, at the time the maintenance fee fell due the showing of record is that Siemens had no steps in place to ensure timely payment of the maintenance fee, which is fatal to reinstatement. See 37 CFR 1.378(b)(3); Ray, supra; Korsinsky, supra. The failure by Siemens to take any action regarding this patent from June 26, 2006, until September 8, 2006, or to obligate another to pay the fee, or even to query the USPTO, or even to inquire with Hologic (or even the USPTO) as to whether the maintenance fee for this patent had been paid by Hologic who Siemens contends should have paid the fee prior to June 26, 2006, is simply not the manner in which prudent and careful persons conduct their most important business. This is because Siemens had entered Hologic into the Siemens IPAS docketing system as an outside cost carrier and the docketing system automatically suppresses the payment reminder for payment when the payment is made by another entity. Mausolf decl. filed June 22, 2010, ¶ 10. While Siemens blindly remained under the impression that Hologic was tracking the fee payment, such blind faith is not the action of a prudent and careful person with respect to his or her most important business. See Burandt v. Dudas, 496 F.Supp.2d 643 at 650 (E.D. Va 2007). What Siemens did know, on and after June 26, 2006, was that it had released Hologic from its obligations with respect to this patent, and that Siemens had no steps in place of itself.

Indeed, Siemens maintains that it was reasonable and prudent to have assumed that Hologic had paid the fee because according to the agreement between Siemens and Hologic, Siemens was responsible for any cost for patent prosecution including the payment of the patent maintenance fees only from the date forward of the contract between Hologic and Siemens, namely June 26, 2006. Siemens believes this even though they were aware that as of April 20, 2006 Hologic had not paid the maintenance fee. Mausolf decl. ¶¶ 7 and 9. California, supra (noting that "if [the patent attorney] had ceased representing [the patent owner] for some reason, [the patent owner] would have been obligated at that time to either familiarize himself with the maintenance fee requirements or retain new counsel..."); Femspec, at * 26-*27 (quoting California); Burandt, supra at 461 (finding that delay not unavoidable because "[o]ther than blindly leaving the maintenance fees for the '031 patent to [a third party]...plaintiff has not established that any

steps were taken."). Siemens knew, or should have known that it was not tracking the maintenance fee due on or about September 4, 2006, the fee payment group received an error protocol from the system for a series of files including this patent which said that the 8th year maintenance could not be paid automatically due to the lack of information on the year for which the fee payment was due. Mausolf received an e-mail from Munzinger of the fee payment group, on September 4, 2006, which asked "From what date on are we responsible for payment of the yearly maintenance fees?" Mausolf responded on September 14, 2006, "As of immediately we are taking on the JG-monitoring-and payment." Mausolf decl. ¶¶ 11-12, Exhibits C and D. Yet, even given an error message from the IPAS docketing system Siemens failed to inquire with either Hologic or the USPTO as to whether the maintenance fee had been paid.

However delay resulting from the failure of the patent holder to have any steps in place to pay the fee by either obligating a third party to track and pay the fee, or by itself assuming the obligation to track and pay the fee, is not unavoidable delay. See R.R. Donnelley & Sons Co. v. Dickinson, 123 F.Supp.2d 456, 460, 57 USPQ2d 1244, 1247 (N.D. Ill. 2000)(failure of patent owner to itself track or obligate another to track the maintenance fee precluded acceptance of the maintenance fee; Ray, supra; California, supra; MMTC v. Rogan, 369 F.Supp2d 675 (E.D. Va 2004)(passive reliance on reminder notice resulting in failure to take any steps to ensure payment of the maintenance fee is not unavoidable delay); Femspec v. Dudas, 2007 U.S. Dist. LEXIS 8482 (N.D.Ca 2007)(lack of any steps in place to maintain patent in force by estate executor unfamiliar with patent law is not unavoidable delay); Burandt. v. Dudas, supra (delay not unavoidable where no steps shown to be employed to remind responsible party to timely pay maintenance fees, no inquiry by patent holder of responsible party or even Patent and Trademark Office as to whether maintenance fees would, or already had been paid.) While petitioner continues to assert that the docketing system and personnel at Siemens were reliable, such that Siemens was prudent in its reliance thereon, this contention is not readily reconciled with petitioner's concurrent admission that an error message was generated by the IPAS docketing system and there was no inquiry made as to whether the maintenance fee had been paid.

The evidence of record indicates that: (1) from September 8, 2005 to June 25, 2006, Hologic was the party responsible for tracking the due date of the maintenance fee; (2) from June 26, 2006 to September 8, 2006 Siemens was responsible for tracking the due date of the maintenance fee; (3) Siemens entered the patent into the IPAS docketing system with an indication that Hologic was an outside carrier and thus suppressed the reminder to pay the fee, thus suppressing the payment reminder, and thus there was no tracking system in place to pay the 7 ½ year maintenance fee; (4) the IPAS system generated an error message indicating that the fee could not be automatically paid; and (5) Siemens failed to act upon this error message and check to see if the fee had been paid.

As noted in MPEP 711.03(c) subsection (II)(C)(2), a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(A) the error was the cause of the delay at issue;

(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and

(C) the employee(s) was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

See In re Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

Unfortunately, the showing of record is that conditions (a), (b), and (c) supra were not met. That is, as noted above, the cause of the delay was Siemen's failure, after acquiring the patent from Hologic, to provide a system to ensure that the maintenance fee would be timely paid. The facts are that the 7 ½ year maintenance fee was not paid because steps were not in place to track and pay the fee. The patent was entered into the IPAS docketing system by Siemens; however, the maintenance fee could not be paid automatically due to the lack of information on the year for which the fee payment was due and Hologic was entered into the docketing system as an outside cost carrier which suppressed the payment reminder. Moreover, there is no evidence that when the docketing system generated an error message that anyone at Siemens inquired with Hologic or the USPTO to see if the fee had been paid. These are not the actions of a prudent and careful person with respect to his or her most important business, and as such preclude a reasonable and rational finding that the delay in payment of the maintenance fee was unavoidable. Rather, a prudent and careful person with respect to his or her most important business would have checked to see if the maintenance fee had been paid and it had not been paid would have initiated its own steps to track and pay the fee. See California, supra (noting that "if [the patent attorney] had ceased representing [the patent owner] for some reason, [the patent owner] would have been obligated at that time to either familiarize himself with the maintenance fee requirements or retain new counsel..."); Femspec, at * 26-*27 (quoting California); Burandt, supra. In any event, petitioner's contention that the system in place functions in an effective manner that is manifested by its negligible error rate is not deemed persuasive. As there is no "sliding scale" based upon the care given to this patent *vis-à-vis* the maintenance in force *vel non* of other patents by the assignee; the issue is solely whether the maintenance of *this* patent –and its subsequent reinstatement, was actually conducted with the care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business. The record fails to show that the system in place had a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance. Thus, the proximate cause of the delay herein cannot be realistically ascribed to clerical error.

The record further does not support a finding of unavoidable delay, as petitioner has not shown adequate diligence in this matter. That is, a showing of diligence in matters before the USPTO on the part of the party in interest is essential to support a finding of unavoidable delay herein. See Futures Technology, Ltd. v. Quigg, 684 F. Supp. 430, 431, 7 USPQ2d 1588 (E.D. Va.

1988)(applicant's diligent inquiries into the status of the application coupled with affirmative misrepresentations by its fiduciary as to its true status which prevented more timely action showed unavoidable delay); Douglas v. Manbeck, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991), aff'd, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992) (even representation by counsel does not relieve the applicant from his obligation to exercise diligence before the USPTO; applicant's lack of diligence extending two and one half years overcame and superseded any omissions by his duly appointed representative); R.R. Donnelley & Sons v. Dickinson, 123 F.Supp.2d 456, 460, 57 USPQ2d 1244 (N.D. Il. 2000)(failure of patent owner to itself track or obligate another to track the maintenance fee and its failure to exercise diligence for a period of seven years, precluded acceptance of the maintenance fee); MMTC v. Rogan, 369 F.Supp2d 675 (E.D. Va 2004)(passive reliance on reminder notice resulting in failure to take any steps to ensure payment of the maintenance fee is not unavoidable delay); Femspec v. Dudas, 2007 U.S. Dist. LEXIS 8482 (N.D.Ca 2007)(lack of any steps in place to maintain patent in force by estate executor unfamiliar with patent law is not unavoidable delay); Burandt. v. Dudas, supra (delay not unavoidable where no steps shown to be employed to remind responsible party to timely pay maintenance fees, no inquiry by patent holder of responsible party or Patent and Trademark Office as to whether maintenance fees would, or already had been paid). The delay was not unavoidable, because had patent holder exercised the due care of a reasonably prudent person upon receipt of the letter dated April 20, 2006 which indicated that the maintenance fee had not yet been paid, petitioner would have been able to act to correct the situation in a more timely fashion. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987); Douglas, supra; Donnelley, supra; Burandt, supra.

The record does not recount a situation where any person or firm, on and after June 26, 2006: falsely represented to Siemens that the maintenance fee was being tracked by that entity on Siemens' behalf; or falsely represented to Siemens that the maintenance fee had been paid on Siemens' behalf; or falsely represented to Siemens that this patent had been maintained in force on Siemens' behalf, such that Siemens was "unavoidably" prevented from taking more timely action in this matter. Cf. Futures, supra. Rather the record shows that on and after June 26, 2006, Siemens was and remained able to freely communicate with e.g., Hologic, as to whether this patent was being tracked, whether the fee had been paid, or whether the patent was in force, and even the USPTO as to whether the fee had been paid, or whether the patent was in force. However, Siemens took no further action after June 26, 2006, with respect to tracking, paying, or checking the status of this patent until June, 2010. The record showing of this protracted absence of due care and diligence by Siemens is inconsistent with the actions of a prudent and careful person with respect to his most important business, and as such precludes a reasonable and rational finding that the delay in payment of the maintenance fee was unavoidable.

It is pointed out that in view of the inordinate delay in this case, even if petitioner could have shown the existence of a clerical error(s) in this case, it would still have been necessary to demonstrate why the lack of assignee diligence for a period of over three years should not be fatal to reinstatement. See Donnelley, supra; Douglas, supra. Rather, as also noted in Douglas, supra, and Haines, supra, it would appear that petitioner's lack of diligence would overcome and supersede any delay caused by its representative(s).

As noted above, the responsible party, Siemens, in the first period, ceased all steps in place to track the fee on an after June 26, 2006, which lead to the expiry. In the second period, Siemens took no action from expiry on September 8, 2006, to June 2010 (3 ½ years) to either check the status of the patent or enquire of either Hologic or even the USPTO, as to whether the fee had been paid and this patent maintained in force. Accordingly, having failed to show adequate activity in the first 2 of the relevant 3 time frames, any Siemens activity in the third time frame comes as too little, too late and does not excuse or mitigate the prior delay causing expiry, or the lack of an earlier attempt at reinstatement. As the court noted in Douglas v. Manbeck, at 1700:

Diligence on the part of the applicant is essential to show unavoidable delay. See Future Technology, Ltd. v. Quigg, 684 F.Supp. 430, 431 [7 USPQ2d 1588] (E.D. Va. 1988). Diligent inquiry into the status of the application is required. Id. For two and a half years there was no inquiry into the status of the application. There is no evidence that the plaintiff was misled or deceived into believing somebody was pursuing the application. The plaintiff may well have not known that his application was abandoned, but the test is whether he exercised due diligence to find out and correct the problem. Based on the facts as developed in the administrative record, the Court agrees with the Deputy Commissioner that the plaintiff failed to exercise due diligence with regard to his application. That reason alone would be sufficient to demonstrate that there was no unavoidable delay.

Thus while petitioner may have exercised diligence after being alerted to expiry, this does not excuse the delay causing expiry, or in filing the first petition, or show that Siemens exercised due diligence in finding out and correcting the problem: expiry.

DECISION

Petitioner has failed to meet his burden of proving to the satisfaction of the Director the entire delay in submission of the maintenance fee herein was unavoidable within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.378(b). Accordingly, the maintenance fee will not be accepted, this patent will not be reinstated, and this patent remains expired. The petition is **denied**.

The USPTO will not further consider or reconsider this matter. See 37 CFR 1.378(e). This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

Telephone inquiries should be directed to Carl Friedman at (571) 272-6842.

Anthony Knight
Director, Office of Petitions

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5790591	1998-08-04	08432907	1995-05-01	211/221

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-18
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5790591
Issue Date: August 4,1998
Application No. 08432907
Filed: May 1,1995
Attorney Docket No. 211/221

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 18,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 18,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5761239	1998-06-02	08432913	1995-05-01	206/300

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

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	Fee	Code
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Small Entity

	Fee	Code
○	3 ½ year	(2551)
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SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

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PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-18
Name	Kendal M. Sheets	Registration Number	47077

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In re Patent No. 5761239
Issue Date: June 2,1998
Application No. 08432913
Filed: May 1,1995
Attorney Docket No. 206/300

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

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SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110427A

DATE : April 27, 2011

TO SPE OF : ART UNIT 1638

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

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - ST (South Tower) 9A22
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

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

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

Comments:

/Anne Marie Grunberg/
Supervisory Patent Examiner, Art Unit 1661

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 5/24/11

TO SPE OF : ART UNIT 1648

SUBJECT : Request for Certificate of Correction for Appl. No.: 08435032 Patent No.: 7153510

CofC mailroom date: 05/17/11

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

You can fax the Director's/SPE response to 571-270-9990

Lamonte Newsome

Certificates of Correction Branch

571-272-3421

Thank You For Your Assistance

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

☒ **Approved** — **All** changes apply.

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

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

Comments: _____

_____

_____

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

/Zachariah Lucas/ 1648

SPE Art Unit

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

COOLEY LLP
ATTN: Patent Group
Suite 1100
777 - 6th Street, NW
WASHINGTON DC 20001

MAILED

APR 22 2011

OFFICE OF PETITIONS

In re Application of :
Buhl et al. :
Application No. 08/436670 :
Filing or 371(c) Date: 05/08/1995 : LETTER
Patent Number: 5,624,597 :
Issue Date: 04/29/1997 :
Attorney Docket Number: :
ABAX-009/01US 010265-2060 :

This is a notice regarding 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.**

Telephone inquiries concerning this petition Decision should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods
Attorney
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5795484	1998-08-18	08436761	1995-05-08	4531-111486

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kent F. Baldauf, Jr./	Date (YYYY-MM-DD)	2011-04-26
Name	Kent F. Baldauf, Jr.	Registration Number	36082

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5795484
Issue Date: August 18,1998
Application No. 08436761
Filed: May 8,1995
Attorney Docket No. 15269-50

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed April 26,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 26,2011 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,679,658	1997-10-21	08/436,770	1995-05-08	2052(204245)

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Ralph Loren/	Date (YYYY-MM-DD)	2010-11-03
Name	Ralph Loren, Esq.	Registration Number	29325

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5679658
Issue Date: October 21,1997
Application No. 08436770
Filed: May 8,1995
Attorney Docket No. CGR-004

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed November 3,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of November 3,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5608341	1997-03-04	08437621	1995-05-09	30019.29US01

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-06
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5608341
Issue Date: March 4,1997
Application No. 08437621
Filed: May 9,1995
Attorney Docket No. 30019.29US01

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5801063	1998-09-01	08437891	1995-05-09	1005-005-US

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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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 displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Michael B. Farber/	Date (YYYY-MM-DD)	2010-11-02
Name	Michael B. Farber	Registration Number	32612

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5801063
Issue Date: September 1,1998
Application No. 08437891
Filed: May 9,1995
Attorney Docket No. 30431.6US01

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed November 2,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of November 2,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5837287	1998-11-17	08437925	1995-05-09	03762.012500.4

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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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 displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Elizabeth F. Holowacz/	Date (YYYY-MM-DD)	2011-01-26
Name	Elizabeth F. Holowacz	Registration Number	42667

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 5837287
Issue Date: November 17,1998
Application No. 08437925
Filed: May 9,1995
Attorney Docket No. 1834-3

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 26,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 26,2011 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper 23

PEPPER HAMILTON LLP
400 BERWYN PARK
899 CASSATT ROAD
BERWYN PA 19312

MAILED

FEB 03 2011

OFFICE OF PETITIONS

In re Patent No. 5,753,622 :
Issue Date: May 19, 1998 :
Application No. 08/438,901 : ON PETITION
Filed: April 25, 2005 :
Title of Invention: USE OF EPIDERMAL GROWTH FACTOR AS A GASTROINTESTINAL THERAPEUTIC AGENT :

This is a decision on the petition under 37 CFR 1.378(c)[1], filed December 1, 2010, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Any petition for reconsideration of this decision must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f). The petition for reconsideration must include 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 Commissioner.

The patent issued May 19, 1998. The patent expired for failure to timely pay the third maintenance fee. The window for payment of the third maintenance fee installment with a surcharge closed on May 19, 2010.

---

[1] 37 CFR 1.378(c) provides that a petition to accept an unintentionally delayed payment of a maintenance fee must be filed within twenty-four months of the six-month grace period provided in § 1.362(e) and must include:
(1) The required maintenance fee set forth in § 1.20(e) through (g);
(2) The surcharge set forth in § 1.20(I)(2); and
(3) A statement that the delay in payment of the maintenance fee was unintentional.

However, the petition under 37 CFR 1.378(c) is signed by James A. Hardin, who is neither an attorney or agent registered to practice before the United States Patent and Trademark Office, nor is it clear that petitioner is a party in interest as required by 37 CFR 1.378(d). Since there is no indication that petitioner herein was ever empowered to handle matters regarding the instant patent, the petition to reinstate is not grantable. If petitioner desires to receive future correspondence regarding this patent, the appropriate power of attorney documentation must be submitted. If the new power of attorney and/or change of address is signed by an assignee, the assignee must comply with the requirements of 37 CFR 3.73(b). A courtesy copy of this decision will be mailed to petitioner. All future correspondence, however, will be mailed solely to the correspondence address of record.

Additionally, if petitioner desires to receive future correspondence regarding any Maintenance Fee Reminder which **may** be mailed concerning this patent, a Fee Address should be submitted to Maintenance Fee Division. A copy of the Fee Address form is included for your convenience.

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

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

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

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

cc:

JAMES A. HARDIN, Ph.D.
56 EDGEPARK CRES N.W.
CALGARY, ALBERTA T3A4CL
CANADA

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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400 BERWYN PARK
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BERWYN PA 19312

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MAR 09 2011

OFFICE OF PETITIONS

In re Patent No. 5,753,622 :
Issue Date: May 19, 1998 :
Application No. 08/438,901 : ON PETITION
Filed: April 25, 2005 :
Title of Invention: USE OF EPIDERMAL GROWTH FACTOR AS A GASTROINTESTINAL THERAPEUTIC AGENT :

This is a decision on the renewed petition under 37 CFR 1.378(c)[1], filed February 16, 2011, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The patent issued May 19, 1998. The patent expired for failure to timely pay the third maintenance fee. The window for payment of the third maintenance fee installment with a surcharge closed on May 19, 2010. A petition filed December 1, 2010 under 37 CFR 1.378(c), was dismissed in a decision mailed February 3, 2011 because it appeared that the person who signed the petition was neither an attorney or agent registered to practice before the United States Patent and Trademark Office, nor was it clear that petitioner was a party in interest as required by 37 CFR 1.378(d).

Comes now petitioner with proof that James A. Hardin is a party in interest pursuant to the statement under 37 CFR 3.73(b) and the power of attorney filed December 9, 2010.

Accordingly, the maintenance fee in this case is hereby accepted and the above-identified patent is hereby reinstated as of the mail date of this decision. Fees in the amount of $2055.00 for the third maintenance fee and $1640.00 for the surcharge have been applied.

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

[1] 37 CFR 1.378(c) provides that a petition to accept an unintentionally delayed payment of a maintenance fee must be filed within twenty-four months of the six-month grace period provided in § 1.362(e) and must include:
(1) The required maintenance fee set forth in § 1.20(e) through (g);
(2) The surcharge set forth in § 1.20(l)(2); and
(3) A statement that the delay in payment of the maintenance fee was unintentional.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,651,763	1997-07-29	08/439,581	1995-05-11	78304-541220(000120US)

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Babak Kusha/	Date (YYYY-MM-DD)	2011-06-01
Name	Babak Kusha	Registration Number	51095

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5651763
Issue Date: July 29,1997
Application No. 08439581
Filed: May 11,1995
Attorney Docket No. 78304-541220(000120US)

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed June 1,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 1,2011 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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WILDMAN HARROLD ALLEN & DIXON LLP
225 WEST WACKER DRIVE, SUITE 2800
CHICAGO IL 60606

MAILED

AUG 08 2011

OFFICE OF PETITIONS

In re Patent No. 6,524,390 :
Issue Date: 02/25/2003 :
Application Number: 08/441,823 : DECISION ON PETITION
Filing Date: 05/16/1995 :
For: HANDWASHING TECHNIQUE :
ANALYSIS :

This is a decision on the petition under 37 CFR 1.378(b),[1] filed on June 27, 2011, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f).

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[1] A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);
(2) the surcharge set forth in §1.20(I)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

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.

The patent issued on February 25, 2003. The first maintenance fee was timely paid. The second maintenance fee could have been paid during the period from February 25 through August 25, 2010, or, with a surcharge, during the period from August 26, 2010 through February 25, 2011. The patent expired at midnight on February 25, 2011 for failure to timely pay the second maintenance fee.

Petitioner's counsel asserts:

> The business owner of this patent suffered from the current recession and the patent owner was unable to pay the past due maintenance fee. However, the patent owner's business has improved as of late and he wants to pay the past due maintenance fee at this time.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".[2] A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."[3] This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."[4] Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.[5] Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[6] However, a

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[2] 35 U.S.C. § 41(c)(1).

[3] Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

[4] Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

[5] In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

[6] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "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"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.[7] In view of In re Patent No. 4,409,763,[8] this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

This petition does not satisfy the requirement of 37 CFR 1.378(b)(3). The statements presented in the petition fail to satisfy the showing required to establish unavoidable delay within the meaning of 37 CFR 1.378(b).

Petitioner has not carried the burden of proof to establish to the satisfaction of the Director that the delay in payment of the second maintenance fee was unavoidable.

At the outset, a showing must be provided that the entire period of delay, from the date the maintenance fee was due until the date of the filing of the subject petition, was unavoidable.

Petitioner has not presented a sufficient showing of unavoidable delay resulting from financial hardship. A showing of unavoidable delay based upon financial condition must establish that the financial condition of the responsible party during the entire period of the delay was such as to excuse the delay.[9] A complete showing is required of petitioner's, or the party responsible for payment of the maintenance fee's, financial condition including all income, expense, assets, credit, and obligations which made the delay from February 25, 2011 until the filing of the petition on June 27, 2011 in payment of the maintenance fee, unavoidable. Petitioner must provide verified copies of any available documents or records covering the entire period between February 25 and June 27, 2011.

The showing must also enumerate the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Statements from all persons who contributed to the delay are also required, and must be verified by including a declaration according to 37 CFR 1.68. Furthermore, petitioner should identify the party responsible for making the payment.

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[7] Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

[8] 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

[9] See Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

In summary, the showing of record is inadequate to establish unavoidable delay. As petitioner has not shown that it exercised the standard of care observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.[10]

Petitioner is cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes), petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

In summary, the showing of record has been considered, but does not rise to the level of unavoidable delay. Rather, the showing of record is of a lack of diligence on the part of petitioner. Since petitioner has not shown unavoidable delay, the petition will be dismissed.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable.

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[10] See note 6, supra.

The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

Petitioner may wish, in the alternative, to request reconsideration in the form of a petition under 37 CFR 1.378(c), requesting that the unintentionally delayed payment of a maintenance fee be accepted. A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(c) must be filed within twenty four months from the end of the six month grace period (e.g., the expiration date of the patent and be accompanied by (1) a verified statement that the delay was unintentional, (2) payment of the appropriate maintenance fee, unless previously submitted, (3) payment of the $1,640.00 surcharge (the $700.00 surcharge already paid may be credited thereto leaving a balance due of $940.00) set forth in 37 CFR 1.20(i)(2). The statement can be verified by using the attached petition form which includes a declaration according to 37 CFR 1.68.

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the patent was expired until the filing of the petition to reinstate under 37 CFR 1.378(c), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.378(c).

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

A reply may also be filed via EFS-Web.

Telephone inquiries should be directed to the undersigned at 571-272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: PTO/SB/66

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POLSTER, LIEDER, WOODRUFF LUCCHESI, L.C.
12412 POWERSCOURT DR.
SUITE 200
ST. LOUIS MO 63131-3615

MAILED
NOV 01 2011
OFFICE OF PETITIONS

In re Patent No. 5,579,959	:	
Issue Date: December 3, 1996	:	
Application No. 08/442,021	:	NOTICE
Filed: May 16, 1995	:	
Attorney Docket No. 5814	:	

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Alexandria, VA 22313-1450
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POLSTER, LIEDER, WOODRUFF & LUCCHESI, L.C.
12412 POWERSCOURT DR. SUITE 200
ST. LOUIS MO 63131-3615

MAILED

MAR 09 2012

OFFICE OF PETITIONS

In re Patent No. 5,579,959
Issue Date: December 3, 1996
Application No. 08/442,021
Filed: May 16, 1995
Attorney Docket No. 5814

DECISION ON REQUEST FOR REFUND

This is a decision on the Request For Refund filed February 27, 2012.

The request is **GRANTED**.

