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Paper No.

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MAILED
MAY 23 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 6,871,472 | : | |
| Jon Folkersen | : | |
| Issue Date: March 29, 2005 | : | DECISION DISMISSING PETITION |
| Application No. 10/460,540 | : | |
| Filed: June 11, 2003 | : | |
| Atty Docket No. Folk US-1(d) | : | |

This is a decision on the "PETITION TO ACCEPT AN UNAVOIDABLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT," filed April 8, 2011 (certificate of mailing dated April 7, 2011).

The patent issued March 29, 2005. The grace period for paying the 3-½ year maintenance fee provided in 37 CFR 1.362(e) expired at midnight on March 29, 2009, with no payment received. The 24 month period to petition to accept the maintenance fee based on unintentional delay ended on March 29, 2011.

For his showing of unavoidable delay, Patentee simply states "My mailing address is PO Box 327, East Wakefield, NH 03830. Mail not forwarded." No additional explanation or documentary evidence is supplied. This statement is interpreted to mean that Patentee attributes the delay in paying the maintenance fee to not receiving a notice in the mail.

**STATUTES, RULES AND REGULATIONS**

35 U.S.C. § 41(c)(1) states that:

> The Director 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 Director 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.

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. 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 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). In addition, decisions on revival 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.

**OPINION**

The patent issued on March 29, 2005. The window for paying the first maintenance fee was open from March 29, 2008 to March 29, 2009. It is undisputed that the maintenance fee was not paid. The petition includes the maintenance fee and the surcharge where the delay is unavoidable. Petitioner explains the delay in paying the maintenance fee as "My mailing address is PO Box 327, Wakefield, NH 03830. Mail not forwarded."

This explanation has been considered, but is not sufficient to meet petitioner's burden of establishing that the entire delay in paying the maintenance fee and in filing the instant petition from the expiration of the patent was unavoidable within the meaning of 35 USC § 41(c) and 37 CFR 1.378(b).

As stated in MPEP 2590,

> 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 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).

Further,

> 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.

In this instance, petitioner makes no showing that any steps were in place to ensure the timely payment of the maintenance fee. Rather, impliedly, petitioner attributes the failure to timely pay the maintenance fee to failure to receive a reminder notice due to his mail not being forwarded. As discussed above, such an argument will not be adequate to support a conclusion that the delay in paying the maintenance fee was unavoidable. Petitioner is responsible for being aware of the statutory set due dates for paying the maintenance fee and having a system in place to ensure the timely payment.

**CONCLUSION**

For the reasons set forth above, it is concluded that petitioner has not met his burden of showing that the delay in paying the

maintenance fee was unavoidable within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b).

In view thereof, the petition is **DISMISSED**.

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.

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 Office of Finance, Refund Section, Commissioner for Patents, Washington DC 20231. A copy of the last decision rendered should accompany the request for refund).

Further correspondence with respect to this decision 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
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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**BURNS, DOANE, SWECKER & MATHIS, L.L.P.**
**P.O. BOX 1404**
**ALEXANDRIA, VA 22313-1404**

**MAILED**

MAR 15 2011

**OFFICE OF PETITIONS**

In re Application of
**Sarojini DEEVI**, et *al.*
Application No. 10/460,631
Filed: June 13, 2003
Attorney Docket No. **021238-509**

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 14, 2011.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others.

The request was signed by Teresa S. Rea on behalf of all attorneys of record. Teresa S. Rea has been withdrawn as attorney or agent of record; all other attorneys remain of record.

The correspondence address of record remains unchanged.

Telephone inquiries concerning this decision 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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In re Patent No. 7006902
Issue Date: February 28,2006
Application No. 10460756
Filed: June 12,2003
Attorney Docket No. 061300-0266

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

This is a decision on the electronic petition, filed August 4,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 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)
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) |
|---|---|---|---|---|
| 7,006,902 | 2006-02-28 | 10/460,756 | 2003-06-12 | 061300-0266 |

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

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 | /Jeffrey S. Gundersen/ | Date (YYYY-MM-DD) | 2010-08-04 |
| Name | Jeffrey S. Gundersen | Registration Number | 47619 |

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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UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/461,012 | 06/13/2003 | Kenneth Ma | 15010US01 | 6477 |

7590 12/07/2011
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| EXAMINER |
|---|
| WILLIAMS, JEFFERY L |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2437 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 12/07/2011 | 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

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CHRISTOPHER C. WINSLADE
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CHICAGO IL 60661

In re Application of: MA, Kenneth
Application No. **10/461,012**
Filed: August 16, 2003
For: MECHANISM FOR SECURE TRANSMISSIONT OF SIGNALS IN WIRELESS COMMUNICATION DEVICES

DECISION ON PETITION UNDER 37 CFR 1.198 TO REOPEN OR RECONSIDER PROSECUTION OF A CASE AFTER DECISION BY THE BOARD

This is a decision on the petition filed October 10, 2011 requesting entry of amendment filed October 10, 2011 after Board of Appeals and Interference ("the Board" hereafter) decision filed October 12, 2010. This petition is filed in response to Examiner's communication mailed September 19, 2011 denying entry to amendments filed June 29, 2011, March 08, 2011 and December 10, 2010.

This petition is hereby **DISMISSED**.

RELEVANT PROSECUTION HISTORY

10/12/10 BPAI decision – Examiner Affirmed in Part:

a) the rejection of claims 1-3, 6, 8-15, 17, 19-27, 34, and 36 under 35 U.S.C. § 102(e) as being anticipated by Nyman is reversed;

b) the rejection of claims 37-44 and 47-51 under 35 U.S.C. § 102(e) as being anticipated by Nyman is affirmed;

c) the rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Nyman in view of Mouly is reversed;

d) the rejection of claims 45, 46, 52, and 53 under 35 U.S.C. § 103(a) as being unpatentable over Nyman in view of Mouly is affirmed;

e) the rejection of claims 33 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Nyman in view of Anderson is reversed;

f) the rejection of claims 16 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Nyman is reversed;

g) the rejection of claims 43 and 44 under 35 U.S.C. § 102(e) as being anticipated by Nyman is affirmed.

Affirmed the § 102(e) rejection of claims 43 and 44 as a new ground of rejection pursuant to 37 CFR § 41.50(b), wherein this provision provides that "a new ground of rejection pursuant to this paragraph shall not be final for judicial review"

12/10/10 Applicant files first amendment in response to decision on appeal (mailed 10/12/10). Applicant indicated that he/she "elects to reopen prosecution by way of submitting an amendment to the claims." (see p. 1 of remarks). Claims 1, 20, 38, 43-44 and 47-49 were amended.

02/24/11 In response to Applicant's amendment, the amendment filed 12/10/10 is "not entered because prosecution is closed and the proposed amendments were not suggested in an explicit statement by the Board under 37 CFR 41.50(c)."

03/08/11 Applicant files a second amendment (of claim 37, 43-44, 47-49) in response to the Office's communication (02/24/11) not allowing entry of amendment and "traverses the statements made by the Examiner in the Office of Communication." indicating that the rule 37 CFR §1.198 relied upon for denying entry states, "when a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary except under the provisions of 1.114 or 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated sufficient cause being shown." And that because the new grounds of rejection are not considered final for judicial review, rule 37CFR §1.198 does not apply.

05/31/11 In response to Applicant's amendment (03/08/11) and arguments, the Office denies entry "because prosecution is closed and the proposed amendments were not suggested in an explicit statement by the Board under 37 CFR 41.50(c).

06/29/11 Applicant files a third amendment (of claims 37, 43-44, 47) in response to the Office communication (filed 05/31/11), and traverses the Office decision to denied entry because "nowhere the Decision of Appeal by the Board state that prosecution is closed. Furthermore, the absence of a proposed amendment by the Board does not imply that the prosecution is closed." (p. 2-3)

09/19/11 In response to Applicant's amendment (06/29/11) and arguments, the Office denies entry "because prosecution is closed and the proposed amendments were not suggested in an explicit statement by the Board under 37 CFR 41.50(c)."

10/10/11 Applicant files a petition in response to Office communication (09/19/11) which denies entry of amendment "after prosecution was reopened in accordance with the Decision on Appeal by the Board of Patent Appeals and Interferences.", wherein on the Decision on Appeal, the "Board stated that 37 CFR 41.50(b) provides that a new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." Therefore, applicant has exercised the option to reopen by way of submitting an amendment of the rejected claims to be considered by the Examiner." Enclosed reply/amendment amends claims 37, 43-44, and 47.

RELEVANT REGULATIONS AND PROCEDURES

MPEP §2682 Action Following Decision

§ 1.198 Reopening after a final decision of the Board of Patent Appeals and Interferences.

1. When a decision by the Board of Patent Appeals and Interferences on appeal has become **final** for judicial review, prosecution of the proceeding before the primary examiner will **not** be reopened or reconsidered by the primary examiner **except** under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

2. Sometimes an amendment is filed after the Board's decision which **does not** carry into effect any recommendation made by the Board **and** which presents a new or **amended** claim(s). In view of the fact that prosecution is closed, the appellant is not entitled to have such amendment entered as a matter of right. However, if the amendment is submitted with a request for continued examination (RCE) under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e), prosecution of the application will be reopened and the amendment will be entered. See MPEP § 706.07(h), paragraph XI. ...If the amendment obviously places an application in condition for allowance, regardless of whether the amendment is filed with an RCE, the primary examiner should recommend that the amendment be entered, and with the concurrence of the supervisory patent examiner, the amendment will be entered. Note MPEP § 1002.02(d).

MPEP §1214.01 Procedure Following New Ground of Rejection by Board

1. When the Board makes a new rejection under 37 CFR 41.50(b), the appellant, as to each claim so rejected, has the option of: (A) reopening prosecution before the examiner by submitting an **appropriate amendment** and /or new evidence (37 CFR 41.50(b) (1)); or (B) requesting rehearing before the Board (37 CFR 41.50(b) (2)). The amendment and/or new evidence under 37 CFR 41.50(b) (1), or the request for rehearing under 37 CFR 41.50(b) (2), must be filed within 2 months from the date of the Board's decision. In accordance with 37 CFR 41.50(f), this 2-month time period may not be extended by the filing of a petition and fee under 37 CFR 1.136(a), but only under the provisions of 37 CFR 1.136(b), or under 37 CFR 1.550(c) if the appeal involves an ex parte reexamination proceeding.

I. SUBMISSION OF AMENDMENT OR NEW EVIDENCE

1. 37 CFR §41.50(b) (1) provides that the application will be remanded to the examiner for reconsideration **if** the appellant submits "an **appropriate amendment**" of the claims rejected by the Board, "or new evidence relating to the claims so rejected, or both." An amendment is "appropriate" under the rule if it **amends** one or more of the claims **rejected**, or substitutes **new claims** to avoid the art or reasons adduced by the Board. Ex parte Burrowes, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims **must** be directed to the **same** subject matter as the appealed claims. Ex parte Comstock, 317 O.G. 4,1923 C.D. 82 (Comm'r Pat. 1923). An amendment which adds new claims without either amending the rejected claims, or substituting new claims for the rejected claims, is not appropriate. The new claims will not be entered, and the examiner should return the application file to the Board for consideration of the amendment as a

request for rehearing under 37 CFR 41.50(b)(2), if it contains any argument concerning the Board's rejection. The "new evidence" under the rule may be a showing under 37 CFR 1.130, 1.131 or 1.132, as may be appropriate. If the appellant submits an argument without either an appropriate amendment or new evidence as to any of the claims rejected by the Board, it will be treated as a request for rehearing under 37 CFR 41.50(b)(2).

2. The **new ground** of rejection raised by the Board **does not** reopen prosecution **except** as to that **subject matter** to which the **new rejection** was applied. If the Board's decision in which the rejection under 37 CFR 41.50(b) was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is **not open** to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmance of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time. Prosecution before the examiner of the 37 CFR 41.50(b) rejection can incidentally result in overcoming the affirmed rejection even though the affirmed rejection is not open to further prosecution. Therefore, it is possible for the application to be allowed as a result of the limited prosecution before the examiner of the 37 CFR 41.50(b) rejection. If the application becomes allowed, the application should not be returned to the Board. Likewise, if the application is abandoned for any reason, the application should not be returned to the Board.

3. If the rejection under 37 CFR 41.50(b) is not overcome, the applicant can file a second appeal (as discussed below). Such appeal must be limited to the 37 CFR 41.50(b) rejection and may not include the affirmed rejection.

4. If the application does not become allowed or abandoned as discussed above, once prosecution of the claims which were rejected under 37 CFR 41.50(b) is terminated before the examiner, the application file must be returned to the Board so that a decision making the original affirmance final can be entered. The time for filing a request for rehearing on the affirmance or seeking court review runs from the date of the decision by the Board making the original affirmance final. See MPEP § 1214.03 and § 1216. If the examiner does not consider that the amendment and/or new evidence overcomes the rejection, he or she will again reject the claims. If appropriate, the rejection will be made final.

5. An applicant in whose application such a final rejection has been made by the examiner may mistakenly believe that he or she is entitled to review by the Board of the rejection by virtue of the previous appeal, but under the provisions of 37 CFR 41.50(b)(1), after such a final rejection, an applicant who desires further review of the matter must file a **new appeal** to the Board. Such an appeal from the subsequent rejection by the examiner will be an entirely new appeal involving a different ground and will require a new notice of appeal, appeal brief, and the payment of the appropriate fees.

## OPINION

The amendment filed (10/10/11) after the Board's decision does not carry into effect any recommendation made by the Board and/or is not an "appropriate amendment of the claims rejected by the Board, namely, the amendments of claims 37 and 47.

In accordance with the above rules, when the Board makes a new rejection under 37 CFR §41.50(b), the appellant, as to each claim so rejected, has the option of: (A) reopening

prosecution before the examiner by submitting an appropriate amendment and/or new evidence. 37 CFR §41.50(b)(1) provides that the application will be remanded to the examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board. An amendment is "appropriate" under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board. In this case, claims 37 and 47 were not rejected by the Board, only claims 43-44 were rejected under new grounds of rejection by the Board. (see Board's decision mailed 10/12/10 pages 10-11). Thus, amendment filed 10/10/11 of claims 37, 43-44, and 47 is not an "appropriate amendment". (see MPEP 1214.01(I))

The new ground of rejection raised by the Board does not reopen prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision in which the rejection under 37 CFR §41.50(b) was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. Meaning that the affirmed rejection of claims 37-44 and 47-51 under 35 U.S.C. § 102(e) as being anticipated by the Nyman reference by the Board, is not open to further prosecution. (see MPEP §1214.01(I)(par 2 above)). In view of the fact that prosecution is closed (with respect to claims 37 and 47), the appellant is not entitled to have such amendment entered as a matter of right. However, if the amendment is submitted with a request for continued examination (RCE) under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e), prosecution of the application will be reopened and the amendment will be entered. See MPEP § 706.07(h), paragraph XI.

For the reasons above mentioned, this petition is **DISMISSED**.

For the reasons mentioned above, amendment filed 10/10/11 will not be entered.

Applicant is given a shortened statutory period for reply to this action is set to expire ONE MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this letter.

Any inquiry regarding this decision should be directed the undersigned whose telephone number is (571) 272-3902. If attempts to reach the undersigned by telephone are unsuccessful, alternatively, Christopher Grant, Quality Assurance Specialist, can be reached at (571) 272-7294.

/Beatriz Prieto/

Beatriz Prieto, Quality Assurance Specialist
Technology Center 2400

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July 6, 2008

Michael A. Mann
Nexsen Pruet, LLC
P.O. Drawer 2426
Columbia, SC 29202-2426

| | |
|---|---|
| Patent No. | : 6,782,652 B1 |
| Ser. No. | : 10/461,804 |
| Inventor(s) | : Milton W. Erickson |
| Issued | : August 31, 2004 |
| Docket No. | : 23532-69B |
| Title | : **RAIL COVER FOR USE WITH A PICATINNY RAIL** |

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:

Copy

| | |
|---|---|
| By mail: | Mail Stop PETITIONS<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Service Window<br>Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (571) 273-0025<br>ATTN: Office of Petitions |

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

/Virginia Tolbert/
Virginia Tolbert
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) 756-1580 or (703) 756-1814

vt

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AMGEN INC.
LAW DEPARTMENT
1201 AMGEN COURT WEST
SEATTLE WA 98119

MAILED
OCT 08 2010
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| | | |
|---|---|---|
| In re Kerwin et al. | : | DECISION ON REQUEST |
| Patent No. 7,700,722 | : | FOR |
| Issue Date: April 20, 2010 | : | RECONSIDERATION OF |
| Application No. 10/461,839 | : | PATENT TERM ADJUSTMENT |
| Filed: June 12, 2003 | : | and |
| Atty Docket No. A-810-US-CIP | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on June 4, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand three hundred seventy-five (1375) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand three hundred seventy-five (1375) days is **GRANTED to the extent indicated herein.**

Patentees assert the total period of adjustment is 1375 days, which is the sum of 323 days of A delay and 318 days of B delay and 911 days C delay, reduced by 177 days of applicant delay.

The Office concurs with patentees' assertions the period of A delay is 175 days and the period of C delay is 911 days. The Office will not dispute the period of applicant delay is 177 days.

The Office does not concur with patentees' assertion the period of B delay is 318 days. The period of B delay in this case is 316 days. Unless a Request for Continued Examination ("RCE") is filed, the period of B Delay ends of the date the patent issues. In this case, a RCE was filed October 22, 2009. Per 35 U.S.C. § 154(b)(1)(B)(i), B Delay does not include "any time consumed by

continued examination of the application requested by the applicant under section 132(b)." The maximum period of B Delay in this case is 1227 days, which is the number of days beginning on June 13, 2006, the day after the date three years after the application's filing date, and ending on October 21, 2009, the day before the date the RCE was filed.

As stated in 35 U.S.C. 154(b)(1)(B)(ii), B delay does not include "any time consumed by appellate review by the Board of Patent Appeals and Interferences." Excluding the 911 days consumed by appellate review results in a period of B delay of 316 days (1227 - 911).

In light of the above, the patent term adjustment is 1373 days, which is the sum of 323 days of A delay and 316 days of B delay and 911 days of C delay, reduced by 177 days of applicant delay.

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

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

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

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand three hundred seventy-three (1373)** days.

Telephone inquiries should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,700,839 B2

DATED : **April 20, 2010** **DRAFT**

INVENTOR(S) : Kerwin et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 1057 days

Delete the phrase "by 1057 days" and insert – by 1373 days--

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Lisa E. Alexander
Sagres Discovery, Inc.
c/o Chiron Corporation
P.O. Box 8097
Emeryville CA 94662-8097

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OCT 08 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent of Morris et al. | : | |
| Patent No. 7,767,387 | : | |
| Issue Date: August 3, 2010 | : | DECISION ON REQUEST |
| Application No. 10/461,862 | : | FOR RECONSIDERATION OF |
| Filed: June 13, 2003 | : | PATENT TERM ADJUSTMENT |
| Docket No. CHIR0011-100 | : | |

This is a decision on the petition filed on July 22, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand thirty-eight (1038) days.

The petition under 37 CFR 1.705(d) is **dismissed**.

Patentees argue that the Office failed to correctly calculate a period of adjustment due to examination delay, pursuant to 37 CFR §1.702(a)(1), for the failure by the Office to mail at least one of a notification under 35 U.S.C. 132 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a). Patentees argue the period should be 682 days, not 669 days, as listed in PAIR.

The Office concurs that the length of the delay pursuant to 37 CFR §1.702(a)(1)is 682 days, beginning on August 14, 2004, the date after 14 months after the application was filed, and ending on June 26, 2006, the date a restriction requirement was mailed.

However, a portion of this period overlaps with the B delay period. The period of B delay in this case is 469 days. Unless a Request for Continued Examination ("RCE") is filed, the period of B Delay ends of the date the patent issues. In this case, a RCE was filed on October 9, 2007. Per 35 U.S.C. § 154(b)(1)(B)(i), B Delay does not include "any time consumed by continued examination of the application requested by the

applicant under section 132(b)." The maximum period of B Delay in this case is 482 days, which is the number of days beginning on June 14, 2006, the day after the date three years after the application's filing date, and ending on October 8, 2007, the day before the date the RCE was filed. There is an overlapping period of 13 days, beginning on June 14, 2006, the day after three years from the filing date, and ending on June 26, 2006, the date the first action on the merits was mailed. *See* 35 U.S.C. 154(b)(1)(B)(i) and 37 CFR 1.703(f). The B delay is 469 days (482 - 13).

In short, patentees are correct that the length of delay pursuant to 37 CFR §1.702(a)(1)is 682 days; however, 13 of those days overlap with the B delay period and are therefore subtracted from the B delay period.

In light of the above, the patent term adjustment remains 1024 days (704 days A delay + 469 days B delay - 149 Applicant delay).

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

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.

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

CC: DAVID A. CARPENTER, PH.D.
NOVARTIS VACCINES AND DIAGNOSTICS, INC.
INTELLECTUAL PROPERTY - X-100B
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**DANIEL J. O'CONNOR**
**#821**
**6720 BUCKHORN DR.**
**INDIANAPOLIS IN 46254**

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| | | |
|---|---|---|
| In re Patent No. 6,798,081 | : | |
| Issue Date: September 28, 2004 | : | |
| Application No. 10/462,112 | : | ON PETITION |
| Filed: June 16, 2003 | : | |
| Attorney Docket No. BREHOB | : | |

This is a decision on the petition filed September 16, 2010, which will be treated as a petition 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 September 29, 2008, for failure to pay the three 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.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

The patent file is being forwarded to Files Repository.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Richard Brehob
1128 E. Cameron Street
Indianapolis, IN 46203

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LLP
20333 SH 249 6TH FLOOR
HOUSTON TX 77070

**MAILED**

**DEC 13 2010**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application | : | DECISION OF APPLICATION FOR |
| Gavish, et al. | : | PATENT TERM ADJUSTMENT |
| Application No. 10/462,118 | : | |
| Filed: June 13, 2003 | : | |
| Patent No. 7,701,926 | : | |
| Issued: April 20, 2010 | | |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT", filed April 21, 2010, requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the patent is two thousand, eighteen (2018) days, not two thousand, three hundred seventy-five (2375) days.

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

On April 20, 2010, the instant application matured into U.S. Patent No. 7,701,926 with a patent term adjustment of two thousand, three hundred seventy-five (2375) days. The Office determined a patent term adjustment of 2375 days based upon 1414 days of Office delay pursuant to 37 CFR 1.703(a)(1), 2 days of Office delay pursuant to 37 CFR 1.703(a)(2), and 1275 days of Office delay pursuant to 37 CFR 1.703(b), reduced by 54 and 4 days of Applicant delay, both under 37 CFR 1.704(b).

A review of the file reveals "A delay" to be 1057 days, "B delay" to be 1407 days, overlap to be 388 days (June 14, 2006 to July 6, 2007), and Applicant delay to be 58 days. As such, the patent term adjustment is 2018 days.

Receipt of the $200.00 fee set forth in 37 C.F.R. §1.18(e) is acknowledged.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Anthony Knight
Director
Office of Petitions

# Patent Term Adjustments

PTA/PTE Information | Patent Term Adjustment | Patent Term Extension

Application Number*: 10462118 Search | Explanation of PTA Calculation | Explanation of PTE Calculation

## PTA Calculations for Application: 10462118

| | | | |
|---|---|---|---|
| Application Filing Date | 06/13/2003 | OverLapping Days Between (A and B) or (A and C) | 258 |
| Issue Date of Patent | 04/20/2010 | Non-Overlapping USPTO Delays: | 2076 |
| A Delays | 1059 | PTO Manual Adjustment | 0 |
| B Delays | 1275 | Applicant Delay (APPL) | 58 |
| C Delays | 0 | Total PTA (days) | 2018 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 73 | 12/12/2010 | | P028 | Adjustment of PTA Calculation by PTO | | 357 | 0 |
| 69.5 | 04/20/2010 | 06/13/2006 | PTA36M | PTA 36 Months | 1275 | | 0 |
| 69 | 04/20/2010 | | PTAC | Patent Issue Date Used in PTA Calculation | | | 0 |
| 68 | 03/24/2010 | | EFDC | Export to Final Data Capture | | | 0 |
| 67 | 03/23/2010 | | D1935 | Dispatch to FDC | | | 0 |
| 66 | 03/12/2010 | | MP025 | Mail-Record a Petition Decision of Granted for Patent Term Adjustment after Allowance | | | 0 |
| 65 | 03/12/2010 | | P025 | Record a Petition Decision of Granted for Patent Term Adjustment after Allowance | | | 0 |
| 65 | 03/12/2010 | | P025 | Record a Petition Decision of Granted for Patent Term Adjustment after Allowance | | | 0 |
| 64 | 03/11/2010 | | P028 | Adjustment of PTA Calculation by PTO | | | 0 |
| 64 | 03/11/2010 | | P028 | Adjustment of PTA Calculation by PTO | 1414 | | 0 |
| 63 | 03/11/2010 | | P028 | Adjustment of PTA Calculation by PTO | | | 0 |
| 63 | 03/11/2010 | | P028 | Adjustment of PTA Calculation by PTO | | 1057 | 0 |
| 62 | 01/25/2010 | | FIDC | Finished Initial Data Capture | | | 0 |
| 61 | 01/19/2010 | | PILS | Application Is Considered Ready for Issue | | | 0 |
| 60 | 01/19/2010 | | QURF | Workflow - Query Request - Finish | | | 0 |
| 59 | 01/15/2010 | | TCPUB | TC Return to Pubs | | | 0 |
| 58 | 12/31/2009 | | PET. | Petition Entered | | | 0 |
| 57 | 12/31/2009 | | N084 | Issue Fee Payment Verified | | | 0 |
| 56 | 12/31/2009 | | IFEE | Issue Fee Payment Received | | | 0 |
| 54 | 10/26/2009 | | QURI | Workflow - Query Request - Begin | | | 0 |
| 55 | 10/23/2009 | | PUBTC | Pubs Case Remand to TC | | | 0 |
| 53 | 10/13/2009 | | EIDC | Export to Initial Data Capture | | | 0 |
| 52 | 10/06/2009 | 10/04/2009 | MN/=. | Mail Notice of Allowance | 2 | | 45 |
| 51 | 10/01/2009 | | IREV | Issue Revision Completed | | | 0 |
| 50 | 10/01/2009 | | DVER | Document Verification | | | 0 |
| 49 | 10/01/2009 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 48 | 10/01/2009 | | CNTA | Notice of Allowability | | | 0 |
| 46 | 06/16/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 45 | 06/04/2009 | | AP.B | Appeal Brief Filed | | | 0 |
| 44 | 05/27/2009 | 05/23/2009 | N/AP | Notice of Appeal Filed | | 4 | 38 |
| 43 | 05/27/2009 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 42 | 05/13/2009 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 41 | 05/11/2009 | | CTAV | Advisory Action (PTOL-303) | | | 0 |
| 40 | 04/28/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 39 | 04/22/2009 | | A.NE | Amendment after Final Rejection | | | 0 |
| 38 | 02/23/2009 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 37 | 02/17/2009 | | CTFR | Final Rejection | | | 0 |
| 36 | 12/02/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 35 | 11/20/2008 | 09/27/2008 | A... | Response after Non-Final Action | | 54 | 32 |
| 34 | 11/20/2008 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 33 | 06/27/2008 | | MW/AC | Mail Notice of Withdrawn Action | | | 0 |
| 32 | 06/27/2008 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 31 | 06/25/2008 | | CTNF | Non-Final Rejection | | | 0 |
| 30 | 06/25/2008 | | W/AC | Letter Withdrawing / Vacating Office Action | | | 0 |
| 29 | 08/23/2007 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 28 | 08/23/2007 | | EIDS. | Electronic Information Disclosure Statement | | | 0 |
| 27 | 08/23/2007 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 26 | 07/26/2007 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 25 | 07/11/2007 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 23 | 07/06/2007 | 08/13/2004 | MCTNF | Mail Non-Final Rejection | 1057 | | -1 |
| 22 | 06/25/2007 | | CTNF | Non-Final Rejection | | | 0 |
| 20 | 01/18/2007 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 19 | 10/10/2006 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 18 | 10/05/2006 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 17 | 03/21/2006 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 16 | 02/10/2006 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 15 | 07/16/2004 | | TSSCOMP | IFW TSS Processing by Tech Center Complete | | | 0 |
| 12 | 07/15/2004 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 11 | 11/18/2003 | | COMP | Application Is Now Complete | | | 0 |
| 10 | 11/17/2003 | | OIPE | Application Dispatched from OIPE | | | 0 |
| 9 | 11/17/2003 | | COMP | Application Is Now Complete | | | 0 |
| 8 | 10/14/2003 | | ADDFLFEE | Additional Application Filing Fees | | | 0 |
| 7 | 10/14/2003 | | OATHDECL | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic | | | 0 |
| 3 | 08/18/2003 | | INCD | Notice Mailed--Application Incomplete--Filing Date Assigned | | | 0 |
| 2 | 06/25/2003 | | LI94 | Cleared by OIPE CSR | | | 0 |
| 21 | 06/13/2003 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 14 | 06/13/2003 | | RCAP | Reference capture on IDS | | | 0 |
| 13.7 | 06/13/2003 | | MB44 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 13 | 06/13/2003 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 6 | 06/13/2003 | | CLAIM | Claim Preliminary Amendment | | | 0 |
| 5 | 06/13/2003 | | DRAWING | Drawing Preliminary Amendment | | | 0 |
| 4 | 06/13/2003 | | SPECIFIC | A document that contains, at least in part, a written description of an invention, and of the manne | | | 0 |
| 1 | 06/13/2003 | | IEXX | Initial Exam Team nn | | | 0 |

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**MICHAEL E. BELK**
**C/O U.S. PHILLIPS CORPORATION**
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**TARRYTOWN NY 10591**

In re Application of
Josephus A.H.M. KAHLMAN
Application No. 10/462,197
Filed: June 16, 2003
Attorney Docket No. PHN 16,904A

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 25, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely pay the issue and publication fees on or before March 22, 2005, as required by the Notice of Allowance and Fee(s) Due, mailed December 22, 2004, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on March 23, 2005.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the Issue Fee of $1510 and Publication Fee of $300; (2) the petition fee of $1620; and (3) an adequate statement of unintentional delay.

Since this application has been abandoned for an extended period of time, petitioner is reminded that the Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement of unintentional delay pursuant to 37 CFR 1.137(b)(3).

A review of the record discloses that Michael E. Belk was never given an appropriate power of attorney or authorization of agent to prosecute the above application. Therefore, as Mr. Belk was never given a power of attorney or authorization of agent, he cannot change the correspondence address of record. Please see 37 CFR 1.33. In this regard, the Change of Address filed with the petition on October 25, 2010, has not been entered. While a courtesy copy of this decision is being mailed to petitioner, 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 application is being referred to the Office of Data Management for processing into a patent. .

/DCG/
Diane C. Goodwyn
Petitions Examiner
Office of Petitions

Cc: MICHAEL E. BELK
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

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

**ALFRED J MANGELS**
**4729 CORNELL ROAD**
**CINCINNATI OH 45241-2433**

**MAILED**

FEB 23 2011

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,966,144 | : | |
| Issued: November 22, 2005 | : | |
| Application No. 10/462,269 | : | DECISION ON PETITION |
| Filed: June 16, 2003 | : | |
| Attorney Docket No. 1611 | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed January 11, 2011, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on November 23, 2009 for failure to pay the three 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.

Additionally, 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. 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. 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
Petitions Examiner
Office of Petitions

cc: Ueli Ambauen
CTS Technologies AG
c/o Kerdos Asset Management AG
Oberneuhofstrasse 5
CH-6340 Baar, Switzerland

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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**DAFFER MCDANIEL LLP**
**P.O. BOX 684908**
**AUSTIN TX 78768**

MAILED

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OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| **Igor C. IVANOV**, et *al.* | : | |
| Application No. 10/462,343 | : | DECISION GRANTING PETITION |
| Filed: June 16, 2003 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. **5866-00200** | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed November 1, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on September 22, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 1715 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the amendment previously filed September 22, 2010.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 5/19/2011

TO SPE OF : ART UNIT 1715 Timothy Meeks Spe

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/462343 Patent No.: 7883739

CofC mailroom date: 5/08/2011

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**

Certificates of Correction Branch
703-756-1571 _____

**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

1715
Art Unit

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P.O. Box 1450
Alexandria, VA 22313-1450
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OFFICE OF PETITIONS

FISH & RICHARDSON P.C. (TC)
PO BOX 1022
MINNEAPOLIS MN 55440-1022

| | | |
|---|---|---|
| In re Patent No.7,994,400 | : | |
| Clair, et al. | : | DECISION FOR REQUEST |
| Issue Date: August 9, 2011 | : | FOR RECONSIDERATION |
| Application No.10/462,540 | : | OF PATENT TERM |
| Filed: June 16, 2003 | : | ADJUSTMENT |
| Attorney Docket No. 21425-012001 | : | |

This is a decision on the "Application for Patent Term Adjustment Under 37 CFR 1.705(d)," filed October 10, 2011. Patentees request that the patent term adjustment indicated on the face of the Letters of Patent be corrected from one thousand, fifty (1,050) days, to one thousand, one hundred and seventy-four (1,174) days.

The request for reconsideration of the patent term adjustment under 37 CFR 1.705(d) is **DISMISSED**.

On August 9, 2011, the above-identified application matured into U.S. Patent No. 7,994,400, with a revised patent term of 1,050 days. By the instant petition, patentees assert that the patent term should be adjusted by 623 days pursuant to 37 CFR 1.702(b) and 37 CFR 1.703(b). Patentees state:

> Section 154(b)(1)(B)(i) of Title 35 excludes from the calculation of B Delay "any time consumed by continued examination of the application." In the present matter, a Request for Continued Examination was filed on October 29, 2007. The Director erred in the calculation of the patent term adjustment by subtracting from B Delay a period of time that was not "consumed by continued examination of the application." The PTO mailed a Notice of Allowance on April 8, 2011, thereby closing examination of the application on that date. Thus, no continued examination took place during 124 day period from April 8, 2011 (the mailing date of the Notice of Allowance) until August 9,

> 2011 (the date the patent was issued). Accordingly, 124 days for "B Delay" should have been included in addition to the 499 days accorded by the Director for a total B Delay of 623 days.

*Excerpt taken from "Application for Patent Term Adjustment Under 37 CFR 1.705(d)," filed October 10, 2011, pgs. 3-4.*

The Office's calculation of "B delay" is correct. The "B delay" is an adjustment entered if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed. However, the adjustment does not include, among other things, any time consumed by continued examination of the application at the request of the applicant under 35 U.S.C. 132(b)[1]. So, with respect to calculating the "B delay" where applicant has filed a request for continued examination, the period of adjustment is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the number of days in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

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[1] Pursuant to 35 U.S.C. 132(b), 37 CFR 1.114 provides for continued examination of an application, as follows:

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under § 1.313 is granted;

(2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

Further, counting the period of time excluded from the "B delay" for the filing of a request for continued examination under 35 U.S.C. 132(b), from the date on which the request for continued examination is filed to the date the patent is issued is proper. Patentee does not dispute that time consumed by continued examination of an application under 35 U.S.C. 132(b) is properly excluded and that the calculation of the excluded period begins on the date of filing of the request for continued examination. At issue is what further processing or examination beyond the date of filing of the request for continued examination is not any time consumed by continued examination of the application under 35 U.S.C. 132(b). The USPTO indicated in September of 2000 in the final rule to implement the patent term adjustment provisions of the AIPA that once a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. 132(b) and CFR 1.114. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56366, 56376 (Sept. 18, 2000) (response to comment 8). Thus, the excluded period begins with the filing of the request for continued examination and ends with the issuance of the patent.

Patentee's argument that the period of time after the issuance of a notice of allowance on a request for continued examination is not "any time consumed by continued examination requested by the applicant under section 132(b)" within the meaning of 35 U.S.C. 154(b)(1)(B)(i) is not availing. This limitation is not supported by the statutory language. Garcia v. United States, 469 U.S. 70, 75 (1984) ("only the most extraordinary showing of contrary intentions from [legislative history] would justify a limitation on the 'plain meaning' of the statutory language"). BP Am. Prod. Co. v. Burton, 549 U.S. 84, 91 (2006) ("Unless otherwise defined, statutory terms are generally interpreted in accordance with their ordinary meaning"). The statute provides for a guarantee of no more than 3-year application pendency, by providing for an adjustment in the patent term:

First, "Subject to the limitations of paragraph (2)," means that the limitations of paragraph 2 apply to this paragraph's adjustment of patent term. That is, the day-to-day extension of patent term for pendency beyond the 3 year period is restricted as follows: 1) "B delay" cannot accrue for days of "A delay"

that overlap, 2) the patent term cannot be extended beyond disclaimed term, and 3) the period of adjustment, including accrued "B delay," will be reduced for applicant delay.

Second, "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States," meaning that the condition must first occur that the issuance of an original patent (35 U.S.C. 153), not merely the issuance of a notice of allowance, is delayed due to the Office's failure to issue a patent (sign and record a patent grant in the name of the United States), not merely mail a notice of allowance, within 3 years after the actual filing date of the application in the United States. This provision gives the Office a three-year period to issue a patent (sign and record a patent grant in the name of the United States) after the application filing date before an adjustment will accrue for "B delay."

Third, "not including- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b); (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), meaning that the three-year period does not include "any time consumed by" or "any delay in processing," as specified in clauses (i)-(iii). This language correlates to 35 U.S.C. 154(b)(1)(A) which likewise provides the basis for determining the period given the Office to take the specified actions before an adjustment will accrue for "A delay" (e.g., extended for 1 day after the day after the period specified in clauses (i)-(iv)).

Furthermore, these clauses are interpreted using their ordinary meanings. Nonetheless, the context of the legislation should be considered. As stated in Wyeth v. Dudas, 580 F. Supp.2d 138(D.D.C., September 30, 2008), because the clock for calculating the 20-year patent term begins to run on the filing date, and not on the day the patent is actually granted, some of the effective term of a patent is consumed by the time it takes to prosecute the application. To mitigate this effect, the

statute, *inter alia*, grants adjustments of patent term whenever the patent prosecution takes more than three years, regardless of the reason. The time consumed by prosecution of the application includes every day the application is pending before the Office from the actual filing date of the application in the United States until the date of issuance of the patent. The time it takes to prosecute the application ends not with the mailing of the notice of allowance, but with the issuance of the patent.

Thus, not including "any time consumed by" means not including any days used to prosecute the application as specified in clauses (i)-(ii)[2]. Clause (i) specifies "any time consumed by continued examination of the application requested by the applicant under section 132(b)." Clause (ii) specifies "any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court." "Time" in the context of this legislation throughout refers to days. "Consumed by" means used by or used in the course of. *Websters Collegiate Dictionary*, (11th ed.). The "any" signifies that the days consumed by are "any" of the days in the pendency of the application, and not just days that occur after the application has been pending for 3 years. As such, "any time consumed by" refers to any days used in the course of 1) continued examination of the application under section 132(b)(the filing of a request for continued examination), 2) interference proceedings, 3) secrecy orders, and 4) appellate review. Thus, that 3-year period given to the Office to issue a patent before an adjustment will accrue for "B delay" does not include any days used in the course of or any time consumed by clauses (i)-(ii), including any time consumed by the filing of a request for continued examination.

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[2] Clause (iii) provides for not including (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued. It is noted that paragraph (3)(C) allows with an adequate showing by applicant for reinstatement of no more than 3 months of the patent term reduced for applicant delay in taking in excess of three months to respond.

Fourth, "the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued" meaning that the consequence of this failure is that after "the end of that 3-year period" an additional 1 day of patent term will accrue for each day that the application is pending until the day the patent is issued.

The "time consumed by" or used in the course of the continued examination of the application requested by the applicant under section 132(b) does not end until issuance of the patent. 35 U.S.C. 132(b) was enacted under the same title, the "American Inventors Protection Act of 1999," as 35 U.S.C. 154(b). Section 4403 of the AIPA amended 35 U.S.C. § 132 to provide, at the request of the applicant, for continued examination of an application for a fee (request for continued examination or RCE practice), without requiring the applicant to file a continuing application under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d). Thus, clause (i) is different from clause (ii) in that clause (i) refers to an examination process whereas clause (ii) refers to time consumed by proceedings (interferences, secrecy orders and appeals) in an application.

By nature, the time used in the course of the examination process continues to issuance of the patent. The examination process involves examining the application to ascertain whether it appears that the applicant is entitled to a patent under the law. See 35 U.S.C. 131 ("[t]he Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor"). If on examination it appears that the applicant is entitled to a patent, the USPTO issues a notice of allowance. See 35 U.S.C. 151 ("[i]f it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant"). If on examination it appears that the applicant is not entitled to a patent, the USPTO issues a notice (an Office action) stating the applicable rejection, objection, or other requirement, with the reasons therefor. See 35 U.S.C. 132 ("[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the

propriety of continuing the prosecution of his application"). Neither the issuance of a notice of allowance nor the insurance of an Office action terminates the examination process. If after the issuance of an Office action under 35 U.S.C. 132 it subsequently appears that the applicant is entitled to a patent (e.g., in response to an argument or amendment by the applicant), the USPTO will issue a notice of allowance. Conversely, if after the issuance of a notice of allowance under 35 U.S.C. 151 it subsequently appears that the applicant is not entitled to a patent (e.g., in response to information provided by the applicant or uncovered by the USPTO), the USPTO will withdraw the application from issuance and issue an Office action under 35 U.S.C. 132 stating the applicable rejection, objection, or other requirement, with the reasons therefor.

As held in Blacklight Power, the USPTO's responsibility to issue a patent containing only patentable claims does not end with the issuance of a notice of allowance under 35 U.S.C. 151. See BlackLight Power, Inc. v. Rogan, 295 F.3d 1269, 1273 (Fed. Cir. 2002). Rather, if there is any substantial, reasonable ground within the knowledge or cognizance of the Director as to why an application should not issue, it is the USPTO's duty to refuse to issue the patent even if a notice of allowance has previously been issued for the application. See In re Drawbaugh, 9 App. D.C. 219, 240 (D.C. Cir 1896).

Moreover, the applicant continues to be engaged in the examination process after the mailing of the notice of allowance. 37 CFR 1.56 makes clear that the applicant has a duty to disclose information material to patentability as long as the application is pending before the USPTO (i.e., until a patent is granted or the application is abandoned). See 37 CFR 1.56(a) ("[t]he duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned"). 37 CFR 1.97 and 1.98 provide for the consideration of information submitted by the applicant after a notice of allowance has been mailed. See 37 CFR 1.97(d). In addition, 37 CFR 1.312 provides for the amendment of an application after a notice of allowance has been mailed. In fact, the request for examination procedures[3] permit the filing of a request for continued examination under

[3] Thus, on occasion, even where a request for continued examination has already been filed and a notice of allowance issued pursuant to that request, applicant may file a further request for continued examination.

37 CFR 1.114 even after the issuance of a notice of allowance under 35 U.S.C. 151. See 37 CFR 1.114(a)(1).

As the examination process does not terminate with the mailing of the notice of allowance, the time consumed by continued examination requested by the applicant under section 132(b) does not terminate with the mailing of the notice of allowance. All the time the application is pending from the date of filing of the request for continued examination to the mailing of the notice of allowance through issuance of the patent is a consequence of the filing of the request for continued examination. Further action by the Office is pursuant to that request. Applicant has gotten further prosecution of the application without having to file a continuing application under 37 CFR 1.53(b).

All of the continued examination pursuant to the filing of the request by the applicant is properly excluded from the delay attributed to the Office. 35 U.S.C. 154(b)(1)(B)'s guarantee of a total application pendency of no more than three years provides for adjustment of the patent term for delay due to the Office's failure to issue the patent within three years, but does not include "any time consumed by continued examination requested by the applicant under 35 U.S.C. 132(b)." It is not necessary to mitigate the effect on the 20-year term to the extent that applicant has requested that the Office continue to examine the application via a request for continued examination, in lieu of, the filing of a continuing application under 37 CFR 1.53(b).

In this instance, a request for continued examination was filed on October 29, 2007, and the patent issued by virtue of that request on August 9, 2011. Pursuant to 35 U.S.C. 154(b)(1)(B)(i), the period beginning on October 29, 2007, and ending on August 9, 2011, is not included in calculating Office delay.

In view thereof, it is concluded that the patent term adjustment of 1,050 days indicated on the patent is correct.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District

Court for the District of Columbia within 180 days after the grant of the patent.

Telephone inquiries specific to this matter 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
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www.uspto.gov

In re Patent No. 7249053
Issue Date: July 24,2007
Application No. 10462578
Filed: June 16,2003
Attorney Docket No. 4001-0515

:
: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 3.5 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.

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) |
|---|---|---|---|---|
| 7249053 | 2007-07-24 | 10462578 | 2003-06-16 | 4001-0515 |

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

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 | /Brian Siritzky/ | Date (YYYY-MM-DD) | 2011-08-05 |
| Name | Brian Siritzky | Registration Number | 37497 |

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
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) |
|---|---|---|---|---|
| 7172651 | 2007-02-06 | 10462779 | 2003-06-17 | 04465.0039us-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 | | 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

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).<br>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 | /R. Douglas Carter/ | Date (YYYY-MM-DD) | 2012-02-02 |
| Name | R. Douglas Carter | | |
| Enter Reel and Frame Number | | Remove | |
| Reel Number | 027629 | Frame Number | 0603 |
| 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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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 7172651
Issue Date: February 6,2007
Application No. 10462779
Filed: June 17,2003
Attorney Docket No. 01-212 (80162)

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

This is a decision on the electronic petition, filed February 2,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 2,2012 .
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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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**GLOBAL IP LAW, LLC**
**233 SOUTH WACKER DRIVE (WILLIS TOWER)**
**SUITE 8400**
**CHICAGO IL 60606**

MAILED

MAY 20 2011

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|---|---|---|
| In re Patent No. 6,914,772 | : | |
| Issue Date: July 05, 2005 | : | |
| Application No. 10/462,898 | : | DECISION ON PETITION |
| Filed: June 16, 2003 | : | |
| Attorney Docket No. HESS-10711 | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed April 12, 2011 to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on July 05, 2009 for failure to pay the three and one-half 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 the undersigned at (571) 272-4231.

The patent file is being forwarded to Files Repository.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

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STEPHEN C FORD
APT 102
29135 LANCASTER DR
SOUTHFIELD MI 48034

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|---|---|---|
| In re Patent No. 7,073,225 | : | |
| Issue Date: July 11, 2006 | : | |
| Application No. 10/463,014 | : | DECISION ON PETITION |
| Filed: June 17, 2003 | : | |

This is a decision on the petition to reinstate an expired patent under 37 CFR 1.378(c), filed September 17, 2010.

The petition under 37 CFR 1.378(c) is **GRANTED**.

The above-identified patent issued July 11, 2006. Accordingly, the first maintenance fee could have been paid during the period from July 11, 2009 through January 11, 2010 without surcharge, or with a late payment surcharge during the period from January 12, 2010 through July 11, 2010. No maintenance fee having been received, the patent expired on July 12, 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
P.O. Box 1450
Alexandria, VA 22313-1450
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MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO IL 60661

MAILED
JAN 06 2011
OFFICE OF PETITIONS

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| In re Application of | : | |
| Pai et al. | : | |
| Application No. 10/463170 | : | ON APPLICATION FOR |
| Filing or 371(c) Date: 06/16/2003 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No.: | : | |
| 15007US01 | : | |

This is in response to the APPLICATION FOR RECONSIDERATION OF THE DETERMINATION OF PATENT TERM ADJUSTMENT UNDER 35 U.S.C. 154(b) ACCOMPANYING NOTICE OF ALLOWANCE, filed December 13, 2010. Applicant proposes that the correct Patent Term Adjustment is 522 days, not 393 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction solely on the basis that the Office will take in excess of three years to issue this patent. The application for patent term adjustment is properly treated under 37 C.F.R. § 1.705(b).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and ***must*** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods
Attorney
Office of Petitions

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[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

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CHICAGO IL 60661

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| In re Application of | : | |
| BIDNUR et al. | : | |
| Application No. 10/463,315 | : | ON APPLICATION FOR |
| Filed: 06/17/2003 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. 14162US01 | : | |

This is in response to the APPLICATION FOR RECONSIDERATION OF THE DETERMINATION OF PATENT TERM ADJUSTMENT UNDER 35 U.S.C. 154(b) ACCOMPANYING THE NOTICE OF ALLOWANCE (37 CFR § 1.705), filed November 24, 2010, which is being treated as a petition under 37 CFR 1.705(b). Applicants submit that the correct patent term adjustment to be indicated on the patent is 1379 days, not 814 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants seek this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR

1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.[1]

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

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[1] For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within two months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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

| | | |
|---|---|---|
| In re Patent No. 7,011,768 | : | |
| Issue Date: March 14, 2006 | : | |
| Application No. 10/463,352 | : | ON PETITION |
| Filed: June 16, 2003 | : | |
| Attorney Docket No. **026509-0003P** | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed July 1, 2010, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

This patent expired at midnight March 14, 2010, for failure to pay the 3½ 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 **GRANTED**.

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.

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 JoAnne Burke at (571) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Stephen E. Zweig, Ph.D.
224 Vista De Sierra
Los Gatos, CA 95030

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GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

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In re Patent No. 7,994,289 :
Issued: August 9, 2011 : LETTER REGARDING
Application No. 10/463,442 : PATENT TERM ADJUSTMENT
Filed: June 18, 2003 :
Attorney Docket No. 07588.0094-00 :

This is a decision on theAPPLICATION FOR PATENT TERM ADJUSTMENT-POST GRANT filed on September 1, 2011, requesting that the patent term adjustment indicated on the above-identified patent be corrected from 399 days to 553 days.

The request for review of the patent term adjustment is **DISMISSED.**

Patentees are given **THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer,** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The patent term adjustment indicated in the patent is properly reflected.

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on June 18, 2006 and ends on December 17, 2007, the day before the RCE was filed, the B delay would be 547 days (not 548 days). See 35 U.S.C. 154(b)(1)(B)(i). However, patentee fails to account for the filing of a Notice of Appeal on July 18, 2007, and the subsequent filing of the RCE on December 18, 2007. The 547 days of the over three year period therefore would be consumed by appellate review, beginning on July 18, 2007 and ending on December 18, 2007. The time for appellate review is excluded (547-153); thus the "B delay is 394 days. *See* 35 U.S.C. § 154(b)(1)(B)(ii). As such, the patent term adjustment is 399 days (398 "A delay days" + 394 "B delay days" (547-153) - 393 Applicant delay days), not 553 days.

The Office acknowledges the submission of the required fee of $200.00 set forth in 37 CFR 1.18(e) .

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
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

**BURNS, DOANE, SWECKER & MATHIS, L.L.P.**
**P.O. BOX 1404**
**ALEXANDRIA VA 22313-1404**

MAILED

JAN 13 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,196,068 | : | |
| Issue Date: March 27, 2007 | : | |
| Application No. 10/463,676 | : | DECISION ON PETITION |
| Filed: June 18, 2003 | : | |
| Attorney Docket No. 012679-091 | : | |

This is a decision on the renewed petition under 37 CFR 1.182, filed June 29, 2010, 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 received.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3208. 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 the Office of Data Management for issuance of duplicate Letters Patent.

/KOC/
Karen Creasy
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

Commissioner for Patents
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BEYER LAW GROUP LLP/APPLE INC.
P.O. BOX 1687
CUPERTINO CA 95015-1687

MAILED
SEP 27 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent of Hodge et al. | : | |
| Patent No. 7,499,232 | : | |
| Issue Date: March 3, 2009 | : | DECISION ON REQUEST FOR |
| Application No. 10/463,700 | : | RECONSIDERATION OF |
| Filed: June 16, 2003 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. APL1P265/ | : | |
| P3033-34 | : | |

This is in response to the "REQUEST FOR REINSTATEMENT OF PREVIOUSLY FILED REQUEST FOR RECONSIDERATION PATENT TERM ADJUSTMENT," filed February 10, 2010. This petition will be treated under 37 CFR 1.705(d).

The request for reconsideration of patent term adjustment is **DISMISSED**.

On March 3, 2009, the above-identified application matured into U.S. Patent No. 7,499,232 with a patent term adjustment of 757 days. On March 6, 2009, patentees timely filed a request for reconsideration of patent term adjustment within two months of the issue date of the patent. See 1.705(d). On May 12, 2009, the request for reconsideration of patent term adjustment was dismissed.

Patentees filed the present renewed petition almost 9 months after the May 12, 2009 decision was mailed on February 10, 2010. Patentees admit that they elected not to request reconsideration of the May 12, 2009 decision because they felt such a request would be denied as a matter of course, because it was the Office's position that *Wyeth v. Dudas* decision was incorrect.

37 CFR 1.181(f) states in pertinent part, "...Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided."

It is undisputed that patentees failed to file a reconsideration petition within 2 months of the mailing of the May 12, 2009 decision on petition. Patentees admittedly chose not to renew their challenge of the revised patent term adjustment within the two-month period.

On February 1, 2010, the USPTO published a Federal Register notice that, *inter alia*, announced a limited waiver of the two-month deadline for filing a petition for reconsideration of a PTA determination under 37 CFR sec. 1.705(d). *See Interim Procedure for Patentees to Request a Recalculation of the Patent Term Adjustment to Comply with the Federal Circuit Decision in Wyeth v. Kappos Regarding Overlapping Delay Provisions of 35 U.S.C. sec. 154(b)(2)(A)*, 75 *Fed. Reg.* 5043 (Feb. 1, 2010) (notice). Specifically, patent owners were permitted to request recalculation of a patent's PTA in view of the Federal Circuit decision *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010) up to 180 days after the grant of the patent. The USPTO determined not to accept any requests for PTA recalculation initially filed more than 180 days after patent grant. However, in view of the statutory judicial-review provisions of 35 U.S.C. sec. 154(b)(4), which require that any civil action to challenge the USPTO's PTA determination be brought within 180 days of patent grant, The USPTO believes that the statutory 180-day period for seeking court review of the USPTO's PTA determinations, particularly in view of the six-year statute of limitations that otherwise is applicable for actions under the Administrative Procedure Act, indicates a congressional intent that PTA issues be resolved shortly after a patent issues. The USPTO does not consider it likely that Congress created a scheme under which the time period to seek initial USPTO review of a PTA determination extends beyond the time period provided for a dissatisfied patentee to seek judicial review of the USPTO's PTA determination. Thus, the USPTO believes that the 180-day period in 35 U.S.C. sec. 154(b)(4) represents the outer limit on the USPTO's ability to conclude its PTA determination.

The February 10, 2010 petition for recalculation/reconsideration of the USPTO's PTA determination for U.S. Patent No. 7,499,232 is dismissed as untimely.

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

Shirene Willis Brantley

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO IL 60606

**MAILED**

JAN 25 2011

OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7577978 | : DECISION ON REQUEST |
| Wistendahl et al. | : FOR |
| Issue Date: 08/18/2009 | : RECONSIDERATION OF |
| Application No. 10/463949 | : PATENT TERM ADJUSTMENT |
| Filed: 06/16/2003 | : and |
| Atty Docket No. | : NOTICE OF INTENT TO ISSUE |
| 08-473-US-CIP3 | : CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on February 2, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand three hundred fifty-two (1352) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand three hundred fifty-two (1352) days is **GRANTED**.

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

The Office thanks patentees for their good faith and candor in bringing this to the attention of the Office.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand three hundred fifty-two (1352)** days.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,577,978 B1

DATED : **Aug., 18, 2009** **DRAFT**

INVENTOR(S) : Wistendahl et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 1380 days.

Delete the phrase "by 1380 days" and insert – by 1352 days--

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/5/09

TO SPE OF : ART UNIT 2614 Chin Vivian (Spe)

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/463964 Patent No.: 7460520

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

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

Certificates of Correction Branch
**703-308-9390 ext.** _____

**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:** _____

/Ahmad F Matar/ — **SPE**

2614 — **Art Unit**

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

MAILED
JAN 31 2011
OFFICE OF PETITIONS

In re Patent No. 7,173,821 :
Issue Date: February 6, 2007 :
Application No. 10/464,028 : NOTICE
Filed: August June 17, 2003 :
Attorney Docket No. RACK-010/01US :

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) 272-1642.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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**SCHWEGMAN, LUNDBERG & WOESSNER, P.A.**
**P.O. BOX 2938**
**MINNEAPOLIS, MN 55402**

MAILED
AUG 03 2010
OFFICE OF PETITIONS

In re Application of :
Irvine Dubow :
Application No. 10/464,105 :
Filing: June 18, 2003 :
Attorney Docket No. 1831.001US1 :

ON PETITION

This is a decision on the petition under 37 CFR 1.102(c)(1), filed June 9, 2010, to make the above-identified application special based on applicant's age as set forth in M.P.E.P. § 708.02, Section IV.

The petition is **GRANTED**.

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

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. Albert W. Watkins appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts. If, Mr. Watkins desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted.

The instant petition includes a statement by the applicant's attorney that he is at least 65 years of age and is also accompanied with a copy of applicant's Florida Driver's License. Accordingly, the above-identified application has been accorded "special" status.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-6059. All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

This matter is being referred to the Technology Center Art Unit 1612 for action on the merits commensurate with this decision.

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) |
|---|---|---|---|---|
| 7070297 | 2006-07-04 | 10464120 | 2003-06-18 | 383-003 |

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

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 D. Marston, Reg. No. 61,432/ | Date (YYYY-MM-DD) | 2010-10-15 |
| Name | Michael D. Marston | Registration Number | 61432 |

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. 7070297
Issue Date: July 4,2006
Application No. 10464120
Filed: June 18,2003
Attorney Docket No. 338-003

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

This is a decision on the electronic petition, filed October 15,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 15,2010 . 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) |
|---|---|---|---|---|
| 7286914 | 2007-10-23 | 10464177 | 2003-06-18 | 4117-030964 |

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

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 | /Randall A. Notzen/ | Date (YYYY-MM-DD) | 2011-12-23 |
| Name | Randall A. Notzen | Registration Number | 36882 |

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. 7286914
Issue Date: October 23,2007
Application No. 10464177
Filed: June 18,2003
Attorney Docket No. 4117-030964

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

This is a decision on the electronic petition, filed December 23,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 23,2011 . 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

**DAVID A. EINHORN, ESQ.**
**BAKER HOSTETLER LLP**
**45 ROCKEFELLER PLAZA**
**NEW YORK NY 10111**

**MAILED**

AUG 04 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Tanaka et al. | : | |
| Application No. 10/464,547 | : | DECISION ON PETITION |
| Filed: June 18, 2003 | : | |
| Attorney Docket No. MM4625DIV | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 6, 2010, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before March 10, 2009, as required by the Notice of Allowance and Fee(s) Due mailed December 10, 2008. Accordingly, the date of abandonment of this application is March 11, 2009. A Notice of Abandonment was mailed September 18, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $1,510.00 and publication fee of $300.00; (2) the petition fee of $1,620.00; and (3) a proper statement of unintentional delay.

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

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

Joan Olszewski
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 4/16/2010

TO SPE OF : ART UNIT 2621 (2600)

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/464,773 Patent No.: 7,616,866

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, LTE*
*Randolph Sq. Ste 9D62A*
*703-756-1590*

**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.

SPE THAI Q TRAN SUPERVISORY PATENT EXAMINER TECH CENTER 2600/2400 ART UNIT 2484

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. WILLIAMS, EDWARD E. | : | |
| Issue Date: 10/17/2006 | : | **DECISION GRANTING** |
| Appl No.: 10/465,375 | : | **PETITION** |
| Filed: June 19, 2003 | : | *37 CFR 1.324* |
| For: APPARATUS AND PROCESS FOR CUTTING EXTRUDED MATERIAL | : | |

This is a decision on the petition filed 4/11/2008 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.

/Boyer D. Ashley/

Boyer D. Ashley
Supervisory Patent Examiner
Art Unit 3724
Technology Center 3724

STORM LLP
BANK OF AMERICA PLAZA
901 MAIN STREET, SUITE 7100
DALLAS, TX 75202

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:** January 31, 2011
**TO:** Certificates of Correction Branch
**FROM:** Boyer D. Ashley
SPE, Art Unit 3724
**SUBJECT:** REQUEST FOR CERTIFICATE OF CORRECTION

Please issue a Certificate of Correction in U. S. Letters Patent No. 7,121,181 as specified on the attached Certificate.

/Boyer D. Ashley/

Boyer D. Ashley, SPE
Art Unit 3724

# UNITED STATES PATENT AND TRADEMARK OFFICE

## CERTIFICATE

Patent No. 7,121,181
Patented: October 17, 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:

Edward E. Williams
Alan Eugene Crystal

/Boyer D. Ashley/

Boyer D. Ashley
Supervisory Patent Examiner
Art Unit 3724

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

ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON DC 20036

**MAILED**

AUG 31 2010

OFFICE OF PETITIONS

In re Application of
Satoh, et al.
Application No. 10/465,663
Filed: 20 August, 2003
Attorney Docket No. 13768.455

DECISION

This is a decision on the petition filed on 9 August, 2010, properly considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

**NOTE:**

Papers filed herein prompt the noting that Petitioner appears not to have inquired about the instant application until the filing of the instant petition.

The history now presented with those papers suggests that some thirty-seven (37) months elapsed between: the submission of papers on 6 July, 2007, and the filing of the instant petition on 9 August, 2010.

The petition pursuant to 37 C.F.R. §1.181 is **GRANTED**.

As to the Request to Withdraw
the Holding of Abandonment

*Petitioners always are directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing and timeliness requirements for relief under 37 C.F.R. §1.181.*

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the final Office action mailed on 6 February, 2007, with reply due under absent an extension of time on or before 6 May, 2007.

The instant application would have gone abandoned by operation of law—in the absence of an extension of time—after midnight 6 May, 2007.

From the image file wrapper (IFW) It appears that the Office did not mail a Notice of Abandonment before a subsequent petition was filed, however, for completeness of the record it is noted that the PALM system reflects a scheduled mailing date of 4 October, 2007.

On 9 August, 2010, Petitioner filed, *inter alia*, a petition pursuant to 37 C.F.R. §1.181 and averred, *inter alia*, that a timely reply had been filed, with a copy of a date-stamped ("JUL 6 2007") receipt card evidencing the filing of a request and fee for extension of time and request for continued examination (RCE) and fee and a submission under the provisions of 37 C.F.R. §1.114 in the form of an amendment and Office records reflect the charging of the fees authorized—thus Office records also clearly support that showing.

What is absent from the record is any indication that even a single Status Inquiry was filed, and Petitioner provides no evidence thereof.

*Thus, as discussed above, Petitioner appears not to have inquired about the instant application in the thirty-seven (37) months between the submission of papers on 6 July, 2007, and the filing of the instant petition on 9 August, 2010—notwithstanding the fact that applications/application papers are available online twenty-four (24) hours a day, seven (7) days a week to applicants/practitioners who diligently associate their Customer Number with the respective application(s). The system provides an applicant/practitioner on-demand information as to events/transactions in an application.*

Petitioners always are directed to the appropriate guidance (MPEP §711.03(c ), and requested to comply with it. The guidance in the Commentary at MPEP §711.03(c )(I) provides in pertinent part:

***

> 37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 C.F.R. §1.10(c), (d), (e), or (g) (see MPEP §513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.
>
> Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP §503. For example, if the application has been held abandoned for

failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. 1.8(b) and MPEP §512. As stated in 37 C.F.R. §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).

37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. §1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP §512. [1]

***

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (*see*: 37 C.F.R. §1.181(f)), and 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.[2]

---

[1] *See*: MPEP §711.03(c) (I)(B).

[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).

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.

## STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).

### Allegations as to the Request to Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how it is to be made and supported.

Petitioner appears to have made the showing required pursuant to the Rule.

## CONCLUSION

Accordingly, the petition pursuant to 37 C.F.R. §1.181 is **granted**. While there appears in the image file wrapper to be no Notice of Abandonment mailed, the PALM system reflects a scheduled mailing date of 4 October, 2007, and so for the purposes of record such Notice of Abandonment is **vacated**.

The instant application is released to Technology Center/AU 2192 for further processing in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

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

BUCHANAN INGERSOLL & ROONEY, PC
1737 King Street, Suite 500
ALEXANDRIA VA 22314

MAILED
JAN 24 2012
OFFICE OF PETITIONS

In re Application
Bas Ording et al.
Application No. 10/465,855
Filed: June 20, 2003
Attorney Docket No. 1001580-000902

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. §1.705 filed January 11, 2012. Applicant requests that the determination of patent term adjustment be corrected from 295 to 732 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and is considered in light of the recent court decision in light of the Court of Appeals for the Federal Circuit's decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the patent term adjustment relating to those provisions until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.[1]

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within two months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

[1] For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

OK TO ENTER: /L.S./ (05/16/2011)

**Patent 7,930,170** **PATENT**

**IN UNITED STATES PATENT AND TRADEMARK OFFICE**

| | | | |
|---|---|---|---|
| Patent No.: | 7,930,170 | Docket No: | 1488.001US1 |
| Issue Date: | April 19, 2011 | Patentee: | K. P. P. Kalyan Chakravarthy et al. |
| Customer No.: | 21186 | Confirmation No.: | 6129 |
| Title | COMPUTATIONALLY EFFICIENT AUDIO CODER | | |

## REQUEST FOR CERTIFICATE OF CORRECTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTN: CERTIFICATE OF CORRECTION BRANCH

It is requested that a Certificate of Correction be issued correcting printing errors appearing in the above-identified United States patent. A copy of the text of the Certificate in the suggested form is enclosed.

**Authorization to charge Deposit Account No. 19-0743 in the amount of $100.00 to cover the Certificate of Correction Fee.**

Issuance of the Certificate of Correction would neither expand nor contract the scope of the claims as properly allowed, and re-examination is not required.

The Examiner is authorized to charge any additional fees or credit overpayment to Deposit Account No.19-0743.

Respectfully Submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6900

Date : 4 May 2011

By: Bradley A. Forrest
Reg. No: 30,837
BAF:rk

CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is filed using the USPTO's electronic filling system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450, on this 4 day of May 2011

Sallie Knudsen
Name

/Sallie Knudsen/
Signature

PTO/SB/44 (02-01)
Approved for use through 01/31/2004. OMB 0651-0033
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.
(Also Form PTO-1050)

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

PATENT NO : 7,930,170 Page (1) of 1

DATED : April 19, 2011

INVENTOR(S) : K. P. P. Kalyan Chakravarthy et al.

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

On the face page, in field (75), in "Inventors", in column 1, line 5, delete "Bishwarup Moindal" and insert - - Bishwarup Mondal - -, therefor.

In column 15, line 36, in Claim 11, delete "generated" and insert - - generator - -, therefor.

In column 15, line 37, in Claim 11, after "the" delete "signal".

In column 15, line 40, in Claim 11, after "blocks;" insert - - and - -.

In column 15, line 44, in Claim 11, delete "short blocks" and insert - - short-blocks - -, therefor.

In column 15, lines 53-54, in Claim 11, delete "compress" and insert - - compresses - -, therefor.

In column 15, line 66, in Claim 11, delete "determining" and insert - - determines - -, therefor.

In column 15, line 67, in Claim 11, after "ratios;" insert - - and - -.

In column 17, line 12, in Claim 23, delete "Rate control" and insert - - Rate Control - -, therefor.

In column 18, line 11, in Claim 26, delete "Rate-Control" and insert - - Rate Control - -, therefor.

In column 18, line 12, in Claim 26, delete "intializes" and insert - - initializes - -, therefor.

MAILING ADDRESS OF SENDER:

PATENT NO. 7,930,170

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

No. of additional copies

Atty Docket No: 1488.001US1

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 5/10/11

**TO SPE OF** : ART UNIT 2626

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10466027 Patent No.: 7930170

**CofC mailroom date:** 05/04/11

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 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.

- [X] **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

SPE Art Unit

PTO/SB/131 (02-10)
Approved for use through 02/28/2011. OMB 0651-0020
U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH**

| | | | |
|---|---|---|---|
| Attorney Docket Number: | ICON 3.3-004 | | |
| Application Number: | 10/466,291-Conf. #2124 | Filing Date (or 371(b) or (f) Date): | July 15, 2003 |
| Patent Number: | 7,670,801 | Issue Date: | March 2, 2010 |
| First Named Inventor: | Yuri Gleba | | |
| Title: | USING VIRUSES TO DETECT OR PURIFY PROTEINS | | |

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-*WYETH* INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

**Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

| | | | |
|---|---|---|---|
| Signature | /Shawn P. Foley/ | Date | August 13, 2010 |
| Name (Print/Typed) | Shawn P. Foley | Registration Number | 33,071 |

***Note**: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms if more than one signature, see below**.*

☐ *Total of 1 forms are submitted.

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being transmitted via the Office electronic filing system in accordance with § 1.6(a)(4).

Dated: August 13, 2010 Electronic Signature for Shawn P. Foley: /Shawn P. Foley/

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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LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

Mail Date: 08/23/2010

| | | |
|---|---|---|
| **Applicant** | : Yuri Gleba | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7670801 | : RECALCULATION of PATENT |
| **Issue Date** | : 03/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/466,291 | : OF WYETH |
| **Filed** | : 07/15/2003 | : |
| | | : |

The Patentee's Request for Recalculation is **DISMISSED.**

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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**FISH & RICHARDSON P.C. (BO)**
**P.O. BOX 1022**
**MINNEAPOLIS, MN 55440-1022**

**MAILED**
MAR 23 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| **Christian BLOCK**, et *al.* | : | |
| Application No. 10/466,338 | : | DECISION GRANTING PETITION |
| Filed: February 12, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. **14219-0025US1** | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 22, 2011, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on February 16, 2011 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 2618 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

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

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

**MAILED**

SEP 29 2010

OFFICE OF PETITIONS

In re Patent No. 7,582,985
Issued: September 1, 2009
Application No. 10/466,358
Filed: July 16, 2003
Attorney Docket No. 029856-0103

: LETTER REGARDING
: PATENT TERM ADJUSTMENT

This is a decision on the REQUEST FOR RECONSIDERATION OF DECISION ON REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH filed on May 20, 2010, requesting that the patent term adjustment indicated on the above-identified patent be corrected from 935 days to 1346 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and is being considered in light of the Court of Appeals for the Federal Circuit's decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

The request for review of the patent term adjustment is **DISMISSED.**

Patentees are given **THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer,** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The patent term adjustment indicated in the patent is properly reflected.

Patentee has miscalculated the total patent term adjustment. In this instance the period consumed by appellate review began on February 8, 2007 and ended on March 25, 2008 with the mailing of non-Final Office Action and is 411 days. Further, the Office has determined that the period of overlap is 107 days. Considering the exclusion and the overlap, the "B delay" is 625 days. Thus, the patent term adjustment is 935 days.

The Office acknowledges the submission of the required fee of $200.00 set forth in 37 CFR 1.18(e) .

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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MAILED
NOV 24 2010
PCT LEGAL ADMINISTRATION

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

In re Application of OKAJIMA et al :
U.S. Application No.: 10/466,518 :
PCT Application No.: PCT/JP2002/000350 : DECISION
Int. Filing Date: 18 January 2002 :
Priority Date Claimed: 18 January 2001 :
Attorney Docket No.: 240532US90PCT :
For: PACKET COMMUNICATION SYSTEM :

This is in response to applicant's correspondence filed 21 September 2010, which is being treated as a petition under 37 CFR 1.181. No petition fee is due.

## BACKGROUND

On 18 January 2002, applicant filed international application PCT/JP2002/000350, which claimed priority of an earlier Japan application filed 18 January 2001. A copy of the international application was communicated to the USPTO from the International Bureau on 25 July 2002. The thirty-month period for paying the basic national fee in the United States expired on 18 July 2003.

On 17 July 2003, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 12 November 2003, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 08 January 2004, applicant filed an executed declaration.

On 18 February 2004, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903), which indicated 01 January 2004 as the 35 U.S.C. 371 date.

On 21 September 2010, applicant filed the present petition under 37 CFR 1.181.

## DISCUSSION

A review of the application file reveals that the declaration was received on 08 January 2004 rather than 01 January 2004.

## CONCLUSION

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

The Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) mailed 18 February 2004 is hereby VACATED.

The application has an International Filing Date under 35 U.S.C. 363 of 18 January 2002, and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 08 January 2004.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of a corrected Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) and a corrected filing receipt.