Applicant files the above request and states that "On September 23, 2011, we faxed an Entity Status Change Form and a Petition authorizing the USPTO to charge the top up for a maintenance fee that was paid as a small entity on June 3, 2008, in the amount of $2,055 since this patent now qualifies as a large entity."

Applicant further states that "On the October 2011 Deposit Account Statement (copy attached), the USPTO charged the account $2,055 under Fee Code 1599. Then, on the November 2011 Deposit Account Statement (copy attached), the USPTO refunded the top up fee in the amount of $2,055 under Fee code 1599 and then re-charged $4,110 under Fee Code 1552; however, this amount is the entire amount for the maintenance fee for a large entity. Therefore, the USPTO should have only re-charged $2,055 as the top up maintenance fee under Fee Code 1552."

In view of the above, a refund of $2,155 is being credited to applicant's credit card account as it is the method in which the fee was paid. Applicant should note that the correct amount of the large entity portion to have been charged to the maintenance fee paid on June 3, 2008, should have been **$2,155** instead of $2,055 as was authorized by applicant.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5692034	1997-11-25	08444571	1995-05-19	2102-1-0022

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-08
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 5692034
Issue Date: November 25,1997
Application No. 08444571
Filed: May 19,1995
Attorney Docket No. 2102-1-0022

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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DW Feb-11

Paper No. 15

LOUIS D'ALTO
222-44 41 ROAD
BAYSIDE NY 11361

MAILED

FEB 02 2011

OFFICE OF PETITIONS

In re Patent No. 5,941,801 :
Issue Date: 08/24/1999 :
Application Number: 08/445,226 : DECISION ON PETITION
Filing Date: 05/18/1995 :
For: MULTIDIRECTIONAL :
COMBINATION BOXING AND KICKING :
BAG :

This is a decision on the petition under 37 CFR 1.378(b),[1] filed on November 23, 2010, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f). 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.

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[1] A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);
(2) the surcharge set forth in §1.20(I)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The patent issued on August 24, 1999. The first maintenance fee could have been paid during the period from August 24, 2002, through February 24, 2003, or, with a surcharge, during the period from February 25, through August 24, 2003. The patent expired at midnight on August 24, 2003, for failure to timely pay the first maintenance fee.[2]

Petitioner, *pro se*, states that the delay was unavoidable due to petitioner's mental illness and because of his divorce from his wife. Specifically, petitioner avers that prior to and during the divorce proceedings, it was agreed that his now ex-wife would be responsible for payment of the maintenance fees. Lastly, petitioner states that no notification was received from the USPTO indicating that the maintenance fee(s) were due.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".[3] A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."[4] This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."[5] Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.[6] Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[7] However, a

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[2] It is noted that petitioner states, on the petition form, that the subject patent "is a reissue of original Patent No. 5,437,590, original issue date August 1, 1995; original application number 08/202692, original filing date February 14, 1994." A review of Office records, however, reveals that the subject patent is not a reissue of the above-reference application, but that Application No. 08/445,226, which matured into U.S. Patent No. 5,941,801, is a *continuation* of Application No. 08/202,692, filed on February 14, 1994, which matured into U.S. Patent No. 5,437,590 on August 1, 1995.

[3] 35 U.S.C. § 41(c)(1).

[4] Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

[5] Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

[6] In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

[7] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "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"); In re

petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.[8] In view of In re Patent No. 4,409,763,[9] this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable.[10] 35 U.S.C. § 133 does not require the Director to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.[11]

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.[12] That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the second maintenance fee for this patent.[13]

At the outset, there are three periods to be considered during the evaluation of a petition under 37 CFR 1.378(b):

(1) The delay in reply that originally resulted in expiration;

Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

[8] Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

[9] 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

[10] See Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

[11] See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991)(table), *cert. denied*, 502 U.S. 1075 (1992); Ray v. Lehman, supra.

[12] Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

[13] Id.

(2) The delay in filing an initial petition pursuant to § 1.378(b) to revive the application; and

(3) The delay in filing a *grantable* petition pursuant to § 1.378(b) to revive the application.[14]

The petition lacks the showing required by items (1) and (2).

With regard to period (1), while physical or mental incapacitation can be a cause of delay, a showing of "unavoidable" delay based upon incapacitation must establish that petitioner's incapacitation was of such a nature and degree as to render petitioner unable to conduct business (*e.g.*, correspond with the Office) during the period between August 24, 2003, and the date of filing of the subject petition.

Such a showing must be supported by a statement from petitioner's treating physician, and such statement must provide the nature of petitioner's incapacitation during the above-mentioned period.

In support, petitioner has provided a statement from his physician, Adarsh K. Gupta, M.D., stating, in pertinent part:

> This is in reference to Mr. Louis D'Alto DOB 04/13/61, who has been under my psychiatric care since 08/08/2002. Mr. D'Alto suffers from bipolar disorder and had several psychiatric hospitalizations during 2001-2002, when he had his first psychological breakdown. Prior to this, he was functioning well and had work experience in 'acting', personal training and development of his fitness apparatus. After his psychiatric hospitalizations, he had emotional and cognitive deterioration requiring outpatient psychiatric care. During this period he was not able to work or keep track of his responsibilities. He has been doing consistently doing better in the last 1 year and feels motivated to go back to work. He remains compliant with his treatment process.

The showing of record, however, is insufficient to demonstrate unavoidable delay due to mental incapacitation. Specifically, petitioner not provided a sufficient showing that the period of petitioner's incapacitation was of such a nature and degree as to render petitioner unable to conduct business (e.g. correspond with the Office) during the period between August 24, 2003, and

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[14] See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

the date of filing of the subject petition. In particular, Dr. Gupta's letter states that petitioner was hospitalized during 2001-2002, and has apparently been recovering during the past year, but is unclear as to the period during which petitioner was incapacitated to such a degree that he was unable to conduct business (*e.g.*, correspond with the Office). Likewise, petitioner must provide a documented showing as to when he had recovered sufficiently to resume conducting business and correspondence with the Office. Petitioner may wish to consider obtaining an additional statement from his physician addressing these issues.

Turning to petitioner's assertion that his ex-wife was responsible for payment of the maintenance fees, reliance upon third party prosecution of a patented file without an express contractual obligation does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133.[15] Assuming, *arguendo*, such a contract does exist, petitioner is further required to show what steps were taken by petitioner to inquire as to the third party's reasonably diligent efforts to timely pay the maintenance fees.[16] If petitioner cannot provide evidence that a third party was contractually obligated to pay the maintenance fees for the present patent and that petitioner had maintained inquiry with that third party as to the steps taken to timely pay the maintenance fee, then petitioner must indicate what steps were taken by the petitioner to ensure timely payment of the maintenance fee.

Petitioner has provided no evidence that his ex-wife had agreed to pay the pay the maintenance fee in the present patent. While it is noted that petitioner asserts that "[t]his was a verbal agreement," petitioner must, nonetheless, provide copies of documents, if any, which establish that his ex-wife had assumed responsibility for payment of the maintenance fee.

Additionally, statements must be provided from all persons having first-hand knowledge of the delay, setting forth the facts as they know them. As such, if petitioner's ex-wife was responsible for payment of the maintenance fee, a statement from the ex-spouse must be provided, setting forth the facts as she knows them regarding her responsibility for payment of the maintenance fee and why the maintenance fee was not timely paid.

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[15] See Futures Tech. Ltd. v. Quigg, 7 USPQ2d 1588 (E.D. Va. 1988).

[16] See Winkler v. Ladd, 138 USPQ 666 (Comm'r Pat. 1963).

Further, petitioner's contention that he did receive any notification from the USPTO that the maintenance fee was due is not well taken. A patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay.[17] Under the statute and regulations, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. The Office mailing of Maintenance Fee Reminders is carried out strictly as a courtesy. Accordingly, it is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and/or the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.[18]

Lastly, in regards to period (2) above, petitioner must explain when he learned that the subject patent had become expired, and provide a documented showing to the effect that any delay between the date that petitioner became aware that the patent had expired, and the date of the filing of the subject petition, was unavoidable.

Petitioner is cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes), petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment

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[17] *See* Patent No. 4,409,763, *supra*; see *also* "Final Rules for Patent Maintenance Fees" 49 Fed. Reg. 34716, 34722-34723 (August 31, 1984), *reprinted in* 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984).

[18] Rydeen v. Quigg, 748 F. supp. at 900.

purposes are not retained in the application file and therefore are not publicly available.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

Receipt of the change of correspondence address is acknowledged. The correspondence address has been updated.

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 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DIW May-11

Paper No.

LOUIS D'ALTO
222-44 41 ROAD
BAYSIDE NY 11361

MAILED

MAY 16 2011

OFFICE OF PETITIONS

In re Patent No. 5,941,801 :
Issue Date: 08/24/1999 : DECISION ON PETITION
Application Number: 08/445,226 :
Filing or 371(c) Date: 05/18/1995 :
For: MULTIDIRECTIONAL COMBINATION :
BOXING AND KICKING BAG :

This is a decision on the petition, filed on March 31, 2011, under 37 CFR 1.378(e), requesting reconsideration of the petition under 37 CFR 1.378(b) to accept the unavoidably delayed payment of maintenance fees for the above-referenced patent.

The petition is **granted**.

In light of the showing of record, it is concluded that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fees would be timely paid.

Accordingly, the first and second maintenance fees in this case are hereby accepted and the above-identified patent is hereby reinstated as of the mail date of this decision.

Telephone inquiries should be directed to the undersigned at 571-272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Conferee: Anthony Knight
Director, Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 24

DEMPSEY WATTS
1829 COURTLAND DR.
LEXINGTON KY 40505

MAILED
FEB 16 2011
OFFICE OF PETITIONS

In re Patent No. 5,683,352 :
Issue Date: 11/04/1997 :
Application Number: 08/445,483 : DECISION ON PETITION
Filing Date: 05/22/1995 :
For: AN ELONGATED LOOP FOR SELF :
ADMINISTERED PHYSIOTHERAPY :

This is a decision on the petition under 37 CFR 1.378(b),[1] filed on January 11, 2011, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f). The petition for reconsideration should include an exhaustive

[1] A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include
(1) the required maintenance fee set forth in § 1.20(e) through (g);
(2) the surcharge set forth in §1.20(I)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

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.

The patent issued on November 4, 1997. The first and second maintenance fees were timely paid. The third maintenance fee could have been paid during the period from November 4, 2008, through May 4, 2009, or, with a surcharge, during the period from May 5 through November 4, 2009. The patent expired at midnight on November 4, 2009, for failure to timely pay the third maintenance fee.

The petition, which is signed by inventor Dempsey Watts, contains the following statement:

> My name is Derane Combs I am the nephew of Mr. Watts. Mr. Watts is a 75 year old man and can't always remember a lot of things. He has asked me to help some with the paperwork and of his bussiness (*sic*). Well, in doing so I started checking on the status of his Trademark + Patent. The Trademark is in good shape but the Patent had expired, therefore here I am talking to you folks. It would be nice, if somehow a notice could be sent to remind folks when a payment is due.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".[2] A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."[3] This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."[4] Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.[5] Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving abandoned applications have adopted the reasonably prudent person

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[2] 35 U.S.C. § 41(c)(1).

[3] Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

[4] Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

[5] In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

standard in determining if the delay was unavoidable.[6] However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.[7] In view of In re Patent No. 4,409,763,[8] this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.[9] That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the second maintenance fee for this patent.[10]

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable.[11] 35 U.S.C. § 133 does not require the Director to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.[12]

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[6] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "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"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

[7] Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

[8] 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

[9] Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

[10] Id.

[11] See Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

[12] See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991)(table), *cert. denied*, 502 U.S. 1075 (1992); Ray v. Lehman, supra.

Papers filed in the Office must be signed in accordance with 37 CFR 1.4 by the person making the statements contained in the papers. A statement which is not signed by the person making the statement (such as the statement asserted to be by Combs' nephew) cannot be accepted as being made by that person because he (Combs' nephew) did not sign the statement. As such, any statements submitted by other persons (e.g., Watts' family members, business associates, or any other individuals) must be signed by the individual(s) filing those statements, setting further the facts as they know them.

If petitioner Dempsey Watts (hereinafter "Watts") was responsible for payment of the maintenance fee, petitioners must submit an affidavit or statement of first-hand knowledge from Watts, setting forth the facts as he knows them, surrounding the circumstances leading to the expiration of the subject patent, and why the delay in payment of the maintenance fee is unavoidable.

A showing of unavoidable delay further requires that petitioners submit statements or declarations of facts by all other persons with first-hand knowledge of the delay surrounding the payment of the maintenance fee, setting forth the facts as the know them.

With regard to the lack of receipt of a reminder, patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay.[13] Under the statute and regulations, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. The Office mailing of Maintenance Fee Reminders is carried out strictly as a courtesy. Accordingly, it is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and/or the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.[14]

While the Office is mindful of petitioner's age, the showing of record does not support a finding of unavoidable delay. Therefore, the petition must be dismissed.

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[13] *See* Patent No. 4,409,763, *supra; see also* "Final Rules for Patent Maintenance Fees" 49 Fed. Reg. 34716, 34722-34723 (August 31, 1984), *reprinted in* 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984).

[14] Rydeen v. Quigg, 748 F. supp. at 900.

Petitioner is cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes), petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

ALTERNATIVE VENUE

Petitioner may wish, in the alternative, to request reconsideration in the form of a petition under 37 CFR 1.378(c), requesting that the unintentionally delayed payment of a maintenance fee be accepted. A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(c) must be filed within twenty four months from the end of the six month grace period (e.g., the expiration date of the patent and be accompanied by (1) a verified statement that the delay was unintentional, (2) payment of the appropriate maintenance fee, unless previously submitted, (3) payment of the $1,640.00 surcharge (the $700.00 surcharge already paid may be credited thereto leaving a balance due of $940.00) set forth in 37 CFR 1.20(i)(2). The statement can be verified by using the attached petition form which includes a declaration according to 37 CFR 1.68.

Petitioner is cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes), petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

ALTERNATIVE VENUE

Petitioner may wish, in the alternative, to request reconsideration in the form of a petition under 37 CFR 1.378(c), requesting that the unintentionally delayed payment of a maintenance fee be accepted. A petition to accept the delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(c) must be filed within twenty four months from the end of the six month grace period (e.g., the expiration date of the patent and be accompanied by (1) a verified statement that the delay was unintentional, (2) payment of the appropriate maintenance fee, unless previously submitted, (3) payment of the $1,640.00 surcharge (the $700.00 surcharge already paid may be credited thereto leaving a balance due of $940.00) set forth in 37 CFR 1.20(i)(2). The statement can be verified by using the attached petition form which includes a declaration according to 37 CFR 1.68.

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the patent was expired until the filing of the petition to reinstate under 37 CFR 1.378(c), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.378(c).

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 should be directed to the undersigned at 571-272-3231.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: PTO/SB/66

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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DW Apr-11

Paper No.

DEMPSEY WATTS
1829 COURTLAND DR.
LEXINGTON KY 40505

MAILED
APR 25 2011
OFFICE OF PETITIONS

In re Patent No. 5,683,352 :
Issue Date: 11/04/1997 :
Application Number: 08/445,483 : ON PETITION
Filing Date: 05/22/1995 :
Attorney Docket Number: L95426S :

This is a decision on the petition under 37 CFR 1.378(c), filed on March 14, 2011, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on November 4, 2009, for failure to timely pay the second maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

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

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5680564	1997-10-21	08445569	1995-05-26	66935-4455

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Michael B. Stewart/	Date (YYYY-MM-DD)	2010-09-08
Name	Michael B. Stewart	Registration Number	36018

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5680564
Issue Date: October 21,1997
Application No. 08445569
Filed: May 26,1995
Attorney Docket No. NSC1-65000[N

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed September 8,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 8,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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DIW Jan-11

Paper No. 18

SURFACE TECHNOLOGY INC
PO BOX 8585
TRENTON NJ 08650

MAILED

JAN 13 2011

OFFICE OF PETITIONS

In re Patent Number: 5,834,065 :
Issue Date: 11/10/1998 :
Application Number: 08/446,129 : DECISION ON PETITION
Filing Date: 05/22/1995 :
For: COMPOSITE PLATED ARTICLES :
HAVING LIGHT-EMITTING :
PROPERTIES

This is a decision on the petition under 37 CFR 1.378(b),[1] filed on November 8, 2010, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is dismissed.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f). 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.

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[1] A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);
(2) the surcharge set forth in §1.20(I)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

The patent issued on November 10, 1998. The first maintenance fee was timely paid. The second maintenance fee could have been paid during the period from November 10, 2005 through May 10, 2006, or, with a surcharge, during the period from May 11 through November 10, 2006. The patent expired at midnight on November 10, 2006, for failure to timely pay the second maintenance fee.

Petitioner, Michael Feldstein, President of assignee Surface Technology, Inc., (hereinafter "the Company") asserts that the delay in payment was unavoidable due to an error in the patent tracking and docketing system utilized by the Company. Petitioner further states that no maintenance fee reminders were received by the Company from the USPTO.

Petitioners state, in pertinent part:

> 9. In order to save costs and avoid time working through an attorney, my father (inventor and company founder Nathan Feldstein) prosecuted his patent applications pro se and generally handled all IP matters himself and without assistance from a law firm. Each such patent has been duly assigned to the Company.
>
> 10. After each of my father's applications issued as a patent, an administrative assistant in the Company, under my father's supervision, was given responsibility for timely payment of the maintenance fees.
>
> 11. This tracking and paying maintenance fee task was just one of many tasks assigned to the administrative assistant; including but not limited to accounts receivable, accounts payable, reception, answering the phones, correspondence, shipping and receiving purchasing, and other operations of the office.
>
> 12. I believe that the administrative assistant was instructed by my father to be very careful to pay maintenance fees when due.
>
> 13. In order to manage the tasks associated with timely paying maintenance fees, the administrative assistant set up a process whereby she kept rudimentary records of maintenance fees and due dates for such fees in a spreadsheet file on a Company computer. This spreadsheet file served as the Company's docketing system for payment of maintenance fees.

...

15. At some point during the 1990's, supervisory responsibility for the administrative assistant transitioned from my father to me.

16. Self-prosecuting patent applications, self-maintaining records of dates for payments of maintenance fees in a spreadsheet file on a personal computer, and tasking a particular employee for tracking dates and paying fees are reasonable steps for a patent tracking and docketing program for a small company like Surface Technology, Inc.

17. In general, this patent tracking and docketing program has been successful in assuring that maintenance fees are timely paid, particularly considering the Company's needs to keep costs low.

18. U.S. Patent No. 5,834,065 was granted in November 1998.

19. U.S. Patent No. 5,834,065 was assigned to the Company by the named inventor, Nathan Feldstein, and continues to be assigned to the Company.

20. The first maintenance fee due on U.S. Patent No. 5,834,065 was timely paid by the administrative assistant on behalf of the Company on June 3, 2002.

21. Soon after that first maintenance fee was paid, the administrative assistant resigned from the Company.

22. After the administrative assistant left the Company, the Company hired a new administrative assistant who was given similar responsibilities, including tracking and paying maintenance fees. At the time she was hired, the administrative assistant had no patent experience, but I instructed her as to the importance of timely paying maintenance fees, having learned it myself from my father and by observing the work of the previous administrative assistant.

23. To the best of our understanding, the previous administrative assistant had failed to leave any indication of maintenance fee due dates for U.S. Patent No. 5,834,065.

> 24. The new administrative assistant was initially unable to open the spreadsheet file and needed to create a new spreadsheet based on existing documentation she could gather. Because the prior administrative assistant left no indication of maintenance fees associated with U.S. Patent No. 5,834,065 and the earlier spreadsheet file could not be opened, the new administrative assistant was unavoidably unaware of maintenance fees coming due for U.S. Patent No. 5,834,065.
>
> 25. The new administrative assistant prepared the new spreadsheet without indication that any maintenance fee was due regarding U.S. Patent No. 5,834,065, although other records are in the spreadsheet and other maintenance fees have been paid.
>
> 26. In addition we have no record of having received any reminder notices from the U.S. Patent and Trademark Office regarding payment of the 7 ½ year maintenance fee and have no record of having paid the 7 ½ year maintenance fee.

Petitioner further states that the Company did not become aware that the patent had expired until after a July 28, 2010, meeting concerning the subject patent.

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".[2] A patent owner's failure to pay a maintenance fee may be considered to have been "unavoidable" if the patent owner "exercised the due care of a reasonably prudent person."[3] This determination is to be made on a "case-by-case basis, taking all the facts and circumstances into account."[4] Unavoidable delay under 35 U.S.C. § 41(b) is measured by the same standard as that for reviving an abandoned application under 35 U.S.C. § 133.[5] Under 35 U.S.C. § 133, the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". Decisions on reviving

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[2] 35 U.S.C. § 41(c)(1).

[3] Ray v. Lehman, 55 F.3d 606, 608-09 (Fed.Cir.), cert. denied, -- U.S. ---, 116 S.Ct. 304, L.Ed.2d 209 (1995).

[4] Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

[5] In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (PTO Comm'r 1988).

abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[6] However, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.[7] In view of In re Patent No. 4,409,763,[8] this same standard will be applied to determine whether "unavoidable" delay within the meaning of 37 CFR 1.378(b) occurred.

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.378(b):

(1) The delay in reply that originally resulted in expiration;
(2) The delay in filing an initial petition pursuant to § 1.378(b) to revive the application; and
(3) The delay in filing a *grantable* petition pursuant to § 1.378(b) to revive the application.[9]

This petition lacks the showing required by periods (1) and (2).

With regard to period (1), a delay resulting from an error (*e.g.*, a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

(1) the error was the cause of the delay at issue;

(2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance;

(3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.[10]

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[6] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "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"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

[7] Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

[8] 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988), aff'd sub nom. Rydeen v. Quigg, 748 937 F.2d 623 (Fed. Cir. 1991) (table), cert. denied, 502 U.S. 1075 (1992).

[9] See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

[10] See MPEP 711.03(c)(III)(C)(2).

An adequate showing requires:

(A) Statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them.

(B) Petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledgers, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.

(C) Petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

The present petition lacks the showing required by (1), (2), and (3) above.

At the outset, it is noted that petitioner has not provided statements from all of the persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them. In this regard, petitioner states that the heretofore-unidentified first administrative assistant who allegedly was responsible for tracking the second maintenance fee resigned from the Company before the fee was due, but failed to leave a tracking system that could be utilized by any other employees of the Company. Petitioner must nonetheless attempt to obtain a statement from her, explaining the circumstances surrounding the error and why the error occurred. If petitioner is unable to locate the former administrative assistant, petitioner should provide a showing of the attempts made to contact her and obtain a statement concerning the payment of the maintenance fee. Furthermore, petitioner must provide an affidavit or declaration of facts by the current administrative assistant, setting forth the facts as she knows them surrounding the delay in payment of the maintenance fee for the subject patent.

Additionally, petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the

type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledgers, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due. Petitioner should provide a copy of the spreadsheet and any other documentation utilized in the tracking and payment of maintenance fees.

Lastly, petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks. As both petitioner Michael Feldstein, and his father, inventor Nathan Feldstein, supervised the administrative assistant(s), affidavits or declarations of facts describing this information in detail must be provided by both individuals.

Rather than unavoidable delay, the showing of record is that petitioner lacked a reliable system for tracking and paying maintenance fees. The showing of record is that petitioner essentially relied on one person, the first administrative assistant, to docket and pay maintenance fees, and did not have a system of checks or supervision in place to verify that the administrative assistant was properly completing tasks related to the docketing of the maintenance fees, once that individual was no longer available. In this regard, the petitioner concedes that when the first administrative assistant resigned, her replacement was unable to open the spreadsheet containing, *inter alia*, the maintenance fee docketing information. As such, the new administrative assistant created a new docketing system, which, unfortunately, failed to include the subject patent. As such, petitioners were unaware the maintenance fee was due, and did not timely pay it.

In summary, the showing of record is inadequate to establish unavoidable delay. Petitioner has provided no evidence to substantiate a claim of docketing error. Rather, the showing of record is that petitioner failed to ensure that a reliable tracking system was in place such that the new administrative assistant could access the system and determine the due date for the payment of the maintenance fee for the subject patent. Rather, petitioners simply relied on the first administrative assistant, and were unable to access any of the information compiled by her after her resignation from the Company. As petitioner has not shown that it exercised the standard of care

observed by a reasonable person in the conduct of his or her most important business, the petition will be dismissed.[11]

Lastly, petitioner's contention that the Company did not receive any notification from the USPTO that the maintenance fee was due is not well taken. A patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay.[12] Under the statute and regulations, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. The Office mailing of Maintenance Fee Reminders is carried out strictly as a courtesy. Accordingly, it is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and/or the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.[13]

Further, with regard to period (2) above, the petition states that patentee learned, sometime after a meeting on July 28, 2010, that the patent had become expired for nonpayment of the maintenance fee, and that petitioner's administrative assistant called the USPTO on August 1, 2010, for assistance in determining how to reinstate the patent. The subject petition to reinstate the patent was not filed until November 3, 2010 (certificate of mailing date), however, over three (3) months after petitioner had learned that the patent had become expired. Petitioners must show that they diligently took steps to file the petition to reinstate the patent, and must explain why the Office should consider the entire delay in the payment of the maintenance fee, from the date the fee was due until the date a grantable petition is filed, to be unavoidable.