Bryan Lin

Bryan Lin
PCT Legal Examiner
PCT Legal Office

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** —

**DATE** : 3/10/2011

**TO SPE OF** : ART UNIT 2462

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/466518 Patent No.: 7881250 B2

**CofC mailroom date:** 2/23/2011

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**

**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:** CofC for correcting 371 date

/Seema S. Rao/
**SPE**

2462
**Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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WALTER H. SCHNEIDER
21530 BEECHWOOD ROAD
CIRCLEVILLE, OH 43113

MAILED
AUG 22 2011
OFFICE OF PETITIONS

In re Patent No. 6,897,333 :
Issue Date: May 24, 2005 :
Application No. 10/466,713 : ON PETITION
Filed: November 24, 2003 :
Attorney Docket No. 1764 :

This is a decision on the petition under 37 CFR 1.378(c), filed July 1, 2011, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED** as time barred.

This patent expired on May 24, 2009 for failure to pay the 3-½ 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 571-272-1642.

April M. Wise
Petitions Examiner
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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WALTER H. SCHNEIDER
21530 BEECHWOOD ROAD
CIRCLEVILLE, OH 43113

MAILED
OCT 14 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 6,897,333 | : | |
| Issue Date: May 24, 2005 | : | |
| Application No. 10/466,713 | : | ON PETITION |
| Filed: November 24, 2003 | : | |
| Attorney Docket No. 1764 | : | |

## CORRECTED DECISION

This is a decision on the petition under 37 CFR 1.378(c), filed July 1, 2011, to accept the delayed payment of a maintenance fee for the above identified patent.

The petition is **GRANTED**.

This patent expired on May 24, 2009 for failure to pay the 3 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 copy of the petition will be accepted in place of the petition shown to have been mailed (or transmitted by facsimile on July 9, 2009.

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.

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
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Alexandria, VA 22313-1450
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**KNOBBE MARTENS OLSON & BEAR LLP**
**2040 MAIN STREET**
**FOURTEENTH FLOOR**
**IRVINE CA 92614**

**MAILED**

AUG 16 2010

**OFFICE OF PETITIONS**

ON PETITION

| | | |
|---|---|---|
| In re Patent No. 7,449,989 | : | |
| Issue Date : November 11, 2008 | : | |
| Application No. 10/467,034 | : | |
| Filed: August 1, 2003 | : | |
| Attorney Docket No. FBRIC41.001APC | : | |

This is a decision on the petition filed June 15, 2010, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee information 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 Diane C. Goodwyn at (571) 272-6735. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Thurman K. Page
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

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APR 28 2011
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Squire, Sanders & Dempsey (US) LLP
8000 TOWERS CRESCENT DRIVE
14TH FLOOR
VIENNA VA 22182-6212

| | | |
|---|---|---|
| In re Patent No. 7,551,576 | : | |
| Issue Date: June 23, 2009 | : | |
| Application No. 10/467,276 | : | DECISION ON PETITION |
| Filed: August 6, 2003 | : | |
| Attorney Docket No. 47092.00053 | : | |

This is a decision on the Petition To Accept Request For Certificate Of Correction Under 37 C.F.R. §1.183 and Request For Certificate Of Correction, filed July 30, 2009, which is being treated as Petition Under 37 CFR §3.81(b), to identify the correct assignee's name. A completed Certificate of Correction Form (PTO/SB/44) was submitted with Petition.

The petition under 37 CFR §3.81(b) is **GRANTED**.

Petitioner urges that the present Petition was submitted to correct the assignee's name on the previously submitted PTOL 85B. Accordingly, petitioner requests, in effect, that the Title Page of the above-identified patent be corrected, via issuance of Certificate of Correction, to correct the assignee's name identified thereon from:

"Nokia Corporation"

to:

--Nokia Siemens Networks Oy--

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

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

The requisite $100.00 fee (Fee Code 1811), as set forth under 37 CFR §1.20(a), and the requisite $130.00 processing fee (Fee Code 1464), as set forth under 37 CFR §1.17(i), have been submitted. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR §3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the Form (PTO/SB/44) submitted with Petition.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

Any questions concerning the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (703)756-1814.

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,551,576.

Cheryl Gibson-Baylor

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

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AUG 09 2010

OFFICE OF PETITIONS

**HOGAN LOVELLS US LLP**
**1999 AVENUE OF THE STARS**
**SUITE 1400**
**LOS ANGELES CA 90067**

In re Application of

**KIM,** Jong-Hae
Application No. 10/467,520
Filed: August 20, 2004
Attorney Docket No. **88500.0001**

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 14, 2010.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Troy Schmelzer on behalf of all attorneys of record who are associated with customer No. 26021. All attorneys/agents associated with the Customer Number 26021 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the inventor Jong-Hae Kim at the address indicated below. There is an outstanding Office action mailed May 07, 2010 that requires a reply from the applicant.

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

/Tredelle D. Jackson/
Paralegal Specialist
Office of Petitions

cc: **JONG-HAE KIM**
**818 N. PACIFIC AVENUE #E**
**GLENDALE CA 91203**

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 04/16/11

TO SPE OF : ART UNIT 1742

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/467,894 Patent No.: 7,749,417

CofC mailroom date: 3/21/11

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**

**RoChaun Johnson**
**Certificates of Correction Branch**
**703-756-1580**

**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:** _____

/Christina Johnson/ AU 1742

SPE Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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DOBE LAW GROUP, LLC
7207 HANOVER PARKWAY
SUITE C/D
GREENBELT MD 20770

MAILED

SEP 16 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Luger | : | |
| Application No. 10/467,993 | : | NOTICE |
| Filed: August 14, 2003 | : | |
| Attorney Docket No. 966927.00038 | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed August 18, 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) 272-3230.

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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THE NATH LAW GROUP
112 South West Street
Alexandria, VA 22314

**MAILED**

MAR 28 2011

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,155,874 | : | |
| Issue Date: January 2, 2007 | : | |
| Application No. 10/468,063 | : | ON PETITION |
| Filed: August 14, 2003 | : | |
| Patentee(s): Dae-Jun Lee | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed on February 1, 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.

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

**RAMBUS INC.**
**C/O Ann Williams**
**4440 EL CAMINO REAL**
**LOS ALTOS CA 94022**

MAILED

OCT 12 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,290,162 | : | |
| Issued: October 30, 2007 | : | |
| Application No. 10/468,168 | : | ON PETITION |
| Filed: February 11, 2004 | : | |
| Attorney Docket No. HASE0005 | : | |

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

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

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

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

The address given on the petition differs from the new 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 inquires concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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JUN 14 2011

OFFICE OF PETITIONS

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

In re Patent No. 7,927,623
Issued: April 19, 2011
Application No. 10/468,208
Filing or 371(c) Date: August 18, 2003
Dkt. No.: 0020-5164P

: DECISION ON APPLICATION FOR
: PATENT TERM ADJUSTMENT

This is a decision on the application for patent term adjustment under 37 CFR 1.705(d) filed on June 2, 2011 requesting a decrease in patent term adjustment from 1246 days to 1209 days.

The petition for reconsideration of the patent term adjustment is **DISMISSED**.

The above-identified application matured into U.S. Patent No. 7,927,623 on April 19, 2011. The patent issued with a patent term adjustment of 1246 days. The instant application for patent term adjustment was timely filed June 2, 2011.

Patentees assert that the period of overlap between the adjustments under 37 CFR 1.702(a) and 1.702(b) is 37 days.

The calculation of adjustment has been carefully reviewed and no error has been found. The period of adjustment under 37 CFR 1.702(a) is 703 days. The period of adjustment under 37 CFR 1.702(b) is 723 days. Considering the excluded period, the Office has determined that there are zero days of overlap between the two periods of adjustment.

As patentees have not been granted the relief requested, no adjustment to the patent term will be made.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Attorney Advisor
Office of Petitions

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NOV 22 2011

PCT LEGAL ADMINISTRATION

KUBOVCIK & KUBOVCIK
SUITE 1105
1215 SOUTH CLARK STREET
ARLINGTON VA 22202

In re Application of:
KUBO, Kenzo, et al.
U.S. Application No.: 10/468,255
PCT No.: PCT/JP2002/001523
International Filing Date: 21 February 2002
Priority Date: 21 February 2001
Attorney's Docket No.: TGW-001
For: POLYPHENYLENE SULFIDE MEMBER AND METHOD FOR PRODUCING THE SAME

DECISION

This decision is issued in response to the "Request For Corrected Notice Of Acceptance Of Application" and "Request For Corrected Filing Receipt" filed 30 January 2004. No petition fee is required.

## BACKGROUND

On 21 February 2002, applicant filed international application PCT/JP2002/001523. The international application claimed a priority date of 21 February 2001, and it designated the United States. On 29 August 2002, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submitting the basic national fee was thirty months from the priority date, i.e., 21 August 2003.

On 19 August 2003, applicants filed a Transmittal Letter requesting entry into the U.S. national stage accompanied by, among other materials, payment of the basic national fee and an English translation of the international application as filed.

On 11 September 2003, applicants filed, among other materials, an executed declaration and the surcharge for filing the declaration later than thirty months after the priority date.

On 12 December 2003, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Acceptance" (Form PCT/DO/EO/903) identifying the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements" as 19 August 2003 and the "Date Of Receipt Of All U.S.C. 371 Requirements" as 11 September 2003. Also on 12 December 2003, a filing receipt was issued that identified the "Filing Or 371(c) Date" as 19 August 2003.

On 30 January 2004, applicants filed the "Request For Corrected Notice Of Acceptance Of Application" and the "Request For Corrected Filing Receipt" considered herein.[1]

On 12 September 2011, the USPTO mailed a "Notice Of Allowance And Fee(s) Due" (Form PTOL-85).

## DISCUSSION

### 1. Request For Corrected Notification Of Acceptance

The "Request For Corrected Notice Of Acceptance Of Application" seeks to correct the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements" from 19 August 2003 to 11 September 2003. The submission also requests correction of the filing dates for the Preliminary Amendment, Oath or Declaration, Request for Immediate Examination, and Assignee Statement, and removal of the indication that an Information Disclosure Statement was filed on 19 August 2003.

A review of the application file confirms that the executed declaration completing the final requirement of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) was filed on 11 September 2003. The correct "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements" is therefore 11 September 2003. In addition, the materials filed by applicants here (including the itemized "Receipt Of Filing Of Papers" bearing a USPTO receipt stamp dated 11 September 2003) confirm that the correct filing date for the Preliminary Amendment, the Request for Immediate Examination, and the Assignee Statement is 11 September 2011, as asserted by applicants herein. Finally, the file does not include an Information Disclosure Statement filed on 19 August 2003.

In view of the above, the Notification Of Acceptance (Form PCT/DO/EO/903) mailed 12 December 2003, which incorrectly identified the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements" as 19 August 2003 and the filing dates of some of the application elements, is appropriately vacated.

As requested by applicants in the "Request For Corrected Notice Of Acceptance Of Application," a corrected Notification of Acceptance will be issued that: (1) identifies the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4)" and the "Date Of Completion Of All U.S.C. 371 Requirements" as 11 September 2003; (2) correctly identifies the filing dates of the Preliminary Amendment, Oath or Declaration, Request for Immediate Examination, and Assignee Statement as 11 September 2003; and (3) removes the reference to an Information Disclosure Sheet.

### 2. Request For Corrected Filing Receipt

The "Request For Corrected Filing Receipt" seeks to correct the "Filing Or 371(c) Date" listed on the filing receipt, as well as the title, the number of drawings, and the number of independent claims.

---

[1] Applicants filed renewed requests for a corrected filing receipt on 01 April 2005 and on 19 October 2009.

Based on the above correction of the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4)," a corrected filing receipt identifying the "Filing Or 371(c) Date" as 11 September 2003 will be issued. A review of the application file also confirms that the application as filed did not include any drawings, and it included two independent claims. Accordingly, the corrected filing receipt will be corrected with respect to the number of drawings and independent claims.

With respect to the request to correct the title contained in the request for a corrected filing receipt, such correction was previously made in a revised filing receipt issued on 23 October 2009.

## CONCLUSION

The "Request For Corrected Notice Of Acceptance Of Application" and "Request For Corrected Filing Receipt" are **GRANTED** to the following extent.

The Notification Of Acceptance (Form PCT/DO/EO/903) mailed 12 December 2003, which incorrectly identified the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements" as 19 August 2003, is hereby **VACATED.**

The "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements" and the "Filing Or 371(c) Date" is corrected to 11 September 2003.

This application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including (1) issuing a corrected Notification of Acceptance (Form PCT /DO/EO/903) correcting the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements" and the filing dates for the Preliminary Amendment, Oath or Declaration, Request for Immediate Examination, and Assignee Statement to 11 September 2003, and removing the reference to an Information Disclosure Statement; and (2) issuing a corrected filing receipt identifying the "Filing Or 371(c) Date" as 11 September 2003 and indicating that the application contains no drawings and includes two independent claims.

/RichardMRoss/

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

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**POST OFFICE BOX 1404**
**ALEXANDRIA, VA 22313-1404**

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MAR 15 2011

**OFFICE OF PETITIONS**

In re Application of
**Clement FLORENCE**, et *al.*
Application No. 10/468,461
Filed: February 9, 2004
Attorney Docket No. **1022702-000050**

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 14, 2011.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others.

The request was signed by Teresa S. Rea on behalf of all attorneys of record. Teresa S. Rea has been withdrawn as attorney or agent of record; all other attorneys remain of record.

The correspondence address of record remains unchanged.

There is an outstanding Office action mailed November 16, 2010 that requires a reply from the applicant.

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

/Monica A. Graves/
Petitions Examiner, Office of Petitions

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

| | | |
|---|---|---|
| In re Application of | : | |
| Kabulesh Mafatlal Khamar et al. | : | |
| Application No. 10/468,467 | : | ON PETITION |
| Filed: January 20, 2006 | : | |
| Attorney Docket No. 21059/0206953-us0 | : | |

This is a decision on the petition filed September 7, 2010 under the unintentional provisions of 37 CFR 1.137(b), to revive the above-identified application.

The petition is **DISMISSED**.

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

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 3, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 4, 2010.

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

As to item 3, the statement of unintentional delay is presently not acceptable because the petition was not signed.

The power of attorney filed on September 7, 2010 is not acceptable. A proper statement under 3.73(b) must be submitted, authorizing an individual(s) to act on behalf of the assignee. At this time the power of attorney can not be made of record. Refer to Form No. PTO/SB/96.

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

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

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

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

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Jerry Cohen
Burns & Levinson, LLP
125 Summer Street
Boston, MA 02110

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**BURNS & LEVINSON, LLP**
**125 SUMMER STREET**
**BOSTON MA 02110**

**MAILED**
DEC 07 2010
**OFFICE OF PETITIONS**

In re Application of :
Kabulesh Mafatlal Khamar et al. :
Application No. 10/468,467 : ON PETITION
Filed: January 20, 2006 :
Attorney Docket No. 21059/0206953-us0 :

This is a decision on the renewed petition filed November 18, 2010 under the unintentional provisions of 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 3, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 4, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1,620 and (3) a proper statement of unintentional delay. Accordingly, the amendment is accepted as being unintentionally delayed.

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

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 1648 for appropriate action by the Examiner in the normal course of business on the reply received November 18, 2010.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/468,467 | 01/20/2006 | Kabulesh Mafatlal Khamar | 21059/0206953-us0 |

**CONFIRMATION NO. 1961**

**POA ACCEPTANCE LETTER**

26486
BURNS & LEVINSON, LLP
125 SUMMER STREET
BOSTON, MA 02110

*OC000000044789734*

Date Mailed: 12/03/2010

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/07/2010.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

/kainabinet/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/468,514 | 01/21/2004 | Claudio Cenedese | WZP1-35864 | 4542 |

116 7590 02/08/2011
PEARNE & GORDON LLP
1801 EAST 9TH STREET
SUITE 1200
CLEVELAND, OH 44114-3108

| EXAMINER |
|---|
| PRESTON, JOHN O |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3691 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 02/08/2011 | 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.

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FEB - 7 2011

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

| | | |
|---|---|---|
| In re Application of<br>CENEDESE et al.<br>Application No. 10/468,514<br>Filed: August 19, 2003<br>For: KITCHEN AND/OR DOMESTIC APPLIANCE | :<br>:<br>:<br>:<br>:<br>: | DECISION ON PETITION REGARDING REQUEST TO WITHDRAWAL FINALITY UNDER 37 CFR §1.181 |

This is a decision on applicants' petition under 37 CFR 1.181 filed June 16, 2010 requesting withdrawal of the finality of the Office action mailed June 8, 2010.

The petition is **GRANTED to the extent indicated below.**

A review of the file record indicates that a non-final Office action was mailed May 18, 2009. In response to an amendment filed September 1, 2009, the examiner finally rejected the claims over a combination of references, including Kawasaki. In a response filed April 30, 2010, applicants disqualified the Kawasaki reference. In the final Office action mailed June 8, 2010, the "examiner established new grounds of rejection for claims 31-49 and 51-62." The Examiner further indicated that "since the new grounds of rejection were necessitated by applicant's previous amendment of the claim(s), the rejection of claims 31-49 and 51-62 is a final rejection of the claim(s)." The examiner withdrew the December 4, 2009 final rejection and replaced it with the June 8, 2010 final rejection.

Petitioner argues that "the new ground of rejection introduced by the Examiner [in the June 8, 2010 final rejection] was neither "necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement." Accordingly, it should not be made final." Petitioner requests that a new, non-final action be issued and the time for reply be reset.

MPEP 706.07(a) sets forth that the second or any subsequent action on the merits shall be made final except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Since the only amendatory changes to the claims in the April 30, 2010 response was a change in dependency of claims 51-54 from cancelled claim 50 to pending claim 31, clearly the new grounds of rejection of the claims in the June 8, 2010 final Office action was not necessitated by amendment. Therefore, the finality of the June 8, 2010 Office action is premature. Accordingly, the finality of the Office action, **but not the action itself**, is hereby withdrawn. The Office action mailed June 8, 2010 is now considered to be non-final and the shortened statutory period for response continues to run THREE (3) MONTHS from the date of the mailing of the Office action. Therefore, applicant's request for the time period for reply to be reset is denied.

Summary: The petition is **GRANTED to the extent indicated above.**

Questions concerning this decision should be referred to Teri Luu, Quality Assurance Specialist, at (571) 272-7045.

Wynn Coggins, Director
Patent Technology Center 3600
Telephone No.: (571)-272-5350

WC:tl 02/04/11

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SEP 15 2010

**OFFICE OF PETITIONS**

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

| | | |
|---|---|---|
| In re Patent of Holger Plote et al. | : | DECISION ON REQUEST |
| Patent No. 7,647,764 | : | FOR RECONSIDERATION OF |
| Issue Date: January 19, 2010 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/468,662 | : | AND NOTICE OF INTENT TO |
| Filing Date: January 23, 2004 | : | ISSUE CERTIFICATE OF |
| Attorney Docket No. 10191/3339 | : | CORRECTION |

This is a decision on the request filed May 21, 2010, requesting reconsideration of the decision issued April 21, 2010, in response to a "Request for Recalculation of Patent Term Adjustment in View of *Wyeth*." The instant request is requesting the patent term adjustment indicated on the patent be corrected to indicate the term of the patent is extended or adjusted by four hundred nine (409) days.

The request to correct the patent term adjustment indicated on the patent to indicate the term of the patent is extended or adjusted by four hundred nine (409) days is **GRANTED**.

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

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **four hundred nine (409)** days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**UNITED STATES PATENT AND TRADEMARK OFFICE**

# CERTIFICATE OF CORRECTION

| | | |
|---|---|---|
| PATENT NO. | : | 7,647,764 B2 |
| APPLICATION NO. | : | 10/468,662 |
| DATED | : | January 19, 2010 |
| INVENTOR(S) | : | Holger Plote et al. |

**DRAFT**

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

On the Title page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 781 days.

Delete the phrase "by 781 days" and insert -- by 409 days--

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Paper No.

Accenture c/o Murabito, Hao & Barned LLP
Two North Market Street, Third Floor
San Jose CA 95113

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| | | |
|---|---|---|
| In re Application of | : | |
| Rippert et al. | : | |
| Application No. 10/468,785 | : | DECISION ON PETITION |
| Filed: February 4, 2004 | : | PURSUANT TO |
| Attorney Docket No.: ACNR- | : | 37 C.F.R. § 1.137(B) |
| D01-016/01294-00/US | : | |
| Title: DISTRIBUTED | : | |
| DEVELOPMENT ENVIRONMENT FOR | : | |
| BUILDING INTERNET | : | |
| APPLICATIONS BY DEVELOPERS | : | |
| AT REMOTE LOCATIONS | : | |

This is a decision on the petition pursuant to 37 C.F.R. § 1.137(b), filed September 16, 2010, to revive the above-identified application.

This petition pursuant to 37 C.F.R. § 1.137(b) is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed March 29, 2010, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue[1] or publication fees.[2] Accordingly, the above-identified application became abandoned on June 30, 2010. A Notice of Abandonment was mailed on July 16, 2010.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

(1) The reply required to the outstanding Office

1 See MPEP § 710.02(e)(III).
2 See 37 C.F.R. § 1.211(e).

action or notice, unless previously filed;
(2) The petition fee as set forth in 37 C.F.R. § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
(4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

With this petition, Applicant has submitted the issue, publication, and petition fees, along with the proper statement of unintentional delay. As such, requirements one through three of Rule 1.137(b) have been met. The fourth requirement of Rule 1.137(b) is not applicable, as a terminal disclaimer is not required.[3]

The Office of Patent Publication will be notified of this decision so that the present application can be processed into a patent.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the revival has been acknowledged by the Office of Patent Publication in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Office of Patent Publication where that change of status must be effected - **the Office of Petitions cannot effectuate a change of status.** Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[4] All other inquiries concerning the status of the application should be directed to the Office of Patent Publication at 571-272-4200.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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3 See Rule 1.137(d).
4 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

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PO BOX 7068
PASADENA, CA 91109-7068

| | | |
|---|---|---|
| In re Patent No. 7,214,211 | : | |
| Issue Date: May 8, 2007 | : | |
| Application No. 10/468,923 | : | ON PETITION |
| Filed: February 2, 2004 | : | |
| Attorney Docket No.: 50891/THD/K163 | : | |

This is a decision on the petition, filed June 28, 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 May 8, 2011 for failure to pay the first 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 3 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. Petitioner is reminded, however, that the mere filing of a change of correspondence address does not affect fee address. Therefore, if petitioner desires to receive future correspondence regarding any Maintenance Fee Reminder which may be mailed regarding maintenance fees for the above-identified patent, an appropriate "fee address" and/or "customer number" form should be submitted to the Maintenance Fee Division. A courtesy copy of this decision is being mailed to the address given on the petition.

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: TOM H. DAO
18200 VON KARMAN AVENUE, SUITE 725
IRVIN, CA 92612

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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MAILED

SEP 13 2010

OFFICE OF PETITIONS

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

In re Application
Jeffrey Mark Huxter et al.
Application No. 10/468,972
Filed: November 15, 2005
Attorney Docket No. 026032-4432

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR PATENT APPLICATION UNDER 37 C.F.R. §1.705(b) filed July 27, 2010. Applicant requests that the determination of patent term adjustment be corrected from 180 to 1052 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and is considered in light of the recent court decision in light of the Court of Appeals for the Federal Circuit's decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the patent term adjustment relating to those provisions until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for

continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.[1]

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within two months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

[1] For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 03/29/11

TO SPE OF : ART UNIT 3636

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/468,972 Patent No.: 7,815,258

CofC mailroom date: 12/08/10

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**

RoChaun Johnson
**Certificates of Correction Branch**
**703-756-1580**

**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:** _____

DAVID DUNN
SUPERVISORY PATENT EXAMINER
SPE

3616
Art Unit

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DEC 14 2010

OFFICE OF PETITIONS

PROSKAUER ROSE LLP
ONE INTERNATIONAL PLACE
BOSTON MA 02110

| | | |
|---|---|---|
| In re Patent No. 7,740,014 | : | DECISION ON |
| Per Gisle Djupesland | : | PATENT TERM ADJUSTMENT |
| Issue Date: June 22, 2010 | : | AND NOTICE OF INTENT |
| Application No. 10/469,103 | : | TO ISSUE |
| Filed: February 6, 2004 | : | CERTIFICATE OF |
| Attorney Docket No. 44508-080 | : | CORRECTION |

This is a decision on the "REQUEST FOR CORRECTION OF THE PATENT TERM ADJUSTMENT", filed August 20, 2010. Patentee requests that the patent term adjustment indicated on the patent be corrected from six hundred eighty-eight (688) days to seven hundred sixty-three (763) days.

The request is **GRANTED**.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **seven hundred sixty-three (763)** days.

On June 22, 2010, the above-identified application matured into U.S. Patent No. 7,740,014. The instant request for reconsideration filed August 20, 2010 was timely filed within two months of the date the patent issued. The Patent issued with a Patent Term Adjustment of six hundred eight-eight (688) days. Patentee states that they should not have been assessed applicant delay of seventy-five (75) days for the submission of a "REQUEST FOR CORRECTION OF THE FOREIGN PRIORITY DATE" after the mailing of the Notice of Allowance, because the request was

previously made on April 2, 2009 and November 23, 2009, with no action being made by the Office.

Under the circumstances of this case, it is concluded that the filing of applicant's "REQUEST FOR CORRECTION OF THE FOREIGN PRIORITY DATE" on April 9, 2010 is not a failure to engage under 37 C.F.R. §1.704(c)(10). A review of the record reveals that applicant previously submitted a request to have the foreign priority date corrected on April 2, 2009 and November 23, 2009. However, the BIB Data Sheet mailed with the Notice of Allowance did not include the correct foreign priority date. As this was the first opportunity for applicants to correct this error, the assessment of seventy-five (75) days of applicant delay with respect to this filing is not warranted.

In view thereof, the correct determination of PTA at the time of issuance is **seven hundred sixty-three (763)** days (1130 days of PTO delay, reduced by 367 days of applicant day).

Receipt of the $200.00 fee set forth in 37 C.F.R. §1.18(e) is acknowledged.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. See 35 U.S.C. § 254 and 37 C.F.R. § 1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **seven hundred sixty-three (763)** days subject to any disclaimers.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Anthony Knight
Director
Office of Petitions

Enc: draft certificate of correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# DRAFT CERTIFICATE OF CORRECTION

PATENT : 7,740,014 B2

DATED : **June 22, 2010**

INVENTOR(S) : Djupesland

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 688 days.

Delete the phrase "by 688 days" and insert – by 763 days--

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

**DATE:** June 23, 2011
**TO:** Certificates of Correction Branch
**FROM:** Gary Nickol
SPE, Art Unit 1645
**SUBJECT:** REQUEST FOR CERTIFICATE OF CORRECTION

Please issue a Certificate of Correction in U. S. Letters Patent No. 7348010 as specified on the attached Certificate.

/Gary B. Nickol/

Gary Nickol, SPE
Art Unit 1645

# UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE

Patent No. 7348010
Patented: 03/25/2008

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:

Christoph Zielinski
Otto Scheiner
Erika Jensen-Jarolim
Heimo Breiteneder
Hubert Pehamberger
Ursula Wiedermann

/Gary B. Nickol/

Gary Nickol
Supervisory Patent Examiner
Art Unit 1645

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**Dolby Laboratories Inc.**
**100 Potrero Avenue**
**San Francisco CA 94103-4938**

MAILED

SEP 14 2010

OFFICE OF PETITIONS

In re Application of :
Lorne Whitehead et al. :
Application No. 10/469,473 :
Patent No. 6,891,672 :
Filed: August 27, 2003 :
Attorney Docket No. **BST03US02**

NOTICE

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

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

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

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

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.

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.

Inquiries related to this communication should be directed to the undersigned at (571) 272-2783.

/Tredelle D. Jackson/
Paralegal Specialist
Office of Petitions

cc: **OYEN WIGGS GREEN & MUTALA LLP**
**INTELLECTUAL PROPERTY LAWYERS**
**480-THE STATION, 601 WEST CARDOVA ST.**
**VANCOUVER, BRITISH COLUMBIA**
**CANADA V6B 1G1**

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**COOPER & DUNHAM, LLP**
**30 ROCKEFELLER PLAZA**
**20TH FLOOR**
**NEW YORK NY 10112**

**MAILED**

OCT 25 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Masahiro TAKIZAWA et al. | : | |
| Application No. 10/469,566 | : | DECISION ON PETITION |
| Filed: August 29, 2003 | : | |
| Attorney Docket No. 1141/70988 | : | |

This is a decision on the petition, filed June 16, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to reply to the final Office action mailed October 01, 2009, which set a three (3) month shortened statutory period for reply. The application became abandoned on January 02, 2010.

Petitioner asserts that the final Office action dated October 01, 2009 was not received.

A review of the written record indicates no irregularity in the mailing of the Office action and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

1. a statement from practitioner stating that the Office action was not received by the practitioner;

2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and

3. a copy of the docket record where the nonreceived Office action would have been entered had it been received and docketed must be attached to and referenced in the practitioner's statement.

*See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The petition satisfies the above-stated requirements. Accordingly, the application was not abandoned in fact.

In view of the above, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Telephone inquiries concerning this decision should be directed to Michelle R. Eason at (571) 272-4231.

This application is being referred to the Technology Center technical support staff of Art Unit 3768 for re-mailing the final Office action of October 01, 2009. The period for reply will run from the mailing date of the Office action.

Thurman K. Page
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/469,591 | 09/02/2003 | Nikolaj Deichmann | P69114US0 | 1514 |

21839 7590 06/03/2011
BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

| EXAMINER |
|---|
| GEBRESILASSIE, KIBROM K |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2128 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 06/03/2011 | 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):

ADIPFDD@bipc.com
offserv@bipc.com

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BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA VA 22313-1404

In re Application of:
DEICHMANN, Nikolaj et al.
Application No. 10/469,591
Filed: September 2, 2003
For: **METHOD FOR MODELING CUSTOMIZED EARPIECES**

**DECISION ON PETITION UNDER 37 C.F.R. § 1.84(a)(2) TO ACCEPT COLOR DRAWINGS**

This is a decision on the petition under 37 C.F.R. § 1.84(a)(2), filed on May 9, 2011, requesting acceptance of color drawings.

The petition requests that the color drawings of Figures 5-7, 10-13, 16, 18-20, 22-26, 30, 31, 33, 37-39 and 41 be accepted in lieu of black and white drawings.

A grantable petition under 37 C.F.R. § 1.84(a)(2) must be accompanied by a fee set forth under 37 C.F.R. § 1.17(h), 3 (three) sets of the color drawings in question, and the specification must contain, or be amended to contain, the following language as the first paragraph in that portion of the specification relating to the brief description of the drawings:

*"The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawings will be provided by the U.S. Patent and Trademark Office upon request and payment of the necessary fee."*

The petition was filed with the required fee and was filed with three (3) sets of color drawings of Figures 5-7, 10-13, 16, 18-20, 22-26, 30, 31, 33, 37-39 and 41. The amendment filed May 9, 2011 to the specification contains the required notification described above.

Accordingly, the petition is **GRANTED**.

Any inquiry regarding this decision should be directed to Eddie C. Lee at (571) 272-1732.

/Eddie C. Lee/

Eddie C. Lee
Quality Assurance Specialist, TC 2100

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AUG 04 2010

OFFICE OF PETITIONS

**MYERS BIGEL SIBLEY & SAJOVEC**
**PO BOX 37428**
**RALEIGH, NC 27627**

| | | |
|---|---|---|
| In re Application of | : | |
| Lane et al. | : | |
| Application No. 10/469,626 | : | ON PETITION |
| Filed: August 22, 2003 | : | |
| Attorney Docket No. 9013-55 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 12, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, August 24, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on November 25, 2009. A Notice of Abandonment was mailed April 29, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment , (2) the petition fee of $810 , and (3) a proper statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $555 extension of time fee submitted with the petition on June 9, 2010, was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account as authorized.

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

This application is being referred to Technology Center 1656 for further examination on the merits

Carl Friedman
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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FREDRIKSON & BYRON, P.A.
INTELLECTUAL PROPERTY GROUP
200 SOUTH SIXTH STREET, SUITE 4000
MINNEAPOLIS MN 55402

MAILED
NOV 22 2011
OFFICE OF PETITIONS

In re Application of :
Albrecht Wuthrich :
Application No. 10/469,659 :
Filed: February 3, 2004 :
Attorney Docket No. **49477.2.1** :

NOTICE

This is a notice regarding your request filed October 28, 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**.

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) 272-4584.

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
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**SOROKER-AGMON ADVOCATE AND PATENT ATTORNEYS**
**NOLTON HOUSE, 14 SHENKAR STREET**
**HERZELIYA PITUACH 46725 IL ISRAEL**

**MAILED**
JUN 30 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Weintraub et al. | : | |
| Application No. 10/469,685 | : | ON PETITION |
| Filed: September 3, 2003 | : | |
| Attorney Docket No. 4186/20 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 7, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Amendment and an Information Disclosure Statement (IDS), (2) the petition fee of $810.00, and (3) a proper statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since any extension of time fee submitted with the petition would be considered subsequent to the maximum extendable period for reply, the fee would be unnecessary. Accordingly, petitioner's deposit account will not be charged an extension of time fee.

As the Power of Attorney was only recently given to the petitioner, it is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

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

This matter is being referred to Technology Center AU 3772 for further examination on the merits.

*/Liana Walsh/*
Liana Walsh
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : June 28, 2011

**TO SPE OF** : ART UNIT 3617

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10469711 Patent No.: 7921782

CofC mailroom date: June 22, 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:** _____

**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:** Changes to specification are Ok, Changes to CLAIMS are NOT OK and NOT Approved.

See Attached explanation

3617

The proposed changes to the claims are NOT acceptable and NOT APPROVED for the following reasons:

REASON 1: Proposed claim 1 of the certificate does not correspond to any claim issued by the examiner. While proposed claim 1 of the certificate *substantially* corresponds to claim 1 of the patent (issued claim 29 of the application), the limitation of patent claim 1 that appears on lines 54-55 of column 10 which states: "wherein the vehicle is readily releasably coupled to the carriage system via a coupling system; and" has been removed in the proposed certificate claim, and therefore proposed claim 1 of the certificate is broader in scope than the claim that was issued by the examiner during examination. It is noted applicant has not provided an explanation as to why claim 1 of the patent was altered.

REASON 2: Proposed claims 10-18 of the certificate do not correspond to any claims issued by the examiner. It is noted applicant has not provided an explanation for the inclusion of these proposed claims in the certificate.

REASON 3: Claims 6-10 of the patent (which correspond to issued claims 60-64 of the application) have been eliminated by the proposed certificate. It is noted applicant has not provided an explanation as to why these claims of the patent were eliminated.

REASON 4: Proposed claim 21 of the certificate does not correspond to any claim issued by the examiner. While proposed claim 21 of the certificate substantially corresponds to claim 13 of the patent (issued claim 71 of the application), the limitation in patent claim 13 that appears on lines 45-46 of column 12 which reads: ", the second portion of the coupling system" has been changed to (emphasis added) ", the second **half** of the coupling system" in the proposed certificate claim, and therefore proposed claim 21 of the certificate is different in scope than the claim that was issued by the examiner during examination. It is noted applicant has not provided an explanation as to why the scope of patent claim 13 was changed.

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Alexandria, VA 22313-1450
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MAILED
JUN 09 2011
PCT LEGAL ADMINISTRATION

MARTIN D. MOYNIHAN d/b/a PRTSI, INC.
P.O. BOX 16446
ARLINGTON VA 22215

In re Application of
LIVNEH et al.
Application No.: 10/469,992
Filed: September 16, 2003
Attorney Docket No.: 26315
For: METHODS AND KITS FOR DETERMINING A RISK TO DEVELOP CANCER, FOR EVALUATING AN EFFECTIVENESS AND DOSAGE OF CANCER THERAPY AND FOR CORRELATING BETWEEN AN ACTIVITY OF A DNA REPAIR ENZYME AND A CANCER

DECISION ON PETITION

This is a decision on the "Petition To Accept An Unintentionally Delayed Claim of Benefit of Earlier Filing Date and Cross-Reference to Other Applications (37 CFR 1.78(a)(6)" filed April 4, 2011. Since, the petition seeks acceptance of a claim under 35 U.S.C. § 120 for the benefit of the prior filed nonprovisional application set forth in the concurrently filed amendment the petition has been treated as a petition under 37 CFR 1.78(a)(3).

The petition is GRANTED.

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

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

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the

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

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional application has been included in an amendment filed with present petition, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) applicant's statement that "the entire delay between the date the priority claim was due and the date the priority claim was unintentional" is construed as meaning that "the entire delay between the date the claim was due under 37 CFR 1.78(a)(3) and the date the claim was filed was unintentional." If this is incorrect, petitioner must immediately notify the Office of PCT Legal Administration. As construed, petitioner's statement satisfied item (3) above.

*The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.*

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional applications, was previously mailed on 26 May 2011.

Any inquiries concerning this decision may be directed to Anthony Smith, Attorney Advisor, at (571) 272-3298. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Technology Center Art Unit 1637 for appropriate action on the amendment filed April 04, 2011, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 and 365(c) to the prior-filed application.

Bryan Lin

Bryan Lin
Legal Examiner
Office of Petitions and PCT Legal Administration

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OFFICE OF PETITIONS

CONNOLLY BOVE LODGE & HUTZ LLP
1875 EYE STREET, N.W.
SUITE 1100
WASHINGTON DC 20006

In re Patent No. 7,645,839 :
Issue Date: January 12, 2010 :
Application No. 10/470,098 : DECISION ON PETITION
Filed: November 19, 2004 :
Attorney Docket No. **22106-00036-US1** :

This is a decision on the petition July 8, 2010, requesting issuance of a duplicate Letters Patent for the above-identified patent that is being considered under 37 CFR 1.182.

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

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

The fee for a petition under 37 CFR 1.182 requesting issuance of a duplicate Letter Patent is $400. However, the $130 petition fee submitted will be applied towards the $400 petition fee. Therefore, the balance of $270 will be charged to petitioner's deposit account as authorized.

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

Any questions concerning this matter may be directed to the undersigned at (571) 272-4584. Any questions concerning issuance of the duplicate Letters Patent should be directed to Niomi Farmer at (703)756-1556.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Niomi Farmer, P/ODM, Randolph Square Building, 9th Floor, 09/D30-B
FAX No. (571) 270-9753

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BACHMAN & LAPOINTE
SUITE 1201
900 CHAPEL STREET
NEW HAVEN CT 06510-2802

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AUG 08 2011

OFFICE OF PETITIONS

In re Patent Number: 7,066,067 :
Issue Date: 06/27/2006 :
Application Number: 10/470,222 : NOTICE
Filing or 371(c) Date: 12/05/2003 :
Attorney Docket Number: 03-481 :

This is a notice regarding your request for acceptance of a fee deficiency submission, which is treated under 37 CFR 1.28, filed on June 27, 2011.

The Office no longer investigates or rejects original or reissue patents 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) 272-3231.

D Wood

Douglas Wood
Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 04/11/11

TO SPE OF : ART UNIT: 1636 Attn: GROSS CHRISTOPHER M

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/470296 Patent No.: 7645721

C of C Mailroom date: 03/29/11

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**

**Tasneem Siddiqui**
**Certificates of Correction Branch**
**703-756-1593 or 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:** _____

ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER

SPE

1636
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
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) |
|---|---|---|---|---|
| 6998439 | 2006-02-14 | 10470401 | 2003-11-21 | ID 058511 |

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

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) | 2011-12-27 |
| 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. 6998439
Issue Date: February 14,2006
Application No. 10470401
Filed: November 21,2003
Attorney Docket No. TAIYO52.001APC

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

This is a decision on the electronic petition, filed December 27,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 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.

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OFFICE OF PETITIONS

**GLAXOSMITHKLINE**
**GLOBAL PATENTS -US, UW2220**
**P. O. BOX 1539**
**KING OF PRUSSIA PA 19406-0939**

| | | |
|---|---|---|
| In re Application of | : | |
| MacAllister et al. | : | |
| Application No. 10/470,439 | : | DECISION ON PETITION |
| Filed: January 20, 2004 | : | |
| Attorney Docket No. P51319 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 13, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers (Notice) mailed July 16, 2010, which set a shortened statutory period for reply of two (2) months. Accordingly, the above-identified application became abandoned on September 17, 2010. A Notice of Abandonment was mailed on October 7, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) a Replacement drawing, (2) the petition fee of $1,620.00, and (3) a proper statement of unintentional delay.

Further, 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.

This application is being referred to Publishing Division for further processing and review of the Replacement drawing submitted with the instant petition.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Dara L Dinner
GlazoSmithKine, Global Patent, US
709 Swedeland Rd
King of Prussia, PA 19406

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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CHURCH & DWIGHT CO., INC.
LAW DEPT. - PATENTS
469 NORTH HARRISON STREET
PRINCETON, NJ 08543-5297

**MAILED**

OCT 28 2011

**OFFICE OF PETITIONS**

In re Patent No. 7,326,578 :
Issued: February 5, 2008 :
Application No. 10/470,728 : ON PETITION
Filed: August 26, 2003 :
Attorney Docket No: **99121** :

This is a decision regarding the request for acceptance of a fee deficiency submission and loss of small entity status filed October 11, 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.

The 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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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**OSTROLENK FABER GERB & SOFFEN**
**1180 AVENUE OF THE AMERICAS**
**NEW YORK NY 10036-8403**

MAILED

JUN 23 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,315,175 | : | |
| Application No. 10/470,836 | : | |
| Filed: December 11, 2003 | : | ON PETITION |
| Issued: January 1, 2008 | : | |
| Attorney Docket No. P/25-294 | : | |

This is a decision on the petition under 37 CFR 1.182, filed April 24, 2008, requesting issuance of a duplicate Letters Patent for the above-identified application.

The petition is **DISMISSED**.

The file record discloses that the instant application matured into U.S. Patent No. 7,315,175 on January 1, 2008. However, petitioner contends that the patent was never received and that instead "only the photocopies of the patent have been received by Applicants' representative."

The showing required to establish non-receipt of an Office communication must include:

1. A statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received.

2. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.[1]

In the absence of any irregularity there is a strong presumption that the communications was properly mailed to the applicant at the correspondence address of record. This presumption may be overcome by a showing that the aforementioned communications was not in fact received.

The showing in the instant petition is not sufficient to waive the petition fee because practitioner did not include a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

---

[1] See MPEP 711.03(c) and notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

Although petitioner did authorize the $400.00 petition fee to be collected, charging of the fee will be held in abeyance to allow petitioner the opportunity to submit the above documents to show non-receipt. Should petitioner choose not to submit the appropriate documents, instructions to collect the petition fee should be submitted.

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

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

By hand: Customer 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) 272-7751.

/Joan Olszewski/
Joan Olszewski
Petitions Examiner
Office of Petitions

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**OSTROLENK FABER GERB & SOFFEN**
**1180 AVENUE OF THE AMERICAS**
**NEW YORK NY 10036-8403**

MAILED
JUL 22 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,315,175 | : | |
| Application No. 10/470,836 | : | |
| Filed: December 11, 2003 | : | ON PETITION |
| Issued: January 1, 2008 | : | |
| Attorney Docket No. P/25-294 | : | |

This is a decision on the renewed petition under 37 CFR 1.182 filed July 13, 2011 which will be treated as a petition under 37 CFR 1.181 (no fee), requesting issuance of a duplicate Letters Patent for the above-identified patent.

The petition is **DISMISSED**.

Petitioner states that the original Letters Patent was never received and that "only the photocopies of the patent have been received by Applicants' representative."

The Office follows the guidelines set forth in MPEP § 711.03(c) (*see also* "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993), which sets forth that, in the absence of any irregularity in the mailing of an Office action (in this case, the Letters Patent), there is a strong presumption that the Office action (Letters Patent) was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Letters Patent was not in fact received. In this regard, the showing required to establish the failure to receive the Letters Patent must consist of the following:

1. a statement from practitioner stating that the Letters Patent was not received by the practitioner;
2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Letters Patent was not received; and
3. a copy of the docket record where the nonreceived Letters Patent would have been entered had it been received must be attached to and referenced in the practitioner's statement.

The petition is not accompanied by the evidence required to establish nonreceipt of the original Letters Patent. In this regard, petitioner has submitted insufficient docket records

as evidence. Petitioner must submit docket records covering the time period from January 1, 2008 (the date of issuance) until three months after that date.

In view of the above, the petition fails to provide the necessary evidence to establish nonreceipt of the Letters Patent. Accordingly, the petition for issuance of a duplicate Letters Patent under 37 CFR 1.181 cannot be granted at this time.

Although petitioner did authorize the $400.00 petition fee to be collected, charging of the fee will be held in abeyance to allow petitioner the opportunity to submit the above documents to show non-receipt. Should petitioner choose not to submit the appropriate documents, instructions to collect the petition fee should be submitted.

Further, it is not apparent whether the person signing the instant petition was ever given a power of attorney or authorization of agent regarding the above-identified patent. However, 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.

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 Joan Olszewski at (571) 272-7751.

/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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**1180 AVENUE OF THE AMERICAS**
**NEW YORK NY 10036-8403**

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SEP 09 2011
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| | | |
|---|---|---|
| In re Patent No. 7,315,175 | : | |
| Application No. 10/470,836 | : | |
| Filed: December 11, 2003 | : | ON PETITION |
| Issued: January 1, 2008 | : | |
| Attorney Docket No. P/25-294 | : | |

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

The petition is **granted to the extent indicated below**.

Petitioner states that the original Letters Patent was never received and that "only the photocopies of the patent have been received by Applicants' representative."

Additionally, petitioner asserts that "no copy of the Docket record is required in the instant situation." Further, petitioner asserts that "This requirement has absolutely no basis in law or practice and is clearly arbitrary and capricious."

37 CFR 1.182 states:

> All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, **subject to such other requirements as may be imposed**, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f). [Emphasis added]

The Office has consistently followed the guidelines set forth in MPEP § 711.03(c) in order to establish nonreceipt of Office mailings, in this case, the Letters Patent. As such the requirement is not arbitrary and capricious.

As the Office follows the guidelines set forth in MPEP § 711.03(c) (*see also* "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993), which sets forth that, in the absence of any irregularity in the mailing of an Office action (in this case, the Letters Patent), there is a strong presumption that the Office action (Letters Patent) was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Letters Patent was not in fact received. In this regard, the showing required to establish the failure to receive the Letters Patent must consist of the following:

1. a statement from practitioner stating that the Letters Patent was not received by the practitioner;
2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Letters Patent was not received; and
3. a copy of the docket record where the nonreceived Letters Patent would have been entered had it been received must be attached to and referenced in the practitioner's statement.

The instant petition is not accompanied by the evidence required to establish nonreceipt of the original Letters Patent. In this regard, petitioner has submitted insufficient docket records as evidence. Submitting docket records covering the time period from January 1, 2008 **(the date of receipt by petitioner)** until three months after that date would have been required to establish nonreceipt of the original Letters Patent. Petitioner has failed to submit a copy of the docket records starting at the point of receipt by petitioner covering the time period from January 1, 2008 forward for three months. Instead, petitioner has included only the dates of receipt of January 28, 2008 and January 8, 2008.

In view of the above, the petition fails to provide the necessary evidence to establish nonreceipt of the Letters Patent. Accordingly, the petition for issuance of a duplicate Letters Patent under 37 CFR 1.182 cannot be granted at this time.

Petitioner's deposit account will be charged the required duplicate Letters Patent fee of $400.00, as authorized August 19, 2011.

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

A copy of this decision is being forwarded to Publishing Division for issuance of duplicate Letters Patent.

Any questions concerning this matter may be directed to the Joan Olszewski at (571) 272-7751. Any questions concerning issuance of the duplicate Letters Patent should be directed to Ollie Person at 703-756-1555 or Kimberly Terrell at 703-756-1568.

/dab/
David Bucci
Petitions Examiner
Office of Petitions

cc: Ollie Person, RSQ 09 D 30-A (FAX 571-270-9764)
Kimberly Terrell, RSQ 09 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

**OSTROLENK FABER GERB & SOFFEN**
**1180 AVENUE OF THE AMERICAS**
**NEW YORK NY 10036-8403**

MAILED
OCT 11 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,315,175 | : | |
| Application No. 10/470,836 | : | |
| Filed: December 11, 2003 | : | ON PETITION |
| Issued: January 1, 2008 | : | |
| Attorney Docket No. P/25-294 | : | |

This is a decision on the renewed petition, filed October 4, 2011, which is being treated as a petition under 37 CFR 1.181 in which petitioner is seeking a Request for Reconsideration of the September 9, 2011 petition decision in the above-identified patent.

The petition is **DISMISSED**.

Petitioner contends that "petitioner did, in fact, submit a copy of dockets records covering the time period from January 1, 2008 forward for three months.

The petition filed August 19, 2011 and the instant petition were not accompanied by the evidence required to establish nonreceipt of the original Letters Patent. In this regard, petitioner has submitted insufficient docket records as evidence. Submitting docket records covering the time period from **January 1, 2008 (the date of receipt by petitioner)** until three months after that date would have been required to establish nonreceipt of the original Letters Patent. Petitioner has failed to submit a copy of the docket records starting at the point of receipt by petitioner covering the time period from **January 1, 2008** forward for three months. Instead, petitioner has included only the dates of receipt beginning **January 8, 2008**. The dates of receipt covering January 1, 2008 to January 7, 2008 have not been submitted.

In view of the above, the petition fails to provide the necessary evidence to establish nonreceipt of the Letters Patent.

Any questions concerning this matter may be directed to the Joan Olszewski at (571) 272-7751.

/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
Alexandria, VA 22313-1450
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**OSTROLENK FABER GERB & SOFFEN**
**1180 AVENUE OF THE AMERICAS**
**NEW YORK NY 10036-8403**

**MAILED**

NOV 22 2011

**OFFICE OF PETITIONS**

ON PETITION

In re Patent No. 7,315,175 :
Application No. 10/470,836 :
Filed: December 11, 2003 :
Issued: January 1, 2008 :
Attorney Docket No. P/25-294 :

This is a decision on the renewed petition under 37 CFR 1.182 filed October 24, 2011 which will be treated as a petition under 37 CFR 1.181 in which petitioner is seeking a request for reconsideration of the October 11, 2011 petition decision in the above-identified patent.

The petition is **DISMISSED**.

Petitioner asserts that "no patents were received between December 29, 2007 and January 7, 2008 and has currently submitted a copy of "Attachment D" indicating patents received from December 18, 2007 to April 30, 2008.

The Office follows the guidelines set forth in MPEP § 711.03(c) (*see also* "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993), which sets forth that, in the absence of any irregularity in the mailing of an Office action (in this case, the Letters Patent), there is a strong presumption that the Office action (Letters Patent) was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Letters Patent was not in fact received. In this regard, the showing required to establish the failure to receive the Letters Patent must consist of the following:

1. a statement from practitioner stating that the Letters Patent was not received by the practitioner;
2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Letters Patent was not received; and
3. a copy of the docket record where the nonreceived Letters Patent would have been entered had it been received must be attached to and referenced in the practitioner's statement.

Petitioner lacks items (2) and (3).

With respect to item (2) petitioner has failed to submit a statement attesting to the fact that a search of the file jacket and docket records indicates that the Letters Patent was not received.

With respect to item (3) petitioner contends in the petitions filed April 24, 2008, July 13, 2011 and August 19, 2011 that "only the photocopies of the patent have been received by Applicants' representative." However, petitioner's docket records do not show receipt of these photocopies. Petitioner should explain why receipt of these photocopies does not appear in petitioner's docket records.

In view of the above, the petition fails to provide the necessary evidence to establish nonreceipt of the Letters Patent.

Any questions concerning this matter may be directed to the Joan Olszewski at (571) 272-7751.

/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
Alexandria, VA 22313-1450
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MAILED

AUG 04 2010

OFFICE OF PETITIONS

**BANNER & WITCOFF, LTD.**
**1100 13th STREET, N.W.**
**SUITE 1200**
**WASHINGTON DC 20005-4051**

| | | |
|---|---|---|
| In re Patent No. 7,694,475 | : | |
| Issue Date: April 13, 2010 | : | |
| Application No. 10/471,203 | : | DECISION ON PETITION |
| Filed: February 24, 2004 | : | |
| Attorney Docket No. 006329.00002 | : | |

This is a decision on the petition, filed, June 2, 2010, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee's name on the Fee(s) Transmittal form PTOL-85(b) by way of a certificate of correction in the patent.

The request is **GRANTED**.

Petitioner states that the correct assignee name is Ely Holdings Limited. Petitioner further states that the assignee's name was not correctly identified on the Fee(s) Transmittal form PTOL-85(b) at the time of payment of the issue fee. Accordingly, petitioner requests that a certificate of correction be issued to reflect the correct assignee on the front page of the Letters Patent.

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

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

The request was accompanied by a certificate of correction (and fee) as required by 3.81(b). Further, Office assignment records reflect that Ely Holdings Limited was the assignee of record before issuance of the patent. Accordingly, as the request complies with the provisions of 37 CFR 3.81(b), it is appropriate for a certificate of correction to be processed.

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[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

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.

Inquiries concerning this decision should be directed to Alicia Kelley at (571) 272-6059. Any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a certificate of correction.

Carl Friedman
Petitions Examiner
Office of Petitions

cc: ERIN E. BRYAN
BANNER & WITCOFF, LTD.
28 STATE STREET
SUITE 1800
BOSTON, MA 02109

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

**NORMAN H. STEPNO**
**BURNS DOANE SWECKER & MATHIS**
**P.O. BOX 1404**
**ALEXANDRIA, VA 22313-1404**

**MAILED**

MAR 15 2011

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of<br>**Christophe LEBON**, et *al.*<br>Application No. 10/471,234<br>Filed: June 22, 2004<br>Attorney Docket No. **017753-179** | DECISION ON PETITION TO WITHDRAW FROM RECORD |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 14, 2011.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others.

The request was signed by Teresa S. Rea on behalf of all attorneys of record. Teresa S. Rea has been withdrawn as attorney or agent of record; all other attorneys remain of record.

The correspondence address of record remains unchanged.

There is an outstanding Office action mailed November 10, 2010 that requires a reply from the applicant.

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

/Monica A. Graves/
Petitions Examiner, Office of Petitions

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. : **7749347**
Ser. No. : **10/471320**
Inventor(s) : **BAR-EREZ, YOSI**
Issued : **07/06/2010**
Title : **METHOD AND APPARATUS FOR ADHERING SHEETS TOGETHER WITHOUT TRAPPED BUBBLES AND EASY DETACHMENT OF STACK**
Docket No. : **1529/30**

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

MARK FRIEDMAN
ROBERT SHEINBEIN
2940 BIRCHTREE LANE
SILVER SPRING, MD 20906

**OL**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

20879
EMCH, SCHAFFER, SCHAUB & PORCELLO CO
P.O. Box 916
One Seagate Suite 1980
Toledo, OH 43697

**MAILED**

MAY 17 2011

PCT LEGAL ADMINISTRATION

In re Application of
WILLEY *et al*
Application No.: 10/471,473
PCT No: PCT/US02/07259
Filing Date: 12 March 2002
Priority Date: 14 March 2001
Attorney Docket No.: 8855
For: METHOD FOR QUANTITATIVE MEASUREMENT OF GENE EXPRESSION FOR INDENTIFYING INDIVIDUALS AT RISK FOR BRONCHOGENIC

**DECISION**

This is a decision on the "Petition under 37 CFR §§ 1.78(a)(3)(6)" filed in the above-captioned application on 07 March 2011.

A petition under 37 CFR 1.78 is not required where the benefit claim was picked up by the Office on the initial filing receipt. See MPEP 201.11(V). However, because applicant seeks to amend an abandoned application, the petition has been treated as a petition under 37 CFR 1.182.[1]

The petition under 37 CFR 1.182 is **DISMISSED** without prejudice for the following reason:

Applicants filed an amendment to the specification indicating that the present application claims priority to international application PCT No: PCT/US02/07259 "under 35 U.S.C. § 120." The present application is a national stage application under 35 U.S.C. 371 of the international application; as such, it cannot properly claim benefit under 35 U.S.C. 120 to the international application. See MPEP 1893.03(c)(III).

Before the petition under 37 CFR 1.182 can be granted, a substitute amendment (complying with 37 CFR 1.121) stating the proper relationship is required.

[1] The $1,410 petition fee paid on 07 March 2011 has been credited back to Deposit Account No. 13-0005. A $400.00 fee for a petition under 37 CFR 1.182 (37 CFR 1.17(f)) has been charged to Deposit Account No. 13-0005 as authorized

Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web, by facsimile to the Office of PCT Legal Administration at (571) 273-04559, or if mailed addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A courtesy copy of this decision is being mailed to counsel below, who filed the petition considered herein. No further correspondence will be sent to counsel below absent a proper correspondence address change. See 37 CFR 1.33.

Any questions concerning this matter may be directed to James Thomson at (571) 272-3302.

/Boris Milef/

Boris Milef
Legal Examiner
Office of PCT Legal Administration

cc: MACMILLAN SOBRANSKI & TODD, LLC
One Maritime Plaza, Fifth Floor
720 Water Street
Toledo, OH 43604

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

20879
EMCH, SCHAFFER, SCHAUB & PORCELLO CO
P.O. Box 916
One Seagate Suite 1980
Toledo, OH 43697

**MAILED**

DEC 20 2011

PCT LEGAL ADMINISTRATION

In re Application of
WILLEY *et al*
Application No.: 10/471,473
PCT No: PCT/US2002/07259
Filing Date: 12 March 2002
Priority Date: 14 March 2001
Attorney Docket No.: 8855
For: METHOD FOR QUANTITATIVE MEASUREMENT OF GENE EXPRESSION FOR INDENTIFYING INDIVIDUALS AT RISK FOR BRONCHOGENIC

**DECISION**

Applicants' renewed petition under 37 CFR 1.182 filed 20 October 2011 is hereby **DISMISSED** without prejudice for the following reason:

A substitute amendment (complying with 37 CFR 1.121) stating the proper relationship of the prior-filed international application and U.S. provisional application to the instant application was required for a grantable petition. In the instant response, applicants filed an amendment to the specification as follows:

> This is a national stage application filed under 37 CFR §1.371 of international application PCT/US2002/07259 filed March 12, 2002, which claims the priority to United States provisional Application Serial Number 60/275,854 filed March 14, 2001.

This amendment is not acceptable. The subject application was filed pursuant to 35 U.S.C. § 371.

A corrected amendment (complying with 37 CFR 1.121) stating the proper relationship of the prior-filed international application and U.S. provisional application to the instant application is required for a grantable petition.

A courtesy copy of this decision will not be sent to the address of the counsel[1] who filed this petition as a proper correspondence address change made pursuant to 37 CFR

[1] MACMILLAN SOBRANSKI & TODD, LLC, One Maritime Plaza, Fifth Floor, 720 Water Street, Toledo, OH 43604

1.33 was not submitted as requested.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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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04859
MACMILLAN SOBRANSKI & TODD, LLC
One Maritime Plaza, Fifth Floor
720 Water Street
Toledo, OH 43604

**MAILED**

MAR 08 2012

PCT LEGAL ADMINISTRATION

In re Application of :
WILLEY *et al* :
Application No.: 10/471,473 :
PCT No: PCT/US2002/07259 :
Filing Date: 12 March 2002 :
Priority Date: 14 March 2001 :
Attorney Docket No.: 8855 :
For: METHOD FOR QUANTITATIVE :
MEASUREMENT OF GENE :
EXPRESSION FOR IDENTIFYING :
INDIVIDUALS AT RISK FOR :
BRONCHOGENIC :

**DECISION**

Applicants' second renewed petition under 37 CFR 1.182 filed 16 January 2012 is **GRANTED** as follows:

The prior decision dated 20 December 2011 stated that a substitute amendment (complying with 37 CFR 1.121) listing the proper relationship of the prior-filed international application and the U.S. provisional application to the instant application was required for a grantable petition.

In the instant response, applicants have filed an amendment indicating that the subject application is a national stage application of PCT/US2002/07259 filed 12 March 2002 claiming priority to U.S. Provisional Application No. 60/275,854 filed 14 March 2001.

This amendment is acceptable. The above-captioned application now has a proper reference to U.S. provisional application No. 60/275,854.

No further action is required in the subject application.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

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

MAYER & WILLIAMS PC
251 NORTH AVENUE WEST
2ND FLOOR
WESTFIELD NJ 07090

MAILED
SEP 21 2010
OFFICE OF PETITIONS

In re Application of
Merk, et al.
Application No. 10/471,936
Filed: April 29, 2004
Atty. Dkt. No: 00140/020001

: DECISION ON PETITION

This decision is in response to the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed April 28, 2010.

The application became abandoned January 7, 2009 for failure to timely submit a proper reply to the non-final Office action mailed October 6, 2008. The non-final Office action set a three month shortened statutory period of time for reply. Notice of Abandonment was mailed February 18, 2009.

Any petition filed pursuant to 37 CFR 1.181 must be filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable. See, 37 CFR 1.181(f).

As the instant petition was filed a year after the mail date of the Notice of Abandonment mailed April 28, 2009, the instant petition filed pursuant to 37 CFR 1.181 is deemed untimely.

In view thereof, the petition under 37 CFR 1.181 is hereby **DISMISSED AS UNTIMELY**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." This is not a final agency decision.

**ALTERNATE VENUE**

Petitioners may wish to consider filing a petition stating that the entire delay was unintentional. Petitioners' attention is directed to 37 CFR 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable". An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee and reply.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered

that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b). The Director may require additional information where there is a question whether the delay was unintentional.

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
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
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

MAYER & WILLIAMS PC
251 NORTH AVENUE WEST
Suite 201
WESTFIELD NJ 07090

**MAILED**

DEC 13 2010

**OFFICE OF PETITIONS**

In re Application of
Merk, et al.
Application No. 10/471,936
Filed: April 29, 2004
Atty. Dkt. No.: 00140/020001

: DECISION ON PETITION

This decision is in response to the petition under 37 CFR 1.137(b), filed November 22, 2010.

The petition is **GRANTED**.

The application became abandoned January 7, 2009 for failure to timely submit a proper reply to the non-final Office action mailed October 6, 2008. The non-final Office action set a three month shortened statutory period of time for reply. Notice of Abandonment was mailed April 28, 2009.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition has been carefully reviewed and found in compliance with the requirements set forth above.

This application is being forwarded to Group Art Unit 1636 for further processing.

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 8-18-10 Paper No.: _____

TO SPE OF : ART UNIT 2883

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/471964 Patent No.: 7303340

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 9C62-D**
**Palm Location 7580**

Ennis Young
**Certificates of Correction Branch**
**703-756-1542**

**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:** _____

SPE

2883
Art Unit

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : December 6, 2011

TO SPE OF : ART UNIT 1627 SPE Sreenivasan Padmanabhan.

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/472,056 Patent No.: 7,998,947 B2

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square Building**
**2800 South Randolph Street**
**Arlington, VA 22206**

**Should the changes to the Abstract be approved as requested by applicant?**
**See COCIN dated 11-16-2011**

*Antonio Johnson*

**Certificates of Correction Branch**

**(571)272-0483 Fax – (571)270-9846**

**Thank You For Your Assistance**

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

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

**Comments:** All changes are approved. Applicant does have support for changes requested in the abstract portion of the patent. Additionally, errors must have been made while printing the PgPub since original specification does not show any errors. Ok. to enter the amendments.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

SPE_____ Art Unit ___1627___

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

12/6/11

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

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY & POPEO, P.C.
ONE FINANCIAL CENTER
BOSTON, MA 02111

Mail Date: 08/06/2010

| | | |
|---|---|---|
| **Applicant** | : Peter Bittner | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7657528 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/02/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/472,272 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/25/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **129** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 9-16-10

TO SPE OF : ART UNIT 1641

SUBJECT : Request for Certificate of Correction for Appl. No.: 10472421 Patent No.: 7759067

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:** Issued patent claim does not correspond to allowed claim; appears to be a typographical error.

/Mark Shibuya/ — **SPE**

1641 — **Art Unit**

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : September 7, 2010

TO SPE OF : ART UNIT 1618 - SPE Michael G. Hartley.

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/472,439 Patent No.: 7,589,056 B2

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square Building**
**2800 South Randolph Street**
**Arlington, VA 22206**

**Antonio Johnson**

**Should the the change in claim 6 should be made. The applicant filed an amendment requesting this change on March 6, 2009 (See CLM dated 03-06-2009) but was not acted on. It was filed right before the request for continued exam?**
**See COCIN dated 08-13-2010**

_____
**Certificates of Correction Branch**

**(571)272-0483**

**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

SPE: /Michael Hartley/

Art Unit 1618

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

**STEPHEN A BENT**
**FOLEY & LARDNER**
**WASHINGTON HARBOUR**
**SUITE 500 3000 K STREET N W**
**WASHINGTON DC 20007-5143**

**MAILED**
FEB 02 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,589,056 | : | |
| Issued: September 15, 2009 | : | |
| Application No. 10/472,439 | : | ON PETITION |
| Filed: August 25, 2004 | : | |
| Attorney Docket No. 017227-0191 | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed December 8, 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 **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
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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FEB 10 2012
OFFICE OF PETITIONS

QUARLES & BRADY LLP
411 E. WISCONSIN AVENUE
SUITE 2040
MILWAUKEE, WI 53202-4497

| | | |
|---|---|---|
| In re Patent No. 6,979,170 | : | |
| Issue Date: December 27, 2005 | : | |
| Application No. 10/472,578 | : | ON PETITION |
| Filed: September 22, 2003 | : | |
| Attorney Docket No.: 410718.00003 | : | |

This is a decision on the petition, filed December 29, 2011, under 37 CFR 1.378(c) to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

This patent issued on December 27, 2005. Accordingly, this patent expired on December 27, 2009 for failure to pay the first maintenance fee. The petition was filed on December 29, 2011, using a Certificate of Mailing dated December 27, 2011; therefore, the petition is timely 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).

The petition lacks item (1) above. In this regard, the petition is not signed, as required by 37 CFR 1.378(d), by an attorney or agent registered to practice before the Patent and Trademark Office, the patentee, or the assignee or other party in interest as established by 37 CFR 3.73(b).[1] Consequently, the petition is considered not to contain a proper statement of unintentional delay and cannot be accepted.

[1] 37 CFR 3.73(b) provides that: (1) when an assignee seeks to take action in a matter before the Office, the assignee must establish its ownership of the property to the satisfaction of the Commissioner; (2) ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording) or by specifying (e.g., reel and frame number) where such evidence is recorded in the Office; (3) the submission establishing ownership must be signed by a party authorized to act on behalf of the assignee; and (4) documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office.

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. 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 must also 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. For applicant's convenience a Statement under 37 CFR 3.73(b) is attached.

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.

If petitioner does not wish to pursue reinstatement of this expired patent, petitioner may request a refund of the $2,205 fees 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 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[2]

If petitioner does not wish to pursue reinstatement of this expired patent, petitioner may request a refund of the $2,365 maintenance fee and the $1,640 surcharge fee submitted with the petition. The request should be made in writing and addressed to: Mail Stop 16, Director of the U.S.

[2] www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)

Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3204.

/SDB/

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

Attachment: Statement Under 37 CFR 3.73(b)

cc: KEVIN B. COOK, PRESIDENT
DERMOND, INC.
7627 PARK PLACE
BRIGHTON, MI 48116

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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FISH & RICHARDSON P.C. (TC)
PO BOX 1022
MINNEAPOLIS MN 55440-1022

MAILED

JAN 05 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,427,260 | : | DECISION ON REQUEST FOR |
| PANG et al. | : | RECONSIDERATION OF |
| Issue Date: 09/23/2008 | : | PATENT TERM ADJUSTMENT AND |
| Application No. 10/472,708 | : | NOTICE OF INTENT TO ISSUE |
| Filing Date: 09/23/2003 | : | CERTIFICATE OF CORRECTION |
| Atty Docket No. 07039-301US1 | : | |

This is a decision on the RESPONSE TO DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT, filed August 3, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by nine hundred ninety-nine (999) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.** The term of the above-identified patent is extended or adjusted by **nine hundred ninety-eight (998) days**.

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the B delay period, the over three year period begins on October 1, 2006, and ends on November 13, 2007, the day before the RCE was filed, and is 409 days. See 35 U.S.C. 154(b)(1)(B)(i). As such, the patent term adjustment is 998, not 999 days.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a

certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentee is given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under 37 CFR 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges the previous payment of the $200.00 fee set forth in 37 CFR 1.18(e).

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **nine hundred ninety-eight (998) days.**

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,427,260 B2

DATED : Sep. 23, 2008 **DRAFT**

INVENTOR(S) : PANG et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 589 days

Delete the phrase "by 589 days" and insert – by 998 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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MAY 10 2011
OFFICE OF PETITIONS

DAVIS WRIGHT TREMAINE, LLP/Seattle
1201 Third Avenue, Suite 2200
SEATTLE WA 98101-3045

In re Application of
Nootebos, et al.
Application No. 10/472,711
Filed: March 26, 2004
Atty. Dkt. No.: 64820-001US0

: DECISION ON PETITION

This decision is in response to the petition under 37 CFR 1.137(b), filed February 11, 2011.

The petition is **DISMISSED**.

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

This application became abandoned February 2, 2008 for failure to timely reply to the non-final Office action mailed November 1, 2007. The non-final Office action set a three month shortened statutory period of time for reply. No extensions of time in accordance with 37 CFR 1.136(a) were timely requested. Notice of Abandonment was mailed May 16, 2008.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition fails to satisfy requirement (3).

As to item (3), there are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

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

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

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

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (3).

A petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional. Further, the Director may require additional information where there is a question whether the entire delay in question was unintentional." Where, as here, there is a question whether the delay in filing a grantable petition was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See* In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). In view of the inordinate delay (more than three years) in resuming prosecution, there is a question whether the entire delay was unintentional.

Any renewed petition must establish that the entire delay, from the time that a reply was due until the filing of a grantable petition, was unintentional. Petitioners may wish to identify the party having the right to reply to avoid abandonment who in turn may explain what effort(s) was made to further reply to the Office action, and, further, why no reply was filed. If no effort was made to further reply, then that party can explain why the delay in this application does not result from a deliberate course of action (or inaction). Likewise, if practitioner was counsel of record at the time of abandonment, practitioner should explain why this application became abandoned and what efforts were made to timely pursue the petition for revive.

Petitioner may wish to submit supporting documentation to establish that the delay in seeking to resume prosecution has been unintentional as well as statements of fact from those having first hand knowledge of the facts and circumstances surrounding the delay at issue. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. See, Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

In view thereof, the petition is **DISMISSED**.

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

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

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

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

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

Telephone inquiries concerning this decision should be directed to 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
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**OPTICUS IP**
**7791 ALISTER MACKENZIE DRIVE**
**SARASOTA, FL 34240**

MAILED
NOV 05 2010
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| | | |
|---|---|---|
| In re Application of | : | |
| **Norbert LUTKENHAUS** | : | |
| Application No. 10/472,837 | : | DECISION ON PETITION |
| Filed: February 24, 2004 | : | UNDER 37 CFR 1.181 |
| Attorney Docket No. **MOII-US1** | : | |

This is a decision on the petition, filed July 22, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to reply to the Notice of Allowance mailed February 16, 2010, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed on June 1, 2010.

Petitioner asserts that the Notice dated February 16, 2010 was not received.

A review of the written record indicates an irregularity in the mailing of the Office action of February 16, 2010. In this regard, the Office received a change of address on January 21, 2009, prior to the mailing of the Notice of February 16, 2010. Office records were not updated to reflect this new change of address. Accordingly, as the Office action was mailed to an incorrect address, the Notice of Abandonment mailed June 1, 2010 is hereby vacated and the holding of abandonment withdrawn.

This application is being referred to the Technology Center technical support staff of Art Unit 2613 for re-mailing the Office action of February 16, 2010 and resetting the period for reply.