Petitioner is cautioned to avoid submitting personal information in a patent application that may contribute to identity theft. If personal information such as social security numbers, bank account numbers, or credit card numbers are included in documents submitted to the USPTO (other than a check or credit card authorization form PTO-2038 submitted for payment purposes),

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[11] See note 4, supra.

[12] *See* Patent No. 4,409,763, *supra*; *see also* "Final Rules for Patent Maintenance Fees" 49 Fed. Reg. 34716, 34722-34723 (August 31, 1984), *reprinted in* 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984).

[13] Rydeen v. Quigg, 748 F. supp. at 900.

petitioners should consider redacting such personal information from the documents before submitting them to the USPTO. This type of personal information is never required by the USPTO to support a petition or an application. Petitioner is advised that any information submitted in an application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, information from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Since petitioner has not shown unavoidable delay, the petition will be dismissed.

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable.

The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

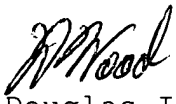
Further correspondence with respect to this matter should be addressed as follows:

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 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DIW May-11

Paper No.

SURFACE TECHNOLOGY INC
PO BOX 8585
TRENTON NJ 08650

MAILED

MAY 11 2011

OFFICE OF PETITIONS

In re Patent No. 5,834,065 :
Issue Date: 11/10/1998 : DECISION ON PETITION
Application Number: 08/446,129 :
Filing or 371(c) Date: 05/22/1995 :
For: COMPOSITE PLATED ARTICLES :
HAVING LIGHT-EMITTING PROPERTIES :

This is a decision on the petition, filed on March 14, 2011, under 37 CFR 1.378(e), requesting reconsideration of the petition under 37 CFR 1.378(b) to accept the unavoidably delayed payment of maintenance fees for the above-referenced patent.

The petition is **granted**.

In light of the showing of record, it is concluded that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fees would be timely paid.

Accordingly, the second and third maintenance fees in this case are hereby accepted and the above-identified patent is hereby reinstated as of the mail date of this decision.

The $65.00 surcharge for late payment of the maintenance fee within six months, submitted with the original petition under 37 CFR 1.378(b), is not required after a patent has expired. A refund of this $65.00 fee has been scheduled.

Telephone inquiries should be directed to the undersigned at 571-272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Conferee: Anthony Knight
Director, 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

Paper No.

DAVID J OLDENKAMP
POMS SMITH LANDE & ROSE
2029 CENTURY PARK EAST
38TH FLOOR
LOS ANGELES CA 90067

MAILED
AUG 22 2011
OFFICE OF PETITIONS

In re Patent No. 5,858,751 :
Paulson et al. :
Issue Date: January 12, 1999:
Application No. 08/446,875 : NOTICE REGARDING DEFICIENCY
Filed: July 12, 1995 :
Atty Docket No. 111-197 :

This is a notice regarding your letter received July 15, 2011, notifying the Office of loss of entitlement to small entity status and requesting acceptance of a fee deficiency submission as provided for in 37 CFR 1.28.

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.

The instant request included an itemization and payment of $3385 for the deficiency in payment of maintenance fees.

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

Payment of the deficiency has been treated under § 1.27(g)(2) as a notification of a loss of entitlement to small entity status.

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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MCDERMOTT, WILL & EMERY
11682 EL CAMINO REAL
SUITE 400
SAN DIEGO CA 92130-2047

MAILED

AUG 04 2010

OFFICE OF PETITIONS

In re Patent No. 5,760,001
Issue Date: June 2, 1998
Application No. 08/447,143
Filed: May 22, 1995
Attorney Docket No. P-HP-1552

DECISION ON REQUEST FOR REFUND

This is a decision on the Request For Refund filed July 20, 2010.

The request is **DISMISSED**.

Applicant states that on June 1, 2010 G2 Research mistakenly made a maintenance payment on the above patent. Applicant further states that, although the payment was instructed by former attorneys, it was later discovered that applicants do not own the above patent. Therefore, applicant request a refund of the maintenance fee paid on June 1, 2010.

Applicant is advised that 37 CFR 1.366(g) provides that maintenance fees and surcharges relating thereto will not be refunded except in accordance with 37 CFR 1.26 and 1.28(a). A patentee cannot obtain a refund of a maintenance fee that was due and payable on the patent. Any duplicate payment will be refunded to the fee submitter.

As the maintenance fee paid in U.S. Patent No. 5,760,001 was due and payable at the time that applicant paid the fee, the fee is not subject to refund. Also, in accordance with 37 CFR 1.366(g), it is not deemed appropriate to refund the maintenance fee paid in U.S. Patent No. 5,760,001.

The file does not indicate a change of address has been submitted, although the address given on the request differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the request; however, the Office will mail all future correspondence solely to the address of record.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

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
By internet:	EFS-Web www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

Cc:

GEORGE M. GRASS, PHD
PO BOX 1242
TAHOE CITY, CA 96145

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MCDERMOTT, WILL & EMERY
11682 EL CAMINO REAL
SUITE 400
SAN DIEGO CA 92130-2047

MAILED

AUG 04 2010

OFFICE OF PETITIONS

In re Patent No. 5,760,001
Issue Date: June 2, 1998
Application No. 08/447,143
Filed: May 22, 1995
Attorney Docket No. P-HP-1552

DECISION ON REQUEST FOR REFUND

This is a decision on the Request For Refund filed July 20, 2010.

The request is **DISMISSED**.

Applicant states that on June 1, 2010 G2 Research mistakenly made a maintenance payment on the above patent. Applicant further states that, although the payment was instructed by former attorneys, it was later discovered that applicants do not own the above patent. Therefore, applicant request a refund of the maintenance fee paid on June 1, 2010.

Applicant is advised that 37 CFR 1.366(g) provides that maintenance fees and surcharges relating thereto will not be refunded except in accordance with 37 CFR 1.26 and 1.28(a). A patentee cannot obtain a refund of a maintenance fee that was due and payable on the patent. Any duplicate payment will be refunded to the fee submitter.

As the maintenance fee paid in U.S. Patent No. 5,760,001 was due and payable at the time that applicant paid the fee, the fee is not subject to refund. Also, in accordance with 37 CFR 1.366(g), it is not deemed appropriate to refund the maintenance fee paid in U.S. Patent No. 5,760,001.

The file does not indicate a change of address has been submitted, although the address given on the request differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the request; however, the Office will mail all future correspondence solely to the address of record.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

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
By internet:	EFS-Web www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

Cc:

GEORGE M. GRASS, PHD
PO BOX 1242
TAHOE CITY, CA 96145

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : December 16, 2010

TO SPE OF : ART UNIT 2625
SUBJECT : Request for Certificate of Correction for Appl. No.: 08/447447 Patent No.: _____

CofC mailroom date: 12-9-10

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (CofC)
Randolph Square – 9D10-A
Palm Location 7580

Magdalene Talley

_____

Certificates of Correction Branch

571-272-0423

Thank You For Your Assistance

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

☑ **Approved** — **All** changes apply.

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

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

Comments: All changes apply

_____

_____

_____

_____

_____ 2625

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NAGANATHASASTRIGAL RAMANATHAN
37 BANKVIEW CIRCLE
REXDALE M9W 6S6 CA CANADA

MAILED

JUN 16 2011

OFFICE OF PETITIONS

In re Patent No. **5,689,443**
Issue Date: November 18, 1997
Application No. 08/451,035
Filed: May 25, 1995
Patentee: **Naganathasastrigal RAMANATHAN**

DECISION ON PETITION
UNDER 37 CFR 1.378(c)

This is a decision on the renewed petition under 37 CFR 1.378(c), filed February 7, 2011, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(c) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2).

The petition lacks items (1) above.

The statement of unintentional delay is not considered to be submitted by a proper party as required by 37 CFR 1.378(d), which states that any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

The petition is not signed by one the above parties and therefore, the statement of delay is not acceptable. In this regard, petitioner's attention is directed to 37 CFR 1.33(b), which states.

> (b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:
>
> (1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);
> (2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;
> (3) An assignee as provided for under §3.71(b) of this chapter; or
> (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

An unsigned amendment (or other paper) or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the

amendment (or other paper) is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

Therefore, as the petition is not properly signed, the petition is considered to not contain a proper statement of unintentional delay.

If reconsideration of this decision is desired, a properly signed petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. For applicant's convenience a Statement under 37 CFR 3.73(b) is attached. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Any such petition for reconsideration must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f). The petition for reconsideration must include any lacking item(s) noted above, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

If petitioner does not wish to pursue reinstatement of this expired patent, petitioner may request a refund of the $2055 maintenance fee and the $1640 surcharge submitted with the petition. The request should be made in writing and addressed to: Mail Stop 16, Director of the U.S. Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

Further correspondence with respect to reinstatement of this patent 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

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

Any questions concerning this decision may be directed to Monica A. Graves at (571) 272-7253.

Thurman K. Page
Petitions Examiner
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5689443	1997-11-18	08451035	1995-05-25	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

◉ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

The Assignee of record of the entire interest			
Under 37 CFR 3.71 an assignee becomes of record by filing a statement in compliance with 37 CFR 3.73(b). Signature requirements are set forth in 37 CFR 1.4(d), and the undersigned certifies that he / she is empowered to act on behalf of the assignee of the entire interest			
Signature	/Vijay Ramanathan/	Date (YYYY-MM-DD)	2011-08-05
Name	RamSoft Inc		
Enter Reel and Frame Number		Remove	
Reel Number	000001	Frame Number	0001
Click ADD for additional Reel Number and Frame Number		Add	

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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 Patent No. 5689443
Issue Date: November 18,1997
Application No. 08451035
Filed: May 25,1995
Attorney Docket No.

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed August 5,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of August 5,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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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BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

MAILED
OCT 03 2011
OFFICE OF PETITIONS

In re Patent No.5,652,463 :
Issue Date: 29 July, 1997 :
Application No. 08/452,024 : DECISION ON PETITION
Filed: 26 May, 1995 :
Attorney Docket No. 011608-011 :

This is a decision on the petition filed on 16 September, 2011, and properly treated as a petition under 37 C.F.R. §1.378(b)[1] requesting acceptance of payment of a maintenance fee for the above-referenced patent as having been delayed due to unavoidable delay.

NOTE:

The address on the petition is other than the correspondence address of record.

As a courtesy, the Office directs/transmits a copy of the decision to the address on the petition.

However, in the absence of the proper submission (*e.g.*, revocation/power of attorney, with certificate pursuant to 37 C.F.R. §1. 3.73(b)), all future correspondence is directed to the correspondence address of record.

It is noted that the petition submitted did not include a complete postal zip code. The code set forth above was obtained from Office records for the Petitioner based upon registration number.

The petition pursuant to 37 C.F.R. §1.378(b) is **DISMISSED**.

[1] A grantable petition to accept a delayed maintenance fee payment under 37 C.F.R. §1.378(b) must be include
(1) the required maintenance fee set forth in §1.20(e) through (g);
(2) the surcharge set forth in §1.20(I)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

If reconsideration of this decision is desired, a petition for reconsideration under 37 C.F.R. §1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision.

No extension of this 2-month time limit can be granted under 37 C.F.R. §1.136(a) or (b).

A petition for reconsideration **must** be accompanied by the petition fee of $400.00 as set forth in 37 C.F.R. §1.17(f).

The petition for reconsideration **shall** include an exhaustive attempt to provide the lacking item(s) noted below, since, after a decision on the petition for reconsideration, the Director will undertake no further reconsideration or review of the matter.

This is **not** a final agency action within the meaning of 5 U.S.C.§704.

A petition to accept the delayed payment of a maintenance fee under 35 USC §41(c) and 37 C.F.R. §1.378(b) must be accompanied by:

> *(1) an adequate showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely;*
>
> *(2) payment of the appropriate maintenance fee, unless previously submitted; and*
>
> *(3) payment of the surcharge set forth in 37 C.F.R. §1.20(i)(1).*

The instant petition fails to satisfy requirement (1), listed/described above.

BACKGROUND

Patent No. 5,652,463 (the '463 patent) issued on 29 July, 1997. The third maintenance fee could have been paid during the period from 29 July, 2008, through midnight 29 January, 2009, or, with a surcharge, during the period from 30 January, 2009, through midnight 29 July, 2009. Accordingly, the patent expired after midnight 29 July, 2009, for failure to pay timely the first maintenance fee

The instant petition (with fee) pursuant to 37 C.F.R. §1.378(b) was filed on 16 August, 2011.

STATUTE AND REGULATION

The grant of authority at 35 U.S.C. §41(c)(1) provides that:

> The Director may accept the payment of any maintenance fee required by subsection (b) of this section...after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.

The regulations 37 C.F.R. §1.378(b)(3) thus set forth that any petition to accept delayed payment of a maintenance fee must include:

> A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date, and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. (Emphasis supplied.)

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 of candor and duty to disclose.[2]

OPINION

The Director may accept late payment of the maintenance fee under 35 U.S.C. §41(c) and 37 C.F.R. §1.378(b) if the delay is shown to the satisfaction of the Director to have been "unavoidable."[3]

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. §133 because 35 U.S.C. §41(c)(1) uses the identical language, i.e., "unavoidable" delay.[4] Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[5] In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."[6] Finally, a petition to revive an application or reinstate a patent as abandoned or expired due to unavoidable delay cannot be granted where a Petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.[7]

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[2] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(Petitioner 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).

[3] 35 U.S.C. §41(c)(1).

[4] *Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)).

[5] *Ex parte Pratt*, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "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 man in relation to their most important business"); *In re Mattullath*, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); *Ex parte Henrich*, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

[6] *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

[7] *Haines v. Quigg*, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner's Contentions
as to Unavoidable Delay

Petitioner Jaye G. Heybl (Reg. No. 42,661) sought relief on behalf of patentees/assignees pursuant to the regulations at 37 C.F.R. §1.378, averring unavoidable delay.

Patent No. 5,652,463 (the '463 patent) issued on 29 July, 1997. The third maintenance fee could have been paid during the period from 29 July, 2008, through midnight 29 January, 2009, or, with a surcharge, during the period from 30 January, 2009, through midnight 29 July, 2009. Accordingly, the patent expired after midnight 29 July, 2009, for failure to pay timely the first maintenance fee.

The entirety of the petition statement was set forth in the petition of Mr. Heybl/Petitioner as follows:

> Our firm was just made aware of the due date of the maintenance fee as we just took over the case.

There was no further statement or documents from Petitioner, the assignee or any prior firm.

(A review of Office records as to assignments indicates an assignment recordation shortly before expiration of the patent.)

Thus, the matter was not otherwise addressed from before expiration of the patent until the Petitioner's involvement, which culminated in the filing of the instant petition.

There is no, or at least insufficient, showing of record as to the docketing/calendaring of maintenance fees for the instant matter—or specifically in whom such responsibility for docketing lay, and or who performed the administrative task of docketing the maintenance fee schedule in this matter, and whether they did so erroneously. Thus, there is no showing of a failure that was systemic—such as that which occurs when a computer or computer program fails.

Possibly the error was of another form: plain human error, which is a delay that is not unavoidable but unintentional—however such a consideration is not before the Office.

In any case, such facts as have been recited do not suggest diligence—at least a level of diligence as required herein—on the part of those who were supposed to attend to this matter.

The provisions of 35 U.S.C. §41(c)(1) do not require an affirmative finding that the delay was avoidable, but only an explanation as to why the Petitioner has failed to carry his or her burden

to establish that the delay was unavoidable.[8] The provisions of 35 U.S.C. §133 do not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing.

Petitioner is reminded that it is the patentee's/assignee's burden under the statutes and regulations to make a showing to the satisfaction of the Director that the delay in payment of a maintenance fee is unavoidable.[9]

This the Petitioner and/ or patentee has/have not done.

At bottom, the question is one of diligence.[10]

Because 35 U.S.C. § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.[11] That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 C.F.R. §1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the third/last maintenance fee for this patent.[12] There are three periods to be considered during the evaluation of a petition under 37 C.F.R. §1.378(b):

(1) The delay in reply that originally resulted in expiration;

(2) The delay in filing an initial petition pursuant to §1.378(b) to reinstate the patent; and

(3) The delay in filing a grantable petition pursuant to §1.378(b) to reinstate the patent.[13]

At the outset and as of this writing, the showing is not persuasive with regards to the nature of the delay in reply that originally resulted in expiration or as to the filing of the initial petition (Items 1 and 2), which are the periods pertinent at this time.

Petitioner must provide documentary foundations in support of a showing of unavoidable delay.

Thus, at this writing the statements presented in/with the petition fail to satisfy the showing required to establish unavoidable delay within the meaning of 37 C.F.R. §1.378(b).

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[8] *See Commissariat A. L'Energie Atomique v. Watson*, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

[9] *See Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991)(table), *cert. denied*, 502 U.S. 1075 (1992); *Ray v. Lehman, supra.*

[10] *See: Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997). *See also: Ray v. Lehman, supra.*

[11] *Ray*, 55 F.3d at 609, 34 USPQ2d at 1788.

[12] *Id.*

[13] *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131 at 53158 (October 10, 1997).

A showing of diligence in matters before the Office is essential to support a finding of unavoidable delay herein.[14] There is no "sliding scale" based upon the priority given to this maintaining this patent in force, or more diligently seeking reinstatement, *vis-a-vis* other matters by Petitioner. The issue is solely whether the maintenance, or reinstatement, of the patent at issue was actually conducted with the care or diligence that is generally used and observed by prudent and careful persons in relation to their most important business.

At this writing the record fails to adequately evidence the exercise of due care and diligence observed by prudent and careful persons, in relation to their most important business, which is necessary to establish unavoidable delay.[15]

The record at this writing does not provide a clear showing that reasonable steps were taken to ensure timely payment of the maintenance fee. In fact, the record indicates that no steps were taken by Patentee(s) and/or Assignee to ensure timely payment of the maintenance fee.

The provisions of 37 C.F.R. §1.378(b) preclude acceptance of the delayed payment of the maintenance fee due to unavoidable delay. The regulations at 37 C.F.R. §1.378(b)(3) state that any petition to accept delayed payment of a maintenance fee must include:

> A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date, and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

In any future filing, this showing should include, but is not limited to, docket records, tickler reports, and file jacket entries for this application, and documents regarding the alleged cause of the delay and copies of any documents referred to in Petitioner's statement as to the cause of the unavoidable delay are required. All the causes which contributed to the failure to timely pay the maintenance fee must be presented and supported with appropriate evidence.[16] (In general, a Petitioner should identify the party(ies) responsible for making the payment: A showing must be made (with supporting documents) outlining the efforts made to ensure timely payment of the maintenance fee--including scheduling and calendaring information, appointment of an individual with the authority and responsibility to pay the fee, and detailing of the causes for a failure in that process.)

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[14] *See Futures Technology, Ltd. v. Quigg*, 684 F. Supp. 430, 431, 7 USPQ2d 1588 (E.D. Va. 1988)(applicant's diligent inquiry into the status of the application is required to show unavoidable delay); *Douglas v. Manbeck*, 21 USPQ2d 1697, 1699-1700 (E.D. Pa. 1991), *aff'd*, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992) (even representation by counsel does not relieve the applicant from his obligation to exercise diligence before the USPTO; applicant's lack of diligence extending two and one half years overcame and superseded any omissions by his counsel).

[15] *Pratt, supra.*

[16] The showing must also enumerate the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Statements from all persons who contributed to the delay are also required.

Thus, as of this writing, the Office is unable to grant the relief sought.

In summary, the showing of record has been considered, but does not rise to the level of unavoidable delay. Rather, the showing of record is of possible a lack of diligence. (*See*: http://www.uspto.gov/web/offices/pac/mpep/documents/2500_2590.htm#sect2590)

CONCLUSION

For the reasons stated above, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. §41(c)(1) and 37 C.F.R. §1.378(b).

Accordingly, the petition under 37 C.F.R. §1.378(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

Patent No.5,652,463
Application No. 08/452,024

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[17]) 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

CC
JAYE G. HEYBL
KOPPEL PARTICK HEYBL & PHILPOTT
2815 ROWNSGATE ROAD/STE. 215
WESTLAKE VILLAGE, CA 91361

[17] 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

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

RADER FISHMAN & GRAUER PLLC
39533 WOODWARD AVENUE
BLOOMFIELD HILLS, MI 48304

MAILED

SEP 01 2011

OFFICE OF PETITIONS

In re Application of :
Teng et al. :
Application No. 08/452246 :
Filing or 371(c) Date: 05/26/1995 : ON PETITION
Patent No. 5630163 :
Issue Date: 03/18/1997 :
Title of Invention: :
COMPUTER HAVING A SINGLE BUS :
SUPPORTING MULTIPLE BUS :
ARCHITECTURES OPERATING WITH :
DIFFERENT BUS PARAMETERS :

This is a notice regarding 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.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods
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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DIW Feb-11

Paper No. 10

BIOTECH BEACH LAW GROUP , PC
5677 OBERLIN DRIVE, SUITE 204
SAN DIEGO CA 92121

MAILED

FEB 15 2011

OFFICE OF PETITIONS

In re Patent No. 5,571,195 :
Issue Date: 11/05/1996 :
Application Number: 08/453,877 : ON PETITION
Filing Date: 05/30/1995 :
Attorney Docket Number: LJO-16 :
:

This is a decision in response to the petition under 37 CFR 1.378(b),[1] filed on December 27, 2010, to accept the delayed payment of the maintenance fee for the above-identified patent.

The petition is **dismissed**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400.00 as set forth in 37 CFR 1.17(f). 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.

The patent issued on November 5, 1996. The first and second maintenance fees were timely paid. The third maintenance fee could have been paid during the period from November 5, 2007,

[1] A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must be include

(1) the required maintenance fee set forth in § 1.20(e) through (g);
(2) the surcharge set forth in §1.20(I)(1); and
(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

through May 5, 2008, or, with a surcharge, during the period from May 6, 2008, through November 5, 2008. Accordingly, this patent expired at midnight on November 5, 2008, for failure to timely remit the maintenance fee.

Petitioner states that he relied upon his registered patent practitioner, W.D. Swayze, Jr. (hereinafter "Swayze"), to notify him of the due dates for the maintenance fees, but that Swayze filed to notify petitioner that the maintenance fee was due, and therefore the patent became expired for failure to timely pay the maintenance fee.

Petitioner further states that he received no notification from the USPTO that the patent had become expired.

A petition to accept the delayed maintenance fee under 35 U.S.C. § 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks requirement (1).

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable".[2]

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 U.S.C. § 133 because 35 U.S.C. § 41(c)(1) uses identical language (i.e. "unavoidable delay").[3] Decisions reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable.[4] In this regard:

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[2] 35 U.S.C. § 41(c)(1).

[3] Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1989)).

[4] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used by prudent and careful men in relation to their most important business").

> 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.[5]

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees.[6] That is, an adequate showing that the delay was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent.[7]

While petitioner alleged chose to rely upon his registered patent practitioner ("Swayze"), such reliance *per se* does not provide petitioner with a showing of unavoidable delay within the meaning of 37 CFR 1.378(b) and 35 U.S.C. § 41(c).[8] Rather, such reliance merely shifts the focus of the inquiry from petitioner to whether the attorney or agent acted reasonably and prudently.[9] As such, assuming that the agent had been so engaged, then it is incumbent upon petitioner to demonstrate, via a documented showing, that

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[5] In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

[6] Ray, 55 F.3d at 609, 34 USPQ2d at 1788.

[7] Id.

[8] See California Med. Prod. v. Technol. Med. Prod., 921 F. Supp. 1219, 1259 (D. Del. 1995).

[9] Id.

the attorney or agent had docketed this patent for the third maintenance fee payment in a reliable tracking system.[10] If petitioner cannot establish that the attorney or agent had been so engaged, then petitioner will have to demonstrate what steps were established by petitioner to monitor and pay the maintenance fee.

Therefore, any showing of unavoidable delay must include a statement from petitioner's patent attorney, as well as any other attorney(s) of record during the period that payment of the maintenance fee was delayed, as to why action was not taken to timely submit the required maintenance fee while the patent was under that agent's control. Petitioner should send a letter (accompanied by a copy of this decision) to Swayze by registered or certified mail, return receipt requested, indicating to the agent that the USPTO is requesting his assistance in determining the circumstances surrounding the expiration of this patent, and is specifically requesting Swayze to provide a statement as to: (1) whether, and when, he first became aware that the first maintenance fee for this patent was due, and (2) why the maintenance fee was not timely submitted. Such statements should be accompanied by copies of any documents relevant to payment of the maintenance fee. In the event that Swayze fails to provide a statement within a person (*e.g.*, within one (1) month) specified in such letter, petitioner should submit a copy of such letter and the return receipt indicating its delivery to the patent attorney or agent with any petition for reconsideration under 37 CFR 1.378(e).

The above paragraph notwithstanding, petitioner is reminded that the failure of communication between an applicant and counsel is not unavoidable delay.[11] Specifically, delay resulting from a lack of proper communication between a patent holder and a registered representative as to who bore the responsibility for payment of a maintenance fee does not constitute unavoidable delay within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).[12] Moreover, the Office is not the proper forum for resolving a dispute as to the effectiveness of communications between parties regarding the responsibility for paying a maintenance fee.[13]

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[10] Id.

[11] In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

[12] See Ray v. Lehman, 55 F.3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1995).

[13] Id.

A delay resulting from a lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP does not constitute an "unavoidable" delay.[14] As the showing of record does not rise to the level of unavoidable delay, the petition will be dismissed.