Thurman K. Page
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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AUG 11 2011
OFFICE OF PETITIONS

**OPTICUS IP LAW, PLLC**
**7791 ALISTER MACKENZIE DRIVE**
**SARASOTA FL 34240**

| | | |
|---|---|---|
| In re Application of | : | |
| Norbert Lutkenhaus | : | |
| Application No. 10/472,837 | : | DECISION ON PETITION |
| Filed: February 24, 2004 | : | |
| Attorney Docket No. MOII-US1 | : | |

This is a decision on the petition, filed July 8, 2011, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

The application was held abandoned for failure to timely pay the issue and publication fees on or before May 16, 2011, as required by the Notice of Allowance and Fee(s) Due, mailed February 15, 2011, which set a statutory period for reply of three (3) months. A Notice of Abandonment was mailed May 31, 2011.

Petitioner asserts that the Office action dated February 15, 2011 was not received.

A review of the written record indicates an irregularity in the mailing of the Notice of February 15, 2011. In this regard, the Office received a revocation of attorney and change of address on January 21, 2009, prior to the mailing of the Notice of February 15, 2011. Office records were not timely updated to reflect this new change of address. Accordingly, as the Notice was mailed to an incorrect address, the Notice of Abandonment mailed May 31, 2011 is hereby vacated and the holding of abandonment withdrawn. The power of attorney filed January 21, 2009 has been accepted and the correspondence address has been updated.

This application is being referred to the Technology Center technical support staff of Art Unit 2613 for re-mailing the Notice of Allowability of February 15, 2011 and resetting the period for reply.

/Ramesh Krishnamurthy/
Ramesh Krishnamurthy
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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FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

MAILED
MAY 23 2011
OFFICE OF PETITIONS

In re Patent No. 7,404,991
Issue Date: July 29, 2008
Application No. 10/472,849
Filed: September 26, 2003
Attorney Docket No. 07043.0034

DECISION ON PETITION

This is a decision on the Request To Correct Assignee On Issued Patent Under 37 C.F.R. §3.81(b), filed September 15, 2009, which is being treated as a Petition Under 37 CFR §3.81(b), to accept the omission of the first assignee's name. A completed Certificate of Correction Form was submitted with Petition.

The petition under 37 CFR §3.81(b) is **GRANTED**.

Petitioner urges that the present Petition was submitted to accept the omission of the first assignee's name on the previously submitted PTOL 85B and such error was inadvertent. Accordingly, petitioner urges that a Certificate of Correction (PTO/SB/44) be issued to add the omitted first assignee's name to the Title Page of the Letters Patent.

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

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

The requisite $100.00 fee (Fee Code 1811), as set forth under 37 CFR 1.20(a), and the requisite $130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), have been submitted. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR §3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the Form submitted with the petition.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

Any questions concerning the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (703)756-1814.

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,404,991.

Cheryl Gibson-Baylor
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

In re Patent No. 7133710
Issue Date: November 7,2006
Application No. 10472856
Filed: September 18,2003
Attorney Docket No. 3693 US

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

This is a decision on the electronic petition, filed December 3,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 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) |
|---|---|---|---|---|
| 7,133,710 | 2006-11-07 | 10/472,856 | 2003-09-18 | SENS0011 |

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

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 | /MAG/ | Date (YYYY-MM-DD) | 2010-12-03 |
| Name | Michael A. Glenn | Registration Number | 30176 |

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

NELSON MULLINS RILEY & SCARBOROUGH LLP
FLOOR 30, SUITE 3000
ONE POST OFFICE SQUARE
BOSTON MA 02109

MAILED
FEB 07 2011
OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,795,387 | : |
| Leveillard et al. | : DECISION ON REQUEST FOR |
| Issue Date: September 14, 2010 | : RECONSIDERATION OF |
| Application No. 10/473,008 | : PATENT TERM ADJUSTMENT |
| Filed: April 2, 2004 | : |
| Attorney Docket No. NV1-046USRCE | : |
| Title: ROD-DERIVED CONE VIABILITY FACTOR (RDCVF) AND A METHOD OF ENHANCING CONE CELL SURVIVAL BY RDCVF | : |

This is a decision on the petition filed on November 11, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand one hundred twenty-two (1,122) days.

The petition to correct the patent term adjustment to indicate one thousand twenty-two (1,122) days is **DISMISSED.**

The period of adjustment to which the patent is entitled under 37 CFR 1.702(a) is 617 days.

The period of adjustment to which the patent is entitled under 37 CFR 1.702(b) is 912 days.

The period of adjustment under 37 CFR 1.702(a) and the period of adjustment under 37 CFR 1.702(b) overlaps for 96 days (September 12, 2009 to October 14, 2009).

Patentees dispute the 35 day reduction for the submission of replacement drawings pursuant 37 CFR 1.704 (c)(10). Patentees maintain the submission on August 11, 2010 was a response to a Notice to File Corrected Application Papers ("Notice") mailed June 18, 2010. Patentees state they replied timely and the submission constituted an attempt to expedite issuance.

Patentees also state a seven (7) day reduction for the submission of the Information Disclosure Statement (IDS)on October 1, 2008 is also required.

Patentees' argument has been considered but is not persuasive. Patentees acknowledge submitting replacement drawings after the mailing of the notice of allowance. The filing of replacement drawings after the mailing of a notice of allowance is a basis for reduction of patent term adjustment.

37 CFR § 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

In this instance, it is undisputed that replacement drawings were filed after the mailing of the notice of allowance. Accordingly, pursuant to § 1.704(c)(10), the patent term adjustment was properly reduced by thirty-five (35) days beginning on August 11, 2010 and ending on September 14, 2010 when the patent issued.

By Notice entitled *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance*, 1247 OG 111 (June 26, 2001), the Director set forth examples of papers deemed not to cause substantial interference and delay in the patent issue process. Other than those papers identified in this Notice, all papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait until payment of the Issue Fee to begin the patent issue process. As a result, 37 CFR 1.704(c)(10) does

not distinguish between papers that are and are not required by the Office.

Further, an additional reduction of 7 days is not required for the submission of an additional IDS on October 1, 2008. In this instance, the 7 day reduction overlaps with the 71 day reduction (September 24, 2008- December 4, 2008).

In view thereof, the patent is entitled to an overall adjustment of 1106 days.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

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

Telephone inquiries specific to this matter should be directed to Petitions Attorney, Charlema Grant at (571) 272-3215.

Charlema Grant
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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OLIFF & BERRIDGE, PLC
P.O. BOX 320850
ALEXANDRIA, VA 22320-4850

| | | |
|---|---|---|
| In re Patent No. 6,925,772 | : | |
| Issue Date: August 9, 2005 | : | |
| Application No. 10/473,051 | : | ON PETITION |
| Filed: September 14, 2001 | : | |
| Attorney Docket No.: 146064 | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed August 4, 2010, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on August 9, 2009 for failure to pay the first 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 3 ½ year maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : February 2, 2011

TO SPE OF : ART UNIT 2464
SUBJECT : Request for Certificate of Correction for Appl. No.: 10/473121 patent no 7751314

CofC mailroom date: 01-21-11

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**

**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:** _____

/Ricky Ngo/ SPE, Art Unit 2464

PTOL-306 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

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**MCDERMOTT WILL & EMERY LLP**
**600 13TH STREET, N.W.**
**WASHINGTON, DC 20005-3096**

MAILED
AUG 13 2010
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| | | |
|---|---|---|
| In re Patent No. **7,014,038** | : | |
| Issue Date: March 21, 2006 | : | |
| Application No. 10/473,164 | : | DECISION ON PETITION |
| Filed: March 15, 2004 | : | UNDER 37 CFR 1.378(c) |
| Attorney Docket No. **44928-036** | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed May 12, 2010, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired at midnight on March 21, 2010 for failure to pay the 3½ 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 noted that the petitioner's correspondence address has been omitted from the petition. This decision is being directed to the address above until otherwise properly notified by the applicant.

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253.

The patent file is being forwarded to Files Repository.

Thurman K. Page
Petitions Examiner
Office of Petitions

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P.O. Box 1450
Alexandria, VA 22313-1450
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**HAHN LOESER & PARKS, LLP**
**ONE GOJO PLAZA**
**SUITE 300**
**AKRON OH 44311-1076**

**MAILED**
JUN 24 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,114,707 | : | |
| Issued: October 3, 2006 | : | |
| Application No. 10/473,498 | : | ON PETITION |
| Filed: September 30, 2003 | : | |
| Attorney Docket No. 117015.00030 | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed May 19, 2011, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on October 4, 2010 for failure to pay the three 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 statement of unintentional delay was signed by a person who would have been in a position of knowing that the delay in filing a timely response 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 in paying the maintenance fee was in fact unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay in paying the maintenance fee was intentional, petitioner must so notify the Office. Further, it is not apparent whether the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute this patent. In accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts. While, a courtesy copy of this decision is being mailed to the address given on the petition, 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: James C. Scott
Roetzel & Andress
1375 East Ninth Street
One Cleveland Center, 9th FL
Cleveland, OH 44114

Best Available Copy

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 01-14-12

**TO SPE OF** : ART UNIT 2455

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/473509 Patent No.: 8005918

CofC mailroom date: 12-19-11

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

**Note:** _____

_____

Angela Green 571.272.9005
CofC 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:** _____

**SPE** /Emmanuel L. Moise/ **Art Unit** 2455

Doc Code: PET.RELIEF
Document Description: Certification and Request for Japan Events Relief

PTO/SB/425 (03-11)

# CERTIFICATION AND REQUEST FOR RELIEF DUE TO EVENTS OF MARCH 11, 2011, IN JAPAN (Page 1 of 2)

| Nonprovisional Application Number or Control Number (if applicable): 10/473,681 | Patent Number (if applicable): |
|---|---|
| First Named Inventor: Masaji ISHIGURO | Title of Invention: Structural Model of a G protein-coupled receptor and Method for Designing Ligand Capable ... |

**APPLICANT/PATENTEE/REEXAMINATION PARTY HEREBY CERTIFIES AND REQUESTS THE FOLLOWING FOR THE ABOVE-IDENTIFIED APPLICATION/PATENT/REEXAMINATION PROCEEDING.**

1. FOR PATENT APPLICATIONS AND REEXAMINATION PROCEEDINGS PENDING IN THE USPTO AS OF MARCH 11, 2011, IN WHICH A COMMUNICATION FROM THE USPTO IS SOUGHT TO BE REMAILED:

   a. One or more inventors, an assignee, or a correspondence address (for the application/proceeding) is in an area of Japan affected by the earthquake and/or tsunami of March 11, 2011.

   b. A reply or response to an Office action (final, non-final, or other), a notice of allowance, or other Office notice (hereinafter collectively referred to as "Office communication") is outstanding.

   c. The statutory or non-statutory time period set for response has not yet expired.

   d. Withdrawal and reissuance of the Office communication is requested.

   e. It is acknowledged that if this request is not made within sufficient time so that withdrawal and reissuance of the Office communication occur prior to expiration of the statutory or non-statutory time period (as permitted to be extended under 37 CFR 1.136(a), or as extended under 37 CFR 1.550(c) or 1.956), this request may not be granted.

   f. The need for the reissuance of the Office communication was due to the effects of the earthquake and/or tsunami of March 11, 2011.

   g. This request is being sent via EFS-Web or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

2. FOR PATENTEES WHO WERE UNABLE TO TIMELY PAY A PATENT MAINTENANCE FEE DURING THE SIX-MONTH GRACE PERIOD FOLLOWING THE WINDOW TO PAY THE MAINTENANCE FEE:

   a. The original window of time to pay the maintenance fee without the surcharge required by 37 CFR 1.20(h) expired on or after March 11, 2011.

   b. The delay in paying the fee was due to the effects of the earthquake and/or tsunami of March 11, 2011.

   c. The USPTO is requested to *sua sponte* waive the surcharge in 37 CFR 1.20(h) for paying a maintenance fee during the six-month grace period following the window to pay the maintenance fee.

   d. This request and payment of the maintenance fee during the six-month grace period following the window to pay the maintenance fee is being mailed to: Director of the United States Patent and Trademark Office, Attn: Maintenance Fee, 2051 Jamieson Avenue, Suite 300, Alexandria, VA 22314; or being transmitted via facsimile to: 571-273-6500.

## CERTIFICATION AND REQUEST FOR RELIEF DUE TO EVENTS OF MARCH 11, 2011, IN JAPAN (Page 2 of 2)

3. FOR PATENTEES WHO NEED TO FILE A PETITION TO ACCEPT A DELAYED MAINTENANCE FEE PAYMENT UNDER 37 CFR 1.378(c):

   a. The maintenance fee payment was required to have been paid after March 10, 2011.

   b. A petition under 37 CFR 1.378(c) (using USPTO form PTO/SB/66 – Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c))) is being promptly filed accompanied by the applicable maintenance fee payment (but not the surcharge under 37 CFR 1.20(i)).

   c. The delay in payment of the maintenance fee was due to the effects of the earthquake and/or tsunami of March 11, 2011.

   d. The USPTO is requested to *sua sponte* waive the surcharge in 37 CFR 1.20(i) for accepting a delayed maintenance fee payment.

   e. It is acknowledged that the petition to accept a delayed maintenance fee payment under 37 CFR 1.378(c) must be filed by March 11, 2012, in order to be entitled to a waiver of the surcharge under 37 CFR 1.20(i).

   f. It is acknowledged that the petition to accept a delayed maintenance fee payment under 37 CFR 1.378(c) must be filed within twenty-four months from the expiration date of the patent. *See* 35 U.S.C 41(c).

   g. This request and the petition to accept a delayed maintenance fee payment under 37 CFR 1.378(c) is being submitted via EFS-Web or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

4. FOR NONPROVISIONAL PATENT APPLICATIONS FILED WITHOUT AN EXECUTED OATH OR DECLARATION OR PAYMENT OF THE BASIC FILING FEE, SEARCH FEE, AND/OR EXAMINATION FEE:

   a. The nonprovisional patent application was filed on or after March 11, 2011, and prior to April 12, 2011.

   b. The late filing of the oath or declaration or the basic filing fee, search fee, or examination fee was due to the effects of the earthquake and/or tsunami of March 11, 2011.

   c. The USPTO is requested to *sua sponte* waive the surcharge set forth in 37 CFR 1.16(f) for the late filing of the oath or declaration or basic filing fee, search fee, and/or examination fee.

   d. This request, together with the executed oath or declaration or the basic filing fee, search fee, or examination fee, as well as the reply to the Notice to File Missing Parts, is being submitted via EFS-Web or by mail directed to Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

| | |
|---|---|
| Signature Brian Lathrop | Date April 14, 2011 |
| Name (Print/Typed) Brian K. Lathrop, Ph.D., Esq. | Practitioner Registration Number 43,740 |

***Note:*** *Signatures of all the inventors, § 1.41(b) applicants, or assignees of record of the entire interest or their representative(s), or reexamination requesters at the appeal stage are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below*.*

■ *Total of 1 forms are submitted.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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**DRINKER BIDDLE & REATH (DC)**
**1500 K STREET, N.W.**
**SUITE 1100**
**WASHINGTON DC 20005-1209**

MAILED
APR 20 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Masaji Ishiguro | : | |
| Application No. 10/473,681 | : | DECISION ON PETITION |
| Filed: February 17, 2004 | : | |
| Attorney Docket No. 47487-0007-00 (221974) | : | |

This is a decision on the request filed April 14, 2011, seeking relief under the provisions of an announcement by the Under Secretary and Director of the United States Patent and Trademark Office on March 17, 2011, http://www.uspto.gov/patents/announce/japan_relief_2011mar17.pdf, providing relief to inventors and patent owners in areas affected by the earthquake and resulting tsunami of March 11, 2011.

The request for relief is **GRANTED**.

In the above-identified application, an Office action was mailed on November 12, 2010. The instant petition was filed prior to the expiration of the period for reply and the certifications for granting of relief are considered to be met by the submission of the request.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

This application is being referred to the Technology Center, Art Unit 1631 for re-mailing the Office action of November 12, 2010. The period for reply will run from the mailing date of the Office action.

/Joan Olszewski/
Joan Olszewski
Petitions Examiner
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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SUTHERLAND ASBILL & BRENNAN LLP
999 PEACHTREE STREET, N.E.
ATLANTA GA 30309

MAILED
DEC 15 2010
OFFICE OF PETITIONS

In re Patent No. 7,211,563 :
Issued: 05/01/2007 :
Application No. 10/473,696 :
Filed: 09/29/2003 :
Attorney Docket No. 18744-0022 :

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed October 29, 2010.

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

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) |
|---|---|---|---|---|
| 7246039 | 2007-07-17 | 10474229 | 2003-10-03 | 7790-X06-023 |

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

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 | /Paul D. Bianco/ | Date (YYYY-MM-DD) | 2011-11-04 |
| Name | Paul D. Bianco | Registration Number | 43500 |

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. 7246039
Issue Date: July 17,2007
Application No. 10474229
Filed: October 3,2003
Attorney Docket No. 7790-X06-023

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

This is a decision on the electronic petition, filed November 4,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 4,2011 . 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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**RONALD J. BARON**
**HOFFMANN & BARON**
**6900 JERICHO TURNPIKE**
**SYOSSET, NY 11791**

MAILED
JUL 20 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| **Robert A. ASHLEY** | : | |
| Application No. 10/474,240 | : | DECISION GRANTING PETITION |
| Filed: October 3, 2003 | : | UNDER 37 CFR 1.313(c)(3) |
| Attorney Docket No. **512-47 PCT/US** | : | |

This is a decision on the petition, filed July 18, 2011, 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

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JUN 16 2011
OFFICE OF PETITIONS

**FISHER, CHRISTEN & SABOL**
**P.O. Box 18385**
**WASHINGTON DC 20036**

| | | |
|---|---|---|
| In re Application of | : | |
| Robert G. TEETER | : | |
| Application No. 10/474,335 | : | DECISION ON PETITION |
| Filed: May 17, 2004 | : | |
| Attorney Docket No. LP-1914 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 31, 2011, to revive the above-identified application.

The petition is **GRANTED**.

**The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.**

This application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of November 03, 2010. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). A one (1) month extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is March 04, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal and fee; (2) the petition fee of $1,620.00; and (3) a proper statement of unintentional delay. Accordingly, the reply to the final Office action of November 03, 2010 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4231.

This application is being referred to Technology Center AU 1615 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

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DARBY & DARBY P.C.
P.O. BOX 770
CHURCH STREET STATION
NEW YORK, NY 10008-0770

MAILED

AUG 05 2010

OFFICE OF PETITIONS

In re Application of
Roland Scheer, et. al.
Application No. 10/474,472
Filed: October 8, 2003
Attorney Docket No. 030602-US

DECISION ON PETITION

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed December 9, 2009, to revive the above-identified application.

In response to the decision mailed September 10, 2009, petitioner submits the present petition along with $130 for a one month extension of time filed on December 9, 2009.

It is noted that Erik R. Swanson was not in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, his 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).

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of $1,510[1] for payment of the issue fee and $300 for payment of the publication fee; (2) the petition fee of $1,540; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

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

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

Andrea Smith
Petitions Examiner
Office of Petitions

[1]Office records reveal that $1,130 for payment of a plant issue fee was submitted on September 5, 2008. However, it should be noted that the above application is a utility application and not a plant application. Therefore, the fee deficiency of $380 has been charged to petitioner's deposit account.

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/474,472 | 10/08/2003 | Roland Scheer | 030602-US |

**CONFIRMATION NO. 3942**

**POA ACCEPTANCE LETTER**

7278
DARBY & DARBY P.C.
P.O. BOX 770
Church Street Station
New York, NY 10008-0770

*OC000000042299885*

Date Mailed: 06/25/2010

## NOTICE OF ACCEPTANCE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/05/2008.

The Power of Attorney in this application is accepted. Correspondence in this application will be mailed to the above address as provided by 37 CFR 1.33.

/amsmith/

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

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**POST OFFICE BOX 1404**
**ALEXANDRIA, VA 22313-1404**

**MAILED**

MAR 15 2011

**OFFICE OF PETITIONS**

In re Application of
**Pierre BARRUEL**, et *al.*
Application No. 10/474,747
Filed: March 1, 2004
Attorney Docket No. **022702-057**

DECISION ON PETITION TO WITHDRAW FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed March 14, 2011.

The request is **APPROVED.**

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others.

The request was signed by Teresa S. Rea on behalf of all attorneys of record. Teresa S. Rea has been withdrawn as attorney or agent of record; all other attorneys remain of record.

The correspondence address of record remains unchanged.

There is an outstanding Office action mailed February 28, 2011 that requires a reply from the applicant.

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

/Monica A. Graves/
Petitions Examiner, Office of Petitions

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**WYETH LLC**
**PATENT LAW GROUP**
**5 GIRALDA FARMS**
**MADISON NJ 07940**

MAILED
AUG 3 1 2010
OFFICE OF PETITIONS

In re Application of
Stephen Bruce Olmsted et al
Application No. 10/474,792
Filed: October 14, 2003
Attorney Docket No. 10/474,792

DECISION ON PETITION

This is a decision on the petition, filed December 18, 2009, under 37 CFR 1.181(a) to Withdraw Holding of Abandonment.

The petition under 37 CFR 1.181(a) is **GRANTED**.

The application was held abandoned for failure to timely reply to the Notice of Non-Compliant Amendment mailed April 9, 2009.

The petition states that a reply was timely submitted on May 11, 2009 (May 9, 2009 being a Saturday). To support this assertion, the petitioner has submitted a copy of the EFS filing receipt, which indicates that a five page response was filed on May 11, 2009. Additionally, a review of the file record show receipt of the above response on May 11, 2009.

In view of the above, the holding of abandonment is hereby withdrawn and the application restored to pending status.

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

This application is being referred to Technology Center AU 1645 for appropriate action by the Examiner in the normal course of business on the reply received May 11, 2009.

/KOC
Karen Creasy
Petitions Examiner
Office of Petitions

Sughrue
SUGHRUE MION, PLLC

2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213
T 202.293.7060
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# FAX

| | |
|---|---|
| Date | May 18, 2011 |
| To | Examiner Brette A. Crouse |
| Of | USPTO |
| Fax | (571) 273 6494 |
| From | Ebenesar Thomas |
| Subject | Interview Agenda |
| Application No. | 10/474,814 Docket No. **Q77959** |
| Pages | 3 (including cover sheet) |

(including cover sheet)

Please call attention to problems with this transmission by return fax or telephone. Thank you.

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U.S. Application No. 10/474,814 Interview Agenda

**FOR DISCUSSION ONLY** **PLEASE DO NOT ENTER**

**Agenda for the Telephone Interview**

(PLEASE DO NOT ENTER)

Date / time / location (tentative)

May 19, 2011 2:00 P.M.

Introductions

U.S. Application No. 10/474,814

Applicant's representative: Mr. Ebenesar Thomas (Reg. No. 62,499)
(202) 857-3235

USPTO: Examiner Brette A. Crouse
(571) 272 6494 (voice)
(571) 273 6494 (fax)

It is Applicant's intention that such an interview will lead to an agreeable resolution of the rejected claims.

Applicant's representative would like to discuss the 35 U.S.C. § 103(a) rejection of claim 1. For instance, Applicant would point out that the idea of using energy patterning to control the direction of emitted light is not present in any of the cited documents. Therefore the use of energy patterning to achieve this would not be obvious. Accordingly, the combination of references do not teach or suggest "wherein the organic layer has been treated selectively to define different areas of different surface energy in order to control the phase separation", as in claim 1. Further, the combination of references do not teach or suggest ""phase separation of the polymers having been induced in at least portion of the polymer blend so as to control the propagation of light emitted by the light emissive material in a predetermined direction."

Applicant's representative would like to show that the idea of using of energy patterning to control the direction of emitted light is not present in any of the cited documents. Therefore the use of energy patterning to achieve this would not be obvious.

For instance, Burroughes at most discloses that the purpose of phase separation is to create different layers, and hence only uses a uniform surface energy across the layer. Nowhere does Burroughes teach that phase separation or energy patterns can be used to control the direction of light.

Furthermore, Boltau only discloses treating a gold substrate to create silicon circuits, not treating an organic surface to create a patterned electroluminescent device which controls the direction of light. Boltau is completely silent on the issue of light emission from organic devices and contains nothing to hint even at the desire to control the direction of such light using energy patterning.

Moreover, this feature cannot be taken from Rogers either. Although Rogers briefly mentions phase separation in column 1, second paragraph, it is only described as a part of a list of techniques which it intends to improve over. Rogers then goes on to disclose that controlling the thickness of a single polymer is the best way to control light, not phase separation which is considered inferior in Rogers. Therefore, one or ordinary skill in the art would not have attempted the proposed combination.

In addition, Applicant's representative would like to point out that another reason the skilled reader would not attempt to modify Burroughes is because Boltau explicitly requires the polymers to be strongly incompatible so as to de-mix during the spin coating procedure (page 877, right column, lines 13-15). However, blend of a light emissive polymer and a charge transport polymer can be phase separated by surface energy patterning of a substrate as light emissive polymers and charge transporting polymers (i.e., polymers in claim 1) are generally soluble in similar solvents and are not strongly incompatible, as required by Boltau.

With regard to claim 3, Applicant's representative would like to point out that Kobashi teaches away from the presently claimed invention as it suggests utilizing a mixed solvent system and polymers which have variable solubility in the solvents in order to control phase separation.

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12-28-2011

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Patent No : 7,902,038 B2
Ser. No. : 10/474,984
Inventor(s) : Bernard Aspar, et. al.
Issued : march 8, 2011

Re: Request for Certificate of Correction

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

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid,* including after issuance of the patent.

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

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

A. **the processing fee set forth in 37 CFR 1.17(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 issue to correct the remaining error noted in your request

Eva James
For Mary Diggs
Decisions & Certificates
of Correction Branch
(571) 272-3422 or 703- 756 -1580

Jasper W. Dockrey
Brinks Hofer Gilson & Lione
P.O. box 10395
Chicago, Illinois 60610

ej

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SEP 21 2010

OFFICE OF PETITIONS

In re Application
Anders Petterson
Application No. 10/475,254
Filed: December 12, 2003
Attorney Docket No. **9404.20833**

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE filed June 7, 2010. Applicant requests that the determination of patent term adjustment be corrected from 254 days to 753 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

With respect to the over 3 year calculation, rather than file an application for patent

term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the Notice of Allowance, the application for patent term adjustment is **GRANTED**.

The Office has updated the PALM screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is two hundred thirty-nine (239) days including two hundred four days for applicant delay. A copy of the updated PALM screen, showing the correct determination, is enclosed.

The instant application for patent term adjustment was timely filed[1] on or before payment of the issue fee.

On March 5, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b)in the above-identified application. The Notice stated that the patent term adjustment to date is 254 days. Applicants state that on March 22, 2010 an amendment pursuant to 37 CFR § 1.312 was filed. This period of Applicant delay under § 1.704 (c)(10)(i) is 14 days.

Specifically, 37 CFR 1.704(c) provides, in pertinent part, that:

> Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:
>
> (10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of

[1]PALM records indicate that the issue fee was paid on June 7, 2010.

adjustment set forth in § 1.703 shall be reduced by the lesser of

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or

(ii) Four months; ...

With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

A review of the record confirms that a period of reduction should be entered for applicant's failure to engage pursuant to 37 CFR 1.704(c)(10). The filing of the amendment pursuant to 37 CFR § 1.312, after the mailing of the Notice of Allowance on March 5, 2010 constituted a failure to engage pursuant to 37 CFR 1.704(c)(10). This period is 15 days, counting the number of days for the amendment beginning on March 22, 2010, to April 5, 2010, the date the response was mailed. Accordingly, a period of reduction of 15 days is being entered.

In view thereof, the determination of Patent Term Adjustment at the time of the mailing of the notice of allowance is TWO HUNDRED THIRTY-NINE (239) days (443 days of Office delay reduced by 204 days of applicant delay).

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

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

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

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of Revised PALM Screen

# Patent Term Adjustments

PTA/PTE Information | Patent Term Adjustment | Patent Term Extension

Application Number*: 10475254 Search Explanation of PTA Calculation Explanation of PTE Calculation

## PTA Calculations for Application: 10475254

| | | | |
|---|---|---|---|
| Application Filing Date | 12/12/2003 | OverLapping Days Between (A and B) or (A and C) | 0 |
| Issue Date of Patent | | Non-Overlapping USPTO Delays: | 443 |
| A Delays | 443 | PTO Manual Adjustment | -15 |
| B Delays | 0 | Applicant Delay (APPL) | 189 |
| C Delays | 0 | Total PTA (days) | 239 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 142 | 09/20/2010 | | P028 | Adjustment of PTA Calculation by PTO | | 15 | 0 |
| 126 | 03/05/2010 | | MN/=. | Mail Notice of Allowance | | | 0 |
| 125 | 03/01/2010 | | DVER | Document Verification | | | 0 |
| 123 | 02/16/2010 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 122 | 02/16/2010 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 121 | 02/04/2010 | | EX.A | Examiner's Amendment Communication | | | 0 |
| 119 | 02/04/2010 | | CNTA | Notice of Allowability | | | 0 |
| 113 | 02/04/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 120 | 02/01/2010 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 107 | 02/01/2010 | | P574 | Paralegal TD Accepted | | | 0 |
| 106 | 02/01/2010 | | P574 | Paralegal TD Accepted | | | 0 |
| 118 | 01/19/2010 | | AF/D | Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received | | | 0 |
| 117 | 01/19/2010 | 01/19/2010 | M844 | Information Disclosure Statement (IDS) Filed | | | 112 |
| 116 | 01/19/2010 | | RCAP | Reference capture on IDS | | | 0 |
| 115 | 01/19/2010 | | DIST | Terminal Disclaimer Filed | | | 0 |
| 114 | 01/19/2010 | | DIST | Terminal Disclaimer Filed | | | 0 |
| 112 | 01/19/2010 | 12/29/2009 | A... | Response after Non-Final Action | | 21 | 97 |
| 111 | 01/19/2010 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 108 | 01/19/2010 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 105 | 01/19/2010 | | DIST | Terminal Disclaimer Filed | | | 0 |
| 104 | 01/19/2010 | | DIST | Terminal Disclaimer Filed | | | 0 |
| 103 | 01/19/2010 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 101 | 01/06/2010 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 124 | 12/29/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 110 | 12/29/2009 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 109 | 12/29/2009 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 102 | 12/29/2009 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 97 | 09/29/2009 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 96 | 09/28/2009 | | CTNF | Non-Final Rejection | | | 0 |
| 100 | 09/16/2009 | | AF/D | Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received | | | 0 |
| 99 | 09/16/2009 | | LET. | Miscellaneous Incoming Letter | | | 0 |
| 98 | 09/16/2009 | 07/15/2009 | M844 | Information Disclosure Statement (IDS) Filed | | 63 | 86 |
| 95 | 09/16/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 93 | 09/16/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 89 | 07/21/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 87 | 07/21/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 85 | 07/21/2009 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 94 | 07/15/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 92 | 07/15/2009 | | RCAP | Reference capture on IDS | | | 0 |
| 91 | 07/15/2009 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 90 | 07/15/2009 | | AF/D | Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received | | | 0 |
| 88 | 07/15/2009 | | AMSB | Amendment Submitted/Entered with Filing of CPA/RCE | | | 0 |
| 84 | 07/15/2009 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 83 | 07/15/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 82 | 07/15/2009 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 81 | 03/25/2009 | | PA.. | Change in Power of Attorney (May Include Associate POA) | | | 0 |
| 80 | 03/24/2009 | | C.AD | Correspondence Address Change | | | 0 |
| 78 | 12/15/2008 | | N/AP | Notice of Appeal Filed | | | 0 |
| 77 | 12/10/2008 | 11/23/2008 | MCTFR | Mail Final Rejection (PTOL - 326) | 17 | | 63 |
| 76 | 12/08/2008 | | CTFR | Final Rejection | | | 0 |
| 69 | 10/05/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 67 | 10/04/2008 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 66 | 09/03/2008 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 74 | 08/28/2008 | | AF/D | Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received | | | 0 |
| 73 | 08/28/2008 | | AF/D | Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received | | | 0 |
| 72 | 08/28/2008 | | AF/D | Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received | | | 0 |
| 71 | 08/28/2008 | | AF/D | Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received | | | 0 |
| 70 | 08/28/2008 | | AF/D | Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received | | | 0 |
| 68 | 08/28/2008 | 07/23/2008 | SA.. | Supplemental Response | | 36 | 63 |
| 65 | 08/26/2008 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 64 | 08/22/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 63 | 07/23/2008 | | A... | Response after Non-Final Action | | | 0 |
| 62 | 05/30/2008 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 61 | 05/27/2008 | | CTNF | Non-Final Rejection | | | 0 |
| 59 | 05/18/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 57 | 05/18/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 55 | 05/18/2008 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 60 | 05/08/2008 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 58 | 05/08/2008 | | AMSB | Amendment Submitted/Entered with Filing of CPA/RCE | | | 0 |
| 56 | 05/08/2008 | | RCEX | Request for Continued Examination (RCE) | | | 0 |
| 54 | 05/08/2008 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 53 | 05/08/2008 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 52 | 05/08/2008 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 51 | 05/08/2008 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 50 | 04/22/2008 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 49 | 04/15/2008 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 47 | 02/29/2008 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 46 | 02/19/2008 | | CTFR | Final Rejection | | | 0 |
| 44 | 01/22/2008 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 48 | 12/19/2007 | | C602 | Oath or Declaration Filed (Including Supplemental) | | | 0 |
| 42 | 12/06/2007 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 45 | 11/07/2007 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 43 | 11/07/2007 | 11/07/2007 | M844 | Information Disclosure Statement (IDS) Filed | | | 41 |
| 41 | 11/07/2007 | 10/02/2007 | A... | Response after Non-Final Action | | 36 | 37 |
| 40 | 11/07/2007 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 39 | 11/07/2007 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 38 | 11/07/2007 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 37 | 07/02/2007 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 36 | 06/23/2007 | | CTNF | Non-Final Rejection | | | 0 |
| 34 | 06/19/2007 | | PA.. | Change in Power of Attorney (May Include Associate POA) | | | 0 |

| | | | | | | | | |
|---|---|---|---|---|---|---|---|---|
| 35 | 06/18/2007 | | | CAD | Correspondence Address Change | | | 0 |
| 33 | 06/18/2007 | | | FWDX | Date Forwarded to Examiner | | | 0 |
| 32 | 06/01/2007 | | | A.NE | Amendment after Final Rejection | | | 0 |
| 31 | 05/30/2007 | | | MEXIN | Mail Examiner Interview Summary (PTOL -413) | | | 0 |
| 29 | 04/23/2007 | | | PA. | Change in Power of Attorney (May Include Associate POA) | | | 0 |
| 28 | 03/08/2007 | | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 27 | 03/05/2007 | | | CTFR | Final Rejection | | | 0 |
| 30 | 03/03/2007 | | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 23 | 01/03/2007 | | | FWDX | Date Forwarded to Examiner | | | 0 |
| 26 | 12/11/2006 | | | IDSC | Information Disclosure Statement considered | | | 0 |
| 25 | 12/11/2006 | | | RCAP | Reference capture on IDS | | | 0 |
| 24.7 | 12/11/2006 | | 12/11/2006 | M844 | Information Disclosure Statement (IDS) Filed | | | 22 |
| 24 | 12/11/2006 | | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 22 | 12/11/2006 | | 11/08/2006 | A. | Response after Non-Final Action | | 33 | 20 |
| 21 | 12/11/2006 | | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 20 | 08/08/2006 | | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 19 | 08/04/2006 | | | CTNF | Non-Final Rejection | | | 0 |
| 18 | 07/15/2006 | | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 17 | 06/02/2006 | | | FWDX | Date Forwarded to Examiner | | | 0 |
| 16 | 05/18/2006 | | | ELC. | Response to Election / Restriction Filed | | | 0 |
| 15 | 04/14/2006 | | 02/12/2005 | MCTRS | Mail Restriction Requirement | 326 | | 0 |
| 14 | 04/13/2006 | | | CTRS | Requirement for Restriction / Election | | | 0 |
| 13 | 11/07/2005 | | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 12 | 06/16/2005 | | | LET. | Miscellaneous Incoming Letter | | | 0 |
| 11 | 09/22/2004 | | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 10 | 06/08/2004 | | | TSSCOMP | IFW TSS Processing by Tech Center Complete | | | 0 |
| 9 | 05/27/2004 | | | RCAP | Reference capture on IDS | | | 0 |
| 8.7 | 05/27/2004 | | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 8 | 05/27/2004 | | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 5 | 03/25/2004 | | | L194 | Cleared by OIPE CSR | | | 0 |
| 3 | 03/04/2004 | | | OIPE | Application Dispatched from OIPE | | | 0 |
| 2 | 03/04/2004 | | | M903 | Notice of DO/EO Acceptance Mailed | | | 0 |
| 7 | 12/12/2003 | | | RQPR | Request for Foreign Priority (Priority Papers May Be Included) | | | 0 |
| 6 | 12/12/2003 | | | A.PE | Preliminary Amendment | | | 0 |
| 4 | 12/12/2003 | | | 371COMP | 371 Completion Date | | | 0 |

Export to: Excel

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 7/19/10 **Paper No.:** _____

**TO SPE OF** : ART UNIT 2614

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/475568 Patent No.: 7715576B2

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**

Virginia Tolbert
**Certificates of Correction Branch**
571-272-0460

**Thank You For Your Assistance**

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

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

**Comments:**

All changes are approved by Examiner.