Further, petitioner's contention that he did not receive any notification from the USPTO that the maintenance fee was due is not well taken. A patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay.[15] Under the statute and regulations, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. The Office mailing of Maintenance Fee Reminders is carried out strictly as a courtesy. Accordingly, it is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and/or the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.[16]

Petitioner should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

Petitioners should note that if this petition is not renewed, or if renewed and not granted, then the maintenance fee and post-expiration surcharge are refundable. The $400.00 petition fee for seeking reconsideration is not refundable. Any request for refund should be in writing to the address noted below.

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[14] See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

[15] *See* Patent No. 4,409,763, *supra*; see *also* "Final Rules for Patent Maintenance Fees" 49 Fed. Reg. 34716, 34722-34723 (August 31, 1984), *reprinted in* 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984).

[16] Rydeen v. Quigg, 748 F. supp. at 900.

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 should be directed to the undersigned at 571-272-3231.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5652785	1997-07-29	08454015	1995-05-30	2102-1-0013

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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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 displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-08
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5652785
Issue Date: July 29,1997
Application No. 08454015
Filed: May 30,1995
Attorney Docket No. 2102-1-0013

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6406844	2002-06-18	08456887	1995-06-01	1000.1B4

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
◉	7 ½ year	(1552)
○	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Leticia R. Block/	Date (YYYY-MM-DD)	2010-09-01
Name	Leticia R. Block	Registration Number	50167

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 6406844
Issue Date: June 18,2002
Application No. 08456887
Filed: June 1,1995
Attorney Docket No. 16528J-00018

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed September 1,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 1,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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RADER FISHMAN & GRAUER PLLC
39533 Woodward Avenue
Bloomfield Hills, MI 48304

MAILED

SEP 13 2011

OFFICE OF PETITIONS

In re Patent No. 5,710,929
Issued: 01/20/1998
Application No. 08/458,189
Filed: 06/02/1995
Attorney Docket No. VDM-001

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed August 10, 2011.

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

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

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

Inquiries related to this communication should be directed to the undersigned at (571) 272-3211.

C. T. 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
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SAM TALPALATSKY,ESQ.
DIRECTED ELECTRONICS INC.
2560
PROGESS STREET
VISTA CA 9208

MAILED
OCT 06 2011
OFFICE OF PETITIONS

In re Patent No. 5,713,950	:	
Issue Date: February 3, 1998	:	
Application No. 08/459,979	:	NOTICE
Filed: June 2, 1995	:	
Attorney Docket No. JLC-95-2	:	

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed September 23, 2011. 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. The petition is **GRANTED**.

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.

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.

This file is being forwarded to Files Repository.

Telephone inquiries related to this decision should be directed to the Kimberly Inabinet at (571) 272-4618.

/Kimberly Inabinet/
Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Kyle Conklin
Sterne, Kessler, Goldstein & Fox
1100 New York Avenue NW
Washington, DC 20005

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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CROWE AND DUNLEVY, P.C.
DAVID SULLIVAN
20 NORTH BROADWAY
SUITE 1800
OKLAHOMA CITY, OK 73102-8273

MAILED
MAY 20 2011
OFFICE OF PETITIONS

In re Patent No. 5,601,323	:	
Issue Date: February 11, 1997	:	
Application No. 08/461,138	:	ON PETITION
Filed: June 5, 1995	:	
Attorney Docket No. 21684	:	

This is a decision in response to a petition filed February 11, 2011 and supplemented on March 9, 2011, under 37 CFR 1.378(c), to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on February 12, 2009, for failure to pay the 11 ½ year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

Alicia Kelley-Collier
Petitions Examiner
Office of Petitions

cc: ARNOLD A. KAISER
20096 WALDEN STREET
COVINGTON, LA 70435

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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HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD MA 01742-9133

MAILED

APR 25 2011

OFFICE OF PETITIONS

In re Patent No.7,238,345 :
Issue Date: July 3, 2007 :
Application No. 08/461,651 : DECISION ON PETITION
Filed: June 5,1995 :
Attorney Docket No. ACC89-11FZ :

This is a decision on the Petition For Correction Of Assignees, filed November 5, 2010, which is being treated as a Petition Under 37 CFR 3.81(b), to add --State of the Netherlands (National Institute of Public Health and the Environment/RIVM, and agency of the Ministry of Health, Welfare and Sport), (NL)-- as the additional assignee to the Title Page of the Patent via a Certificate of Correction.

The petition under 37 CFR §3.81(b) is **DISMISSED**.

Petitioner urges that the present Petition was submitted to add the omitted --State of the Netherlands (National Institute of Public Health and the Environment/RIVM, and agency of the Ministry of Health, Welfare and Sport), (NL)-- on the previously submitted PTOL-85B and such error was inadvertent.

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

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

A review of United States Patent and Trademark Office (USPTO) records reveals that the assignment documents recorded at Reel: 005818, Frame: 0518 on August 22, 1991 identify *De Staat Der Nederlanden Vertegenwoordigo Door De Minster Van Welzin, Volksgezondheid En Cultuur* as the second assignee. However, the present petition requests identification of *State of the Netherlands (National Institute of Public Health and the Environment/RIVM, and agency of the Ministry of Health, Welfare and Sport), (NL)* to be added as the second assignee. Notwithstanding, the second assignee name was filed for recordation in Germany, therefore, the instant petition cannot be granted.

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

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

cc: Wyeth
Patent Law Department
Five Giralda Farms
Madison, NJ 07940

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5689502	1997-11-18	08463220	1995-06-05	211/300

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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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 displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-08
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

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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 Freedom of Information Act requires disclosure of these records.

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3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

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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

In re Patent No. 5689502
Issue Date: November 18,1997
Application No. 08463220
Filed: June 5,1995
Attorney Docket No. 211/300

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

SEP 13 2011

David Resnick
Nixon Peabody LLP
100 Summer Street
Boston, MA 02110-2131

Re: Patent Term Extension
Application for
U.S. Patent No. 5,502,034

WITHDRAWAL OF APPLICATION FOR PATENT TERM EXTENSION

In accordance with the provisions of 37 C.F.R. 1.785(b), the present application for patent term extension is withdrawn. Because applicant did not expressly elect a patent for extension from U.S. Patent No. 5,502,034, U.S. Patent No. 5,476,777 or U.S. Patent No. 5,527,692, the USPTO will extend the patent which was issued first, i.e., U.S. Patent No. 5,476,777 will be extended.

Because U.S. Patent No. 5,502,034 was NOT elected, the application is withdrawn.

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

By mail: Mail Stop Hatch-Waxman PTE
P.O. Box 1450
Alexandria, VA 22313-1450

Telephone inquiries related to this determination should be directed to the undersigned at (571) 272-7755. E-mail inquiries should be directed to mary.till@uspto.gov.

Mary C. Till
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

Attention: Beverly Friedman

RE: RECOTHROM® (rh Thrombin)
Docket No.:

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5745484	1998-04-28	08465137	1995-06-05	211/256

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-18
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5745484
Issue Date: April 28,1998
Application No. 08465137
Filed: June 5,1995
Attorney Docket No. 211/256

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 18,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 18,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

COOLEY LLP
ATTN: Patent Group
Suite 1100
777 - 6th Street, NW
WASHINGTON DC 20001

MAILED
APR 22 2011
OFFICE OF PETITIONS

In re Application of	:	
Buhl et al.	:	
Application No. 08/466155	:	
Filing or 371(c) Date: 06/06/1995	:	LETTER
Patent Number: 5,776,563	:	
Issue Date: 07/07/1998	:	
Attorney Docket Number:	:	
ABAX-009/03US 010265-2061	:	

This is a notice regarding 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.**

Telephone inquiries concerning this petition Decision should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods
Attorney
Office of Petitions

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Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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NOVARTIS
CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 101/2
EAST HANOVER, NJ 07936-1080

MAILED

AUG 17 2011

OFFICE OF PETITIONS

In re Patent No. 5,891,429 :
Issue Date: April 6, 1999 :
Application No. 08/466,308 : ON PETITION
Filed: June 6, 1995 :
Attorney Docket No. 118-6415-US-CNT2 :

This is a decision on the petition under 37 CFR 1.378(b), filed August 5, 2010 and resubmitted March 9, 2011, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within **TWO (2) MONTHS** from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). **Any such petition for reconsideration must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f)**. 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, the Director will undertake no further reconsideration or review of the matter.

The patent issued April 6, 1999. The second (7 1/2 year) maintenance fee was due April 6, 2007, and could have been paid from April 6, 2006 through October 6, 2006, or with a surcharge during the period from October 7, 2006 through April 6, 2007. Accordingly, the patent expired at midnight April 6, 2007, for failure to timely submit the second maintenance fee.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1) above.

Petitioner asserts that docketing error was the cause of delay in acting to prevent payment of the maintenance fee(s). A delay resulting from an error (e.g., a docketing error) on the part of an employee in performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it shown that: (1) the error was the cause of the delay at issue; (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; (3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented to the exercise of due care.

Specifically, petitioner asserts that failure to docket the above-identified patent was the cause of the delay.

An adequate showing requires statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts, as they know them. Petitioner must supply a thorough explanation of the docketing and call up system in use and must identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledger, docket sheets, file-wrappers and such other records as my exist which would substantiate an error in docketing, and include an indication as to why the system failed in this instance to provide adequate notice that a reply was due. Petitioner must also supply information regarding training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

In support of the assertion of docketing error as the cause for the delay petitioner provides, *inter alia* : (1) a declaration of Linda Rothwell (Rothwell); (2) Exhibit 2, which is a brochure for a docketing system name PATTSY, this brochure sets forth the capabilities of the PATTSY system, PATTSY was used until May 2006 to track the maintenance fee(s) due; (3) Exhibit 3, which is a brochure for a docketing software named Memotech, that has been used since May 2006 to track and maintain payment of maintenance fees; (4) Exhibit 4, characterized in the Rothwell declaration as a screen shot from Memotech which indicates the docket reminder was closed on December 19, 2006; (5) Exhibit 5, a page of records management software; and (6) Exhibit 6, which is a copy of a Memotech docket report showing that the status of the instant application is "Live".

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.378(b)(3).

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995). That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the maintenance fee for this patent. Id.

However, the record fails to show that adequate steps within the meaning of 37 CFR 1.378(b)(3) were taken by or on behalf of petitioner to schedule or pay the maintenance fee. Petitioner is reminded that 37 CFR 1.378(b)(3) is a validly promulgated regulation, as is the requirement therein for petitioner's showing of the steps taken to pay the fee. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. In the absence of a showing of the steps taken by or on behalf of petitioner, 37 CFR 1.378(b)(3) precludes acceptance of the maintenance fee.

An adequate showing should include (when relevant):

(1) statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them;
(2) a thorough explanation of the docketing and call up system in use;
(3) identification of the type of records kept;
(4) identification of the persons responsible for the maintenance of the system;
(5) copies of mail ledger, docket sheets, filewrappers and such other records

as may exist which would substantiate an error in docketing;
(6) include an indication as to why the system failed in this instance, and;
(7) information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

Specifically, Rothwell asserts in her declaration that she does not recall receiving any instructions to close the maintenance fee reminder for the above identified patent, a notice from the USPTO, an outside law firm or from Memotech that the patent would expire, and that the docket reminder was "likely closed in error, likely as a computer error in the conversion from PATTSY to Memotech."

While the declaration of Rothwell states that she has no recollection of receiving any instructions to close the maintenance fee reminder for the above-identified patent, there is no statement from the party responsible for determining whether or not the maintenance fee should be paid or the party responsible for instructing Rothwell, as to the circumstances surrounding the delay. Statements from these parties are required.

Next, it is noted that the petition refers to two docketing systems by commercial name, *i.e.*, PATTSY and Memotech. However, neither the petition nor declarations set forth a thorough explanation of the docketing system in use at the time the maintenance fee was due.

Petitioner has also failed to provide any copies of mail ledgers, docket sheets, filewrappers and any other records which would substantiate docketing error. The declaration of Rothwell states that exhibit 5 shows no record of instructions to close the docket reminder. However, it is unclear as to what exactly exhibit 5 is or how it would show an instruction to close the docket reminder. It appears as though exhibit 5 only covers the time period from January 1, 2004 through December 31, 2005 and the docket reminder was, according to exhibit 4, closed December 19, 2006. Additionally, exhibit 4 is said to be a screenshot from Memotech, however, while the document mentions PATTSY, nowhere does it mention Memotech. Exhibit 4 also contains: to be done by, executed by, and record created by entry fields, however, none of these fields have a data entry. How is the failure to enter data into these fields the actions of reasonable and prudent person with respect to their most important business? Assuming *arguendo*, that exhibit 4 is a Memotech document and Memotech was not relied upon until May 2006, how does this document have a record created by date of 10 Jan 2006? Furthermore, with respect to exhibit 6, it is unclear as what is meant by the record for the above-identified patent being "Live" as opposed to "Close"? How could Memotech indicate that the above-identifed patent was live if the reminder was closed? If the above-identified patent is live, why did the system fail to generate a reminder? If the system failed to generate a reminder for a live application, how is this a reliable docketing system?

Additionally, the petition does not provide information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

Further, Rothwell states that the docket reminder was likely closed as computer error in the conversion from PATTSY to Memotech. Did Novartis Pharmaceutical Corporation have a system in place to check as to whether or not the data transferred from PATTSY to Memotech was transferred accurately?

While petitioner notes that they did not receive any correspondence from the USPTO regarding this patent while it remained in force, petitioner is reminded that a party does not have had a right to personalized notice that this patent would expire if the maintenance fee was not paid, as the publication of the statute was sufficient notice. See Rydeen 749 F.Supp at 907, 16 USPQ2d at 1882. Rather, the ultimate responsibility for keeping track of maintenance fee due dates lies with the patentee, not the USPTO. Id. Since the inception of maintenance fees, the USPTO has maintained that it has no duty to notify patentees when their maintenance fees are due, and that the lack of any USPTO notice will in no way shift the burden of monitoring the time for paying the maintenance fees from the patentee to the USPTO. Further, such lack of notice will not constitute unavoidable delay under the statute. Rydeen, 748 F.Supp at 905, 16 USPQ2d at 1880. Rather, the requirement for notice is only set forth in 35 USC 133 (and § 151), and is not found in 35 USC 41(c)(1) or 37 CFR 1.378(b)(3). Ray, 55 F.3d at 609, 34 USPQ2d at 1788; Rydeen, *supra*.

As authorized the surcharge of $700 and the maintenance fee of $1240 have been charged to the petitioner's deposit account 19-0134.

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 Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Telephone inquiries regarding this decision should be directed to April M. Wise at (571) 272-1642.

/dab/
David Bucci
Petitions Examiner
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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APR 20 2011

OFFICE OF PETITIONS

GLAXOSMITHKLINE
GLOBAL PATENTS
FIVE MOORE DR., PO BOX 13398
MAIL STOP: C.2111F
RESEARCH TRIANGLE PARK NC 27709-3398

In re Patent No.: 5,817,664 :
Issue Date: October 6, 1998 : ON PETITION
Application No. 08/470,317 :
Filed: June 6, 1995 :

This is a decision on the petition under 37 CFR 1.378(c), filed March 22, 2011, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED.**

The patent expired on October 7, 2010 for failure to pay the eleven and one-half year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

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

It is noted that an amount of $3695.00 was inadvertently charged to Deposit Account 19-1090 as the authorization to charge was submitted twice. Petitioner may request a refund of this amount by writing to the following address: Mail Stop 16, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. A copy of this decision should accompany Petitioner's request.

Telephone inquiries concerning this decision should be directed to Robert DeWitty, Petitions Examiner, at 571-272-8427.

for David Bucci
Petitions Examiner
Office of Petitions

cc: SEED Intellectual Property Law Group PLLC
701 Fifth Avenue, Suite 5400
Seattle, Washington 98104

UNITED STATES PATENT AND TRADEMARK OFFICE

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RESEARCH TRIANGLE PARK NC 27709-3398

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JUL 06 2011

OFFICE OF PETITIONS

In re Patent No. 5,817,664
Issue Date: October 6, 1998
Application No. 08/470,317
Filed: June 6, 1995
For: URACH REDUCTASE INACTIVATORS

DECISION ON REQUEST FOR REFUND

This is a decision on the Request For Refund filed June 27, 2011.

The request is **GRANTED**.

The decision mailed in the above application on April 20, 2011, stated the below:

"It is noted that an amount of $3695.00 was inadvertently charged to Deposit Account 19-1090 as the authorization to charge was submitted twice. Petitioner may request a refund of this amount by writing to the following address: Mail Stop 16, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450. A copy of this decision should accompany Petitioner's request."

In view of the above, the request for refund submitted on June 27, 2011, is granted. As authorized, the fee of $3,695.00 has been credited to petitioner's deposit account.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3208.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

Cc:

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVENUE, SUITE 5400
SEATTLE, WASHINGTON 98104

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5598554	1997-01-28	08470989	1995-06-06	B-9576

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-06
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5598554
Issue Date: January 28,1997
Application No. 08470989
Filed: June 6,1995
Attorney Docket No. B-9576

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/471,890	06/07/1995	DONALD R. HUFFMAN	MITS-003/05US 308622-2007	9010

58249 7590 10/04/2010

COOLEY LLP
ATTN: Patent Group
Suite 1100
777 - 6th Street, NW
WASHINGTON, DC 20001

EXAMINER	
YUAN, DAH WEI D	

ART UNIT	PAPER NUMBER
1795	

MAIL DATE	DELIVERY MODE
10/04/2010	PAPER

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

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

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

Mailed:
In re application of
Huffman et al.
Serial No. 08/471,890
Filed: June 7, 1995
For: New Form Of Carbon

OCT 04 2010

DECISION ON PETITION

This is a response to the petition under 37 CFR 1.181 filed August 23, 2010. Applicant requests entry of the supplemental amendment filed September 25, 2009 or alternatively that the finality of the Office action dated June 23, 2010 be withdrawn.

A review of the record indicates that applicant's amendment of March 12, 2009 cancelled claims 89-121 and presented new claims 122-163. The supplemental amendment of September 25, 2009 presented new claims 164-245. The examiner in the final rejection of June 23, 2010 denied entry of the supplemental amendment. Applicant asserts that claims 202-245 of the supplemental amendment incorporate amendments that were suggested by the Office and address concerns raised by the examiner and in any case clearly simplify the issues for appeal under section (F) of 37 CFR 1.111.

Supplemental replies are governed by 37 CFR 1.111(a) (2).

37 CFR 1.111(a) (2) states:

(2) *Supplemental replies.*

(i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a) (2) (ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);
(B) Adoption of the examiner suggestion(s);
(C) Placement of the application in condition for allowance;
(D) Reply to an Office requirement made after the first reply was filed;
(E) Correction of informalities (*e.g.*, typographical errors); or
(F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).

At the September 23, 2008 interview it was agreed that an amendment would be made canceling the pending claims and adding a new set of claims mirroring those allowed in corresponding parent application 07/580,246, now U.S. Patent 7,494,638, but limited to "cage molecules consisting of carbon atoms soluble in non-polar organic solvents".

On March 12, 2009, applicant filed an amendment, cancelling claims 89-121 and adding new claims 122-163 that did not include the agreed upon language in all of the independent claims. The claims were not limited to "cage molecules consisting of carbon atoms soluble in non-polar organic solvents". Instead, the claims were directed to "cage molecules consisting of carbon atoms". The examiner in an interview on September 11, 2009 proposed an examiner's amendment which incorporated language that was initially agreed upon in the interview dated September 23, 2008; "cage molecules consisting of carbon atoms soluble in non-polar organic solvents". Agreement was not reached. Two additional interviews were conducted with the examiner of record on September 23 and 24, 2009.

Applicant's representative proposed a draft amendment on September 23, 2009 which had adopted the examiner's proposed amendment for claims 122-163 and added new claims 164-181. Upon review of proposed new independent claim 164, the examiner did not accept the proposed draft amendment. Specifically, the examiner had concerns with the language that "A substantially pure fullerene compound comprising a polyhedral carbon cage" was not supported by the original disclosure because the meaning of fullerene encompasses carbon nanotubes and that the term fullerene was not used in the original disclosure. The examiner did not accept applicant's proposed amendment.

Applicant then filed a supplemental amendment on September 25, 2009 where claims 164-245 were newly presented. Applicant asserts that claims 164-201 are duplicates of the claims suggested by the examiner and are therefore allowable. Applicant further states that claims 202-245 are newly presented and responsive to the interviews with the examiner. Applicant cites newly proposed claims 203, 204, 216, 217, 224, 225, 236 and 237 as incorporating suggestions made by the Office. Those claims are drawn to carbon cages containing 60 or 70 carbons. Applicant further points out that proposed claims 202, 209-211, 215, 221, 222 and 239-245 are limited to fullerenes having a polyhedral, spherical or icosahedral structure. Applicant asserts that claims 202-245 would clearly simplify the issues for appeal.

The examiner on September 24, 2009 had concerns with applicant's proposed language of "A substantially pure fullerene compound comprising a polyhedral carbon cage" that was not supported by the original disclosure because the present day meaning of fullerene encompasses carbon nanotubes and the term fullerene was not used in the original disclosure. Applicant's supplemental amendment still cites the term "fullerene". The examiner's position is that claims 202-245 are not responsive to any interview and do not adopt any suggestions made by the examiner that would place the application into condition for allowance.

While some claims appear to adopt the examiner's suggestions, others do not. For example, claims 202, 205-215, 218-223, 226-235, and 238-245 do not adopt any examiner suggestions. Applicant's petition in fact does not actually assert that these claims adopt the examiner's suggestions. Rather, the petition asserts that these claims "address concerns" raised by the

examiner. Attempting to address a concern is not adopting a suggestion, as a suggestion has been agreed to in advance, whereas an attempt to address a concern has not. Thus the reply is not limited to claims that meet the conditions of 37 CFR 1.111(a)(2)(B).

Nor can these claims be said to simplify the issues on appeal. Applicant's petition does not point to any particular issue present in the non-final rejection of September 12, 2008 which the addition of these claims would remove from consideration. To the contrary, they appear to raise a variety of new issues, such as the enablement of claims reciting an atom enclosed within the cage (e.g. claim 206) when the specification does not appear to describe how this is accomplished, the scope of enablement for claims covering any and all molded products including the claimed fullerene (e.g. claim 211) when no such products are actually described in the specification and claim interpretation issues and the patentability of the claims over the prior art (e.g. "effectively spherical" as in claims 241 and 245). Given the above, the September 25, 2009 amendment appears to complicate, rather than simplify, the potential issues for appeal. Thus the reply is not limited to claims that meet the conditions of 37 CFR 1.111(a)(2)(F).

The remaining provisions of 37 CFR 1.111(a)(2) do not apply, nor were they asserted. Since entry of supplemental replies is not a matter or right, and none of permissive conditions of 37 CFR 1.111(a)(2) apply, the supplemental reply filed on September 25, 2009 was properly denied entry.

With respect to applicant's arguments concerning their right to respond under 37 CFR 1.112, the mere discussion of issues or hypothetical situations during an interview does not constitute an action and does not afford applicants the right to supplemental amendments. Interview practice is addressed in 37 CFR 1.133, not 37 CFR 1.112.

Applicants argue that equity warrants entry of the Supplemental Amendment however supplemental replies are governed by 37 CFR 1.111(a) (2). A review of the record indicates that entry of the Supplement Amendment would not be allowed under 37 CFR 1.111(a) (2).

In the Final Rejection of June 23, 2010, newly presented claims 110, 111, 120-161 and 164-179 were rejected under 35 USC 112, first paragraph. Applicants assert that the previous Non-Final Office Action dated October 27, 2008 did not include any rejection under 35 USC 112, first paragraph and that the 35 USC 112 first paragraph issues should have been first raised in the Non-Final Office Action. The scope of the newly presented claims was different from the claims that were originally presented. Applicant's amendment necessitated the new ground of rejection presented in this Office Action. The finality of the Office Action is proper.

Applicants assert that the newly raised 112, first paragraph rejection is a clear error and sets forth arguments to support their position. A rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences and is not a petitionable issue.

DECISION

The petition is **DENIED**.

_____/Sharon.A. Gibson/_____
Sharon A. Gibson, Director
Technology Center 1700
Chemical and Materials Engineering

Bonnie Weiss McLeod
COOLEY LLP
ATTN: Patent Group
Suite 1100
777 - 6th Street, NW
WASHINGTON DC 20001

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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In re Patent No. 5650105
Issue Date: July 22,1997
Application No. 08472175
Filed: June 7,1995
Attorney Docket No.

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed July 15,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 15,2011 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5650105	1997-07-22	08/472,175	1995-06-07	Yocum

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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Patent Practitioner			
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 form of the signature			
Signature	/Robert M. Downey/	Date (YYYY-MM-DD)	2011-07-15
Name	Robert M. Downey	Registration Number	33684

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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.

PTO/SB/66 (03-09)
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,845,088	1998-12-01	08/472,221	1995-06-07	JAS102CIP

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

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○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Joseph A. Sawyer, Jr./	Date (YYYY-MM-DD)	2011-01-31
Name	Joseph A. Sawyer, Jr.	Registration Number	30801

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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
P.O. Box 1450
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In re Patent No. 5845088
Issue Date: December 1,1998
Application No. 08472221
Filed: June 7,1995
Attorney Docket No. JAS-102CIP

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 31,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 31,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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CENTERS FOR DISEASE CONTROL
c/o Ballard Spahr LLP
999 PEACHTREE STREET
SUITE 1000
ATLANTA GA 30309

MAILED
JUL 06 2011
OFFICE OF PETITIONS

In re Patent No. 6,013,433 :
Issued: January 11, 2000 : REQUEST FOR INFORMATION
Application No.: 08/472,507 :
Filing Date: June 7, 1995 :
Attorney Docket No. **1141.658** :

This is a request for information in response to the petition under 37 CFR 1.137(a) filed May 27, 2011. The petition is properly treated under 37 CFR 1.378(b), to reinstate the above-cited patent.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed September 28, 2009. No additional fees are due.

The patent issued January 11, 2000. The7.5 year maintenance fee could have been paid from January 11, 2008, through July 11, 2008, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from July 12, 2008, to January 11, 2009. Petitioner did not do so. Accordingly, the patent expired at midnight on January 11, 2009.

In summary, petitioner maintains that the assignee for the subject patent gave instructions to the firm of Needle & Rosenberg, P.C. to pay the 7.5-year maintenance fee on April 24, 2007, however, the 7.5-year maintenance fee was not paid. The situation was further complicated by the fact that patent files were being transferred to the law firm of Gifford Krass or Klarquist Sparkman from Needle & Rosenberg as these firms were the receipents of the new contract to facilitate tracking and payment of the maintenance fees. Somewhere, in the transfer of the files to the new firms, the file for the subject patent was lost and apparently never docketed with Gifford Krass or Klarquist Sparkman.

Petitioner is required to address the following points:

- Petitioner does not affirmatively identify the cause of the delay in paying the maintenance fee aside from concluding that instruction was given to Needle & Rosenberg to pay the maintenance fee in April 2007, but it was not paid. A successful petition under 37 CFR 1.378(b) must affirmatively identify the cause of the delay in paying the maintenance fee and provide a statement from every person with first-hand knowledge of the circumstances surrounding the delay in paying the maintenance fee. Petitioner must provide statements from any person who

may have been charged with paying the maintenance fee and statements from any person with first-hand knowledge of the circumstances surrounding the failure to pay the maintenance fees. This would presumably include a statement from the person or persons at Needle & Rosenberg responsible for paying the maintenance fee. It is noted that petitioner states that Needle & Rosenberg was acquired by Ballard and Spar in June of 2008. Notwithstanding, petitioner should made some effort to obtain a statement from previous employees of Needle & Rosenberg who may have some first-hand knowledge into the docketing procedures employed by Needle & Rosenberg and how the 7.5-year maintenance fee payment for the subject patent was missed. If petitioner's investigation reveals that a docketing error at Needle & Rosenberg caused the 7.5-year maintenance fee not to paid, petitioner is cautioned to adhere to guidance provided in Section Section 711.03(c)(2) of the Manual of Patent Examining Procedure, which provides, in pertinent part that:

> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).
>
> A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:
>
> (A) the error was the cause of the delay at issue;
>
> (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
>
> (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

A delay resulting from an error, such a docketing error, on the part of an employee in the performance of a clerical function may provide the basis for a showing of unavoidable delay. Such a showing should identify the specific error, the individual who made the error, and the business routine in place for performing the action which resulted in the error. The showing must establish that the individual who erred was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. The showing should include information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned task.

- Petitioner states that Needle & Rosenberg sent a reminder letter to the assignee on July 10, 2007, to inform the assignee that the 7.5-year maintenance fee was coming due for the subject patent despite assignee having sent instruction in April 24, 2007, to pay the upcoming maintenance fee for the subject patent. Petitioner must explain why receiving a maintenance fee reminder from Needles & Rosenberg on a patent which the assignee already instructed Needles & Rosenberg to pay the maintenance fee would not have prompted the assignee to contact Needles & Rosenberg to confirm that the instructions to pay the maintenance fee were being followed.

- It is noted that petitioner states that the file for the subject patent was retained by Needle & Rosenberg "in order to deplete funds awarded to Needle & Rosenberg, pursuant to their prior contract". It is also noted that Needle & Rosenberg was acquired by Ballard and Spar in June of 2008, and that the period of time for paying the 7.5-year maintenance fee began January 11, 2008, and ended January 11, 2009. Petitioner is required to explain what procedures the assignee used to ensure that the subject patent file was properly transferred, especially in light of the fact that the file was retained by Needle & Rosenberg in order to deplete funds. Further, petitioner is required to explain whether Ballard and Spar has any knowledge of the non-payment of the 7.5-year maintenance fee considering that the Ballard and Spar acquired Needle Rosenberg during the period during which the 7.5-year maintenance fee for the subject patent could have paid.

- Petitioner states that on May 14, 2008, Ms. Suzanne Shope, the case manager for the assignee between June 2007, through April 14, 2008, contacted Mr. Valentin Fikovsky, the current case manager for the assignee seeking his assistance in tracking down the file for the subject patent. Ms. Shope noted that instruction to Needles & Rosenberg to pay the 7.5-year maintenance fee and also noted that there was no indication that the file was properly transferred to either of the new law firms. On May 15, 2008, petitioner states that Mr. Fikovsky responded to Ms. Shope and stated that the assignee received no notices that the maintenance fees were due for four patents, but there does not appear to be any further discussion of the status of the subject patent. According to the petition, it was not until April 13, 2011, that the status of the subject patent was checked and it was found to be expired. Petitioner must, therefore, explain why Ms. Shope's inquiry in May 2008, into the status of the patent did not prompt further inquiry into the status of the patent and whether or not the patent file had been properly transferred to one of law firms for docketing.

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

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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OFFICE OF PETITIONS

KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND OR 97204

In re Patent No. 6,013,433
Issued: January 11, 2000
Application No.: 08/472,507
Filing Date: June 7, 1995
Attorney Docket No. **1141.658**

: REQUEST FOR INFORMATION

This is a request for information in response to the petition under 37 CFR 1.137(a) filed May 27, 2011. The petition is properly treated under 37 CFR 1.378(b), to reinstate the above-cited patent.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed September 28, 2009. No additional fees are due.

The patent issued January 11, 2000. The7.5 year maintenance fee could have been paid from January 11, 2008, through July 11, 2008, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from July 12, 2008, to January 11, 2009. Petitioner did not do so. Accordingly, the patent expired at midnight on January 11, 2009.

In summary, petitioner maintains that the assignee for the subject patent gave instructions to the firm of Needle & Rosenberg, P.C. to pay the 7.5-year maintenance fee on April 24, 2007, however, the 7.5-year maintenance fee was not paid. The situation was further complicated by the fact that patent files were being transferred to the law firm of Gifford Krass or Klarquist Sparkman from Needle & Rosenberg as these firms were the receipents of the new contract to facilitate tracking and payment of the maintenance fees. Somewhere, in the transfer of the files to the new firms, the file for the subject patent was lost and apparently never docketed with Gifford Krass or Klarquist Sparkman.

Petitioner is required to address the following points:

- Petitioner does not affirmatively identify the cause of the delay in paying the maintenance fee aside from concluding that instruction was given to Needle & Rosenberg to pay the maintenance fee in April 2007, but it was not paid. A successful petition under 37 CFR 1.378(b) must affirmatively identify the cause of the delay in paying the maintenance fee and provide a statement from every person with first-hand knowledge of the circumstances surrounding the delay in paying the maintenance fee. Petitioner must provide statements from any person who may have been charged with paying the maintenance fee and statements from any person with

first-hand knowledge of the circumstances surrounding the failure to pay the maintenance fees. This would presumably include a statement from the person or persons at Needle & Rosenberg responsible for paying the maintenance fee. It is noted that petitioner states that Needle & Rosenberg was acquired by Ballard and Spar in June of 2008. Notwithstanding, petitioner should made some effort to obtain a statement from previous employees of Needle & Rosenberg who may have some first-hand knowledge into the docketing procedures employed by Needle & Rosenberg and how the 7.5-year maintenance fee payment for the subject patent was missed. If petitioner's investigation reveals that a docketing error at Needle & Rosenberg caused the 7.5-year maintenance fee not to paid, petitioner is cautioned to adhere to guidance provided in Section Section 711.03(c)(2) of the Manual of Patent Examining Procedure, which provides, in pertinent part that:

> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).
>
> A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:
>
> (A) the error was the cause of the delay at issue;
>
> (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
>
> (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

A delay resulting from an error, such a docketing error, on the part of an employee in the performance of a clerical function may provide the basis for a showing of unavoidable delay. Such a showing should identify the specific error, the individual who made the error, and the business routine in place for performing the action which resulted in the error. The showing must establish that the individual who erred was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. The showing should include information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned task.

- Petitioner states that Needle & Rosenberg sent a reminder letter to the assignee on July 10, 2007, to inform the assignee that the 7.5-year maintenance fee was coming due for the subject patent despite assignee having sent instruction in April 24, 2007, to pay the upcoming maintenance fee for the subject patent. Petitioner must explain why receiving a maintenance fee reminder from Needles & Rosenberg on a patent which the assignee already instructed Needles & Rosenberg to pay the maintenance fee would not have prompted the assignee to contact Needles & Rosenberg to confirm that the instructions to pay the maintenance fee were being followed.

- It is noted that petitioner states that the file for the subject patent was retained by Needle & Rosenberg "in order to deplete funds awarded to Needle & Rosenberg, pursuant to their prior contract". It is also noted that Needle & Rosenberg was acquired by Ballard and Spar in June of 2008, and that the period of time for paying the 7.5-year maintenance fee began January 11, 2008, and ended January 11, 2009. Petitioner is required to explain what procedures the assignee used to ensure that the subject patent file was properly transferred, especially in light of the fact that the file was retained by Needle & Rosenberg in order to deplete funds. Further, petitioner is required to explain whether Ballard and Spar has any knowledge of the non-payment of the 7.5-year maintenance fee considering that the Ballard and Spar acquired Needle Rosenberg during the period during which the 7.5-year maintenance fee for the subject patent could have paid.

- Petitioner states that on May 14, 2008, Ms. Suzanne Shope, the case manager for the assignee between June 2007, through April 14, 2008, contacted Mr. Valentin Fikovsky, the current case manager for the assignee seeking his assistance in tracking down the file for the subject patent. Ms. Shope noted that instruction to Needles & Rosenberg to pay the 7.5-year maintenance fee and also noted that there was no indication that the file was properly transferred to either of the new law firms. On May 15, 2008, petitioner states that Mr. Fikovsky responded to Ms. Shope and stated that the assignee received no notices that the maintenance fees were due for four patents, but there does not appear to be any further discussion of the status of the subject patent. According to the petition, it was not until April 13, 2011, that the status of the subject patent was checked and it was found to be expired. Petitioner must, therefore, explain why Ms. Shope's inquiry in May 2008, into the status of the patent did not prompt further inquiry into the status of the patent and whether or not the patent file had been properly transferred to one of law firms for docketing.

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

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Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND OR 97204

MAILED
JAN 27 2012
OFFICE OF PETITIONS

In re Patent No. 6,013,433 :
Issued: January 11, 2000 : ON PETITION
Application No.: 08/472,507 :
Filing Date: June 7, 1995 :
Attorney Docket No. **1141.658**

This is responsive to the Response to Request for Information filed September 19, 2011, and a decision on the petition under 37 CFR 1.378(b), filed June 1, 2011, to reinstate the above-cited patent.

The petition is **dismissed**.

The patent issued January 11, 2000. The7.5 year maintenance fee could have been paid from January 11, 2007, through July 11, 2007, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from July 12, 2007, to January 11, 2008. Petitioner did not do so. Accordingly, the patent expired at midnight on January 11, 2008.

A grantable petition under 37 CFR 1.378(b) must be accompanied by a showing to the satisfaction of the Commissioner that the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable. The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.378(b).

Opinion

Petitioner must establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.[1]

[1]The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard. 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee . . . at any time . . .if the delay is shown *to the satisfaction of the Commissioner* to have been unavoidable." (emphasis added).

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference." Rydeen v. Quigg, 748 F. Supp. 900, 904, 16 U.S.P.Q2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion Rule 36), 937 F.2d 623 (Fed Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d agencys' interpretation of a statute it administers is entitle to deference"); see also Chevron U.S.A. Inc, v. Natural Resources Defense Counsil, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute s silent or

However, "[t]he question of whether an applicant's delay in prosecuting an application was unavoidable [will]be decided on a case-by-case basis, taking all of the facts and circumstances into account."[2] Nonawarness of the content of, or misunderstanding of PTO statutes, PTO rules, the MPEP, or the Official Gazette notices does not constitute unavoidable delay.[3] The statute requires a "showing" by petitioner, therefore; petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Petitioner is responsible for possessing knowledge of the need to pay maintenance fees and the due dates for such fees, Petitioner is responsible for instituting a reliable docketing system to remind him or her when maintenance fees become due.

Petitioner is responsible for having knowledge of the need to pay maintenance fees and knowing when the fees are due.[4] The Office has no duty to notify a patentee of the requirement to pay maintenance fees or to notify patentee when a maintenance fee is due.[5] Even if the Office were required to provide notice to

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ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F. 3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1781 (Fed Cir. 1995) (Citing In re patent No. 4,409, 763, 7 U.S.P.Q.2d BNA) 1798, 1800 (Comm'r Pat. 1990; Smith v. Mossinghoff, 671 F. 2d 533, 538, 213 U.S.P. Q. (BNA) 977 (D.C. Cir. 1982). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which "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." In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat 31, 32-33 (1887)).

[2]Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

[3]See Smith v. Mossinghoff, 671 F. 2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable " delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (plaintiffs, through their counsel's action, or their own, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

[4]Nonawarness of PTO statutes, PTO rules, the MPEP, or Official Gazette notices, which state maintenance fee amounts and dates they are due does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. *BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable" delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (Plaintiffs, through their counsel's actions, or their own must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

Petitioner must act as a reasonable and prudent person in relation to his most important business. Upon obtaining the patent, a reasonable and prudent person, in relation to his most important business, would become familiar with the legal requirements of that business, in this case, the requirement to pay maintenance fees. In addition, a reasonable and prudent individual would read the patent itself and thereby become aware of the need to pay maintenance fees and the fact that such fee amounts are sometimes changed by law or regulation.

[5]Congress expressly conditioned §§ 133 and 151 [of the United States Code] on a specific type of notice, while no such notice requirements are written into § 41(c) . . . [T]he Commissioner's no timely-notice interpretation." Ray v. Comer, 1994 U.S. Dist.

applicant of the existence of maintenance fee requirements, such notice is provided by the patent itself.[6]

A reasonable and prudent person, aware of the existence of maintenance fees, would not rely on maintenance fee reminders or on memory to remind him or her when payments would fall due several years in the future. Instead, such an individual would implement a reliable and trustworthy tracking system to keep track of the relevant dates.[7] The individual would also take steps to ensure that the patent information was correctly entered into the tracking system.

Application of the unavoidable standard to the present facts

In the instant petition, petitioner argues that the above-cited patent should be reinstated because the delay in paying the 7.5-year maintenance fee was unavoidable. More specifically, petitioner maintains that the assignee for the subject patent, the Centers for Disease Control, gave instructions to the firm of Needle & Rosenberg P.C. (now Ballard Spahr) to pay the 7.5-year maintenance fee on April 24, 2007. However, the assignee apparently did not have sufficient monies with Needle & Rosenberg to pay the maintenance fee of which Needle & Rosenberg advised in correspondence sent July 10, 2007. This correspondence was not noted by Ms. Suzanne Shope who temporarily served as the case manager for the subject patent until the new Patent Advisor, Valentin Fikovsky, took over the matter. In the interim period, petitioner maintains that new government contract was awarded to two new law firms, Gifford and Krass and Klarquist Sparkman, from Needle & Rosenberg, P.C., for the tracking and payment of maintenance fees on patents owned by the assignee. In the period spanning 2007 and 2008, the assignee was undergoing a

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LEXIS 21478, 8-9 (1994), *aff'd on other grounds* Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995) (Citing Rydeen v. Quigg, 748 F. Supp. 900, 905 (1990), Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 81 L. ed. 2d 694, 104 S. Ct. 2778 (1984)). "The Court concludes as it did in Rydeen, that as a constitutional matter, 'plaintiff was not entitled to any notice beyond publication of the statute." Id. at 3 (citing Rydeen v. Quigg, 748 F. Supp. at 906, Texaco v. Short, 454 U.S. 516, 536, 70 L. Ed. 2d 738, 102 S. Ct. 781 (1982)).

The Patent Office, as a courtesy tries to send maintenance fee reminders and notices of patent expiration to the address of record. However, the failure to receive the reminder notice, and the lack of knowledge of the requirement to pay the maintenance fee, will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. See MPEP 2575, 2540, 2590. Petitioner does not have a right to a personalized notice that this patent will expire if a certain maintenance fee is not paid, as the publication of the statute was sufficient notice. See Rydeen v. Quigg, 748 F. Supp. 900, 907 (1990). the ultimate responsibility for keeping track of maintenance fee states lies with the patentee, not the USPTO. Since the mailing of Notices by the Office is completely discretionary and not a requirement imposed by Congress, accepting an argument that failure to receive a Notice is unavoidable delay would result in all delays being unavoidable should the Office discontinue the policy. All petitions could allege non-receipt of the reminder, and therefore all petitions could be granted. This was clearly not the intent of Congress in the creation of the unavoidable standard.

[6]See Ray v. Lehman, 55 F.3d 606, 610; 34 USPQ2d 1786, 1789 (Fed. Cir. 1995). The Letters of Patent contain a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. While it is unclear as to who was and is in actual possession of the patent, petitioner's failure to read the Notice does not vitiate the Notice, nor does the delay resulting from such failure to read the Notice establish unavoidable delay.

[7] 37 CFR 1.378(b)(3) precludes acceptance of a late maintenance fee for a patent unless a petitioner can demonstrate that steps were in place to monitor the maintenance fee. The federal Circuit has specifically upheld the validity of this regulation. Ray v. Lehman, 55 F.3d 606, 609; 34 USPQ2d (BNA) 1786 (Fed.Cir. 1995). In Ray v. Lehman, petitioner claimed that he had not known of the existence of the maintenance fees and therefore had no steps in place to pay such fees. The petitioner therefore argues that the PTO's regulation, 37 CFR 1.37(b)(3), supra, arguing that it 'creates a burden that goes well beyond what is reasonably prudent." We disagree, The PTOs' regulation merely sets forth how one is to prove that he was reasonably prudent, i.e., by showing what steps he took to ensure that the maintenance fee would be timely paid, and the steps taken in seeking to reinstate the patent. We do not see these requirements additional to proving unavoidable delay, but as the very elements of unavoidable delay." Id.

series of personnel transitions and patent files were being transferred to the new law firms. Petitioner states that it was the assignees' understanding that only inactive files would be sent to the assignee, while the active files would be sent to one of the two new law firms. So as to run out all of the funds from the government contract, Needle & Rosenberg retained management of some patent files, including the subject patent. However, petitioner states that by late 2007, Needle & Rosenberg's contract has expired and funding was depleted. At that time, many active and inactive files were sent directly to CDC. This was contrary to the assignee's understanding of the process. Believing that only inactive files would have been transferred to it, the assignee did not review the contents of the boxes that were sent to it directly from Needle & Rosenberg nor did it review the spreadsheets of the boxes content that Needle & Rosenberg sent. Petitioner surmises that this miscommunication between the assignee and Needle & Rosenberg resulted in the non-payment of the 7.5-year maintenance fee.

Petitioner also notes that in April and May of 2008, Ms. Shope was transferring her responsibilities to the new Patent Advisor, Mr. Fikovsky at which point she discovered the July 10, 2007, e-mail correspondence from Needle & Rosenberg. Ms. Shope forwarded the e-mail to Mr. Fikovsky. Petitioner states that, at the time, the assignee's database indicated that the patent was in good standing. Because of the assignee's procedures for maintenance fees to be tracked and paid by the outside firms, Mr. Fikovsky believed that the assignee would be contacted by one of the law firms if further action was required. Thus, Mr. Fikovsky did not take any action. Petitioner intimates that this contributed to the delay in filing the petition under 37 CFR 1.378(b). The patent was discovered to be expired pn April 13, 2011, after a search in PAIR.

The argument has been considered, but is not persuasive as the showing made in the petition is incomplete. Further to this point, Section 711.03(c)(2) provides, in pertinent part that:

> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner has not established that the entire delay—from the expiration of the patent to filing of a grantable petition under 37 CFR 1.378(b)-- was unavoidable. Petitioner's argument that it was fully the responsibility of one of two law firms to track and pay the maintenance fee for the patent which relieved the assignee of any responsibility for maintenance of the patent is without merit. Simply because the assignee contracted out the responsibility for tracking and paying the maintenance fee for patent does not relieve the assignee of the burden of establishing that the assignee treated the maintenance of the patent as its most important business during the entire period in question. The petition makes clear that Needle & Rosenberg sent correspondence on July 10, 2007, advising the assignee that there were insufficient funds to pay the maintenance fee. This correspondence was not discovered until May 2008, at which point Ms. Shope sends the correspondence to the new Patent Advisor, Mr. Fikovsky, who apparently saw no reason to investigate the matter further in simple reliance on the established procedure that outside firms were handling these matter and if further action was necessary the firms would contact the assignee. Arguably, this is not treating the maintenance of the patent as one's most important business a duty of which the assignee is not relieved just because the responsibility for tracking and paying the maintenance fee was contracted out. This is true especially considering that the assignee was in a period of transition in personnel and the law firms contracted to track and pay maintenance fees for the hundreds of patents the assignee owns. Arguably, an inquiry with the USPTO or Needle & Rosenberg as to whether the maintenance fee has yet been paid, especially in view of correspondence from Needle & Rosenberg

noting that it had not been paid because there was insufficient funds to pay it, may have adverted the expiration of the patent or certainly lessened the three year time period that the patent remained expired before a petition under 37 CFR 1.378 was filed. The assignee's reliance upon an outside law firm does not provide the assignee with an absolute defense, but rather shifts the focus to whether the law firms acted reasonably and prudently. The assignee, as the patent holder, still must demonstrate that during all relevant periods the assignee treated the maintenance of the patent as its most important business. The petition fails in this respect.

It is further noted the petitioner, and the statement of Gwendolyn Spratt (who was an attorney at Needle & Rosenberg until July 31, 2009) states that Needle & Rosenberg held on to a few of the active patent files even once the government contract was awarded to the new law firms so as to deplete the funds remaining under the contract of Needle & Rosenberg. Once the funds were depleted, Ms. Spratt indicates that all files, whether inactive or active, were boxed up and sent directly to CDC which is apparently contrary to the established procedure between Needle & Rosenberg and the CDC. Petitioner should address why Needle & Rosenberg took a course of action that was contrary to established procedure. Further, it is requested that petitioner explain what the close-out procedures were between the CDC and Needle & Rosenberg were, i.e., how were remaining files to be handled after the funds were depleted. It is reasonable to think that if the CDC and Needle & Rosenberg agreed that Needle & Rosenberg would hold on to some of the files in order to deplete funds that an agreement was also reached as to how to handle remaining files once the funds were depleted.

Petitioner's Current Options

I. Petitioner may file a request for reconsideration.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within TWO (2) MONTHS from the mail date of this decision.[8] The petition for reconsideration should be titled "Petition for Reconsideration under 37 CFR 1.378(b)." Any petition for reconsideration for this decision must be accompanied by a non-refundable petition fee of $400.00 as set forth in 37 CFR 1.17(h).

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. It is, therefore, extremely important that petitioner supply any and all relevant information and documentation with the request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence "to show" that the delay was unavoidable. If a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

A reasonable and prudent person would not rely on maintenance fee reminders from the Office for two reasons. First, the Office has indicated that such reminders are a mere courtesy and has reserved the right to discontinue such reminders at any time. second, such reminders may be lost in the mail. A reasonable and prudent person, in regard to his most important business would not rely solely on reminders that the Office may or may not send which may or may not be lost in the mail.

[8]No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is not a final agency action within the meaning of 5 U.S.C. § 704.

II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Refund Section. A copy of this decision should accompany petitioner's request.

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

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/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petition 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

In re Patent No. 5562371
Issue Date: October 8,1996
Application No. 08473448
Filed: June 7,1995
Attorney Docket No. 25076-PA

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed September 28,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 28,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5562371	1996-10-08	08473448	1995-06-07	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

◉ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Sole Patentee			
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 form of the signature.			
Signature	/ Gary J. Reed/	Date (YYYY-MM-DD)	2010-05-25
Name	Gary J. Reed		

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5671219	1997-09-23	08473746	1995-06-07	214/044

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-08
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5671219
Issue Date: September 23,1997
Application No. 08473746
Filed: June 7,1995
Attorney Docket No. 214/044

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

LATHROP & CLARK LLP
740 REGENT STREET SUITE 400
P.O. BOX 1507
MADISON WI 53701-1507

MAILED

SEP 21 2010

OFFICE OF PETITIONS

In re Patent No. 5,643,596 :
Issued: July 1, 1997 :
Application No. 08/474,127 : ON PETITION
Filed: June 7, 1995 :
For: CLARFU-17 :

This is a decision on the communication filed September 20, 2010, which is being treated as a request for further consideration of the decision mailed September 13, 2010 pursuant to 37 CFR 1.378(e).

The petition is **GRANTED**.

The patent issued July 1, 1997. The 3.5 year maintenance fee was timely paid. The 7.5 year maintenance fee could have been paid from July 1, 2004 to January 1, 2005 without a surcharge or from January 2, 2005 to July 1, 2005 with a surcharge. The maintenance fee, however, was not submitted. Accordingly, the patent expired July 1, 2005 for failure to timely submit the 7.5 year maintenance fee.