All changes are supported by originally filed application. (SPEC at 5, 22 October 2003.)

/Walter F. Briney III/ 24 August 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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www.uspto.gov

Rebecca Ball, Esq.
BARNES & THORNBURG LLP
11 South Meridian Street
Indianapolis IN 46204

MAILED
NOV 18 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Green et al. | : | |
| Application No. 10/475,876 | : | ON APPLICATION FOR |
| Filed: 06/21/2004 | : | PATENT TERM ADJUSTMENT |
| Attorney Docket No. 3220-213261 | : | |

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d), filed November 2, 2010, which is being treated as a petition under 37 CFR 1.705(b). Applicants submit that the correct patent term adjustment to be indicated on the patent is 1520 days, not 426 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants seek this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR

1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.[1]

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

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[1] For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within two months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

OCT 12 2010

OFFICE OF PETITIONS

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON DC 20005-3096

In re Patent No. 7,205,302
Issued: April 17, 2007
Application No. 10/476,196
Filed: October 23, 2003
Atty. Dkt. No.: 086625-0012

: DECISION ON APPLICATION FOR
: PATENT TERM ADJUSTMENT UNDER
: 37 CFR 1.705(d)

This is a decision on the "REQUEST FOR CERTIFICATE OF CORRECTION," filed August 30, 2010. This matter is being properly treated as an application for patent term adjustment pursuant to 37 C.F.R. §1.705(d)," filed August 30, 2010.

The above-identified application matured into U.S. Patent No. 7,205,302 on April 17, 2007. The patent issued with a patent term adjustment of 344 days.

The instant request for reconsideration of patent term adjustment under 37 CFR 1.705(d) was filed August 30, 2010. However, in accordance with 37 CFR 1.705(d), a proper request for reconsideration of patent term adjustment must be timely submitted within two months of the date of issuance of the patent. As the instant request for reconsideration of patent term adjustment was submitted more than two months after the date of issuance of the patent, the request is deemed untimely submitted within the meaning of 37 CFR 1.705(d).

Accordingly, the application for patent term adjustment ("PTA") under 37 CFR 1.705(d) is DISMISSED AS UNTIMELY.

The required fee set forth at 37 CFR 1.18(e) has been charged to the authorized deposit account.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

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

March 1, 2012

Patent No. :6,930,438 B2
Ser. No. : 10/476209
Inventor(s) :Dieter Cramer, et al.
Issued :August 16, 2005
Title :MULTILAYER ELECTRICAL,COMPONENT HAVING A PASSIVATION LAYER

Docket No. :14219-035US1/P200 417 US N

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 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

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

BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO CA 94303

MAILED

SEP 29 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Durrant, et al. | : | |
| Application No. 10/476,233 | : | ON REQUEST FOR |
| Filed: May 14, 2004 | : | RECONSIDERATION OF |
| Attorney Docket Number: DVCC-001 | : | PATENT TERM ADJUSTMENT |

This is a decision on the petition under 37 CFR 1.705(b), filed July 7, 2010. Applicants believe that they should be accorded an additional PTA of 120 days. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment solely as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file a request for reconsideration of patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

In view thereof, the correct determination of PTA prior to issuance is **fifty-three (53) days** (144 days of PTO delay, reduced by 91 days of Applicant delay).

Receipt of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged.

The application is being forwarded to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Petitions Attorney Cliff Congo at (571) 272-3207.

Anthony Knight
Director
Office of Petitions

[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

# UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Patent No. 7100897
Issue Date: September 5,2006
Application No. 10476253
Filed: October 30,2003
Attorney Docket No. P08096US00/DEJ

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

This is a decision on the electronic petition, filed November 2,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 2,2011 .
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) |
|---|---|---|---|---|
| 7,100,897 | 2006-09-05 | 10/476,253 | 2003-10-30 | P08096US00 |

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

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 | /Douglas E. Jackson/ | Date (YYYY-MM-DD) | 2011-11-02 |
| Name | Douglas E. Jackson | Registration Number | 28518 |

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

MUIRHEAD AND SATURNELLI, LLC
200 FRIBERG PARKWAY
SUITE 1001
WESTBOROUGH, MA 01581

**MAILED**

NOV 29 2010

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Patent No. 7,316,030 | : DECISION GRANTING PETITION |
| Issue Date: January 1, 2008 | : UNDER 37 CFR 1.78(a)(3) AND |
| Application No. 10/476,316 | : REQUEST FOR CERTIFICATE OF |
| Filed: October 29,2003 | : CORRECTION |
| Attorney Docket No. AIM-201US2 | : |

This is a decision on the petition, filed July 14, 2010, which is being treated as a petition under 37 CFR 1.78(a)(3), seeking to add a claim for priority under 35 U.S.C. § 120 to nonprovisional Application Nos. 09/844,246, filed April 30, 2001 and 09/844,439 filed April 30,2001, by way of a certificate of correction.

A review of the file record fails to disclose that a claim for the benefit of priority to the above-noted, prior-filed nonprovisional applications was made within the time period set forth in 37 CFR 1.78(a)(2)(ii) and further failed to include a proper reference to the prior-filed applications as required by 37 CFR 1.78(a)(2)(i) and 1.78(a)(2)(iii).

The instant application was filed October 29, 2003. Therefore, since this application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(3), along with submission of a Certificate of Correction, is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed nonprovisional applications after issuance of the application into a patent. *See* MPEP 1481.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) must be accompanied by:

**(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

As the petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the above-noted, prior-filed nonprovisional applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is **granted**.

A corrected Filing Receipt, which includes the priority claim to the above-noted, prior-filed nonprovisional applications, accompanies this decision on petition.

Petitioner is advised that the granting of this petition and the mailing of a corrected Filing Receipt should not be viewed as an indication that a determination has been made that this application is entitled to claim benefit of the prior-filed applications. A determination that applicant is entitled to claim benefit of the prior-filed applications will be made by the Examiner prior to the mailing of a certificate of correction.

This application is being referred to the Certificates of Correction Branch for processing the request for a certificate of correction in accordance with this decision on the petition under 37 CFR 1.78(a)(3).

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

Andrea Smith
Petitions Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 10/476,316 | 10/29/2003 | 2131 | 1040 | AIM-201US2 | 19 | 3 |

**CONFIRMATION NO. 9248**

**CORRECTED FILING RECEIPT**

54004
MUIRHEAD AND SATURNELLI, LLC
200 FRIBERG PARKWAY
SUITE 1001
WESTBOROUGH, MA 01581

*OC000000044696676*

Date Mailed: 11/29/2010

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

Yves Louis Gabriel Audebert, Los Gatos, CA;
Olivier Clemont, Rueil-Malmaison, FRANCE;

**Power of Attorney:** The patent practitioners associated with Customer Number 54004

**Domestic Priority data as claimed by applicant**

This application is a 371 of PCT/EP02/03929 04/09/2002
which is a CIP of 09/844,246 04/30/2001 ABN
and is a CIP of 09/844,439 04/30/2001 PAT 7,363,486

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 11/26/2010

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 10/476,316**

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No
**** SMALL ENTITY ****

**Title**

METHOD AND SYSTEM FOR AUTHENTICATING A PERSONAL SECURITY DEVICE VIS-A-VIS AT LEAST ONE REMOTE COMPUTER SYSTEM

**Preliminary Class**

726

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

## LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where

the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

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

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

**NOT GRANTED**

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

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P.O. Box 1450
Alexandria, VA 22313-1450
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**MUIRHEAD AND SATURNELLI, LLC**
**200 FRIBERG PARKWAY**
**SUITE 1001**
**WESTBOROUGH MA 01581**

**MAILED**
SEP 21 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,316,030 | : | |
| Issue Date: January 01, 2008 | : | |
| Application No. 10/476,316 | : | NOTICE UNDER 37 CFR. 1.28(c) |
| Filed: October 29, 2003 | : | |
| Attorney Docket No. **AIM-201US2** | : | |

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.

Inquiries related to this communication should be directed to the Michelle R. Eason at (571) 272-4231.

Thurman Page
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

MAILED

AUG 3 1 2010

OFFICE OF PETITIONS

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

In re Application of :
Lee et al. :
Application No. 10/476,388 :
Filed: April 1, 2004 :
For: COMPOSITE DOSAGE FORMS :
HAVING AN INLAID PORTION :

ON APPLICATION FOR
PATENT TERM ADJUSTMENT

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT" filed April 19, 2010. Applicants request that the determination of patent term adjustment be corrected from one thousand three hundred seventy-six (1,376) days to one thousand five hundred seventy-two (1,572) days.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

The $200.00 petition fee set forth in 37 CFR 1.18(e) has been assessed from deposit account no. 10-0750. No additional fees are required.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As

such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

To the extent that applicant otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is **DISMISSED.**

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[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

On January 29, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 1,376 days. The instant application for patent term adjustment was timely filed on April 19, 2010.

Applicants state that a 64-day reduction for the submission of a defective appeal brief on March 28, 2007 is warranted.

The Office has considered applicants' argument and finds it unpersuasive. A reduction of 64 days, pursuant to 37 CFR 1.704(c)(7) as disclosed by applicants, is not warranted for the filing of an appeal brief on March 28, 2007. An appeal brief is not a reply within the meaning of 37 CFR 1.704(c)(7). Accordingly, a defective appeal brief is not a submission of a reply having an omission, and the filing of an appeal brief in compliance is not a submission of a reply correcting an omission in a reply.

In view thereof, the correct determination of PTA at the time of the mailing of the notice of allowance is one thousand three hundred seventy-six (1,376) days.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.

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

Christopher M Tobin
Collier Shannon Scott
Suite 400
3050 K Street NW
Washington DC 20007

MAILED
SEP 2 0 2010
OFFICE OF PETITIONS

In re Patent No. 7,302.110
Issue Date: November 27, 2007
Application No. 10/476,587
Filed: June 7, 2004
Attorney Docket No. 59017-00601

DECISION ON PETITION

This is a decision on the Renewed Request For Certificate Of Correction, filed May 19, 2010, which is being treated as a Petition Under 37 CFR 3.81(b) to accept the omission of the assignee's name and residence. A completed Certificate of Correction Form (PTO/SB/44) was submitted with Petition.

The petition under 37 CFR §3.81(b) is **GRANTED**.

Petitioner requests that the present Petition was submitted to add the omission of the assignee's name and residence on the previously submitted PTOL-85B. Accordingly, petitioner requests that a Certificate of Correction (PTO/SB/44) be issued to add the omitted assignee's name and residence to the Title Page of the Letters Patent.

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

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

The requisite $100.00 fee (Fee Code 1811) as set forth under 37 CFR 1.20(a), and the requisite $130.00 processing fee (Fee Code 1464) as set forth under 37 CFR 1.17(i) have been submitted. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR 3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the Form PTO/SB/44 that accompanied the petition.

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. However, the file does not indicate a change of representative being submitted, although the address given on the petition is the same address of record but a different representative. If petitioner no longer wishes to be represented by the representative of record, then a revocation of the power of attorney or patent agent should be submitted. *See* 37 CFR 1.33(a).

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

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

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,302,110.

Cheryl Gibson-Baylor

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 04/11/11

TO SPE OF : ART UNIT ~~1617~~ 1627

SUBJECT : Request for Certificate of Correction for Appl. No.: 10476716 Patent No.: 7488722

CofC mailroom date: 04/07/11

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 (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:** _____

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

SPE

Art Unit 1627

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No.

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OFFICE OF PETITIONS

IP GROUP OF DLA PIPER LLP (US)
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1650 MARKET ST, SUITE 4900
PHILADELPHIA PA 19103

| | | |
|---|---|---|
| In re Patent No. 7,652,025 | : | DECISION ON REQUEST |
| Suzuki et al. | : | FOR |
| Issue Date: January 26, 2010 | : | RECONSIDERATION OF |
| Application No. 10/477,062 | : | PATENT TERM ADJUSTMENT |
| Filed: December 18, 2003 | : | and |
| Atty Docket No. 1396-03 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on May 20, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by seven hundred and twenty (720) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by six hundred and forty (640) days is **GRANTED to the extent indicated herein.**

On January 26, 2010, Application No. 10/477,062 matured into U.S. Patent No. 7,652,025, with a patent term adjustment of 201 days. On March 25, 2010, Patentee filed a Request for Recalculation of Patent Term Adjustment in view of Wyeth. On April 20, 2010, the Office mailed a "DECISION ON REQUEST FOR RECALCULATION of PATENT TERM ADJUSTMENT IN VIEW OF WYETH AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION," indicating that the patent term adjustment had been determined to be 669 days.

The Office notes that the decision of April 20, 2010 was issued in error as it accorded Patentee 80 more days of patent term

adjustment than was warranted. The present decision supersedes the decision mailed on April 20, 2010.

The Office has determined that the patent term adjustment for the above-identified patent is **640 days**. The 80 additional days of adjustment will be removed.

It is noted that the 371 acceptance letter (M903) mailed on March 25, 2004 indicates that the priority date is May 8, 2001. The 30-month anniversary of this date is November 8, 2003, which fell on a Saturday. Therefore, the national stage commencement date is November 10, 2003.

Pursuant to 37 C.F.R. § 1.703(b), the "B-period" of adjustment (37 C.F.R. § 1.702(b)) is:

> the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods…

*Patentee has incorrectly calculated the period of B-delay as beginning three years from the filing date, as opposed to three years from the national stage commencement date.* It follows that the B-delay is 557 days, measured from November 10, 2006 to the filing of the Request for Continued Examination on May 21, 2008.

Moreover, a first notice of appeal was filed on February 22, 2008, and a Request for Continued Examination was filed on May 21, 2008. The 90 days of the over three year period consumed by appellate review, beginning on February 22, 2008 and ending on May 21, 2008 are not included in the B delay. Similarly, a second notice of appeal was filed on September 3, 2009, and a notice of allowance was mailed on September 30, 2009. The 28 days of the over three year period consumed by appellate review, beginning on September 3, 2009 and ending on September 30, 2009 are not included in the B delay. As such, 118 (90 + 28) days are excluded from the B-delay. See 35 U.S.C. § 154(b)(1)(B)(ii).

As such, the patent term adjustment is increased by 640 (594 days of examination delay plus 439 "B-delay" minus the

aforementioned excluded 118 days minus 393 days of Applicant delay) days, not 720 days.

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

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,[1] hand-delivery,[2] or facsimile.[3] Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.[4]

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

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **six hundred and forty (640) days**.

Telephone inquiries specific to this matter should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

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1 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
2 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
3 (571) 273-8300 - please note this is a central facsimile number.
4 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,652,025 B2

DATED : **January 26, 2010** **DRAFT**

INVENTOR(S) : Suzuki et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 201 days

Delete the phrase "by 201 days" and insert – by 640 days--

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PHILADELPHIA PA 19103

**MAILED**

NOV 04 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,652,025 | : | DECISION ON REQUEST |
| Suzuki et al. | : | FOR |
| Issue Date: January 26, 2010 | : | RECONSIDERATION OF |
| Application No. 10/477,062 | : | PATENT TERM ADJUSTMENT |
| Filed: December 18, 2003 | : | and |
| Atty Docket No. 1396-03 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on October 14, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by six hundred and sixty-eight (668) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by six hundred and sixty-eight (668) days is **GRANTED**.

On January 26, 2010, Application No. 10/477,062 matured into U.S. Patent No. 7,652,025, with a patent term adjustment of 201 days. On March 25, 2010, Patentee filed a Request for Recalculation of Patent Term Adjustment in view of Wyeth. On April 20, 2010, the Office mailed a "DECISION ON REQUEST FOR RECALCULATION of PATENT TERM ADJUSTMENT IN VIEW OF WYETH AND NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION," indicating that the patent term adjustment had been determined to be 669 days.

A petition pursuant to 37 CFR 1.705(d) was filed on May 20, 2010, which requested that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by seven hundred and twenty (720) days. The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by six hundred and forty (640) days was granted to the extent indicated in a decision mailed on September 14, 2010. The decision indicated, *in pertinent part*:

> Moreover, a first notice of appeal was filed on February 22, 2008, and a Request for Continued Examination was filed on May 21, 2008. The 90 days of the over three year period consumed by appellate review, beginning on February 22, 2008 and ending on May 21, 2008 are not included in the B delay. Similarly, a second notice of appeal was filed on September 3, 2009, and a notice of allowance was mailed on September 30, 2009. The 28 days of the over three year period consumed by appellate review, beginning on September 3, 2009 and ending on September 30, 2009 are not included in the B delay. As such, 118 (90 + 28) days are excluded from the B-delay. See 35 U.S.C. § 154(b)(1)(B)(ii).
>
> As such, the patent term adjustment is increased by 640 (594 days of examination delay plus 439 "B-delay" minus the aforementioned excluded 118 days minus 393 days of Applicant delay) days, not 720 days.
>
> Decision on the petition of May 20, 2010, page 2.

With this request for reconsideration, Patentee argues that the second appellate period, which commenced subsequent to the filing of the Request for Continued Examination on May 21, 2008 (and therefore subsequent to the cut-off of the period of "B-delay") should not be included in the period of exclusion.

Patentee's argument has been considered, and has been deemed to be persuasive.

It follows that 90 (not 118) days are excluded from the B-delay to total 467 days.

As such, the patent term adjustment is increased by 668 (594 days of examination delay plus 467 "B-delay" minus 393 days of Applicant delay) days, not 640 days.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction.

The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **six hundred and sixty-eight (668) days**.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3225.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,652,025 B2

DATED : **January 26, 2010** **DRAFT**

INVENTOR(S) : Suzuki et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 640 days

Delete the phrase "by 640 days" and insert – by 668 days--

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No**.:20100911

**DATE** : September 10, 2010

**TO SPE OF** : ART UNIT 2617

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7319863

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:**

/Dwayne D Bost/
Supervisory Patent Examiner.Art Unit 2617

UNITED STATES PATENT AND TRADEMARK OFFICE

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Haynes and Boone, LLP
IP Section
2323 Victory Avenue
SUITE 700
Dallas TX 75219

MAILED
APR 19 2011
OFFICE OF PETITIONS

In re Application of :
Haring, et al. : ON PETITION
Application No. 10/477,174 :
Filed: January 9, 2004 :
Attorney Docket No.**M-16756US**

This is a decision on the petition under 37 CFR 1.137(b) filed on February 15, 2011.

The petition is **DISMISSED AS MOOT**.

A review of the application file revealed that a Notice of Non-Compliant Amendment was mailed in this application on October 14, 2010. The notice allowed a shortened period for reply of one month from its mailing date. Extensions of the time set for reply are available pursuant to 37 CFR 1.136(a). The instant petition was filed on February 15, 2011.

This petition is improper because it was filed prematurely as the application is not abandoned. The Notice of Non-Compliant Amendment allowed a shortened period for reply of one month from its mailing date with extensions of time available under 37 CFR 1.136(a). The petition was filed during the extendable period—four additional months after the expiration of the one month period granted. The fee for the extension of time within the fourth month is $865.00. Petitioner paid $810.00 for the petition fee. Accordingly, the amount of $55.00 will be charged to deposit account 08-1394.

The application file is being directed to Technology Center, GAU 1777 for further review.

Telephone inquiries concerning this matter 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

In re Patent No. 7074161
Issue Date: July 11,2006
Application No. 10477276
Filed: November 10,2003
Attorney Docket No. AP10123

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

This is a decision on the electronic petition, filed January 23,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 23,2012 .
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) |
|---|---|---|---|---|
| 7074161 | 2006-07-11 | 10477276 | 2003-11-10 | AP10123 |

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

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 | /Christine M. Mackiewicz/ | Date (YYYY-MM-DD) | 2012-01-23 |
| Name | Christine M. Mackiewicz | Registration Number | 55418 |

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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Alexandria, VA 22313-1450
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**VIDAS, ARRETT & STEINKRAUS, P.A.**
**SUITE 400, 6640 SHADY OAK ROAD**
**EDEN PRAIRIE MN 55344**

MAILED
JUN 28 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,032,878 | : | |
| Issued: April 25, 2006 | : | |
| Application No. 10/477,286 | : | ON PETITION |
| Filed: June 9, 2004 | : | |
| Attorney Docket No. H01.2-11392-US01 | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed May 27, 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

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE of Data Management

Gerlinde M Nattler
Continental Teves Inc
One Continental Drive
Auburn Hills MI 48326

FEB 03 2011

In re Application of
LOHBERG, PETER
Application No. 10/477,303
Filed: November 10, 2003
Attorney Docket No.: AP10126

**DECISION ON PETITION**

This is a decision on the Petition To Withdraw Holding Of Abandonment, received in the United States Patent & Trademark (USPTO) on March 29, 2007.

The petition is **DISMISSED**.

The above-identified application was held abandoned for applicant's failure to timely pay the issue fee, as required in the Notice of Allowance and Fee(s) Due mailed January 9, 2006. The Notice of Abandonment, mailed on June 8, 2006 indicates, "The submitted fee of $0 is insufficient. A balance of $1700 is due".

The Office acknowledges receipt of Part B – Fee(s) Transmittal via facsimile transmission on April 10, 2006 authorizing that the Issue Fee be charged to Deposit Account No. 50-2570. On April 10, 2006 when an attempt was made by the Office of Finance to charge the fees, there were insufficient funds in the Deposit Account to charge the required fee.

37 CFR 1.25 (a) and (b), which states in part:

> 1.25(a) ...An amount sufficient to cover all fee, services, copies, etc., requested must always be on deposit. Charges to accounts with insufficient funds will not be accepted."
>
> 1.25 (b) ...An authorization to charge a fee to a deposit account will not be considered payment of the fee on the date the authorization to charge the fee is effective as to the particular fee to be charged unless sufficient funds are present in the account to cover the fee.

In light of the non-compliance with 37 CFR 1.25, the holding of abandonment cannot be withdrawn.

Applicant may seek relief by filing a petition for Revival of Abandoned Application under CFR § 1.137 (a) or (b). (Forms are available at USPTO website http://www.uspto.gov)

- Under 37 CFR 1.137(a), a petition for the revival of an ***unavoidable*** abandoned application
- Under 37 CFR 1.137(b), a petition for the revival of an ***unintentionally*** abandoned application

Further inquires with respect to filing a petition under 37 CFR § 1.137 may be directed to the Office of Petitions at 571-272-3282 or addressed as follows:

*By mail:* Mail Stop Petitions
Commissioner for Patents
Office of Petitions
P O Box 1450
Alexandria, VA 22313-1450

Telephone inquires concerning this decision matter may 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

MAILED
JUN 10 2011
OFFICE OF PETITIONS

Browdy and Neimark, PLLC
1625 K Street, N.W.
Suite 1100
Washington, DC 20006

| | | |
|---|---|---|
| In re Patent of Girondi | : | |
| Patent No. 7,141,163 | : | |
| Issue Date: November 28, 2006 | : | Letter |
| Application No. 10/477,397 | : | |
| Filing Date: June 2, 2002 | : | |
| Attorney Docket No. GIRONDI4 | : | |

This is a notice regarding the request for acceptance of a fee deficiency submission under 37 CFR 1.28(c) filed May 9, 2011.

The deficiency payment of $1,720 is hereby accepted.

The change of status to large entity has been entered and made of record.

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : August 26, 2010

**TO SPE OF** : ART UNIT 3766

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10477514 Patent No.: 7727221

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 – 9D40-C**
**Palm Location 7580**

**Certificates of Correction Branch**

**703-756-1573**

**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:** TITLE PAGE WAS CORRECTED TO BE CONSISTENT WITH BIB DATA SHEET. CLAIM TO FOREIGN PRIORITY IS PROPER. SEE MPEP 201.13.G.

Carl H. Layno
**SPE**

3766
**Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/477,580 | 11/12/2003 | Brigitte Hellhammer | ETH1612 [14786] | 7377 |

25570 7590 11/22/2010
ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
Intellectual Property Department
P.O. Box 10064
MCLEAN, VA 22102-8064

| EXAMINER |
|---|
| MENDOZA, MICHAEL G |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3734 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 11/22/2010 | ELECTRONIC |

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

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

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lgallaugher@rmsclaw.com
dbeltran@rmsclaw.com
docketing@rmsclaw.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

ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
Intellectual Property Department
P.O. Box 10064
MCLEAN VA 22102-8064

In re Application of:
HELLHAMMER, BRIGITTE et al
Serial No. 10/477,580
Filed: Nov. 12, 2003
Docket: ETH1612(14786)
Title: AREAL IMPLANT

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition filed November 15, ~~2006~~ 2010 under 37 CFR 1.181 requesting a response to the Rule 116 amendment filed on August 11, 2010. The petition is being considered under 37 CFR 1.181 and no fee is required.

The petition is Dismissed as moot.

In finding petitioner's points of argument persuasive, the requested relief is granted. The examiner was instructed to mail a response to the applicant's Rule 116 amendment filed on August 11, 2010 as requested in the petition. In view of the Advisory Action mailed November 13, 2010, decision on the petition is moot and is dismissed. Since the application is under final, there is no basis for restarting any time period for further response.

It is noted that the applicant has filed a Notice of Appeal on Sep. 13, 2010, the application is now being forwarded to the examiner via the SPE of Art Unit 3734 awaiting for the applicant's appeal brief. The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DISMISSED AS MOOT.

Angela D. Sykes

Angela D. Sykes, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/477,580 | 11/12/2003 | Brigitte Hellhammer | ETH1612 [14786] | 7377 |

25570 7590 11/22/2010
ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
Intellectual Property Department
P.O. Box 10064
MCLEAN, VA 22102-8064

| EXAMINER |
|---|
| MENDOZA, MICHAEL G |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3734 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 11/22/2010 | ELECTRONIC |

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

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

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

lgallaugher@rmsclaw.com
dbeltran@rmsclaw.com
docketing@rmsclaw.com

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ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
Intellectual Property Department
P.O. Box 10064
MCLEAN VA 22102-8064

In re Application of:
HELLHAMMER, BRIGITTE et al
Serial No. 10/477,580
Filed: Nov. 12, 2003
Docket: ETH1612(14786)
Title: AREAL IMPLANT

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition filed November 15, ~~2006~~ 2010 under 37 CFR 1.181 requesting a response to the Rule 116 amendment filed on August 11, 2010. The petition is being considered under 37 CFR 1.181 and no fee is required.

The petition is Dismissed as moot.

In finding petitioner's points of argument persuasive, the requested relief is granted. The examiner was instructed to mail a response to the applicant's Rule 116 amendment filed on August 11, 2010 as requested in the petition. In view of the Advisory Action mailed November 17, 2010, decision on the petition is moot and is dismissed. Since the application is under final, there is no basis for restarting any time period for further response.

It is noted that the applicant has filed a Notice of Appeal on Sep. 13, 2010, the application is now being forwarded to the examiner via the SPE of Art Unit 3734 awaiting for the applicant's appeal brief. The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any inquiry regarding this decision should be directed to Henry Yuen, Special Programs Examiner, at (571) 272-4856.

PETITION DISMISSED AS MOOT.

Angela D. Sykes

Angela D. Sykes, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON MA 02111

MAILED
OCT 08 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent of Kallio et al. | : | DECISION ON REQUEST |
| Patent No. 7,620,389 | : | FOR RECONSIDERATION OF |
| Issue Date: November 17, 2009 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/477,630 | : | AS SET FORTH IN May 20, 2010 |
| Filed: December 31, 2003 | : | DECISION |
| Docket No. 39700-546N01US/ | : | |
| NC15502US | : | |

This is a decision on the petition filed on June 16, 2010, requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by four hundred thirteen (413) days. The petition was timely filed within one month of the mailing of a Decision on Request for Recalculation of Patent Term Adjustment in View of Wyeth and Notice of Intent to Issue Certificate of Correction, mailed May 20, 2010. As required by the May 20, 2010 decision, deposit account no. 50-0311 will be charged the required $200.00 fee under 37 CFR 1.18(e).

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by four hundred thirteen (413) days is **DISMISSED.**

The calculation of delay pursuant to 37 CFR 1.702(b) is based on a national stage commencement date of Monday, November 17, 2003, not November 14, 2003, as patentees argue. The international filing date is May 16, 2001. Applicants did not claim benefit of an earlier priority date. Early processing was requested. However, the applicant did not satisfy the 371(c) requirements before 30 months. As the expiration of the 30-month period pursuant to 35 U.S.C. 371(b) fell on Sunday, November 16, 2003, the period expired on the subsequent business day. *See* PCT Rule 80.5. Accordingly, the commencement date is Monday, September 23, 2002. As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period

begins on November 17, 2003 and ends on February 27, 2007, the day before the RCE was filed, and is 102 (not 105) days. *See* 35 U.S.C. 154(b)(1)(B)(i). As such, the patent term adjustment is 410 (442 days A delay + 102 days B delay - 134 days applicant delay), not 413 days.

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

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **four hundred ten (410)** days.

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,620,389 B2

DATED : **November 17, 2009** **DRAFT**

INVENTOR(S) : Kallio et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 308 days

Delete the phrase "by 308 days" and insert – by 410 days--

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

Decision Date : January 19, 2012

In re Application of :

Nobuyuki Nagayama

DECISION ON PETITION

UNDER CFR 1.313(c)(2)

Application No : 10477759

Filed : 25-Nov-2003

Attorney Docket No : 245834US2PCT

This is an electronic decision on the petition under 37 CFR 1.313(c)(2), filed January 19, 2012 , to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

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

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

This application file is being referred to Technology Center AU 1716 for processing of the request for continuing examination under 37 CFR 1.114 .

Office of Petitions

| Doc Code: PET.AUTO<br>Document Description: Petition automatically granted by EFS-Web | PTO/SB/140<br>U.S. Patent and Trademark Office<br>Department of Commerce |
|---|---|

| | |
|---|---|
| Electronic Petition Request | **PETITION TO WITHDRAW AN APPLICATION FROM ISSUE AFTER PAYMENT OF THE ISSUE FEE UNDER 37 CFR 1.313(c)** |
| Application Number | 10477759 |
| Filing Date | 25-Nov-2003 |
| First Named Inventor | Nobuyuki Nagayama |
| Art Unit | 1716 |
| Examiner Name | LUZ ALEJANDRO MULERO |
| Attorney Docket Number | 245834US2PCT |
| Title | PLASMA TREATMENT CONTAINER INTERNAL MEMBER, AND PLASMA TREATMENT APPARATUS HAVING THE PLASMA TREATMENT CONTAINER INTERNAL MEMBER. |

An application may be withdrawn from issue for further action upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary.

APPLICANT HEREBY PETITIONS TO WITHDRAW THIS APPLICATION FROM ISSUE UNDER 37 CFR 1.313(c).

A grantable petition requires the following items:
(1) Petition fee; and
(2) One of the following reasons:
(a) Unpatentability of one or more claims, which must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;
(b) Consideration of a request for continued examination in compliance with § 1.114 (for a utility or plant application only); or
(c) Express abandonment of the application. Such express abandonment may be in favor of a continuing application, but not a CPA under 37 CFR 1.53(d).

Petition Fee

☐ Applicant claims SMALL ENTITY status. See 37 CFR 1.27.

☐ Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

☐ Applicant(s) status remains as SMALL ENTITY.

☒ Applicant(s) status remains as other than SMALL ENTITY

Reason for withdrawal from issue

○ One or more claims are unpatentable

◉ Consideration of a request for continued examination (RCE) (List of Required Documents and Fees)

○ Applicant hereby expressly abandons the instant application (any attorney/agent signing for this reason must have power of attorney pursuant to 37 CFR 1.32(b)).

RCE request,submission, and fee.

☐ I certify, in accordance with 37 CFR 1.4(d)(4) that : The RCE request ,submission, and fee have already been filed in the above-identified application on

☒ Are attached.

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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 who has been given power of attorney in this application.

○ An attorney or agent registered to practice before the Patent and Trademark Office, acting in a representative capacity.

○ A sole inventor

○ A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors

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

○ The assignee of record of the entire interest that has properly made itself of record pursuant to 37 CFR 3.71

| | |
|---|---|
| Signature | /Ronald A. Rudder/ |
| Name | Ronald A. Rudder, Ph.D |
| Registration Number | 45618 |

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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OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

**MAILED**

DEC 14 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,585,529 | : | |
| VILLAR et al. | : | |
| Application No. 10/477,935 | : | |
| Issue Date: September 8, 2009 | : | REQUEST FOR RECONSIDERATION |
| Filed: March 9, 2004 | : | OF PATENT TERM ADJUSTMENT |
| Attorney Docket No. P/4043-96 | : | |

This is a decision on the "REPLY TO DECISION ON REQUEST FOR RECALCULATION OF PATENT TEM ADJUSTMENT IN VIEW OF *WYETH*", filed on August 11, 2010.

The petition is **DISMISSED**.

The petition for recalculation/reconsideration of the USPTO's PTA determination for U.S. Patent No. 7,585,529 is dismissed as untimely. On February 1, 2010, the USPTO published a Federal Register notice that, *inter alia*, announced a limited waiver of the two-month deadline for filing a petition for reconsideration of a PTA determination under 37 CFR sec. 1.705(d). *See Interim Procedure for Patentees to Request a Recalculation of the Patent Term Adjustment to Comply with the Federal Circuit Decision in Wyeth v. Kappos Regarding Overlapping Delay Provisions of 35 U.S.C. sec. 154(b)(2)(A)*, 75 *Fed. Reg.* 5043 (Feb. 1, 2010) (notice). Specifically, patent owners were permitted to request recalculation of a patent's PTA in view of the Federal Circuit decision *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010) up to 180 days after the grant of the patent. The USPTO determined not to accept requests for PTA recalculation more than 180 days after patent grant, however, in view of the statutory judicial-review provisions of 35 U.S.C. sec. 154(b)(4), which require that any civil action to challenge the USPTO's PTA determination be brought within 180 days of patent grant. The USPTO believes

that the statutory 180-day period for seeking court review of the USPTO's PTA determinations, particularly in view of the six-year statute of limitations that otherwise is applicable for actions under the Administrative Procedure Act, indicates a congressional intent that PTA issues be resolved shortly after a patent issues. The USPTO does not consider it likely that Congress created a scheme under which the time period to seek USPTO review of a PTA determination extends beyond the time period provided for a dissatisfied patentee to seek judicial review of the USPTO's PTA determination. Thus, the USPTO believes that the 180-day period in 35 U.S.C. sec. 154(b)(4) represents the outer limit on the USPTO's ability to conclude its PTA determination.

The Office notes that extensions of the time period for response are inapplicable under these circumstances. Accordingly, the extension of time fees totalling $2,480.00 will be refunded.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina T. Donnell

Christina Tartera Donnell
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
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Alexandria, Virginia 22313-1450
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OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

Mail Date: 01/19/2011

| | | |
|---|---|---|
| **Applicant** | : Elena Lopez Villar | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7585529 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/477,935 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 03/09/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1146** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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1180 AVENUE OF THE AMERICAS
NEW YORK NY 10036-8403

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OFFICE OF PETITIONS

In re Patent No. 7,585,529 :
VILLAR et al. :
Application No. 10/477,935 :
Issue Date: September 8, 2009 : REQUEST FOR RECONSIDERATION
Filed: March 9, 2004 : OF PATENT TERM ADJUSTMENT
Attorney Docket No. P/4043-96 :

This communication is in response to the decision on the "REPLY TO DECISION ON REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH*" of August 11, 2010, mailed January 19, 2011.