Moreover, the 11.5 year maintenance fee is hereby ACCEPTED. The required 11.5 year maintenance fee has been charged to the authorized deposit account.

The 7.5 year and 11.5 year maintenance fee are accepted and the above-identified patent is reinstated as of September 13, 2010.

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

The patent file is being forwarded to Files Repository.

/ALESIA M. BROWN/

Alesia M. Brown
Petitions Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 12/16/10

TO SPE OF : ART UNIT 2424

SUBJECT : Request for Certificate of Correction for Appl. No.: 08474146 Patent No.: 7836480

CofC mailroom date:
12/09/10

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

[redacted]

Lamonte Newsome
Certificates of Correction Branch
571-272-3421

Thank You For Your Assistance

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

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

Comments: _____

_____

_____

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

GIBSON GUITAR CORP.
309 PLUS PARK BOULEVARD
NASHVILLE TN 37217

MAILED

OCT 29 2010

OFFICE OF PETITIONS

In re Patent No. 5,539,142 : Paper No. 9
Issue Date: July 23, 1996 :
Application No. 08/474,743 : DECISION ON PETITION
Filed: June 07, 1995 :
Attorney Docket No. **001701/0096** :

This is a decision on the petition under 37 CFR 1.378(c), filed August 13, 2010, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

The above-identified patent issued on July 23, 1996. Therefore, the period set forth in 35 U.S.C. § 41(b) for paying the eleven and one-half year maintenance fee expired on July 23, 2008.

A petition under 37 CFR 1.378(c) must be filed within twenty-four months after the six month grace period specified in 35 USC 41(b). The six months grace period for the instant patent expired at midnight on July 23, 2008. Accordingly, an unintentional petition to reinstate the instant patent must have been submitted no later than July 23, 2010. Since the petition was not timely filed, the instant patent will not be considered for reinstatement under the unintentional provisions of 37 CFR 1.378(c).

35 U.S.C. § 41(c)(1) authorizes the Commissioner to accept a delayed maintenance fee payment within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) if the delay is shown to have been unintentional, and authorizes the Commissioner to accept a delayed maintenance fee payment at any time if the delay is shown to have been unavoidable. Thus, 35 U.S.C. § 41(c)(1) does not authorize the Commissioner to accept a delayed maintenance fee payment later than twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) unless the delay is shown to have been unavoidable. Since the instant petition was not filed within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b), the Commissioner cannot accept a delayed maintenance fee payment for the above-identified patent under 37 CFR 1.378(c).

Should petitioner wish to pursue reinstatement of the above-identified patent on the basis of unavoidable delay, petitioner should file a petition under 35 U.S.C. § 41(c) and 37 CFR 1.378(b), which must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the

patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

If petitioner does not wish to pursue reinstatement of this expired patent, petitioner may request a refund of the $5,750 submitted with the instant petition. The request should be made in writing and addressed to: Mail Stop 16, Director of the U.S. Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

Petitioner should note that 1.378(d) requires that the petition under 1.378 for delayed payment of maintenance fees must be signed by an attorney or agent registered to practice before the Office, or by the patentee, the assignee, or other party in interest. It is not clear from the record if the petitioner whose signature is on the instant petition is authorized to sign this petition under 1.378(d).

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. 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 the delay in paying the maintenance fee under 37 CFR 1.378(c) was intentional, petitioner must notify the Office.

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

By Mail:
Mail Stop PETITION
Commissioner for Patents
Post Office 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 should be directed to Tredelle Jackson at 571-272-2783.

Ramesh Krishnamurthy

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

cc: **ANDREA BATES**
BATES & BATES, LLC
1270 CAROLINE STREET, SUITE D-120-393
ATLANTA GA 30307

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20120327

DATE : March 27, 2012

TO SPE OF : ART UNIT 2486

SUBJECT : Request for Certificate of Correction on Patent No.: 7,889,865

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - ST (South Tower) 9A22
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

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

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

Comments:

The requested changes do not introduce new matters, and do not change the scope or meaning of the claims.

/MEHRDAD DASTOURI/
Supervisory Patent Examiner.Art Unit 2486

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5629639	1997-05-13	08476206	1995-06-07	207/113

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-06
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 5629639
Issue Date: May 13,1997
Application No. 08476206
Filed: June 7,1995
Attorney Docket No. 207/113

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

SPENCER FRANK AND SCHNEIDER
SUITE 300 EAST
1100 NEW YORK AVENUE NW
WASHINGTON DC 20005-3955

MAILED
APR 19 2011
OFFICE OF PETITIONS

Paper No. 22

In re Patent No. 5,827,739
Issue Date: October 27, 1998
Application No. 08/476,567
Filed: June 7, 1995
Inventor: Richard H. Wilson et al.

: DECISION ON PETITION

This is a decision on the petition for expungement of information, filed September 28, 2010, which is being treated as petitions under 37 CFR 1.182 to invalidate an assignment previously recorded against the above-identified application.

The petition is **dismissed**. This is not a final agency action.

Petitioner indicates an assignment recorded on August 1, 2006 was erroneously filed for the above identified application and requests this assignment record be expunged from the file.

As discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or "expunge" assignment records are granted only if the petitioner can prove that:

(A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and
(B) the integrity of the assignment records will not be affected by granting the petition.

In regard to B, petitioner has not sufficiently explained how the removal of a document in its entirety will not affect the assignment records. The removal of a document in its entirety will affect the assignment records. The integrity of the records is recognized as separate from the chain of title, and the USPTO endeavors to maintain a complete history of claimed interests in a given property to permit, among other things, the review of matters like chain of title by a competent authority.

Moreover, petitioner seeks an extraordinary remedy, properly addressed under 37 CFR 1.182. The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982).

As set forth in MPEP 323, an error in a recorded assignment is not corrected by invalidating the previous document, but by simply submitting a "corrective document". The "corrective document" must include 1) a copy of the original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and 2) a new Recordation Form Cover Sheet (form PTO-1595). The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06. Petitioner should note that the "assignment documents" and "corrective documents" are not limited to assignments, but include any documents affecting title to a patent or application. See MPEP § 313.

Therefore, the rules of practice and the procedures before the USPTO provide an avenue for the requested relief without relying upon extraordinary measures. That is, the chain of title can be clarified in the assignment records through the recording of a corrective document. As a request for the Office to invalidate an assignment is both extraordinary and contrary to USPTO policy, this petition must be dismissed.

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 USC 261 and 37 CFR 3.11. However, the recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. Moreover, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment document will be retained, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992).

Furthermore, it is well settled that the Office is not the appropriate forum for resolving a dispute concerning the ownership of an application or patent, and, as such, the USPTO will not permit itself to become embroiled in ownership disputes, particularly as it does not have the means or the authority to resolve such disputes. Indeed, the USPTO has no authority to decide ownership issues. See Cedars-Sinai Medical Center v. Watkins, 11F.3d 1573, 1581 n.10, 29 USPQ 2d 1188, 1194 n.10 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. (1994). Rather, state law governs contractual obligations and transfers of property rights, including those relating to patents. See Regents of the University of New Mexico v. Knight, 66 USPQ2d 1001, 1008 (Fed. Cir. 2003). The USPTO cannot settle disputes as to title as a judicial tribunal is the appropriate forum to resolve such controversy. See Jim Arnold Corp. v. Hydrotech Sys., Inc., 109 F.3d 1567, 1572, 42 USPQ2d 1119, 1123 (Fed. Cir. 1997)("the question of who owns the patent right and on what terms typically is a question exclusively for state courts"); Roach v. Crouch, 24 N.W. 2d 400, 33

USPQ2d 1361 (Iowa 1994)(patent ownership issue properly triable in state court); In re Haines, 1900 C.D. 102, 103 (Comm'r Pat. 1900)(same).

If petitioner is successful in resolving this dispute, the proper documentation should be promptly submitted to the USPTO for recordation against the patent.

Also, Office records do not indicate that a change of address has been filed in this case, although the address given on the petition differs from the address of record. If appropriate, 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.

A petition to expunge assignment documents is properly addressed under 37 CFR 1.182 and a fee of $400.00 is required. The $400 petition fee has been charged to petitioner's deposit account.

Telephone inquiries concerning this communication should be directed to Carl Friedman at (571)272-6842.

Christopher Bottorff
Supervisor
Office of Petitions

Cc: Womble Carlyle Sandridge & Rice PLLC
P.O. Box 7037
Atlanta Georgia 30357-0037

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5,674,537	1997-10-07	08/477,293	1995-06-07	18257.24

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
◯	3 ½ year	(1551)	◯	3 ½ year	(2551)
◯	7 ½ year	(1552)	◯	7 ½ year	(2552)
◯	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

◯ A sole patentee

◯ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

◯ A joint patentee; all of whom are signing this e-petition

◯ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Michael F. Krieger/	Date (YYYY-MM-DD)	2011-03-15
Name	Michael Krieger	Registration Number	35232

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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 Freedom 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.

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In re Patent No. 5674537
Issue Date: October 7,1997
Application No. 08477293
Filed: June 7,1995
Attorney Docket No. 8872.CIP.DIV

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed March 15,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of March 15,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5692007	1997-11-25	08477480	1995-06-07	214/070

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-08
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 5692007
Issue Date: November 25,1997
Application No. 08477480
Filed: June 7,1995
Attorney Docket No. 214/070

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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CHARLES F SCHROEDER
2317 VALLEYBROOK DRIVE
TOLEDO OH 43615-2953

MAILED

AUG 11 2010

OFFICE OF PETITIONS

In re Patent No. 6,229,265 :
Issue Date: May 8, 2001 :
Application No. 08/477,893 : ON PETITION
Filed: June 7, 1995 :
Attorney Docket No. 1-51456 :

This is a decision on the petition under 37 CFR 1.378(b), filed March 1, 2010, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this 2-month time limit can be granted under 37 CFR 1.136(a) or (b). Any such petition for reconsideration must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f). 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, the Director will undertake no further reconsideration or review of the matter.

A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1). This petition lacks item (1) above.

Petitioner states co-inventor Charles F. Schroeder "acted as my patent attorney for this patent and handled all correspondence associated therewith." Further, Mr. Schroeder passed away on March 24, 2005. The record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fee. In fact, the record indicates that no steps were taken by patentee to ensure timely payment of the maintenance fee. Since no steps were taken by patentee, 37 CFR 1.378(b) precludes acceptance of the delayed payment of the maintenance fee.

Furthermore, the Letters Patent contains a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. Accordingly, a reasonably prudent patentee would have inquired to see if his/her patent was subject to maintenance fees.

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. See *Patent No. 4,409,763, supra.* See also Final Rule entitled "Final Rules for Patent Maintenance Fees," published in the *Federal Register* at 49 *Fed. Reg.* 34716, 34722-23 (August 31, 1984), and republished in the *Official Gazette* at 1046 *Off. Gaz. Pat. Office* 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance

fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

The payment window for the 3.5-year maintenance fee opened May 8, 2004. On November 24, 2004, a Maintenance Fee Reminder was mailed to the fee address, which matches the address listed above. Since Mr. Schroeder did not pass away until March 2005, it is unclear why the maintenance fee was not timely paid between May 2004 and March 2005.

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

Petitioner will not receive future correspondence related to maintenance fees for the patent unless a "Fee Address" Indication Form (see PTO/SB/47) and Request for Customer Number (see PTO/SB/125) are submitted.

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 Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Telephone inquiries should be directed to Petitions Examiner Liana Walsh at (571) 272-3206.

David Bucci
Petitions Examiner
Office of Petitions

cc: SCOTT A. BLAKE
MACMILLAN, SOBANSKI & TODD, LLC
ONE MARITIME PLAZA
720 WATER STREET
TOLEDO, OH 43604

UNITED STATES PATENT AND TRADEMARK OFFICE

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ONE MARITIME PLAZA FIFTH FLOOR
720 WATER STREET
TOLEDO OH 43604-1619

MAILED
AUG 23 2011
OFFICE OF PETITIONS

In re Patent No. 6,229,265 :
Issue Date: May 8, 2001 :
Application No. 08/477,893 : DECISION ON PETITION
Filed: June 7, 1995 :
Inventor: Schroeder-Perry et al. :

This is a decision on the request for reconsideration, filed October 11, 2010, of a petition under 37 C.F.R. 1.378(b) to accept an unavoidably delayed payment of a maintenance fee in an expired patent.

The petition is **DENIED**[1].

BACKGROUND

The patent issued May 8, 2001. The 3.5-year maintenance fee could have been paid from May 8, 2004, through November 8, 2004, or with a surcharge during the period from November 9, 2004 through May 8, 2005. Accordingly, the patent expired at midnight May 8, 2005, for failure to timely submit the first maintenance fee.

On March 1, 2010, petitioner Becky J. Schroeder-Perry (Schroeder-Perry) filed a first petition to accept an unavoidably delayed payment of the maintenance fee under 37 C.F.R. 1.378(b). Non-payment of the maintenance fee was allegedly unavoidable due to the death of co-inventor Charles F. Schroeder (Schroeder), who also acted as the prosecuting patent attorney.

This petition was dismissed on August 11, 2010 and required that any petition for reconsideration explain with a documented showing the steps in place by patentee(s) to ensure that the fee would be timely paid, and how the system failed in this instance.

The request for reconsideration, filed October 11, 2010, attempted to address this request through the presentation of a Supplemental Declaration from Schroeder-Perry.

The declaration of Schroeder-Perry explains, "I entrusted my father, a co-inventor and experience patent attorney, to handle all matters associated with this patent. Further, "a maintenance fee reminder was mailed from the United States Patent and Trademark Office to my father's home residence on November 24, 2004. In accordance with his patent practice, my father would have docketed this information and noted that the maintenance fee could be paid anytime until May 8, 2005 (with a small surcharge fee). Thus, my father took reasonable steps to ensure payment of the maintenance fee prior to the May 8, 2005 due date." Finally, "My father died on March 24, 2005 prior to the maintenance fee due date of May 8, 2005. I do not know why my father did not pay this maintenance fee prior to his death but I understand that there is no obligation to pay the maintenance fee sooner than the May 8, 2005 due date."

It is the patentee's discretion to delay action until the end of the time period for reply. However, in doing so, the applicant must assume the risk attendant to such delay. *See* Ex parte Warren, 1901 Dec. Comm'r Pat. 137 (Comm'r Pat. 1901). In addition, the USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987); California, 921 F.Supp. 1219, 1259 (D.Del. 1995). Specifically, petitioner's delay caused by the mistakes or omissions of her voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133. See Haines v. Quigg, *supra*; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (Comm'r Pat. 1891). It follows that such is not unavoidable delay within the meaning of 35 USC 41(c) and 37 CFR 1.378(b). Ray, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995).

The Request for Reconsideration has been considered and the Petition of March 1, 2010 has been reconsidered.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. § (2)(B)(2) provides, in part, that:

> The Office-- may, establish regulations, not inconsistent with law, which
>
> (A) shall govern for the conduct of proceedings in Office.

35 U.S.C. § 41(c)(1) provides that:

> The Director may accept the payment of any maintenance fee required by subsection (b) of this section which is made within twenty-four months after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unintentional, or at any time after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable. The Director may require the payment of a surcharge as a condition of accepting payment of any maintenance fee after the six-month grace

> period. If the Director accepts payment of a maintenance fee after the six-month grace period, the patent shall be considered as not having expired at the end of the grace period.

37 CFR 1.378(b) provides that:

> (b) Any petition to accept an unavoidably delayed payment of a maintenance fee filed under paragraph (a) of this section must include:
>
> (1) The required maintenance fee set forth in §1.20 (e) through (g);
>
> (2) The surcharge set forth in §1.20(i)(1); and
>
> (3) A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

OPINION

Petitioner request reconsideration of the previous adverse decision on the petition filed under 37 CFR 1.378(b) and submits that due to have a process in place to pay the maintenance fee due, the expiry of the instant patent is unavoidable.

Petitioner has not met the burden of proving to the satisfaction of the Director that the delay in payment of the maintenance fee was unavoidable within the meaning of 35 USC 41(c)(1) and 37 CFR 1.378(b)(3).

37 CFR 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include:

> "A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date, and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly."

A late maintenance fee is considered under the same standard as that for reviving an abandoned application under 35 USC 133 because 35 USC 41(c)(1) uses the identical language, i.e. "unavoidable delay". Ray v. Lehman, 55 f. 3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the "reasonably prudent person" standard in determining if the delay in responding to an Office action was unavoidable. Ex parte

Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "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"); In re Mattullath, 38 App. D.C. 497, 514-515 (D.C. Cir. 1912); and Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141. In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

35 U.S.C. § 41(c)(1) does not require an affirmative finding that the delay was avoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960)(35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing). Petitioner is reminded that it is the patentee's burden under the statutes and regulations to make a showing to the satisfaction of the Commissioner that the delay in payment of a maintenance fee is unavoidable. See Rydeen v. Quigg, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), aff'd 937 F.2d 623 (Fed. Cir. 1991)(table), *cert. denied*, 502 U.S. 1075 (1992); Ray v. Lehman, supra.

As 35 USC § 41(b) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 USC § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken by the responsible party to ensure the timely payment of the maintenance fee for this patent. Id.

Unfortunately, the record does not show that either Schroeder or petitioner had any steps in place to ensure payment of the maintenance fee at the time it fell due, rather, the record shows that: (1) Petitioner relied upon Schroeder to pay maintenance fees; (2) Schroeder passed before after the first maintenance fee was due; and (3) Petitioner was unaware of the need to pay maintenance fees. No explanation of: a docketing and call up system in use, the types of records kept, or any personnel responsible for such a system was provided by petitioner.

Accordingly, it follows that neither Schroeder nor petitioner had any means of tracking and paying the maintenance fee. However delay resulting from the failure of the patent holder to have any steps in place to pay the fee by either obligating a third party to track and pay the fee, or by itself assuming the obligation to track and pay the fee, is not unavoidable delay. See R.R. Donnelley & Sons Co. v. Dickinson, 123 F.Supp.2d 456, 460, 57 USPQ2d 1244, 1247 (N.D. Ill. 2000); Ray, supra; California, supra; Femspec v. Dudas, 2007 U.S. Dist. LEXIS 8482 (N.D.Ca 2007).

Although petitioner states that her father must have had steps in place, since he received the reminder notice from the USPTO, the record fails to show what, if any, steps within the meaning of 37 CFR 1.378(b)(3) were taken by or on behalf of petitioner to schedule or pay the maintenance fee. Petitioner is reminded that 37 CFR 1.378(b)(3) is a validly promulgated regulation, as is the requirement therein for petitioner's showing of the steps taken to pay the fee. Ray, 55 F.3d at 609, 34 USPQ2d at 1788. In the absence of a showing of the steps taken by or on behalf of petitioner, 37 CFR 1.378(b)(3) precludes acceptance of the maintenance fee. See also Korsinsky v. Godici, 2005 US Dist. LEXIS 20850 at *13 (S.D. N.Y. 2005), *aff'd sub nom;* Korsinsky v. Dudas, 2007 US Dist. LEXIS 7986 (Fed. Cir. 2007); R.R. Donnelley & Sons v. Dickinson, 123 F.Supp.2d 456, 460, 57 USPQ2d 1244 (N.D. Il. 2000)(failure of patent owner to itself track or obligate another to track the maintenance fee precluded acceptance of the maintenance fee); California, *supra*; MMTC v. Rogan, 369 F.Supp2d 675 (E.D. Va 2004)(passive reliance on USPTO reminder notice resulting in failure to take any steps to ensure payment of the maintenance fee is not unavoidable delay); Femspec v. Dudas, 2007 U.S. Dist. LEXIS 8482 (N.D.Ca 2007)(lack of any steps in place to maintain patent in force by estate executor unfamiliar with patent law is not unavoidable delay); Burandt. v. Dudas, 496 F.Supp.2d 643 at 650 (E.D. Va 2007)(delay not unavoidable where no steps shown to be employed to remind responsible party to timely pay maintenance fees.)

As the patent holder at the time of expiration, it was incumbent on petitioner to have docketed this patent for payment of the maintenance fee in a reliable system as would be employed by a prudent and careful person with respect to his most important business, or to have engaged another for that purpose. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995). During the fee payment period from May 8, 2004 to May 8, 2005, petitioners allege Schroeder was engaged for tracking and paying the maintenance fee. However, even where another has been relied upon to pay the maintenance fees, such asserted reliance per se does not provide a petitioner with a showing of unavoidable delay within the meaning of 37 CFR § 1.378(b) and 35 USC § 41(c). Id. Rather, such reliance merely shifts the focus of the inquiry from the petitioner to whether the obligated party acted reasonably and prudently. Id. Nevertheless, a petitioner is bound by any errors that may have been committed by the obligated party. Id.

The facts are that the fee was not paid because steps were not in place to actually pay the fee. These are not the actions of a prudent and careful person with respect to his or her most important business, and as such precludes a reasonable and rational finding that the delay in payment of the maintenance fee was unavoidable. Rather, a prudent and careful person with respect to his or her most important business, would have initiated its own steps to track and pay the fee. See California, supra (noting that "if [the patent attorney] had ceased representing [the patent owner] for some reason, [the patent owner] would have been obligated at that time to either familiarize himself with the maintenance fee requirements or retain new counsel..."); Femspec, at * 26-*27 (quoting California); Burandt, supra.

DECISION

Petitioner has failed to meet the burden of proving to the satisfaction of the Director that the entire delay in submission of the maintenance fee herein was unavoidable within the meaning of

35 U.S.C. § 41(c) and 37 CFR 1.378(b). Accordingly, the maintenance fee will not be accepted, this patent will not be reinstated, and this patent remains expired. The petition is **denied.**

The USPTO will not further consider or reconsider this matter. See 37 CFR 1.378(e).

Any inquiries concerning this communication may be directed to Petitions Examiner Liana Walsh at (571) 272-3206.

Anthony Knight
Director, Office of Petitions
cb/db

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[1] This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of obtaining judicial review. See MPEP 1002.02.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 04-28-11

TO SPE OF : ART UNIT 2456

SUBJECT : Request for Certificate of Correction for Appl. No.: 08/479215 Patent No.: 7818777

CofC mailroom date: 04-20-11

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) 756-1541

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: _____

_____

_____

_____

SPE /Rupal Dharia/ **Art Unit** 2456

PTO/SB/66 (03-09)
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5629956	1997-05-13	08480167	1995-06-07	213/039

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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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 displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-06
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5629956
Issue Date: May 13,1997
Application No. 08480167
Filed: June 7,1995
Attorney Docket No. 213/039

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5627856	1997-05-06	08480442	1995-06-07	213/041

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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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 displays valid OMB control number.

Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-06
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

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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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5627856
Issue Date: May 6,1997
Application No. 08480442
Filed: June 7,1995
Attorney Docket No. 213/041

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5754584	1998-05-19	08480443	1995-06-07	213/043

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
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Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-18
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

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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)).

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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

In re Patent No. 5754584
Issue Date: May 19,1998
Application No. 08480443
Filed: June 7,1995
Attorney Docket No. 213/043

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 18,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 18,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5610940	1997-03-11	08480668	1995-06-07	213/036

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

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	Fee	Code
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Small Entity

	Fee	Code
○	3 ½ year	(2551)
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SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

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STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-06
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

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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

In re Patent No. 5610940
Issue Date: March 11,1997
Application No. 08480668
Filed: June 7,1995
Attorney Docket No. 213/036

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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CENTERS FOR DISEASE CONTROL
c/o Ballard Spahr LLP
999 PEACHTREE STREET
SUITE 1000
ATLANTA GA 30309

MAILED

JUL 06 2011

OFFICE OF PETITIONS

In re Patent No. 6,126,944
Issued: October 3, 2000
Application No.: 08/480,850
Filing Date: June 7, 1995
Attorney Docket No. **1414.657**

: REQUEST FOR INFORMATION

This is a request for information in response to the petition under 37 CFR 1.137(a) filed May 27, 2011. The petition is properly treated under 37 CFR 1.378(b), to reinstate the above-cited patent.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed September 28, 2009. No additional fees are due.

The patent issued October 3, 200. The 7.5 year maintenance fee could have been paid from October 3, 2007, through April 3, 2008, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from April 4, 2008, to October 3, 2008. Petitioner did not do so. Accordingly, the patent expired at midnight on October 3, 2008.

In summary, petitioner maintains that, after a contract was awarded to new law firms for the tracking and payment of the maintenance fees for the patents held by the assignee, the subject patent file was not routed to the proper place in accordance with assignee's established procedures. More specifically, petitioner states that the established procedure was for all active patent files to be sent by Needle & Rosenberg (the prior law firm) to one of two new law firms awarded the contract, either Klarquist Sparkman or Gifford Krass. All inactive patent files were to be sent back to the assignee. For reasons unbeknownst to petitioner, Needle & Rosenberg sent the patent file for the subject patent back to the assignee. Consequently, no maintenance fee payment schedule was docketed for the subject patent.

Petitioner is required to address the following points:

- Petitioner does not affirmatively identify the cause of the delay in paying the maintenance fee aside from concluding that the 7.5-year maintenance fee payment was not made because the filed was erroneously sent back to the assignee, rather than being sent to one of the new law firms. A successful petition under 37 CFR 1.378(b) must affirmatively identify the cause of the delay in paying the maintenance fee and provide a statement from every person with first-hand knowledge

of the circumstances surrounding the delay in paying the maintenance fee. Petitioner must provide statements from any person who may have been charged with paying the maintenance fee and statements from any person with first-hand knowledge of the circumstances surrounding the failure to pay the maintenance fees. Further, petitioner must provide a statement from persons with knowledge of how Needle & Rosenberg could have sent the active patent file to the assignee rather than to the new law firms. It is noted that petitioner states that Needle & Rosenberg was acquired by Ballard and Spar in June of 2008. Notwithstanding, petitioner should made some effort to obtain a statement from previous employees of Needle & Rosenberg who may have some first-hand knowledge into procedures employed by Needle & Rosenberg for screening the patent files and ensuring they were forwarded to the right place. If petitioner's investigation reveals that a clerical error at Needle & Rosenberg caused file to be misrouted, petitioner is cautioned to adhere to guidance provided in Section Section 711.03(c)(2) of the Manual of Patent Examining Procedure, which provides, in pertinent part that:

> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).
>
> A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:
>
> (A) the error was the cause of the delay at issue;
>
> (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
>
> (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

A delay resulting from an error, such a docketing error, on the part of an employee in the performance of a clerical function may provide the basis for a showing of unavoidable delay. Such a showing should identify the specific error, the individual who made the error, and the business routine in place for performing the action which resulted in the error. The showing must establish that the individual who erred was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. The showing should include information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned task.

- Petitioner is required to explain what procedures, if any, petitioner had in place for screening the patent files received from Needle & Rosenberg during the transition between law firms.

- Petitioner states that on November 20, 2008, Needle & Rosenberg sent a letter to the assignee forwarding a Notice of Patent Expiration for the subject patent and their electronic summary noting that the subject patent file had been sent to the assignee on September 28, 2008. Petitioner was notified in November 2008, that the subject patent was expired, yet the no petition to

reinstate the patent was filed on May 2011. Petitioner must explain how this delay was unavoidable.

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

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND OR 97204

MAILED
JUL 18 2011
OFFICE OF PETITIONS

In re Patent No. 6,126,944
Issued: October 3, 2000
Application No.: 08/480,850
Filing Date: June 7, 1995
Attorney Docket No. **1414.657**

: REQUEST FOR INFORMATION

This is a request for information in response to the petition under 37 CFR 1.137(a) filed May 27, 2011. The petition is properly treated under 37 CFR 1.378(b), to reinstate the above-cited patent.

Petitioner is allowed a non-extendable period for reply of **TWO (2) MONTHS** from the mailing date of this communication to provide a response. The response should be titled, "Response to Request for Information." If no response is provided within the period set forth, a decision will be made solely on the merits as set forth in the petition under 37 CFR 1.378(b) filed September 28, 2009. No additional fees are due.

The patent issued October 3, 200. The 7.5 year maintenance fee could have been paid from October 3, 2007, through April 3, 2008, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from April 4, 2008, to October 3, 2008. Petitioner did not do so. Accordingly, the patent expired at midnight on October 3, 2008.

In summary, petitioner maintains that, after a contract was awarded to new law firms for the tracking and payment of the maintenance fees for the patents held by the assignee, the subject patent file was not routed to the proper place in accordance with assignee's established procedures. More specifically, petitioner states that the established procedure was for all active patent files to be sent by Needle & Rosenberg (the prior law firm) to one of two new law firms awarded the contract, either Klarquist Sparkman or Gifford Krass. All inactive patent files were to be sent back to the assignee. For reasons unbeknownst to petitioner, Needle & Rosenberg sent the patent file for the subject patent back to the assignee. Consequently, no maintenance fee payment schedule was docketed for the subject patent.

Petitioner is required to address the following points:

- Petitioner does not affirmatively identify the cause of the delay in paying the maintenance fee aside from concluding that the 7.5-year maintenance fee payment was not made because the filed was erroneously sent back to the assignee, rather than being sent to one of the new law firms. A successful petition under 37 CFR 1.378(b) must affirmatively identify the cause of the delay in paying the maintenance fee and provide a statement from every person with first-hand knowledge of the circumstances surrounding the delay in paying the maintenance fee. Petitioner must

provide statements from any person who may have been charged with paying the maintenance fee and statements from any person with first-hand knowledge of the circumstances surrounding the failure to pay the maintenance fees. Further, petitioner must provide a statement from persons with knowledge of how Needle & Rosenberg could have sent the active patent file to the assignee rather than to the new law firms. It is noted that petitioner states that Needle & Rosenberg was acquired by Ballard and Spar in June of 2008. Notwithstanding, petitioner should made some effort to obtain a statement from previous employees of Needle & Rosenberg who may have some first-hand knowledge into procedures employed by Needle & Rosenberg for screening the patent files and ensuring they were forwarded to the right place. If petitioner's investigation reveals that a clerical error at Needle & Rosenberg caused file to be misrouted, petitioner is cautioned to adhere to guidance provided in Section Section 711.03(c)(2) of the Manual of Patent Examining Procedure, which provides, in pertinent part that:

> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).
>
> A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:
>
> (A) the error was the cause of the delay at issue;
>
> (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
>
> (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.
>
> A delay resulting from an error, such a docketing error, on the part of an employee in the performance of a clerical function may provide the basis for a showing of unavoidable delay. Such a showing should identify the specific error, the individual who made the error, and the business routine in place for performing the action which resulted in the error. The showing must establish that the individual who erred was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. The showing should include information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned task.

- Petitioner is required to explain what procedures, if any, petitioner had in place for screening the patent files received from Needle & Rosenberg during the transition between law firms.

- Petitioner states that on November 20, 2008, Needle & Rosenberg sent a letter to the assignee forwarding a Notice of Patent Expiration for the subject patent and their electronic summary noting that the subject patent file had been sent to the assignee on September 28, 2008. Petitioner was notified in November 2008, that the subject patent was expired, yet the no petition to

reinstate the patent was filed on May 2011. Petitioner must explain how this delay was unavoidable.

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

By mail: Commissioner for Patent
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Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

KLARQUIST SPARKMAN, LLP
121 SW SALMON STREET
SUITE 1600
PORTLAND OR 97204

MAILED
JAN 27 2012
OFFICE OF PETITIONS

In re Patent No. 6,126,944 :
Issued: October 3, 2000 : ON PETITION
Application No.: 08/480,850 :
Filing Date: June 7, 1995 :
Attorney Docket No. **1414.657** :

This is responsive to the Response to Request for Information filed September 19, 2011, and a decision on the petition under 37 CFR 1.378(b), filed June 1, 2011, to reinstate the above-cited patent.

The petition is **dismissed**.

The patent issued October 3, 2000. The 7.5 year maintenance fee could have been paid from October 3, 2007, through April 3, 2008, or with a surcharge, as authorized by 37 CFR 1.20(h), during the period from April 4, 2008, to October 3, 2008. Petitioner did not do so. Accordingly, the patent expired at midnight on October 3, 2008.

A grantable petition under 37 CFR 1.378(b) must be accompanied by a showing to the satisfaction of the Commissioner that the entire delay in paying the required maintenance fee from the due date for the fee until the filing of a grantable petition pursuant to this paragraph was unavoidable. The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.378(b).

Opinion

Petitioner must establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.

The general standard applied by the Office requires petitioner to establish that petitioner treated the patent the same as a reasonable and prudent person would treat his or her most important business.[1]

[1]The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard. 35 U.S.C. 41(c)(1) states, "The Commissioner may accept the payment of any maintenance fee . . . at any time . . .if the delay is shown *to the satisfaction of the Commissioner* to have been unavoidable." (emphasis added).

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. His interpretation of those provisions is entitled to considerable deference." Rydeen v. Quigg, 748 F. Supp. 900, 904, 16 U.S.P.Q2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion Rule 36), 937 F.2d 623 (Fed Cir. 1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d agencys' interpretation of a statute it administers is entitle to deference"); see also Chevron U.S.A. Inc, v. Natural Resources Defense Counsil, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute s silent or

However, "[t]he question of whether an applicant's delay in prosecuting an application was unavoidable [will]be decided on a case-by-case basis, taking all of the facts and circumstances into account."[2] Nonawarness of the content of, or misunderstanding of PTO statutes, PTO rules, the MPEP, or the Official Gazette notices does not constitute unavoidable delay.[3] The statute requires a "showing" by petitioner, therefore; petitioner has the burden of proof. The decision will be based solely on the written, administrative record in existence. It is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to "show" that the delay was unavoidable.

Petitioner is responsible for possessing knowledge of the need to pay maintenance fees and the due dates for such fees, Petitioner is responsible for instituting a reliable docketing system to remind him or her when maintenance fees become due.

Petitioner is responsible for having knowledge of the need to pay maintenance fees and knowing when the fees are due.[4] The Office has no duty to notify a patentee of the requirement to pay maintenance fees or to notify patentee when a maintenance fee is due.[5] Even if the Office were required to provide notice to

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ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute."))

"The critical phrase 'unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable' has remained unchanged since first enacted in 1861." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (D.C. Cir. 1982). The standard for "unavoidable" delay for reinstating a patent is the same as the unavoidable standard for reviving an application. See Ray v. Lehman, 55 F. 3d 606, 608-609, 34 U.S.P.Q.2d (BNA) 1786, 1781 (Fed Cir. 1995) (Citing In re patent No. 4,409, 763, 7 U.S.P.Q.2d BNA) 1798, 1800 (Comm'r Pat. 1990; Smith v. Mossinghoff, 671 F. 2d 533, 538, 213 U.S.P. Q. (BNA) 977 (D.C. Cir. 1982). The court in In re Mattullath, accepted the standard which had been proposed by Commissioner Hall which "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." In re Mattullath, 38 App. D.C. 497, 514-515 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat 31, 32-33 (1887)).

[2]Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

[3]See Smith v. Mossinghoff, 671 F. 2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable " delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (plaintiffs, through their counsel's action, or their own, must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

[4]Nonawarness of PTO statutes, PTO rules, the MPEP, or Official Gazette notices, which state maintenance fee amounts and dates they are due does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. *BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable" delay)); Vincent v. Mossinghoff, 1985 U.S. Dist. LEXIS 23119, 13, 230 U.S.P.Q. (BNA) 621 (D.D.C. 1985) (Plaintiffs, through their counsel's actions, or their own must be held responsible for having noted the MPEP section and Official Gazette notices expressly stating that the certified mailing procedures outlined in 37 CFR 1.8(a) do not apply to continuation applications.) (Emphasis added).

Petitioner must act as a reasonable and prudent person in relation to his most important business. Upon obtaining the patent, a reasonable and prudent person, in relation to his most important business, would become familiar with the legal requirements of that business, in this case, the requirement to pay maintenance fees. In addition, a reasonable and prudent individual would read the patent itself and thereby become aware of the need to pay maintenance fees and the fact that such fee amounts are sometimes changed by law or regulation.

[5]Congress expressly conditioned §§ 133 and 151 [of the United States Code] on a specific type of notice, while no such notice requirements are written into § 41(c) . . . [T]he Commissioner's no timely-notice interpretation." Ray v. Comer, 1994 U.S. Dist.

applicant of the existence of maintenance fee requirements, such notice is provided by the patent itself.[6]

A reasonable and prudent person, aware of the existence of maintenance fees, would not rely on maintenance fee reminders or on memory to remind him or her when payments would fall due several years in the future. Instead, such an individual would implement a reliable and trustworthy tracking system to keep track of the relevant dates.[7] The individual would also take steps to ensure that the patent information was correctly entered into the tracking system.

Application of the unavoidable standard to the present facts

In the instant petition, petitioner argues that the above-cited patent should be reinstated because the delay in paying the 7.5-year maintenance fee was unavoidable. More specifically, petitioner maintains that, after a contract was awarded to new law firms for the tracking and payment of the maintenance fees for the patents held by the assignee, the subject patent file was not routed to the proper place in accordance with assignee's established procedures. Petitioner states that the established procedure was for all active patent files to be sent by Needle & Rosenberg (the prior law firm) to one of two new law firms awarded the contract, either Klarquist Sparkman or Gifford Krass. In the period spanning 2007 and 2008, the assignee was undergoing a series of personnel transitions and patent files were being transferred to the new law firms. Petitioner states that it was the assignees' understanding that only inactive files would be sent to the assignee, while the active files would be sent to one of the two new law firms. So as to run out all of the funds from the government contract, Needle & Rosenberg retained management of some patent

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LEXIS 21478, 8-9 (1994), *aff'd on other grounds* Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995) (Citing Rydeen v. Quigg, 748 F. Supp. 900, 905 (1990), Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837, 81 L. ed. 2d 694, 104 S. Ct. 2778 (1984)). "The Court concludes as it did in Rydeen, that as a constitutional matter, 'plaintiff was not entitled to any notice beyond publication of the statute." Id. at 3 (citing Rydeen v. Quigg, 748 F. Supp. at 906, Texaco v. Short, 454 U.S. 516, 536, 70 L. Ed. 2d 738, 102 S. Ct. 781 (1982)).

The Patent Office, as a courtesy tries to send maintenance fee reminders and notices of patent expiration to the address of record. However, the failure to receive the reminder notice, and the lack of knowledge of the requirement to pay the maintenance fee, will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. See MPEP 2575, 2540, 2590. Petitioner does not have a right to a personalized notice that this patent will expire if a certain maintenance fee is not paid, as the publication of the statute was sufficient notice. See Rydeen v. Quigg, 748 F. Supp. 900, 907 (1990). the ultimate responsibility for keeping track of maintenance fee states lies with the patentee, not the USPTO. Since the mailing of Notices by the Office is completely discretionary and not a requirement imposed by Congress, accepting an argument that failure to receive a Notice is unavoidable delay would result in all delays being unavoidable should the Office discontinue the policy. All petitions could allege non-receipt of the reminder, and therefore all petitions could be granted. This was clearly not the intent of Congress in the creation of the unavoidable standard.

[6]See Ray v. Lehman, 55 F.3d 606, 610; 34 USPQ2d 1786, 1789 (Fed. Cir. 1995). The Letters of Patent contain a Maintenance Fee Notice that warns that the patent may be subject to maintenance fees if the application was filed on or after December 12, 1980. While it is unclear as to who was and is in actual possession of the patent, petitioner's failure to read the Notice does not vitiate the Notice, nor does the delay resulting from such failure to read the Notice establish unavoidable delay.

[7] 37 CFR 1.378(b)(3) precludes acceptance of a late maintenance fee for a patent unless a petitioner can demonstrate that steps were in place to monitor the maintenance fee. The federal Circuit has specifically upheld the validity of this regulation. Ray v. Lehman, 55 F.3d 606, 609; 34 USPQ2d (BNA) 1786 (Fed.Cir. 1995). In Ray v. Lehman, petitioner claimed that he had not known of the existence of the maintenance fees and therefore had no steps in place to pay such fees. The petitioner therefore argues that the PTO's regulation, 37 CFR 1.37(b)(3), supra, arguing that it 'creates a burden that goes well beyond what is reasonably prudent." We disagree, The PTOs' regulation merely sets forth how one is to prove that he was reasonably prudent, i.e., by showing what steps he took to ensure that the maintenance fee would be timely paid, and the steps taken in seeking to reinstate the patent. We do not see these requirements additional to proving unavoidable delay, but as the very elements of unavoidable delay." Id.

files, including the subject patent. However, petitioner states that by late 2007, Needle & Rosenberg's contract has expired and funding was depleted. At that time, many active and inactive files were sent directly to CDC. This was contrary to the assignee's understanding of the process. Believing that only inactive files would have been transferred to it, the assignee did not review the contents of the boxes that were sent to it directly from Needle & Rosenberg nor did it review the spreadsheets of the boxes content that Needle & Rosenberg sent. Petitioner surmises that this miscommunication between the assignee and Needle & Rosenberg resulted in the non-payment of the 7.5-year maintenance fee.

Petitioner further notes that the delay in paying the 7.5-year fee was exacerbated by a clerical error that resulted in the Notice of Patent Expiration sent in November 2008 not being noted and acted upon. Specifically, petitioner concedes that the Notice of Patent Expiration was received in November 2008, however, Ms. Veronica Brown, Management and Program Analyst for the assignee failed to enter the Notice of Patent Expiration in the assignee's database. Because Ms. Brown did not enter any information regarding the Notice of Patent Expiration in the assignee's database, the expired status of the patent was not reflected in the assignees' database. The expiration of the patent went unattended to until April 13, 2011, when Mr. Valetin Fikovsky again found that the patent was expired after a search of the USPTO PAIR database.

The arguments have been considered, but are not persuasive as the showing made in the petition is incomplete. Further to this point, Section 711.03(c)(2) provides, in pertinent part that:

> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner has not established that the entire delay—from the expiration of the patent to filing of a grantable petition under 37 CFR 1.378(b)-- was unavoidable. Petitioner's argument that it was fully the responsibility of one of two law firms to track and pay the maintenance fee for the patent which relieved the assignee of any responsibility for maintenance of the patent is without merit. Simply because the assignee contracted out the responsibility for tracking and paying the maintenance fee for patent does not relieve the assignee of the burden of establishing that the assignee treated the maintenance of the patent as its most important business during the entire period in question. Petitioner was made aware in November 2008, that the patent was in an expired status. It appears that the Notice of Patent Expiration was sent to several agents of the assignee, yet, for various reasons, no one acted on the Notice of Patent Expiration until April 2011.

- The declaration of Veronica Brown states that she received the Notice of Patent Expiration on December 9, 2008, but that notice came in "outside [the assignees] normal procedures." So, she did not enter it into the assignee's database.
- The declaration of Sharon Shropshire, Technology Transfer Assistant for the assignee, states that she date-stamped the Notice of Patent Expiration on November 28, 2008, but, because it was accompanied by a letter that was addressed to Mr. Paco Candal, Ms. Shropshire put the Notice of Patent Expiration into Mr. Candal's mailbox, rather than forward it to Ms. Brown, which was contrary to established procedure.
- The declaration of Cynthia Sherwood, Technology Development Coordinator for the assignee, states that on December 4, 2008, Mr. Candal sent her a copy of the Notice of Patent Expiration by e-mail. Mr. Candal is a Patent Advisor for the assignee. So, Ms. Sherwood states that she

reasoned that since Mr. Candal had the notice that the notice had already been docketed by Ms. Brown. Thus, Ms. Sherwood concluded that no further action was required on the part of the administrative staff. Notwithstanding, Ms. Sherwood indicates that she forwarded a copy of the e-mail to Ms. Brown and Ms. Shropshire on December 9, 2008.

- The declaration of Mr. Paco Candal, Patent Advisor, states that he received the e-mail copy of the Notice of Patent Expiration on December 9, 2008. He determined that the patent was not on his docket and forwarded the e-mail to Valentin Fikovsky, Patent Advisor, and the Director Andrew Watkins. He copied Ms. Suzanne Shope and Donald Prarther. He also copied Ms. Sherwood. Mr. Candal states that, because the patent was licensed, he believed the appropriate Patent Advisor would take any further action if necessary.
- The declaration of Ms. Suzanne Shope, Technology Licensing, and Marketing Scientist for the assignee, states that she received the e-mail from Mr. Candal, but "[s]ince [the assignee] does not internally prosecute patent applications or pay maintenance fees, the normal procedure is that the Patent Advisor would be contacted by our outside counsel for any action required in response to any patent correspondence. As I was not working as the Patent Advisor for this matter, no action was required on my part."
- The declaration of Valentin Fikovsky, Senior Patent Advisor for the assignee, notes that Mr. Fikovsky received a copy of the Notice of Patent Expiration by e-mail, however, he states that, "[w]hen the Notice was received, I assumed that since U.S. Patent No. 6,126,944 was licensed, outside counsel would have the patent file, and would contact me to inform me of any relevant deadlines, and provide advice as to how to revive the patent."

It is evident from the petition and the, and the several accompanying declarations, that the assignee was aware of the expiration of the patent in 2008, but none of the assignee's agents acted on the matter believing it to be someone else's responsibility or, finally, the responsibility of the outside contracted law firm. Arguably, this is not treating the maintenance of the patent as one's most important business a duty of which the assignee is not relieved just because the responsibility for tracking and paying the maintenance fee was contracted out. This is true especially considering that the assignee was in a period of transition in personnel and the law firms contracted to track and pay maintenance fees for the hundreds of patents the assignee owns. Arguably, an inquiry with the USPTO or the contracted law firm by any of the several people noted above may have adverted the expiration of the patent or certainly lessened the three year time period that the patent remained expired before a petition under 37 CFR 1.378 was filed. Instead, it appears that the patent remained expired for three years longer than may have been necessary because none of the assignee's agents took the reasonably diligent step of inquiring about the process of reinstating the patent. The assignee's reliance upon an outside law firm does not provide the assignee with an absolute defense, but rather shifts the focus to whether the law firms acted reasonably and prudently. The assignee, as the patent holder, still must demonstrate that during all relevant periods the assignee treated the maintenance of the patent as its most important business. The petition fails in this respect.

- Further, it is noted that petitioner states that the extended delay resulted from a clerical error committed by Ms. Verionca Brown, however, the declaration of the declaration of Sharon Shropshire, Technology Transfer Assistant for the assignee, states that she date-stamped the Notice of Patent Expiration on November 28, 2008, prior to the notice being forward to Ms. Brown on December 9, 2008, but, because it was accompanied by a letter that was addressed to Mr. Paco Candal, Ms. Shropshire put the Notice of Patent Expiration into Mr. Candal's mailbox, rather than forward it to Ms. Brown, which was contrary to established procedure. This begs the question of whether the initial "clerical error" was committed by Ms. Shropshire, who concedes

that she gave the Notice of Patent Expiration to Mr. Candal first without giving it to Ms. Brown, contrary to established procedure. Petitioner will note that Section 711.03(c)(2) of the Manual of Patent Examining Procedure, which provides, in pertinent part that:

> In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." *Haines v. Quigg*, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).
>
> A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:
>
> (A) the error was the cause of the delay at issue;
>
> (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
>
> (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

In establishing unavoidable delay, petitioner will need to make the above-cited showing as it pertains to Ms. Shropshire and Ms. Brown. Such showing must elaborate upon the training of both employees as iterated by their supervisors and other persons with first hand knowledge of their training and duties.

It is further noted the petitioner, and the statement of Gwendolyn Spratt (who was an attorney at Needle & Rosenberg until July 31, 2009) states that Needle & Rosenberg held on to a few of the active patent files even once the government contract was awarded to the new law firms so as to deplete the funds remaining under the contract of Needle & Rosenberg. Once the funds were depleted, Ms. Spratt indicates that all files, whether inactive or active, were boxed up and sent directly to CDC which is apparently contrary to the established procedure between Needle & Rosenberg and the CDC. Petitioner should address why Needle & Rosenberg took a course of action that was contrary to established procedure. Further, it is requested that petitioner explain what the close-out procedures were between the CDC and Needle & Rosenberg were, i.e., how were remaining files to be handled after the funds were depleted. It is reasonable to think that if the CDC and Needle & Rosenberg agreed that Needle & Rosenberg would hold on to some of the files in order to deplete funds that an agreement was also reached as to how to handle remaining files once the funds were depleted.

Petitioner's Current Options

I. Petitioner may file a request for reconsideration.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within TWO (2) MONTHS from the mail date of this decision.[8] The petition for reconsideration should be titled "Petition

[8] A reasonable and prudent person would not rely on maintenance fee reminders from the Office for two reasons. First, the Office has indicated that such reminders are a mere courtesy and has reserved the right to discontinue such reminders at any time.

for Reconsideration under 37 CFR 1.378(b)." Any petition for reconsideration for this decision must be accompanied by a non-refundable petition fee of $400.00 as set forth in 37 CFR 1.17(h).

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. It is, therefore, extremely important that petitioner supply any and all relevant information and documentation with the request for reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence "to show" that the delay was unavoidable. If a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

II. Petitioner may request a refund of the maintenance fee and surcharge which accompanied the petition.

Petitioner may request a refund of the maintenance fee and surcharge by writing to the Office of Finance, Refund Section. A copy of this decision should accompany petitioner's request.

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

By mail: Commissioner for Patent
Mail Stop Petitions
Box 1450
Alexandria, VA 22313-1460

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petition Attorney
Office of Petitions

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second, such reminders may be lost in the mail. A reasonable and prudent person, in regard to his most important business would not rely solely on reminders that the Office may or may not send which may or may not be lost in the mail.

[8]No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is not a final agency action within the meaning of 5 U.S.C. § 704.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5648955	1997-07-15	08480898	1995-06-07	214/043

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-07
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom of Information Act requires disclosure of these records.

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

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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

In re Patent No. 5648955
Issue Date: July 15,1997
Application No. 08480898
Filed: June 7,1995
Attorney Docket No. 214/043

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5659574	1997-08-19	08481613	1995-06-07	212/049

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

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	Fee	Code
○	3 ½ year	(1551)
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Small Entity

	Fee	Code
○	3 ½ year	(2551)
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SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

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STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-08
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

Privacy Act Statement

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

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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

In re Patent No. 5659574
Issue Date: August 19,1997
Application No. 08481613
Filed: June 7,1995
Attorney Docket No. 212/049

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5694414	1997-12-02	08482292	1995-06-07	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
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SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

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STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-09-07
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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

In re Patent No. 5694414
Issue Date: December 2,1997
Application No. 08482292
Filed: June 7,1995
Attorney Docket No. 214/142

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed September 7,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 7,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5801203	1998-09-01	08482365	1995-06-07	701039-069570-US

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

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☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
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SURCHARGE

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MAINTENANCE FEE (37 CFR 1.20(e)-(g))

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◯ A sole patentee

◯ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

◯ A joint patentee; all of whom are signing this e-petition

◯ The assignee of record of the entire interest

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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/David S. Resnick/	Date (YYYY-MM-DD)	2011-02-07
Name	David S. Resnick	Registration Number	34235

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Patent No. 5801203
Issue Date: September 1,1998
Application No. 08482365
Filed: June 7,1995
Attorney Docket No. 00108/072004

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 7,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 7,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5790587	1998-08-04	08483514	1995-06-07	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-09-07
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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)).