The petition is **DISMISSED** and the decision of January 19, 2011, is **VACATED**.

On September 8, 2009, the above-identified application matured into U.S. Patent No. 7,585,529 with a revised patent term adjustment of 793 days. On June 7, 2010, patentees filed a REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH*. On June 11, 2010, the Office mailed a decision dismissing patentees' Request for Recalculation. Specifically, the Request was deemed to be ineligible for consideration because it was filed more than 180 days after the grant date of the patent. In response, patentees submitted a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136(a) (and fee) requesting an extension of time for response within the fifth month. On August 11, 2010, patentees filed a REPLY TO DECISION ON REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH*, accompanied by a request for an extension of time for response within the first month (and fee). On December 14, 2010, the Office mailed a decision dismissing the petition for recalculation/reconsideration as untimely and indicating that

the patent term adjustment would remain 793 days. Thereafter, the Office erroneously mailed a decision granting the Request for Recalculation and stating that the Office would issue a certificate of correction reflecting a patent term adjustment of 1146 days.

Initially, the Office notes that the REPLY TO DECISION ON REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH* of August 11, 2010, was untimely filed. The decision dismissing patentees' Request for Recalculation stated that patentees must file any reply to the decision within one month or thirty days, whichever was longer, from the mail date of the decision. In this instance, the REPLY TO DECISION ON REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH* of August 11, 2010, was not filed within one month or thirty days of the June 11, 2010 mail date of the decision dismissing patentees' Request for Recalculation. As no extensions of time were permitted under 37 CFR 1.136, the period for filing a request for reconsideration ended on Monday, July 12, 2010. The Office reminds patentee that 35 U.S.C. 154 requires the Office to provide one opportunity to request reconsideration of any patent term adjustment determination made by the Director and authorizes the Director to establish the procedures for requesting such reconsideration.

Moreover, the REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH* of June 7, 2010, and the REPLY TO DECISION ON REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH* of August 11, 2010, were filed more than 180 days after the grant date of the patent. Accordingly, the Office properly dismissing the Requests by decision dated June 11, 2010, and December 14, 2010.

On February 1, 2010, the USPTO published a Federal Register notice that, *inter alia*, announced a limited waiver of the two-month deadline for filing a petition for reconsideration of a PTA determination under 37 CFR sec. 1.705(d). *See Interim Procedure for Patentees to Request a Recalculation of the Patent Term Adjustment to Comply with the Federal Circuit Decision in Wyeth v. Kappos Regarding Overlapping Delay Provisions of 35 U.S.C. sec. 154(b)(2)(A)*, 75 *Fed. Reg.* 5043 (Feb. 1, 2010) (notice). Specifically, patent owners were permitted to request recalculation of a patent's PTA in view of the Federal Circuit decision *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010) up to

180 days after the grant of the patent. The notice indicated that the USPTO would deny as untimely any request for recalculation of patent term adjustment indicated a patent that was not filed within 180 days of the patent grant date. The USPTO is without authority to decide a request for recalculation more than 180 days after patent grant in view of the statutory judicial-review provisions of 35 U.S.C. 154(b)(4), which require that any civil action to challenge the USPTO's PTA determination be brought within 180 days of patent grant.

Accordingly, the Office did not have the statutory authority to grant the request for reconsideration/recalculation by way of the decision mailed January 19, 2011, pursuant to 35 U.S.C. 154(b)(4)(A). The granting of the request for reconsideration/recalculation is improper, and thus, the decision of January 19, 2011, must be vacated. The Office will not issue a certificate of correction reflecting a patent term adjustment of 1146 days.

The Office has updated the PALM and PAIR screens to reflect that the patent term adjustment is 793 days. A copy of the updated PAIR screen, showing the corrected determination, is enclosed. This matter is now closed.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: updated PAIR screen

## Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/477,935

| | | | |
|---|---|---|---|
| Filing or 371(c) Date: | 03-09-2004 | Overlapping Days Between {A and B} or {A and C}: | 324 |
| Issue Date of Patent: | 09-08-2009 | Non-Overlapping USPTO Delays: | 1231 |
| A Delays: | 878 | PTO Manual Adjustments: | -353 |
| B Delays: | 677 | Applicant Delays: | 85 |
| C Delays: | 0 | Total PTA Adjustments: | 793 |

**Patent Term Adjustment History** **Explanation Of Calculations**

| Number | Date | Contents Description | PTO (Days) | APPL (Days) | Start |
|---|---|---|---|---|---|
| 77 | 01-19-2011 | Adjustment of PTA Calculation by PTO | 324 | | 0 |
| 76 | 01-19-2011 | Adjustment of PTA Calculation by PTO | | 677 | 0 |
| 74 | 06-11-2010 | Petition Decision - Granted | | | 0 |
| 71 | 06-07-2010 | Petition Entered | | | 0 |
| 70 | 12-14-2010 | Mail-Petition Decision - Dismissed | | | 0 |
| 69 | 12-14-2010 | Petition Decision - Dismissed | | | 0 |
| 68 | 08-11-2010 | Petition Entered | | | 0 |
| 63 | 09-08-2009 | Recordation of Patent Grant Mailed | | | 0 |
| 62 | 08-19-2009 | Issue Notification Mailed | | | 0 |
| 61.5 | 09-21-2008 | PTA 36 Months | 677 | | 61.4 |
| 61.4 | 11-14-2003 | Commencement Date | | | 0 |
| 61 | 09-08-2009 | Patent Issue Date Used in PTA Calculation | | | 0 |
| 60 | 08-06-2009 | Export to Final Data Capture | | | 0 |
| 59 | 08-04-2009 | Dispatch to FDC | | | 0 |
| 58 | 08-04-2009 | Application Is Considered Ready for Issue | | | 0 |
| 57 | 07-31-2009 | Issue Fee Payment Verified | | | 0 |
| 56 | 07-31-2009 | Issue Fee Payment Received | | | 0 |
| 55 | 05-29-2009 | Finished Initial Data Capture | | | 0 |

| | | | | |
|---|---|---|---|---|
| 54 | 05-08-2009 | Export to Initial Data Capture | | 0 |
| 52 | 05-06-2009 | Mail Notice of Allowance | | 0 |
| 51 | 05-05-2009 | Issue Revision Completed | | 0 |
| 50 | 05-05-2009 | Document Verification | | 0 |
| 49 | 05-05-2009 | Notice of Allowance Data Verification Completed | | 0 |
| 47 | 05-04-2009 | Examiner's Amendment Communication | | 0 |
| 46 | 05-04-2009 | Notice of Allowability | | 0 |
| 42 | 01-15-2009 | Miscellaneous Incoming Letter | | 0 |
| 41 | 01-26-2009 | Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received | | 0 |
| 40 | 02-26-2009 | Date Forwarded to Examiner | | 0 |
| 39 | 01-26-2009 | Response after Non-Final Action | 24 | 35 |
| 38 | 01-26-2009 | Request for Extension of Time - Granted | | 0 |
| 37 | 12-16-2008 | Mail Examiner Interview Summary (PTOL - 413) | | 0 |
| 36 | 12-11-2008 | Examiner Interview Summary Record (PTOL - 413) | | 0 |
| 35 | 10-02-2008 | Mail Non-Final Rejection | | 0 |
| 34 | 09-29-2008 | Non-Final Rejection | | 0 |
| 33 | 09-24-2008 | Date Forwarded to Examiner | | 0 |
| 32 | 09-22-2008 | Amendment Submitted/Entered with Filing of CPA/RCE | | 0 |
| 31 | 09-24-2008 | Date Forwarded to Examiner | | 0 |
| 30 | 09-22-2008 | Request for Continued Examination (RCE) | | 0 |
| 29 | 09-24-2008 | Disposal for a RCE / CPA / R129 | | 0 |
| 28 | 09-22-2008 | Workflow - Request for RCE - Begin | | 0 |
| 27 | 06-27-2008 | Mail Final Rejection (PTOL - 326) | | 0 |
| 26 | 06-20-2008 | Final Rejection | | 0 |
| 25 | 04-18-2008 | Date Forwarded to Examiner | | 0 |

| | | | | | |
|---|---|---|---|---|---|
| 24 | 03-05-2008 | Response after Non-Final Action | | 61 | 21 |
| 23 | 03-05-2008 | Request for Extension of Time - Granted | | | 0 |
| 22 | 10-04-2007 | Case Docketed to Examiner in GAU | | | 0 |
| 21 | 10-04-2007 | Mail Non-Final Rejection | 878 | | 9 |
| 20 | 10-01-2007 | Non-Final Rejection | | | 0 |
| 17 | 11-16-2006 | Case Docketed to Examiner in GAU | | | 0 |
| 15 | 08-03-2004 | Request for Foreign Priority (Priority Papers May Be Included) | | | 0 |
| 14 | 09-15-2005 | Miscellaneous Incoming Letter | | | 0 |
| 13 | 04-27-2004 | IFW TSS Processing by Tech Center Complete | | | 0 |
| 12 | 04-27-2004 | Case Docketed to Examiner in GAU | | | 0 |
| 10 | 04-01-2004 | Cleared by OIPE CSR | | | 0 |
| 9 | 03-09-2004 | 371 Completion Date | | | 0 |
| 8 | 03-25-2004 | Application Return from OIPE | | | 0 |
| 7 | 03-25-2004 | Notice of DO/EO Acceptance Mailed | | | 0 |
| 6 | 03-25-2004 | Application Return TO OIPE | | | 0 |
| 4 | 03-22-2004 | Application Dispatched from OIPE | | | 0 |
| 3 | 03-22-2004 | Notice of DO/EO Acceptance Mailed | | | 0 |
| 2 | 03-18-2004 | Correspondence Address Change | | | 0 |
| 0.5 | 05-03-2002 | International Filing date | | | 0 |

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/478,036 | 11/17/2003 | Daniel Henry Densham | GP247-01.UT | 6371 |

21365 7590 03/03/2011
GEN PROBE INCORPORATED
10210 GENETIC CENTER DRIVE
Mail Stop #1 / Patent Dept.
SAN DIEGO, CA 92121

| EXAMINER |
|---|
| POHNERT, STEVEN C |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1634 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 03/03/2011 | 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):

patentdept@gen-probe.com

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| | |
|---|---|
| In re Application of: | : |
| Daniel Henry Densham | : PETITION DECISION |
| Serial No.: 10/478,036 | : |
| Filed: November 17, 2003 | : |
| Attorney Docket No.: **GP247-01.UT** | |

This is in response to the petition under 37 CFR § 1.181, filed December 20, 2010, requesting that the finality of the Office action of November 16, 2010 be withdrawn because it was premature.

BACKGROUND

On June 10, 2010, the examiner mailed a non-final Office action setting a three month statutory limit for reply. At the time of this Office action, claims 1, 5-12, 14-21 and 28-35 were pending and were objected to. It is believed the examiner intended "rejected" and not "objected to". Claims 1, 5, 7-9, 11-12, 14-19, 21 and 29-33 were rejected under 35 USC 103(a) as being unpatentable over Stemple et al. in view of Grow et al., West et al., Vo-Dinh, Peleg and Lewis et al. Claims 6 and 28 were rejected under 35 USC 103(a) as being unpatentable over Stemple et al. in view of Grow et al., West et al., Vo-Dinh, Peleg and Lewis et al. as applied to claims 1, 5, 7-9, 11-12, 14-19, 21 and 29-33 above, and further in view of Waggoner et al. Claim 10 was rejected under 35 USC 103(a) as being unpatentable over Stemple et al. in view of Grow et al., West et al., Vo-Dinh, Peleg and Lewis et al. as applied to claims 1, 5, 7-9, 11-12, 14-19, 21 and 29-33 above, and further in view of Densham. Claim 20 was rejected under 35 USC 103(a) as being unpatentable over Stemple et al. in view of Grow et al., West et al., Vo-Dinh, Peleg and Lewis et al. as applied to claims 1, 5, 7-9, 11-12, 14-19, 21 and 29-33 above, and further in view of Holzrichter. Claim 34 was rejected under 35 USC 103(a) as being unpatentable over Stemple et al. in view of Grow et al. and Waggoner et al. Claim 35 was rejected under 35 USC 103(a) as being unpatentable over Stemple et al. in view of Grow et al. and Waggoner et al. as applied to claim 34 above, and further in view of Vo-Dinh, Peleg and Lewis et al.

On September 10, 2010, applicants filed amendments to the claims and arguments traversing the examiner's rejections instituted in the non-final Office action of June 10, 2010.

On November 16, 2010, the examiner mailed a final Office action setting a three month statutory limit for reply. At the time of this Office action, claims 1, 5-10, 12, 14, 15, 17, 18, 20, 21, 28-31 and 36-46 were rejected. Claims 1, 5, 7-9, 12, 14-15, 17, 18, 21, 29-31, 36-40 and 42-46 were rejected under 35 USC 103(a) as being unpatentable over Stemple et al. in view of Grow et al., West et al., Vo-Dinh, Haller, Peleg and Lewis et al. Claims 6 and 28 were rejected under 35 USC 103(a) as being unpatentable over Stemple et al. in view of Grow et al., West et al., Vo-Dinh, Haller, Peleg and Lewis et al. as applied to claims 1, 5, 7-9, 12, 14-15, 17, 18, 21, 29-31, 36-40 and 42-46 above, and further in view of Waggoner et al. Claim 10 was rejected under 35 USC 103(a) as being unpatentable over Stemple et al. in view of Grow et al., West et al., Vo-Dinh, Haller, Peleg and Lewis et al. as applied to claims 1, 5, 7-9, 12, 14-15, 17, 18, 21, 29-31, 36-40 and 42-46 above, and further in view of Densham. Claim 20 was rejected under 35 USC 103(a) as being unpatentable over Stemple et al. in view of Grow et al., West et al., Vo-Dinh, Haller, Peleg and Lewis et al. as applied to claims 1, 5, 7-9, 12, 14-15, 17, 18, 21, 29-31, 36-40 and 42-46 above, and further in view of Holzrichter. Claim 41 was rejected under 35 USC 103(a) as being unpatentable over Stemple et al. in view of Grow et al., West et al., Vo-Dinh, Haller, Peleg and Lewis et al. as applied to claims 1, 5, 7-9, 12, 14-15, 17, 18, 21, 29-31, 36-40 and 42-46 above, and further in view of Lukas et al. The examiner pointed out that "Applicant's amendment necessitated the new ground(s) of rejection".

On December 20, 2010, applicant submitted the petition under consideration herein.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition, applicant argues "... the Hailer et al. reference is utilized by the Examiner in the present Office Action solely in an attempt to rebut Applicant's argument, not in response to any claim amendments. MPEP § 706.07(a) states that a second or subsequent action on the merits shall be final *"except* where the examiner introduces a new ground of rejection that is neither necessitated by amendment of the claims nor based on information submitted in an [IDS under § 1.97(c) *(i.e.,* an IDS after an action on the merits)]" (emphasis added). Neither condition applies to the newly introduced ground of rejection."

Applicant also points out "The newly cited Hailer et al. reference[2] was initially cited by the Examiner on Form PTO- 892 that accompanied the present Office Action. As such, the Hailer et al. reference was not submitted by Applicant in a manner that would support making the present Office Action final. Moreover, the amendment of claim 1 in the prior Amendment did not necessitate the citation of Hailer et al. For example, 1 was amended in the reply dated September 9, 2010 as Hailer et al. is not relevant to any amendment to claim 1 set forth in Applicant's most recent Amendment. Accordingly, the amendment to claim 1 did not necessitate the present rejection under 35 U.5.C. 103(a) since the Examiner could have previously cited,[3] but did not

identify or rely upon,[4] the Hailer et al. reference in discussing the merits of claim 1 prior to the November 16, 2010 Amendment."

Finally, applicant points out that "In all fairness, therefore, Applicant should be permitted an opportunity to address the newly cited Hailer et al. reference prior to becoming subject to the limitations inherent under 37 C.F.R. §1.116. Accordingly, Applicant submits that the November 16, 2010 Office Action was inappropriately designated as a Final action, and therefore requests that the finality be withdrawn."

Applicant's points are well-taken and found persuasive. Accordingly, it is *not* proper for an office action to be made final when the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c).

**DECISION**

The petition is subsequently **GRANTED**.

The Office action mailed November 16, 2010 is hereby vacated to the extent that it was made "final" and the Office action is now considered to be a non-final Office action.

Should there be any questions about this decision please contact Quality Assurance Specialist 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.

JMStone

Jacqueline Stone
Director, Technology Center 1600

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 9/23/10 **Paper No.:** —

**TO SPE OF** : ART UNIT 2115

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/478082 Patent No.: 7302397 B2

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**

Virginia Tolbert
**Certificates of Correction Branch**
571-272-0460

**Thank You For Your Assistance**

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

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

**Comments:** _____

/Thomas Lee/ SPE 2115 11/2/2010

**PROPOSED EXAMINER'S AMENDMENT**

**10/478,117**

Claim 1:

An electroluminescent device comprising a hole injecting electrode, an electron injecting electrode and at least one organic light emitting layer disposed between said hole injecting electrode and said electron injecting electrode, wherein a layered $TX_2$ metal dichalcogenide layer is disposed between said hole injecting electrode and said light emitting layer, wherein the chalcogen component of said layered $TX_2$ metal dichalcogenide layer being selected from the group consisting of sulfur, selenium and tellurium, wherein the metallic component of said layered $TX_2$ metal dichalcogenide is selected from the group consisting of titanium, zirconium, hafnium, vanadium, tantalum, niobium, molybdenum and tungsten, and wherein the layered $TX_2$ metal dichalcogenide layer has a structure comprising sheets of metal atoms sandwiched between sheets of chalcogen atoms.

Claim 6:

Cancelled

Claim 7:

Cancelled

Claim 11:

An electroluminescent device according to claim 1, wherein said layered $TX_2$ metal dichalcogenide layer has a thickness of from 3 nm to 20 nm.

Claim 12:

An electroluminescent device according to claim 1, wherein said layered $TX_2$ metal dichalcogenide layer has a thickness of from 3 nm to 10 nm.

Claim 13:

An electroluminescent device according to claim 1, wherein said layered $TX_2$ metal dichalcogenide layer has a thickness of from 3 nm to 7 nm.

Claim 18:

An electroluminescent device according to claim 1, wherein a layer of a material is disposed between said organic light emitting layer and said layered $TX_2$ metal dichalcogenide layer which is capable of restraining migration of electrons from said organic light emitting layer to said layered $TX_2$ metal dichalcogenide layer.

Claim 19:

An electroluminescent device according to claim 18, wherein said material which is capable of restraining migration of electrons from said organic light emitting layer to said layered $TX_2$ metal dichalcogenide layer is an oxide of the same metal as that of the layered $TX_2$ metal dichalcogenide layer.

Claim 20:

An electroluminescent device according to claim 19, wherein said layer of oxide of the same metal as that of said layered $TX_2$ metal dichalcogenide layer is formed by oxidizing the exposed surface of the layered $TX_2$ metal dichalcogenide layer after it has been deposited on said hole injecting electrode.

Claim 21:

An electroluminescent device according to claim 19, wherein said layer of oxide of the same metal as that of said layered $TX_2$ metal dichalcogenide layer has a thickness of from 1 nm to 10 nm.

Claim 22:

An electroluminescent device according to claim 19, wherein said layer of oxide of the same metal as that of said layered $TX_2$ metal dichalcogenide layer has a thickness of from 2 nm to 6 nm.

Claim 23:

An electroluminescent device according to claim 19, wherein said layer of oxide of the same metal as that of said layered $TX_2$ metal dichalcogenide layer has a thickness of from 2 nm to 3 nm.

Claim 29:

A process for the production of an electroluminescent device according to claim 1, which includes the step of depositing said layered $TX_2$ metal dichalcogenide on said hole injecting electrode according the following steps:

(a) intercalating lithium atoms into said layered $TX_2$ metal dichalcogenide;

(b) adding water to the resulting intercalated material resulting in an exfoliation reaction so as to give single layers of said layered $TX_2$ metal dichalcogenide suspended in the water;

(c) adding a water immiscible solvent to the product of step (b) followed by agitating the resulting mixture to give a thin film of layered $TX_2$ metal dichalcogenide at the solvent/water interface; and

(d) wetting said hole injecting layer supported on a substrate and then dipping it into the solvent/water interface produced in step (c) above and allowing the thin film of layered $TX_2$ metal dichalcogenide to spread on the surface of said hole injecting layer.

Claim 30:

A process according to claim 29, wherein the step (d) is followed by annealing of the thin film of layered $TX_2$ metal dichalcogenide at a temperature of at least 100°C.

Claim 32:

An electroluminescent device according to claim 1, wherein said layered $TX_2$ metal dichalcogenide layer is annealed at a temperature of at least 100°C after the deposition thereof on said hole injecting electrode.

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Suite 1100
777 - 6th Street, NW
WASHINGTON DC 20001

**MAILED**

FEB 28 2011

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,842,480 | : | DECISION ON REQUEST FOR |
| CELIS, ESTEBAN | : | RECONSIDERATION OF |
| Issue Date: 11/30/2010 | : | PATENT TERM ADJUSTMENT AND |
| Application No. 10/478,179 | : | NOTICE OF INTENT TO ISSUE |
| Filed: 06/16/2004 | : | CERTIFICATE OF CORRECTION |
| Docket No. GLIK-007/01US | : | |
| 310975-2030 | : | |

This is a decision on the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §§1.705(d) filed on January 14, 2011, requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand eight hundred fifty-two (1852) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.** The term of the above-identified patent is extended or adjusted by **one thousand eight hundred ninety-three (1893) days**.

After further review, the Office has determined that patentee has correctly calculated 500 days of A delay, 608 days of B delay, 865 days of C delay, and 80 days of applicant delay. However, the Office has concluded that there is no overlapping days between the A and C periods or the A and B periods.

Accordingly, the patent term adjustment is 1893 days (500 days of A delay + 608 days of B delay + 865 days of C delay - 0 days of overlap - 80 days of applicant delay).

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

The Office acknowledges the submission of the $200.00 fee set forth in 37 CFR 1.18(e).

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand eight hundred ninety-three (1893) days.**

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT: 7,842,480

DATED: Nov. 30, 2010 **DRAFT**

INVENTOR(S): CELIS

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 1564 days

Delete the phrase "by 1564 days" and insert – by 1893 days--

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400 Berwyn Park
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MAILED

AUG 27 2010

OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent of Weiner et al. | : DECISION ON REQUEST FOR |
| Patent No. 7,625,751 | : RECONSIDERATION OF |
| Issue Date: December 1, 2009 | : PATENT TERM ADJUSTMENT AND |
| Application No. 10/478,743 | : NOTICE OF INTENT TO ISSUE |
| Filed: September 9, 2004 | : CERTIFICATE OF CORRECTION |
| Attorney Docket No. 130694.07101 | : |

This is a decision on the petition filed on January 27, 2010 and supplemented on May 21, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand one hundred and seven (1107) days. The May 21, 2010 petition was timely filed within one month of the mailing of a Decision on Request for Recalculation of Patent Term Adjustment in View of Wyeth and Notice of Intent to Issue Certificate of Correction, mailed April 22, 2010.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand one hundred and seven (1107) days is **GRANTED to the extent indicated herein.**

The Office concurs that a 31 day adjustment should have been entered for the Office delay in mailing an Office action in response to the October 15, 2007 response after non-final. Accordingly, a period of adjustment of 31 days, beginning on February 16, 2008 and ending on March 17, 2008, the date a non-final Office action was mailed, will be entered.

In calculating the period of delay under 35 U.S.C. 154(b)(1)(B) ("B Delay"), patentees indicate the period of delay began on November 25, 2006, the date that is three years after the date of commencement, and ended on June 14, 2009, the day before a Notice of Appeal was filed, and is 933 days.

However, the national stage commenced in this application on November 25, 2003, which is the date that is 30 months from the priority date of May 25, 2001. The date that is three years after the date of commencement is November 26, 2006. The three year period runs from November 26, 2006 and ends on December 1, 2009, the date of issuance of the patent. As stated in

35 U.S.C. 154(b)(1)(B)(ii), B delay does not include "any time consumed by appellate review by the Board of Patent Appeals and Interferences." The period of B delay does not include the 67 day period beginning on June 15, 2009, the date the Notice of Appeal was filed, and ending on August 20, 2009, the day a Notice of Allowance was mailed.

The period of B delay in this case is 1004 days, which is 1102 days beginning on November 26, 2006, the day after the date three years after the commencement date, and ending on December 1, 2009, the date of issuance of the patent, reduced by the 67 days consumed by appellate review and reduced by the 31 days of overlapping A and B delay, beginning on February 16, 2008 and ending on March 17, 2008. *See* 1.703(b).

The Office does not concur that patentees are entitled to 170 days for the period from June 15, 2009 the date the Notice of Appeal was filed to December 1, 2009, the date when the patent issued, pursuant to 37 CFR 1.702(e). There was no successful appellate review, as the board did not address the appeal.

Therefore, correct patent term adjustment is 1039 days, which is the sum of 341 days of delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") and 1004 (1102 - 67 excluded – 31 overlapping period) of B Delay and reduced by 306 days for patentees' delay.

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

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Two $200.00 petition fees under 37 CFR 1.18(e) have been charged. Only one is necessary. One will be credited to petitioners' credit card.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand thirty-nine (1039)** days.

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,625,751 B2

DATED : **December 1, 2009** **DRAFT**

INVENTOR(S) : Weiner et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 1040 days

Delete the phrase "by 1040 days" and insert – by 1039 days--

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. 7100601
Issue Date: September 5,2006
Application No. 10478848
Filed: July 8,2004
Attorney Docket No. Q78436

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

This is a decision on the electronic petition, filed December 27,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 27,2010 . 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) |
|---|---|---|---|---|
| 7,100,601 | 2006-09-05 | 10478848 | 2004-07-08 | Q78436 |

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

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 | /Raja Saliba/ | Date (YYYY-MM-DD) | 2010-12-27 |
| Name | Raja N. Saliba | Registration Number | 43078 |

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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MAILED
AUG 04 2011
OFFICE OF PETITIONS

BATEMAN IP LAW GROUP
P.O. BOX 1319
SALT LAKE CITY UT 84110

In re Patent No. 7,828,777 :
Issue Date: November 9, 2010 :
Application No. 10/479,206 : DECISION ON PETITION
Filed: March 1, 2004 :
Attorney Docket No. 2778.GLE.PT :

This is a decision on the Request For Certificate Of Correction Under 37 C.F.R. §1.322, filed June 16, 2011, which is being treated as a Petition Under 37 CFR 3.81(b) to add --Arzneimittel GmbH Apotheker Vetter & Co. Ravensburg (DE)-- as the correct assignee to the Title Page of the Patent via a Certificate of Correction.

The petition under 37 CFR §3.81(b) is **DISMISSED**.

Petitioner requests that the present Petition was submitted to add the correct –Arzneimittel GmbH Apotheker Vetter & Co. Ravensburg (DE)-- on the previously submitted PTOL-85B and such error was a mistake.

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.

U.S. Patent and Trademark Office assignments records disclose that a corrective assignment *Arzneimittel GmbH Apotheker Vetter & Co. Ravensburg* was submitted for recordation on April 28, 2011. Therefore, the corrective recorded assignment was **after the date of issuance of this patent**. Accordingly, since the corrective assignment was not submitted for recordation until after issuance of this patent, issuance of a certification of correction would not be proper.

However, the requisite $130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(h), was accompanied deposit account authorization to charge any required fees. As such, the fee has been charged as authorized.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

Cheryl Gibson Baylor

Cheryl Gibson-Baylor
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

MAILED

DEC 13 2010

OFFICE OF PETITIONS

MCCARTER & ENGLISH, LLP BOSTON
265 Franklin Street
Boston MA 02110

In re Application
Penger, et al.
Application No. 10/479,225
Filing or 371(c) Date: April 8, 2004
Dkt. No.: 118553-21001

: PATENT TERM ADJUSTMENT

This is in response to the application for patent term adjustment filed September 10, 2010. This matter is being properly treated under 37 CFR 1.705(b) as an application for patent term adjustment.

The application for patent term adjustment is GRANTED TO THE EXTENT INDICATED HEREIN.

Applicant submits that the correct patent term adjustment to be indicated on the patent is at minimum 624 days, not 173 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and on the basis that the overall adjustment is subject to further reduction of 186 days pursuant to 37 CFR 1.704(c)(7) in connection with the reply filed April 10, 2006.

37 CFR 1.702(b)

Insofar as the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See, § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

37 CFR 1.704(c)(7)

In addition to the applicant delay totalling 173 days, as asserted by the applicants, the overall patent term adjustment as of the time of allowance is subject to an additional reduction of 186 days pursuant to 37 CFR 1.704(c)(7). The reduction commenced October 7, 2005 and ended April 10, 2006.

CONCLUSION

Accordingly, for the reasons set forth herein, as of the time of allowance, the application was entitled to an overall adjustment of zero days (507 days per § 1.703(a) - 520 days for applicant delays per § 1.704).

Receipt is hereby acknowledged of the $200.00 patent term adjustment application fee required per 37 CFR 1.705(b)(1).

---

[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Adjusted PAIR Calculation

Day : Wednesday

# PALM INTRANET

Date: 12/8/2010
Time: 09:38:02

| PTA Calculations for Application: 10/479225 | | | |
|---|---|---|---|
| Application Filing Date: | 04/08/2004 | PTO Delay (PTO): | 507 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 334 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 0 |
| PTO Delay Adjustment: | -186 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 130 | 12/08/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 186 | |
| 113 | 06/10/2010 | MAIL NOTICE OF ALLOWANCE | | | |
| 112 | 06/07/2010 | ISSUE REVISION COMPLETED | | | |
| 111 | 06/07/2010 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 110 | 06/07/2010 | DOCUMENT VERIFICATION | | | |
| 109 | 06/04/2010 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 108 | 06/04/2010 | NOTICE OF ALLOWABILITY | | | |
| 107 | 06/02/2010 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 104 | 04/19/2010 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 103 | 04/15/2010 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 102 | 04/01/2010 | DATE FORWARDED TO EXAMINER | | | |
| 101 | 03/29/2010 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 100 | 03/29/2010 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 61 | 96 |
| 99 | 04/01/2010 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 98 | 03/29/2010 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 97 | 03/29/2010 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 96 | 10/27/2009 | MAIL FINAL REJECTION (PTOL - 326) | 4 | | 93 |
| 95 | 10/26/2009 | FINAL REJECTION | | | |
| 94 | 08/11/2009 | DATE FORWARDED TO EXAMINER | | | |
| 93 | 06/23/2009 | RESPONSE AFTER NON-FINAL ACTION | | 92 | 90 |
| 92 | 06/23/2009 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 91 | 11/11/2008 | REFERENCE CAPTURE ON IDS | | | |

| | | | | | |
|---|---|---|---|---|---|
| 90 | 12/23/2008 | MAIL NON-FINAL REJECTION | | | |
| 89 | 12/19/2008 | NON-FINAL REJECTION | | | |
| 88 | 12/18/2008 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 87 | 11/11/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 86 | 11/11/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 0 | 82 |
| 85 | 11/25/2008 | DATE FORWARDED TO EXAMINER | | | |
| 84 | 11/11/2008 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 83 | 11/25/2008 | DATE FORWARDED TO EXAMINER | | | |
| 81 | 11/25/2008 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 80 | 11/11/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 79 | 11/11/2008 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 78 | 10/07/2008 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 77 | 10/02/2008 | ADVISORY ACTION (PTOL-303) | | | |
| 76 | 09/11/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 75 | 09/11/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 74 | 09/26/2008 | DATE FORWARDED TO EXAMINER | | | |
| 73 | 09/11/2008 | AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL | | | |
| 72 | 09/11/2008 | NOTICE OF APPEAL FILED | | 89 | 66 |
| 71 | 09/11/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 70 | 09/11/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 68 | 03/21/2008 | MAIL-PETITION DECISION - DISMISSED | | | |
| 67 | 03/21/2008 | PETITION DECISION - DISMISSED | | | |
| 66 | 03/14/2008 | MAIL FINAL REJECTION (PTOL - 326) | 12 | | 59 |
| 65 | 03/03/2008 | FINAL REJECTION | | | |
| 64 | 02/14/2008 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 63 | 01/30/2008 | PETITION ENTERED | | | |
| 62 | 02/13/2008 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 61 | 01/03/2008 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 60 | 12/30/2007 | DATE FORWARDED TO EXAMINER | | | |
| | | | | | |

| | | | | | |
|---|---|---|---|---|---|
| 59 | 11/02/2007 | RESPONSE AFTER NON-FINAL ACTION | | 92 | 57 |
| 58 | 11/02/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 57 | 05/02/2007 | MAIL NON-FINAL REJECTION | | | |
| 56 | 04/30/2007 | NON-FINAL REJECTION | | | |
| 53 | 02/20/2007 | DATE FORWARDED TO EXAMINER | | | |
| 52 | 01/11/2007 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 51 | 01/11/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 50 | 10/12/2006 | MAIL RESTRICTION REQUIREMENT | 491 | | 42 |
| 49 | 10/02/2006 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 48 | 06/02/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 47 | 06/02/2006 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 45 | 12/01/2005 | PRELIMINARY AMENDMENT | | | |
| 44 | 06/02/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 43 | 05/31/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 42 | 04/08/2004 | 371 COMPLETION DATE | | | |
| 41 | 04/26/2006 | APPLICATION RETURN FROM OIPE | | | |
| 40 | 04/26/2006 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 39 | 04/10/2006 | ADDITIONAL APPLICATION FILING FEES | | | |
| 38 | 10/06/2005 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | | |
| 36 | 10/06/2005 | A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN | | | |
| 35 | 10/06/2005 | A SET OF SYMBOLS AND PROCEDURES, PROVIDED TO THE PTO ON A SET OF COMPUTER LISTINGS, THAT DESCRIBE IN | | | |
| 33 | 10/06/2005 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | | |
| 32 | 04/14/2006 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 31 | 03/10/2006 | NOTICE OF DO/EO DEFECTIVE RESPONSE MAILED. | | | |
| 30 | 02/01/2006 | ADDITIONAL APPLICATION FILING FEES | | | |
| 28 | 02/01/2006 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | | |
| 27 | 01/23/2006 | WITHDRAW PRE-EXAM ABANDON | | | |
| 26 | 03/01/2006 | MAIL-PETITION TO REVIVE APPLICATION - GRANTED | | | |
| 25 | 02/01/2006 | PETITION ENTERED | | | |
| | | | | | |

| | | | | | |
|---|---|---|---|---|---|
| 24 | 01/20/2006 | ABANDONMENT -- INC. APPLICATION UNDER RULE 53(B) - FILING FEE PAID | | | |
| 23 | 01/23/2006 | WITHDRAW PRE-EXAM ABANDON | | | |
| 22 | 01/20/2006 | ABANDONMENT -- INC. APPLICATION UNDER RULE 53(B) - FILING FEE PAID | | | |
| 21 | 08/16/2005 | SEQUENCE DISCLOSURE PROBLEMS | | | |
| 19 | 06/03/2004 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | | |
| 18.7 | 04/08/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 18 | 04/08/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 17 | 07/07/2004 | PRE-EXAM OFFICE ACTION WITHDRAWN | | | |
| 16 | 09/22/2004 | APPLICATION RETURN TO OIPE | | | |
| 15 | 07/28/2004 | CLEARED BY OIPE CSR | | | |
| 14 | 07/09/2004 | CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE | | | |
| 12 | 07/07/2004 | APPLICATION DISPATCHED FROM OIPE | | | |
| 11 | 07/07/2004 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 10 | 06/03/2004 | INFORMATION DISCLOSURE STATEMENTS | | | |
| 9 | 06/03/2004 | ADDITIONAL APPLICATION FILING FEES | | | |
| 7 | 04/08/2004 | PRELIMINARY AMENDMENTS | | | |
| 5 | 06/03/2004 | CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT | | | |
| 4 | 04/08/2004 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 2 | 04/08/2004 | NOTICE OF DO/EO MISSING REQUIREMENTS MAILED | | | |

**Search Another: Application#** [ ] Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to OASIS | Home page

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MAILED

JUN 13 2011

OFFICE OF PETITIONS

MCCARTER & ENGLISH, LLP BOSTON
265 Franklin Street
Boston MA 02110

| | |
|---|---|
| In re Patent No. 7,871,767 | : DECISION ON PATENT TERM |
| Issued: January 18, 2011 | : ADJUSTMENT and NOTICE OF INTENT |
| Application No. 10/479,225 | : TO ISSUE CERTIFICATE OF |
| Filed: April 8, 2004 | : CORRECTION |
| Dkt. No.: 118553-21001 | : |

This is a decision on the petition filed on March 17, 2011 requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by 628 days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by 628 days is **GRANTED**.