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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 Patent No. 5790587
Issue Date: August 4,1998
Application No. 08483514
Filed: June 7,1995
Attorney Docket No. 214/071

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed September 7,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 7,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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VENABLE LLP
P.O. BOX 34385
WASHINGTON DC 20043-9998

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OFFICE OF PETITIONS

Paper No. 28

In re Patent No. 5,981,216
Issue Date: November 9, 1999
Application No. 08/483,813
Filed: June 7, 1995
Inventor: John H. Kenten et al

: DECISION ON PETITION

This is a decision on the petition for expungement of information, filed September 28, 2010, which is being treated as petitions under 37 CFR 1.182 to invalidate an assignment previously recorded against the above-identified application.

The petition is **dismissed**. This is not a final agency action.

Petitioner indicates an assignment recorded on August 1, 2006 was erroneously filed for the above identified application and requests this assignment record be expunged from the file.

As discussed in section 323.01(d) of the Manual of Patent Examining Procedure (MPEP), petitions to correct, modify or "expunge" assignment records are granted only if the petitioner can prove that:

(A) the normal corrective procedures outlined in MPEP § 323.01(a) through §323.01(c) will not provide the petitioner with adequate relief; and
(B) the integrity of the assignment records will not be affected by granting the petition.

In regard to B, petitioner has not sufficiently explained how the removal of a document in its entirety will not affect the assignment records. The removal of a document in its entirety will affect the assignment records. The integrity of the records is recognized as separate from the chain of title, and the USPTO endeavors to maintain a complete history of claimed interests in a given property to permit, among other things, the review of matters like chain of title by a competent authority.

Moreover, petitioner seeks an extraordinary remedy, properly addressed under 37 CFR 1.182. The USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, (Comm'r Pats. 1982).

As set forth in MPEP 323, an error in a recorded assignment is not corrected by invalidating the previous document, but by simply submitting a "corrective document". The "corrective document" must include 1) a copy of the original assignment document with the corrections made therein. The corrections must be initialed and dated by the party conveying the interest; and 2) a new Recordation Form Cover Sheet (form PTO-1595). The new recordation form cover sheet must identify the submission as a "corrective document" submission and indicate the reel and frame number where the incorrectly recorded assignment document appears. The person signing the new recordation form cover sheet must state that the information provided on the new cover sheet is true and correct and that any copy submitted is a true copy of the original document. The original cover sheet should be submitted with the corrective document. The corrective document will be recorded and given a new reel and frame number and recording date. The recording fee set forth in 37 CFR 1.21(h) is required for each patent application and patent against which the corrective document is being recorded. See MPEP § 302.06. Petitioner should note that the "assignment documents" and "corrective documents" are not limited to assignments, but include any documents affecting title to a patent or application. See MPEP § 313.

Therefore, the rules of practice and the procedures before the USPTO provide an avenue for the requested relief without relying upon extraordinary measures. That is, the chain of title can be clarified in the assignment records through the recording of a corrective document. As a request for the Office to invalidate an assignment is both extraordinary and contrary to USPTO policy, this petition must be dismissed.

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 USC 261 and 37 CFR 3.11. However, the recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. Moreover, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment document will be retained, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992).

Furthermore, it is well settled that the Office is not the appropriate forum for resolving a dispute concerning the ownership of an application or patent, and, as such, the USPTO will not permit itself to become embroiled in ownership disputes, particularly as it does not have the means or the authority to resolve such disputes. Indeed, the USPTO has no authority to decide ownership issues. See Cedars-Sinai Medical Center v. Watkins, 11F.3d 1573, 1581 n.10, 29 USPQ 2d 1188, 1194 n.10 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. (1994). Rather, state law governs contractual obligations and transfers of property rights, including those relating to patents. See Regents of the University of New Mexico v. Knight, 66 USPQ2d 1001, 1008 (Fed. Cir. 2003). The USPTO cannot settle disputes as to title as a judicial tribunal is the appropriate forum to resolve such controversy. See Jim Arnold Corp. v. Hydrotech Sys., Inc., 109 F.3d 1567, 1572, 42 USPQ2d 1119, 1123 (Fed. Cir. 1997)("the question of who owns the patent right and on what terms typically is a question exclusively for state courts"); Roach v. Crouch, 24 N.W. 2d 400, 33

USPQ2d 1361 (Iowa 1994)(patent ownership issue properly triable in state court); In re Haines, 1900 C.D. 102, 103 (Comm'r Pat. 1900)(same).

If petitioner is successful in resolving this dispute, the proper documentation should be promptly submitted to the USPTO for recordation against the patent.

Also, Office records do not indicate that a change of address has been filed in this case, although the address given on the petition differs from the address of record. If appropriate, 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.

A petition to expunge assignment documents is properly addressed under 37 CFR 1.182 and a fee of $400.00 is required. The $400 petition fee has been charged to petitioner's deposit account.

Telephone inquiries concerning this communication should be directed to Carl Friedman at (571)272-6842.

Christopher Bottorff
Supervisor
Office of Petitions

Cc: Womble Carlyle Sandridge & Rice PLLC
P.O. Box 7037
Atlanta Georgia 30357-0037

PTO/SB/66 (03-09)
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5757847	1998-05-26	08484007	1995-06-07	211/289

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-18
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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)).

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UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent No. 5757847
Issue Date: May 26,1998
Application No. 08484007
Filed: June 7,1995
Attorney Docket No. 211/289

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 18,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 18,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

APR 20 2011

Mark J. Pino
CONNOLLY BOVE
LODGE & HUTZ LLP
1875 Eye Street, N.W.
Suite 1100
Washington, DC 20006

In Re: Patent Term Extension
Application for
U.S. Patent No. 6,313,146

APPLICATION NOT ELECTED

The application for patent term extension for U.S. Patent No. 6,313,146, claims of which cover the human drug product SENSIPAR® (cinacalcet hydrochloride), is **dismissed**.

A paper titled "Election of Application for Extension of Patent Term Under 35 U.S.C. § 156 and Pursuant to 37 C.F.R. § 1.785(b)" was filed on November 23, 2010, in the application for patent term extension for U.S. Patent No. 6,313,146. The paper states that "Patentee hereby elects U.S. Patent No. 6,011,068 for patent term extension under 35 U.S.C. § 156, *i.e.*, Patentee does **not** elect the above referenced U.S. Patent No. 6,313,146 nor does Patentee elect U.S. Patent Nos. 6,211,244" (emphasis in the original).

Thus, the application for patent term extension for U.S. Patent No. 6,011,068 will be extended based upon the regulatory review period of SENSIPAR® (cinacalcet hydrochloride). Because only one patent may be extended based upon the regulatory review period of a product, the application for patent term extension for 6,313,146 is **dismissed**.

A single request for reconsideration of this dismissal of the application for patent term extension may be made if filed within one month of the date of this notice. Extensions of time under 37 CFR § 1.136(a) are not applicable to this time period.

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

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

By FAX: (571) 273-7728

Telephone inquiries related to this determination should be directed to Raul Tamayo at (571) 272-7728.

Mary C. Till
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Associate Commissioner
for Patent Examination Policy

cc: Office of Regulatory Policy
Food and Drug Administration
10903 New Hampshire Ave., Bldg. 51, Rm. 6222
Silver Spring, MD 20993-0002

Attention: Beverly Friedman

RE: SENSIPAR® (cinacalcet hydrochloride)
FDA Docket No.: FDA-2004-E-0332

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5629921	1997-05-13	08484273	1995-06-07	G016-P11001US

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/Steven C. Sereboff/	Date (YYYY-MM-DD)	2010-12-01
Name	Steven C. Sereboff	Registration Number	37035

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom of Information Act requires disclosure of these records.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5629921
Issue Date: May 13,1997
Application No. 08484273
Filed: June 7,1995
Attorney Docket No. 67754RLO

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed December 1,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of December 1,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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In re Patent No. 5830878
Issue Date: November 3,1998
Application No. 08485005
Filed: June 7,1995
Attorney Docket No. JUVARIS1150-4

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 7,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 7,2011 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
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Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5830878	1998-11-03	08485005	1995-06-07	JUVARIS1150-4

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SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

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SURCHARGE

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MAINTENANCE FEE (37 CFR 1.20(e)-(g))

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○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Karin M. Gerstin/	Date (YYYY-MM-DD)	2011-01-07
Name	Karin M. Gerstin	Registration Number	54119

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED
APR 26 2011
OFFICE OF PETITIONS

SUGHRUE MION PLLC
2100 PENNSYLVANIA AVENUE NW
SUITE 800
WASHINGTON DC 20037

In re
Application No. 08/485,005
Filed: June 7, 1995
Patent No. 5,830,878
Issued: November 3, 1998

DECISION

This is a decision on the fee deficiency submission under 37 CFR 1.28(c), filed April 1, 2011.

The fee deficiency submission under 37 CFR 1.28 of $2055 for the twelve year maintenance fee is hereby accepted.

The change of status to large entity has been entered.

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

Cliff Congo
Petitions Attorney
Office of Petitions

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5768264	1998-06-16	08485267	1995-06-07	214/045

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
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◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
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○	11 ½ year	(2553)

SURCHARGE

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MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-18
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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.

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In re Patent No. 5768264
Issue Date: June 16,1998
Application No. 08485267
Filed: June 7,1995
Attorney Docket No. 214/045

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 18,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 18,2010 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5680414	1997-10-21	08485638	1995-06-07	213/044

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

PTO/SB/66 (03-09)
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U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-08
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5680414
Issue Date: October 21,1997
Application No. 08485638
Filed: June 7,1995
Attorney Docket No. 213/044

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6229792	2001-05-08	08485774	1995-06-07	214/048

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
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Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-09-30
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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

In re Patent No. 6229792
Issue Date: May 8,2001
Application No. 08485774
Filed: June 7,1995
Attorney Docket No. 214/048

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 4,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 4,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5796772	1998-08-18	08485987	1995-06-07	

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

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NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
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SURCHARGE

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MAINTENANCE FEE (37 CFR 1.20(e)-(g))

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STATEMENT

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PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

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○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-09-07
Name	Kendal M. Sheets	Registration Number	47077

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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.

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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

In re Patent No. 5796772
Issue Date: August 18,1998
Application No. 08485987
Filed: June 7,1995
Attorney Docket No. 214/186

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed September 7,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 7,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/486,669	06/07/1995	DONALD R. HUFFMAN	7913ZAZYX	6904

58249 7590 10/04/2010

COOLEY LLP
ATTN: Patent Group
Suite 1100
777 - 6th Street, NW
WASHINGTON, DC 20001

EXAMINER	
YUAN, DAH WEI D	
ART UNIT	PAPER NUMBER
1795	

MAIL DATE	DELIVERY MODE
10/04/2010	PAPER

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

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

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

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OCT 04 2010

Mailed:

In re application of	:	
Huffman et al.	:	DECISION ON
Serial No. 08/486,669	:	PETITION
Filed: June 7, 1995	:	
For: New Form Of Carbon	:	

This is a response to the petition under 37 CFR 1.181 filed August 23, 2010. Applicant requests entry of the supplemental amendment filed September 25, 2009 or alternatively that the finality of the Office action dated June 23, 2010 be withdrawn.

A review of the record indicates that applicant's amendment of April 23, 2009 cancelled claims 57-63 and 68-109, and presented new claims 110-183. The supplemental amendment of September 25, 2009 presented new claims 184-263. The examiner in the final rejection of June 23, 2010 denied entry of the supplemental amendment. Applicant asserts that claims 184-252 of the supplemental amendment incorporate amendments that were suggested by the Office and claims 253-263 incorporate amendments that address concerns raised by the examiner and would clearly simplify the issues for appeal under section (F) of 37 CFR 1.111.

Supplemental replies are governed by 37 CFR 1.111(a) (2).

37 CFR 1.111(a) (2) states:

(2) *Supplemental replies.*

(i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a) (2) (ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

(A) Cancellation of a claim(s);
(B) Adoption of the examiner suggestion(s);
(C) Placement of the application in condition for allowance;
(D) Reply to an Office requirement made after the first reply was filed;
(E) Correction of informalities (*e.g.*, typographical errors); or
(F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).

At the September 23, 2008 interview applicant's representative proposed amending the claims by using the term "cage molecules consisting of carbon atoms soluble in non-polar organic solvents" throughout the claims to overcome duplication of claim objections. It was also agreed in this interview that the case could be allowable by cancelling the currently pending claims and adding a set of claims mirroring those indicated allowable in application 08/236,933 by examiner's amendment. Two additional interviews were conducted with the examiner of record on September 23 and 24, 2009.

In response to the non-final Office action mailed on October 27, 2008, applicant filed an amendment on April 23, 2009 which did not include the agreed upon language in all of the independent claims. Applicant cancelled all pending claims (claims 57-63 and 68-109) and added new claims 110-183. The claims were not limited to "cage molecules consisting of carbon atoms soluble in non-polar organic solvents". Instead, the claims were directed to "cage molecules consisting of carbon atoms". The examiner in an interview on September 11, 2009 proposed an examiner's amendment which incorporated language that was initially agreed upon in the interview dated September 23, 2008; "cage molecules consisting of carbon atoms soluble in non-polar organic solvents". Agreement was not reached.

Applicant's representative proposed a draft amendment on September 23, 2009 which had adopted the examiner's proposed amendment for claims 122-163 and added new claims 164-181. Upon review of proposed new independent claim 164, the examiner did not accept the proposed draft amendment. Specifically, the examiner had concerns with the language that "A substantially pure fullerene compound comprising a polyhedral carbon cage" was not supported by the original disclosure because the meaning of fullerene encompasses carbon nanotubes and that the term fullerene was not used in the original disclosure. The examiner did not accept applicant's proposed amendment.

Applicant then filed a supplemental amendment on September 25, 2009 where claims 184-263 were newly presented. Applicant asserts that claims 184-252 are duplicates of the claims suggested by the examiner and are therefore allowable. Applicant further states that claims 253-263 are newly presented and responsive to the interviews with the examiner.

Applicant asserts that claims 253-263 would clearly simplify the issues for appeal. Claim 253 is limited to a process for preparing a product comprising a cage moiety consisting of carbon atoms that are "soluble in non-polar organic solvents". Applicant asserts that the solubility description in this claim matches the recitation proposed by the examiner. The remaining newly proposed claims are limited to processes of preparing fullerenes having a polyhedral, spherical or icosahedral structure. Applicant believes that the inclusion of these terms clearly responds to the examiner's concerns that the claims not be so broad as to read on carbon nanotubes.

The examiner on September 24, 2009 had concerns with applicant's proposed language of "A substantially pure fullerene compound comprising a polyhedral carbon cage" that was not supported by the original disclosure because the present day meaning of fullerene encompasses carbon nanotubes and the term fullerene was not used in the original disclosure. Applicant's supplemental amendment still cites the term "fullerene". The examiner's position is that claims

253-263 are not responsive to any interview and do not adopt any suggestions made by the examiner that would place the application into condition for allowance.

While claims 184-252 appear to adopt the examiner's suggestions, claims 253-263 do not. Applicant's petition in fact does not actually assert that claims 253-263 adopt the examiner's suggestions. Rather, the petition asserts that these claims "address concerns" raised by the examiner. Attempting to address a concern is not adopting a suggestion, as a suggestion has been agreed to in advance, whereas an attempt to address a concern has not. Thus claims 253-263 do not meet the conditions of 37 CFR 1.111(a)(2)(B).

Nor can these claims be said to simplify the issues on appeal. Applicant's petition does not point to any particular issue present in the non-final rejection of October 27, 2008 which the addition of these claims would remove from consideration. To the contrary, they appear to raise new issues, such as the patentability of product-by-process claims (e.g., claims 254-257) in an application previously restricted to method claims, and the definiteness of a claim that recites in its entirety "a product comprising the product of claim X" (e.g., claims 256 and 257). The claims also appear to raise a variety of new issues regarding claim interpretation and the patentability of the claims over the prior art (e.g. "effectively spherical" as in claims 262 and 263). Given the above, the September 25, 2009 amendment appears to complicate, rather than simplify, the potential issues for appeal. Thus claims 253-263 do not meet the conditions of 37 CFR 1.111(a)(2)(F).

The remaining provisions of 37 CFR 1.111(a)(2) do not apply, nor were they asserted. Since entry of supplemental replies is not a matter or right, and none of permissive conditions of 37 CFR 1.111(a)(2) apply, the supplemental reply filed on September 25, 2009 was properly denied entry.

With respect to applicant's arguments concerning their right to respond under 37 CFR 1.112, the mere discussion of issues or hypothetical situations during an interview does not constitute an action and does not afford applicants the right to supplemental amendments. Interview practice is addressed in 37 CFR 1.133, not 37 CFR 1.112.

Applicants argue that equity warrants entry of the Supplemental Amendment however supplemental replies are governed by 37 CFR 1.111(a) (2). A review of the record indicates that entry of the Supplement Amendment would not be allowed under 37 CFR 1.111(a) (2).

In the Final Rejection of June 23, 2010, newly presented claims 110, 111, 120-161 and 164-179 were rejected under 35 USC 112, first paragraph. Applicants assert that the previous Non-Final Office Action dated October 27, 2008 did not include any rejection under 35 USC 112, first paragraph and that the 35 USC 112 first paragraph issues should have been first raised in the Non-Final Office Action. The scope of the newly presented claims was different from the claims that were originally presented. Applicant's amendment necessitated the new ground of rejection presented in this Office Action. The finality of the Office Action is proper.

Applicants assert that the newly raised 112, first paragraph rejection is a clear error and sets forth arguments to support their position. A rejection, involving the merits of the claim, is subject to review by the Board of Patent Appeals and Interferences and is not a petitionable issue.

DECISION

The petition is **DENIED**.

/Sharon A. Gibson/

Sharon A. Gibson, Director
Technology Center 1700
Chemical and Materials Engineering

Bonnie Weiss McLeod
COOLEY LLP
ATTN: Patent Group
Suite 1100
777 - 6th Street, NW
WASHINGTON DC 20001

PTO/SB/66 (03-09)
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5754585	1998-05-19	08486883	1995-06-07	213/040

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
○	3 ½ year	(1551)
○	7 ½ year	(1552)
◉	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-18
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5754585
Issue Date: May 19,1998
Application No. 08486883
Filed: June 7,1995
Attorney Docket No. 213/040

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 18,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 18,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110304

DATE : March 04, 2011

TO SPE OF : ART UNIT 2628

SUBJECT : Request for Certificate of Correction on Patent No.: 7747217

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - ST (South Tower) 9A22
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

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

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

Comments:

/ULKA CHAUHAN/
Supervisory Patent Examiner.Art Unit 2628

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5772819	1998-06-30	08487631	1995-06-07	741301-1030

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity	Fee	Code	Small Entity	Fee	Code
○	3 ½ year	(1551)	○	3 ½ year	(2551)
○	7 ½ year	(1552)	○	7 ½ year	(2552)
○	11 ½ year	(1553)	◉	11 ½ year	(2553)

SURCHARGE

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MAINTENANCE FEE (37 CFR 1.20(e)-(g))

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STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/harold l marquis/	Date (YYYY-MM-DD)	2010-08-31
Name	Harold L. Marquis	Registration Number	20594

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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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)).

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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.

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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

In re Patent No. 5772819
Issue Date: June 30,1998
Application No. 08487631
Filed: June 7,1995
Attorney Docket No.

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed August 31,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of August 31,2010 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20110124

DATE : January 24, 2011

TO SPE OF : ART UNIT 1631

SUBJECT : Request for Certificate of Correction on Patent No.: 7,115,709

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - ST (South Tower) 9A22
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Thank You For Your Assistance **Certificates of Correction Branch**

The request for issuing the above-identified correction(s) is hereby:

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

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

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

Comments:

The request for change of inventorship, filed 3/18/2009, is approved.

/Marjorie Moran/
Supervisory Patent Examiner.Art Unit 1631

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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
5773918	1998-06-30	08488279	1995-06-07	0931/0255

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SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity			Small Entity		
	Fee	Code		Fee	Code
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◉	11 ½ year	(1553)	○	11 ½ year	(2553)

SURCHARGE

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MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

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Patent Practitioner			
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 form of the signature			
Signature	/Kendal M. Sheets/	Date (YYYY-MM-DD)	2010-10-18
Name	Kendal M. Sheets	Registration Number	47077

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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 Freedom 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 individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public 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

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

In re Patent No. 5773918
Issue Date: June 30,1998
Application No. 08488279
Filed: June 7,1995
Attorney Docket No. 0931/0255

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 18,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 11.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 18,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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

Mark Levy
HINMAN, HOWARD & KATTELL, LLP
80 Exchange Street
P.O. Box 5250
BINGHAMTON NY 13901

Paper No. 9

MAILED

FEB 14 2011

OFFICE OF PETITIONS

In re Patent No. 5,623,778 :
Issue Date: April 29,1997 :
Application No. 08/492,935 : ON PETITION
Filed: June 21, 1995 :
Attorney Docket No. **SIE-167** :

This is a decision on the petition under 37 CFR 1.378(c), filed January 31, 2011, to accept the delayed payment of a maintenance fee for the above-identified patent.

This patent expired at midnight April 29, 2009, for failure to pay the 11½ year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The petition is **DISMISSED**.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Any petition for reconsideration of this decision must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f). The petition for reconsideration must include 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 petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(c) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2). This petition lacks item (1) above.

The instant petition was not signed. Therefore, statement of delay is not acceptable. In this regard, petitioner's attention is directed to 37 CFR 1.33(b), which states.

> (b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:
> (1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);
> (2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;
> (3) An assignee as provided for under §3.71(b) of this chapter; or
> (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

An unsigned amendment (or other paper) or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the amendment (or other paper) is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

Therefore, as the petition is not signed by all the inventors and the record herein fails to disclose that petitioner herein (David Hallam) was ever given a power of attorney to act on behalf of inventor Gary D. Dunn, or that he is an assignee of the entire interest and has complied with the provisions of 37 CFR 3.73(b), the petition is considered to not contain a proper statement of unintentional delay.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record

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 Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Telephone inquiries should be directed to the undersigned at (571) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: David Hallam
289 NW 68th Avenue
Ocala, FL 34482

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Mark Levy
HINMAN, HOWARD & KATTELL, LLP
80 Exchange Street
P.O. Box 5250
BINGHAMTON NY 13901

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MAR 26 2012
OFFICE OF PETITIONS

In re Patent No. 5,623,778 :
Issue Date: April 29,1997 :
Application No. 08/492,935 : **REQUEST FOR INFORMATION**
Filed: June 21, 1995 :
Attorney Docket No. **SIE-167** :

REQUEST FOR INROMATION

A renewed petition under 37 CFR 1.378(b) was filed July 14, 2011, to accept the unavoidably delayed payment of a maintenance fee for the above-identified patent.

Petitioner should submit the requested information within TWO MONTHS of the mailing date of this letter. Extensions of time may not be obtained. No additional fee is due for a response to the instant request for information. The response to this Requirement for Information should include a cover letter entitled "Response to Request for Information." The failure to file a reply to the instant Request for Information will be interpreted as a desire to no longer pursue reinstatement of the patent and the Office will give no further consideration to the matter.

As the petition is not signed by all the inventors and the record herein fails to disclose that petitioner herein (David Hallam) was ever given a power of attorney to act on behalf of the other inventors, **or that he is an assignee of the entire interest and has complied with the provisions of 37 CFR 3.73(b)**, the petition is considered to not contain a proper statement of unintentional delay. As it appears that Mr. David Hallam is signing on behalf of an assignee, compliance with 37 CFR 3.73(b) must be satisfied. In this regard, 37 CFR 3.73(b) provides:

> (1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes

> the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:
>
> (i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment * * * For patent matters only, the submission of the documentary evidence must be accompanied by 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 submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:
>
> (i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or
>
> (ii) Being signed by a person having apparent authority to sign on behalf of the assignee, *e.g.*, an officer of the assignee.
>
> (c) For patent matters only:
>
> (1) Establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted.
>
> (2) If the submission under this section is by an assignee of less than the entire right, title and interest, such assignee must indicate the extent (by percentage) of its ownership interest, or the Office may refuse to accept the submission as an establishment of ownership.

In view of the above, and as it appears that Mr. David Hallam is signing the instant petition as an assignee, then compliance with 37 CFR 3.73(b) must be satisfied. A blank certificate under 37 CFR 3.73(b) is enclosed with this decision for petitioner's convenience.

37 CFR 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include:

> "A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the

> patentee was notified of, or otherwise became aware of, the expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date, and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly."

Petitioner must provide a document showing of the steps petitioner had in pace to ensure timely payment of the maintenance fee.

While the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable, the showing of record is sufficient to establish that the entire delay in filing the petition was unintentional. Petitioner **may consider filing a renewed petition under 37 CFR 1.378(c) to accept the delayed payment as being unintentional**.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record

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

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Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584.

David Bucci
Petitions Examiner
Office of Petitions

Enclosure: A blank certificate under 37 CFR 3.73(b)

cc: David Hallam
289 NW 68th Avenue
Ocala, FL 34482