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

The application is being forwarded to the Certificates of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 628 days.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Attorney Adviser
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,871,767

DATED : January 18, 2011 **DRAFT**

INVENTOR(S) : Penger, et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 512 days

Delete the phrase "by 512 days" and insert – by 628 days--

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

OCT 25 2010

OFFICE OF PETITIONS

**HARNESS, DICKEY & PIERCE, P.L.C.**
**P.O. BOX 828**
**BLOOMFIELD HILLS, MI 48303**

| | | |
|---|---|---|
| Patent No. 7,244,310 | | |
| Application No. 10/479,316 | : | |
| Filed: June 14, 2004 | : | |
| Issued: July 17, 2007 | : | NOTICE |
| Attorney Docket No. 15448-000009/US/USB | : | |
| | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission filed August 26, 2010, under 37 CFR 1.28.

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

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

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

Inquiries related to this communication should be directed to the undersigned at (571) 272-6059.

A. Kelley

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
www.uspto.gov

MICHAEL N. HAYNES
1341 HUNTERSFIELD CLOSE
KESWICK VA 22947

MAILED
OCT 04 2011
OFFICE OF PETITIONS

In re Patent No. 7,410,606 :
Issued : August 12, 2003 : ON PETITION
Application No. 10/479,335 :
Filed: December 1, 2003 :
Attorney Docket No. **1021-014** :

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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In re Patent No. 7079831
Issue Date: July 18,2006
Application No. 10479490
Filed: June 1,2004
Attorney Docket No. 894-16/JLW

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

This is a decision on the electronic petition, filed March 16,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 16,2012 .
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) |
|---|---|---|---|---|
| 7,079,831 | 2006-07-18 | 10/479,490 | 2004-06-01 | MGFAG0100 |

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

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 | /Don W. Bulson/ | Date (YYYY-MM-DD) | 2012-03-16 |
| Name | Don W. Bulson | Registration Number | 28192 |

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.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : March 23, 2011

**TO SPE OF** : ART UNIT 2836

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10479506 Patent No.: 7336468

**CofC mailroom date:** Mar. 14, 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**

_____
**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.

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

**Comments:** _____

_____

_____

_____

_____

/Jared Fureman/ _2836__

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

| SPE | Art Unit |
| --- | --- |

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PEARL COHEN ZEDEK LATZER, LLP
1500 BROADWAY
12TH FLOOR
NEW YORK, NY 10036

**MAILED**

AUG 30 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,436,996 | : | |
| Issued: October 14, 2008 | : | |
| Application No. 10/479,845 | : | NOTICE |
| Filed: December 8, 2003 | : | |
| Attorney Docket No.: P-4259-US | : | |

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

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

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

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

Sherry D. Brinkley
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
www.uspto.gov

**Jennifer H Hamilton**
**The Eclipse Group**
**10453 Raintree Lane**
**Northridge CA 91326**

MAILED

APR 06 2011

OFFICE OF PETITIONS

In re Application of :
Hans-Juergen Nitzpon et al. :
Application No. 10/479,885 :
Filed: July 26, 2004 :
Attorney Docket No. HI02002USU :
(P01085US)

ON PETITION

This is a decision on the petition filed January 5, 2011 under the unintentional provisions of 37 CFR 1.137(b), to revive the above-identified application.

The petition is **DISMISSED**.

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

The application became abandoned for failure to timely file a proper reply within the meaning of 37 CFR 1.113 to the final Office action of April 28, 2009. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). Accordingly, the date of abandonment of this application is July 29, 2009. A Notice of Abandonment was mailed on December 7, 2009.

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

As to item 1, the amendment filed on January 5, 2011, does not *prima facie* place the application in condition for allowance, therefore the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b). See attached courtesy copy of the advisory action.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

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

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

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

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

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

Attachment: Advisory Action

cc: Jennifer H. Hamilton
6345 Balboa Blvd., Suite 325
Encino, CA 91316

| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/479,885 | Applicant(s) NITZPON ET AL. | |
|---|---|---|---|
| | Examiner Christopher Crutchfield | Art Unit 2466 | |

***--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***

THE REPLY FILED 05 January 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Daniel J. Ryman/
Supervisory Patent Examiner, Art Unit 2466

/Christopher Crutchfield/
Examiner, Art Unit 2466

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's Arguments with respect to the rejection of claims 1, 3, 4, 9, 11, 12, 19, 21, 22, 17, 27, 29 and 30 under 35 USC 112, 1st paragraph have been considered and are not persuasive.

The applicant initially argues that a person of ordinary skill in the art would have understood that the claim language of "comparing the first synchronous compressed bit-stream frame of data to the synchronization word" includes comparing the bit stream word by word to the synchronization word. However, the claim language recites that the comparison is between the synchronization word and the entire "bit stream frame" not between the synchronization word and bytewise elements of the bit stream frame. Therefore, the unambiguous interpretation of the claim language requires the impossible operation of comparing elements of dissimilar length.

The applicant further argues that they may be their own lexicographer with respect to the terms presented in the claim language. MPEP 2173.05(a). This is true, but in order to define terms contrary to the understanding of a person of ordinary skill in the art, the applicant must clearly express the intent to do so in the specification. Merck & Co., Inc., v. Teva Pharms. USA, Inc., 395 F.3d 1364, 1370, 73 USPQ2d 1641, 1646 (Fed. Cir. 2005) ("When a patentee acts as his own lexicographer in redefining the meaning of particular claim terms away from their ordinary meaning, he must clearly express that intent in the written description."); See also MPEP 2111.01 (IV). Applicant's specification does not clearly define the term "comparing the first synchronous compressed bit-stream frame of data to the synchronization word" in fact, the term is never used at all. The closest use of similar terminology is with respect to "comparing the first synchronous compressed bit-stream data to the synchronization word". (See Page 9, Lines 11-15). Therefore, the term comparing the "comparing the first synchronous compressed bit-stream frame of data to the synchronization word" is not expressly treated in the specification and therefore has no assigned definition. Furthermore, the treatment of the similar term "comparing the first synchronous compressed bit-stream frame of data to the synchronization word" does not provide an explicit definition for the term, but rather recites one possible technique for performing a comparison.

Therefore, Applicant's Arguments with regard to the rejection of claims 1, 3, 4, 9, 11, 12, 19, 21, 22, 17, 27, 29 and 30 under 35 USC 112, 1st paragraph have been considered and are not persuasive.

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**THE ECLIPSE GROUP LLP**
**6345 Balboa Blvd., Suite 325**
**Encino CA 91316**

MAILED
JUN 23 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hans-Juergen Nitzpon et al. | : | |
| Application No. 10/479,885 | : | ON PETITION |
| Filed: July 26, 2004 | : | |
| Attorney Docket No. HI02002USU (P01085US) | : | |

This is a decision on the renewed petition filed June 6, 2011 under the unintentional provisions of 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to properly reply in a timely manner to the final Office action mailed, April 28, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on July 29, 2009. A Notice of Abandonment was mailed on December 7, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a RCE (Request for Continued Examination, with the required fee of $810, (2) the petition fee of $1,620, and (3) a proper statement of unintentional delay. Accordingly, the RCE is accepted as being unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 2466 for appropriate action by the Examiner in the normal course of business on the reply received June 6, 2011.

/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
www.uspto.gov

In re Patent No. 7040065
Issue Date: May 9,2006
Application No. 10480007
Filed: May 10,2004
Attorney Docket No. FAK-6877

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

This is a decision on the electronic petition, filed March 20,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 20,2012 .
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) |
|---|---|---|---|---|
| 7,040,065 | 2006-05-09 | 10/480,007 | 2004-05-10 | FAK-6877 |

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

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 S. Wesorick/ | Date (YYYY-MM-DD) | 2012-03-20 |
| Name | Richard S. Wesorick | Registration Number | 40871 |

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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Dallas TX 75380

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AUG 16 2010
OFFICE OF PETITIONS

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| In re Application of | : | |
| Du, et al. | : | |
| Application No. 10/480,114 | : | ON APPLICATION FOR |
| Filed: December 9, 2003 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. CN 010001 | : | |

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 37 C.F.R. § 1.705(b), filed April 27, 2010. Applicants submit that the patent term adjustment to be indicated on the patent is eight hundred eighty (880) days, not six hundred twelve (612) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction on the basis that the Office will take in excess of three years to issue this patent.

In addition, applicants dispute the period of adjustment of 679 days for Office delay in mailing at least one of a notification under 35 U.S.C. 132 not later than fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. 371 in an international application. Applicants contend the period of adjustment should be 688 days.

To the extent that applicants request reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has

been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent or even the filing date of the request for continued examination is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

To the extent that applicants otherwise request correction of the initial determination of patent term adjustment (PTA), the application for patent term adjustment is **DISMISSED.**

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[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

On January 27, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 612 days.

Applicants dispute the period of adjustment of 679 days for Office delay in mailing at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. 371 in an international application. Applicants contend the period of reduction should be 688 days. Applicants assert that all requirements of 35 U.S.C. 371(c) were met on December 9, 2003. Therefore, applicants argue that December 9, 2003 should be the date from which the 14 month period is calculated. The Office calculated the 14 month period from December 18, 2003, which is the completion date.

Applicants are informed that the date of completion of all 35 U.S.C. 371 requirements is relevant for purposes of patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)(II) and 37 CFR 1.702(a)(1) when the Office has failed to mail a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than 14 months after the date on which the requirements under 35 U.S.C. 371 were fulfilled. This date is the latest of:

(A) the date of submission of the basic national fee;
(B) the date of submission or communication of the copy of the international application;
(C) the date of submission of the translation of the international application if the international application is not in the English language;
(D) the date of submission of an oath or declaration of the inventor in compliance with 35 U.S.C. 371(c)4)
(E) the earlier of 30 months from the priority date or the date of request for early processing under 35 U.S.C. 371(f) if requested prior to 30 months from the priority date;
(F) if a request for early processing has not been requested prior to 30 months from the priority date, the date of submission of any translation of the annexes to the international preliminary examination report if the translation of the annexes are filed within the time period set in a Notification of Missing Requirements requiring either an English translation of the international application or an oath or declaration; and

(G) the date of submission of any surcharge for submitting the oath or declaration later than 30 months form the priority date.

As early processing was not requested in this application, the date of completion is 30 months from the priority date. The priority date is June 18, 2001. The date of completion is December 18, 2003. Completion was the latest of the above-listed events. Thus, December 18, 2003 is the date from which the 14 month period is calculated

Entry of the period of reduction of 679 days (from February 19, 2005, which is the date after 14 months after the date of completion, to December 29, 2006, the date a non-final Office action was mailed) was warranted.

In view thereof, the determination of patent term adjustment at the time of the mailing of the notice of allowance remains six hundred twelve (612) days.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Shirene Willis Brantley, Senior Petitions Attorney, at (571) 272-3230.

Anthony Knight
Director
Office of Petitions

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WILLIAMS, MORGAN & AMERSON
10333 RICHMOND, SUITE 1100
HOUSTON, TX 77042

Mail Date: 10/07/2010

| | | |
|---|---|---|
| **Applicant** | : David Garrett | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7647547 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/12/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/480,136 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 12/09/2003 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **694** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
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BOSTON MA 02111

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FEB 23 2011

**OFFICE OF PETITIONS**

In re Application
Haitao Wu et al.
Application No. 10/480,215
Filed: December 10, 2003
Attorney Docket No.
**39700-771N01US/NC31524US**

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT filed April 16, 2010. Applicant requests that the determination of patent term adjustment be corrected from 858 days to 908 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued..

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

With respect to the over 3 year calculation, rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may

wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the Notice of Allowance, the application for patent term adjustment is **GRANTED** to the extent indicated herein.

On January 19, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 858 days. The instant application for patent term adjustment was timely filed[1] on or before payment of the issue fee.

With respect to the patent term adjustment at the time of the mailing of the notice of allowance, applicants acknowledge the period of adjustment of 813 days for Office delay pursuant to 37 CFR 1.702(a)(1).

Applicants argue however that the 45 days for the Office's delay in responding on March 16, 2009 to the Applicants' amendment filed on September 30, 2008, pursuant to 37 CFR 1.702(a)(2), is unwarranted. Applicants argue therefore that the Notice of Appeal filed on November 18, 2008 should have put PTA time "on hold". Under 35 U.S.C. § 132, the Office had four months to respond to the Pre-Appeals Conference Decision of January 5, 2009, to reopen prosecution. Moreover, it is believed that the Pre-Appeal Conference Review process counts as "appellate review" under 37 CFR § 1.701(a)(3). The reason is that the rule specifies review by the BPAI or a Federal court and the conference is neither (it is review by a group of examiners). Therefore, there should be no exclusion for appellate review and no delay attributed to the Office.

Applicant's argument has been considered but is not persuasive. In view of the Pre-Appeals Conference Decision of January 5, 2009 which withdrew the Final Office Action mailed August 20, 2008 and issued a non-Final Office Action, the amendment filed September 30, 2008 was treated as if filed after non-Final. In such case the subsequent Notice of Appeal is <u>not</u> treated as a supplemental reply given that it was required by the improper Final OA thus, the Notice of Appeal filed on November 18, 2008 does not put PTA time "on hold" and the calculation for the period from September 30, 2008 to March 16, 2009 in the amount of 45 days, attributed to the Office for Examination delay was properly calculated.

[1] PALM records indicate that the issue fee was paid on April 16, 2010.

Applicant argues also that the Office did not properly assess Applicant delay, pursuant to 37 CFR § 1.704(c)(7) for the Non-Responsive Amendment filed on May 15, 2009 which was corrected on October 1, 2009.

Pursuant to 37 CFR § 1.704(c)(7), circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

> (7) Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

It is undisputed that a response was due by June 15, 2009(See Office action mailed March 15, 2009 and that the response having an omission was filed on May 15, 2009. Accordingly, as stated by applicants, pursuant to 37 C.F.R. § 1.704(c)(7), a period of reduction of 107 days should have been entered (for the period beginning on June 16, 2009 and ending on October 1, 2009, the date a complete response was filed.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is SEVEN HUNDRED FIFTY-ONE **(751)** days.

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

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PALM Screen

# Patent Term Adjustments

PTA/PTE Information | Patent Term Adjustment | Patent Term Extension

Application Number*: 10480215 Search | Explanation of PTA Calculation | Explanation of PTE Calculation

## PTA Calculations for Application: 10480215

| | | | |
|---|---|---|---|
| Application Filing Date | 12/10/2003 | OverLapping Days Between (A and B) or (A and C) | 0 |
| Issue Date of Patent | | Non-Overlapping USPTO Delays: | 858 |
| A Delays | 858 | PTO Manual Adjustment | -107 |
| B Delays | 0 | Applicant Delay (APPL) | 0 |
| C Delays | 0 | Total PTA (days) | 751 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 89 | 02/22/2011 | | P028 | Adjustment of PTA Calculation by PTO | | 107 | 0 |
| 81 | 01/19/2010 | | MN/=. | Mail Notice of Allowance | | | 0 |
| 80 | 01/16/2010 | | IREV | Issue Revision Completed | | | 0 |
| 79 | 01/16/2010 | | DVER | Document Verification | | | 0 |
| 78 | 01/16/2010 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 77 | 01/14/2010 | | EX.A | Examiner's Amendment Communication | | | 0 |
| 76 | 01/14/2010 | | CNTA | Allowability Notice | | | 0 |
| 75 | 01/13/2010 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 73 | 11/16/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 72 | 10/01/2009 | | A... | Response after Non-Final Action | | | 0 |
| 71 | 09/01/2009 | | MCTMS | Mail Miscellaneous Communication to Applicant | | | 0 |
| 70 | 08/30/2009 | | CTMS | Miscellaneous Action with SSP | | | 0 |
| 68 | 07/23/2009 | | PA.. | Change in Power of Attorney (May Include Associate POA) | | | 0 |
| 67 | 07/22/2009 | | C.AD | Correspondence Address Change | | | 0 |
| 65 | 06/18/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 69 | 05/15/2009 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 66 | 05/15/2009 | 05/15/2009 | M844 | Information Disclosure Statement (IDS) Filed | | | 64 |
| 64 | 05/15/2009 | | A... | Response after Non-Final Action | | | 0 |
| 63 | 05/15/2009 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 62 | 03/16/2009 | 01/30/2009 | MCTNF | Mail Non-Final Rejection | 45 | | 47 |
| 61 | 03/15/2009 | | CTNF | Non-Final Rejection | | | 0 |
| 56 | 01/05/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 55 | 01/05/2009 | | MAPCR | Mail Appeals conf. Reopen Prosec. | | | 0 |
| 54 | 01/04/2009 | | APCR | Pre-Appeals Conference Decision - Reopen Prosecution | | | 0 |
| 53 | 11/18/2008 | | AP.C | Request for Pre-Appeal Conference Filed | | | 0 |
| 52 | 11/18/2008 | | N/AP | Notice of Appeal Filed | | | 0 |
| 51 | 10/17/2008 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 50 | 10/14/2008 | | CTAV | Advisory Action (PTOL-303) | | | 0 |
| 49 | 10/07/2008 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 48 | 10/06/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 47 | 09/30/2008 | | A.NE | Amendment after Final Rejection | | | 0 |
| 46 | 08/20/2008 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 45 | 08/18/2008 | | CTFR | Final Rejection | | | 0 |
| 43 | 06/06/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 42 | 05/07/2008 | | A... | Response after Non-Final Action | | | 0 |
| 41 | 02/25/2008 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 40 | 02/19/2008 | | CTNF | Non-Final Rejection | | | 0 |
| 38 | 01/31/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 36 | 01/31/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 34 | 01/31/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 32 | 01/31/2008 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 35 | 01/07/2008 | | AMSB | Amendment Submitted/Entered with Filing of CPA/RCE | | | 0 |
| 33 | 01/07/2008 | | RCEX | Request for Continued Examination (RCE) | | | 0 |
| 31 | 01/07/2008 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 30 | 12/28/2007 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 29 | 12/26/2007 | | CTAV | Advisory Action (PTOL-303) | | | 0 |
| 28 | 12/14/2007 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 37 | 11/30/2007 | | AMPR | RCE- AF Processed | | | 0 |
| 27 | 11/30/2007 | | A.NE | Amendment after Final Rejection | | | 0 |
| 26 | 10/10/2007 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 25 | 10/01/2007 | | CTFR | Final Rejection | | | 0 |
| 22 | 07/24/2007 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 21 | 07/19/2007 | | A... | Response after Non-Final Action | | | 0 |
| 20 | 05/04/2007 | 02/10/2005 | MCTNF | Mail Non-Final Rejection | 813 | | 4 |

| | | | | |
|---|---|---|---|---|
| 19 | 04/30/2007 | CTNF | Non-Final Rejection | 0 |
| 17 | 03/15/2007 | DOCK | Case Docketed to Examiner in GAU | 0 |
| 16 | 02/28/2007 | DOCK | Case Docketed to Examiner in GAU | 0 |
| 15 | 01/23/2007 | DOCK | Case Docketed to Examiner in GAU | 0 |
| 14 | 05/11/2006 | DOCK | Case Docketed to Examiner in GAU | 0 |
| 13 | 05/03/2006 | TI1050 | Transfer Inquiry to GAU | 0 |
| 12 | 11/16/2005 | DOCK | Case Docketed to Examiner in GAU | 0 |
| 11 | 01/13/2005 | DOCK | Case Docketed to Examiner in GAU | 0 |
| 10 | 01/10/2005 | DOCK | Case Docketed to Examiner in GAU | 0 |
| 9 | 07/14/2004 | TSSCOMP | IFW TSS Processing by Tech Center Complete | 0 |
| 8 | 07/14/2004 | DOCK | Case Docketed to Examiner in GAU | 0 |
| 5 | 05/27/2004 | L194 | Cleared by OIPE CSR | 0 |
| 3 | 05/18/2004 | OIPE | Application Dispatched from OIPE | 0 |
| 2 | 05/18/2004 | M903 | Notice of DO/EO Acceptance Mailed | 0 |
| 18 | 12/10/2003 | IDSC | Information Disclosure Statement considered | 0 |
| 7.7 | 12/10/2003 | M844 | Information Disclosure Statement (IDS) Filed | 0 |
| 7 | 12/10/2003 | WIDS | Information Disclosure Statement (IDS) Filed | 0 |
| 6 | 12/10/2003 | A.PE | Preliminary Amendment | 0 |
| 4 | 12/10/2003 | 371COMP | 371 Completion Date | 0 |
| 1 | 12/10/2003 | IEXX | Initial Exam Team nn | 0 |

Export to: Excel

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 07/08/11

TO SPE OF : ART UNIT 2611

SUBJECT : Request for Certificate of Correction for Appl. No.: 10480323 Patent No.: 7933321

CofC mailroom date: 06/28/11

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 Directors/SPE response to 571-273-3421**

Note: **Should Claim 13 be Approved?**

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.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Comments:** _____

_____

_____

_____

_____

Chris W. Tr 2611

**SPE** **Art Unit**

| Doc Code: PET.AUTO<br>Document Description: Petition automatically granted by EFS-Web | PTO/SB/64<br>U.S. Patent and Trademark Office<br>Department of Commerce |
|---|---|

| | |
|---|---|
| Electronic Petition Request | PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b) |
| Application Number | 10480326 |
| Filing Date | 13-Jul-2004 |
| First Named Inventor | Harold Cook Jr |
| Art Unit | 3625 |
| Examiner Name | AMEE SHAH |
| Attorney Docket Number | MSUP122120 |
| Title | INTERACTIVE EXPLODED VIEW DIAGRAM ORDERING TOOL |

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus any extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee – required for all utility and plant applications filed before June 8, 1995; and for all design applications;
(4) Statement that the entire delay was unintentional.

Petition fee
The petition fee under 37CFR 1.17(m) is attached.

☐ Applicant claims SMALL ENTITY status. See 37 CFR 1.27.

☐ Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

☒ Applicant(s) status remains as SMALL ENTITY.

☐ Applicant(s) status remains as other than SMALL ENTITY.

**Issue Fee and Publication Fee :**

Issue Fee and Publication Fee must accompany ePetition.

☒ Issue Fee Transmittal is attached

**Drawing corrections and/ or other deficiencies.**

- (●) Drawing corrections and/ or other deficiencies are not required
- ( ) I certify, in accordance with 37 CFR 1.4.(D)(4), that drawing corrections and/ or other deficiencies have previously been filed on
- ( ) Drawing corrections and/ or other deficiencies are attached.
- [x] STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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 who has been given power of attorney in this application.
- (●) An attorney or agent registered to practice before the Patent and Trademark Office, acting in a representative capacity.
- ( ) A sole inventor
- ( ) A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors.
- ( ) A joint inventor; all of whom are signing this e-petition.
- ( ) The assignee of record of the entire interest that has properly made itself of record pursuant to 37 CFR 3.71.

| | |
|---|---|
| Signature | /David P. Sheldon/ |
| Name | David P. Sheldon |
| Registration Number | 62494 |

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

Decision Date : April 4, 2012

In re Application of :

Harold Cook Jr

Application No : 10480326

Filed : 13-Jul-2004

Attorney Docket No : MSUP122120

DECISION ON PETITION

UNDER CFR 1.137(b)

This is an electronic decision on the petition under 37 CFR 1.137(b), filed April 4, 2012 , to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Allowance and Issue Fee(s) Due. The date of abandonment is the day after the expiration date of the period set for reply in the Notice.

The electronic petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the Issue Fee and the Publication Fee (if necessary); (2) the petition fee as set forth in 37 CFR 1.17 (m); (3) the drawing correction and/or other deficiencies (if necessary); and (4) the required statement of unintentional delay have been received. Accordingly, the Issue Fee payment is accepted as having been unintentionally delayed.

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

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

This application file is being directed to the Office of Data Management.

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 & PIERCE, P.L.C.**
**P.O. BOX 828**
**BLOOMFIELD HILLS MI 48303**

MAILED
OCT 06 2010
OFFICE OF PETITIONS

In re Application of :
Leslie William BOLTON, et al. :
Application No. 10/480,346 :
Filed: June 4, 2004 :
Attorney Docket No.: 8540G-203/USB :

ON PETITION

This is a decision on the petition filed October 19, 2009, under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decisions of the Director, Technology Center 1700 (Technology Center Director), dated March 6, 2009 and September 21, 2009, which refused to withdraw the finality of the August 11, 2008 Office action and compel the entry of the amendment after final filed October 13, 2008, withdraw the Request for Continued Examination (RCE), and refund $940 in fees required under 37 CFR 1.17(e) and 37 CFR 1.136(a).

The petition to overturn the decisions of the Technology Center Director dated March 6, 2009 and September 21, 2009 is **DENIED**[1].

## BACKGROUND

On March 26, 2008, a non-final Office action was mailed.

On May 23, 2008, a response was filed.

On August 11, 2008, a final Office action was mailed.

On October 13, 2008, an amendment under 37 CFR 1.116 was filed requesting withdrawal of the finality of the August 11, 2008 Office action.

On October 20, 2008, an Advisory Action was mailed.

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[1] 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

On November 19, 2008, a Request for Continued Examination and a petition under 37 CFR 1.181 requesting withdrawal of the finality of the August 11, 2008 Office action were filed.

On December 3, 2008, a Notice of Allowability and a Notice of Allowance and Issue Fee(s) Due were mailed.

On January 6, 2009, the application was withdrawn from issue.

On February 18, 2009, a non-final Office action was mailed.

On March 6, 2009, a decision dismissing the petition filed November 19, 2008 as moot was mailed.

On April 27, 2009, a petition requesting reconsideration of the petition decision of March 6, 2009 was filed.

On September 21, 2009, a decision dismissing the petition filed April, 27, 2009 was mailed.

On October 19, 2009, the instant petition was filed.

## STATUTE, REGULATION, AND EXAMING PROCEDURE

35 U.S.C. 42(d) provides:

> The director may refund any fee paid by mistake or any amount paid in excess of that required.

35 U.S.C. 132(b) provides:

> The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

37 CFR 1.26(a) provides, in part, that:

> The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such

fee. The Office will not refund amounts of twenty-five dollar or less unless a refund is specifically requested, and will not notify the payor of such amounts.

37 CFR 1.113(a) provides:

On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

37 CFR 1.114(d) provides:

If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief (§ 41.37 of this title) or a reply brief (§ 41.41 of this title), or related papers, will not be considered a submission under this section.

37 CFR 1.181 provides, in pertinent part, that:

(a)Petition may be taken to the Director:
(1)From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
(2)In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
(3)To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.
(c)When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written

> statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.
> (f)The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

MPEP 706.07(c) provides:

> Any question as to prematureness of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 CFR 1.181. See MPEP § 1002.02(c).

MPEP 706.07(h) provides, in pertinent part, that:

> 35 U.S.C. 132(b) provides for continued examination of an application at the request of the applicant (request for continued examination or RCE) upon payment of a fee, without requiring the applicant to file a continuing application under 37 CFR 1.53(b). To implement the RCE practice, 37 CFR 1.114 provides a procedure under which an applicant may obtain continued examination of an application in which prosecution is closed (e.g., the application is under final rejection or a notice of allowance) by filing a submission and paying a specified fee. Applicants cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions).

MPEP 714.13 provides, in pertinent part, that:

> A reply under 37 CFR 1.113 is limited to:
> (A) an amendment complying with 37 CFR 1.116;
> (B) a Notice of Appeal (and appeal fee); or
> (C) a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e). RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 and design applications.

## OPINION

Petitioner seeks reversal of the Technology Center Director decisions of March 6, 2009 and September 21, 2009, on the grounds that the filing of an RCE does not make the petition filed under 37 CFR 1.181, requesting withdrawal of the finality of the August 11, 2008 Office action, moot. Accordingly, petitioner requests a decision on the petition under 37 CFR 1.181 filed November 19, 2008, the amendment after final filed October 13, 2008 be entered, the RCE be withdrawn, and the RCE and extension of time fees be refunded.

Petitioner specifically argues[2] that after a final rejection, only two actions may be taken by an applicant to prevent an application from becoming abandoned: filing an RCE or filing an appeal as filing a petition does not stay any period set for reply. 37 CFR 1.181(f). Therefore, petitioner states the filing of an RCE was required to prevent the application from becoming abandoned and the timely filed petition under 37 CFR 1.181 to review the examiner's refusal to withdraw the finality should be treated as the rules require petitioner to take action without waiting for a decision on petition. Moreover, petitioner contends the application would have become abandoned prior to a decision on the petition under 37 CFR 1.181, filed November 19, 2008, had the RCE not been filed as the petition decision was not rendered prior to February 11, 2009.

As set forth in MPEP 714.13, *supra*, an RCE is but one of the responses petitioner may have filed in order to prevent abandonment of the instant application. For instance, petitioner may have filed a Notice of Appeal instead of an RCE in order to prevent abandonment of the application. This would have resulted in petitioner having a period of up to seven (7) months or until July 19, 2009 (assuming petitioner filed a Notice of Appeal on November 19, 2008 instead of the RCE) for petitioner to file an Appeal Brief. In any event, petitioner chose to file an RCE. As set forth in 37 CFR 1.114, *supra*, if an applicant timely files a submission and fee set forth in § 1.17(e), the Office **will withdraw the finality** of any Office action and the submission **will** be entered and considered. As the filing of the RCE withdrew the finality of the Office action and entered the amendment submitted under 37 CFR 1.116 the petition under 37 CFR 1.181 was properly considered as moot. (Emphasis added.)

Although petitioner further contends that the issue is not moot because petitioner incurred additional fees as a result of the filing of the RCE on November 19, 2008, the filing of the RCE was petitioner's decision. Petitioner knew that the filing of a reply to avoid abandonment of the application was not required until February 11, 2009. The fact that the Technology Center did not render a decision on the petition filed November 19, 2008 until after February 11, 2009 is immaterial as the filing of the RCE removed any urgency in replying to the petition. Moreover, the applicable statute, 35 U.S.C.

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[2] *See* petition filed April 27, 2009

42(d), authorizes the Director to refund "any fee paid by mistake or any amount paid in excess of that required." Thus, the U.S. Patent and Trademark Office (USPTO) may refund: (1) a fee paid when no fee is required (*i.e.*, a fee paid by mistake), or (2) any fee paid in excess of the amount of the fee that is required. See Ex Parte Grady, 59 USPQ 276, 277 (Comm'r pats. 1943)(the statutory authorization for the refund of fees is applicable only to a mistake relating to the fee payment, and not the underlying action). In the situation, as herein, in which an applicant takes an action "by mistake" (*e.g.*, files an RCE "by mistake"), the submission of fees required to take that action (*e.g.*, an RCE fee submitted with an RCE) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d). See Changes to Implement the Patent Business Goals, Notice of Proposed Rulemaking, 64 FR 53771, 53780 (October 4, 1999), 1228 Off. Gaz. Pat. Office, 15, 23 (November 2, 1999).

Furthermore, even if petitioner erred in presenting an RCE under 37 CFR 1.114 to the USPTO for this application, that does not warrant a finding that the payment was made "by mistake." Rather, the fee was owed at the time it was paid. As noted in 37 CFR 1.26(a), petitioner's change of purpose does not constitute a "mistake" in payment warranting refund of the fees previously paid. The payment of the fee automatically was due, by statute, when petitioner presented, rightly, or mistakenly, the RCE under 37 CFR 1.114. Thus, it is immaterial to the question of "mistake" in payment of the instant RCE fee, that petitioner may have erred in submitting the aforementioned submission. Here, it is noted, that petitioner requested an RCE under 37 CFR 1.114.

Additionally, petitioner submits that the petitions of November 19, 2008 and March 22, 2010 were timely filed. As the initial petition was filed within two months of the mailing of the Advisory Action on October 20, 2008 wherein the examiner refused petitioners request, filed October 13, 2008 (October 11, 2008 being a Saturday), to withdraw the finality of the Office action mailed August 11, 2008, and as the second petition was filed within two months of the first petition decision, the petitions were timely filed.

## DECISION

A review of the record indicates that the Technology Center Directors did not abuse their discretion or act in an arbitrary and capricious manner in their refusal to treat the petitions on their merits, in view of the filing of an RCE, in the petition decisions of March 6, 2009 and September 21, 2009. The record establishes that the Technology Center Directors had a reasonable basis to support their findings and conclusion.

The petition is granted to the extent that the decisions of the Technology Center Director of March 6, 2009 and September 21, 2009 have been reviewed; however, the decisions of March 6, 2009 and September 21, 2009 will not be disturbed because, while the filing of the petitions is timely, the refusal to further treat the petitions of

November 19, 2008 and April 27, 2009, on their merits in view of the filing of the RCE is proper. The petition is denied.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.

Robert W. Bahr
Acting Associate Commissioner for
Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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GLOVSKY AND POPEO PC
ONE FINANCIAL CENTER
BOSTON MA 02111

MAILED

AUG 16 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Serge Haumont | : | |
| Application No. 10/480,440 | : | ON REQUEST FOR |
| Filed: February 6, 2004 | : | RECONSIDERATION OF |
| Attorney Docket Number: 39700-513N01US | : | PATENT TERM ADJUSTMENT |

This is a decision on the petition under 37 CFR 1.705(b), filed May 14, 2010. Applicant believes that they should be accorded an additional PTA of 218 days. Applicant requests this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment solely as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file a request for reconsideration of patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

In view thereof, the correct determination of PTA prior to issuance is **seven hundred seventy (770) days** (770 days of PTO delay, reduced by 0 days of Applicant delay).

Receipt of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged.

The application is being forwarded to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Petitions Attorney Cliff Congo at (571) 272-3207.

Anthony Knight
Director
Office of Petitions

---

[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED
AUG 08 2011
OFFICE OF PETITIONS

**GERLINDE M NATTLER**
**CONTINENTAL TEVES INC**
**ONE CONTINENTAL DRIVE**
**AUBURN HILLS MI 48326**

| | | |
|---|---|---|
| In re Application of | : | |
| KUMMEL, et al | : | |
| Application No. 10/480,554 | : | DECISION ON PETITION |
| Filed: December 12, 2003 | : | |
| Attorney Docket No. AP10145 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 8, 2011, to revive the above-identified application.

The petition is **DISMISSED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, January 26, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on April 27, 2005. A Notice of Abandonment was mailed April 4, 2006.

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

With respect to item (3): The instant petition filed July 8, 2011, does not include a clear date of execution for the statement of unintentional delay. Since the date is illegible, the Office cannot determine when the statement was signed. In this regard, the date of execution of the statement of unintentional delay is in question, the petition does not meet the requirement as set out in 37 CFR 1.137(b) and cannot be granted at this time.

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

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

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

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

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

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

/Diane C. Goodwyn/
Diane C. 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
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MAILED
NOV 08 2011
OFFICE OF PETITIONS

**GERLINDE M NATTLER**
**CONTINENTAL TEVES INC**
**ONE CONTINENTAL DRIVE**
**AUBURN HILLS MI 48326**

| | | |
|---|---|---|
| In re Application of | : | |
| KUMMEL, et al | : | |
| Application No. 10/480,554 | : | DECISION ON PETITION |
| Filed: December 12, 2003 | : | |
| Attorney Docket No. AP10145 | : | |

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed October 7, 2011, and supplemental filed October 28, 2011, 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, January 26, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on April 27, 2005. A Notice of Abandonment was mailed April 4, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1620; and (3) a proper statement of unintentional delay.

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.

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

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.

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

This application is being referred to Technology Center AU 2612 for appropriate action by the Examiner in the normal course of business.

/Diane Goodwyn/
Diane Goodwyn
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : April 30, 2010

**TO SPE OF** : ART UNIT 1646 -

**SUBJECT** : Request for Certificate of Correction for Appl. No/10/480730 patent ~~7253994~~ 7252994

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:** _____

/Phillip Gambel\
Acting SPE 1646

**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

**ROBERT W STROZIER, P.L.L.C**
**PO BOX 429**
**BELLAIRE TX 77402-0429**

**MAILED**

**MAR 30 2011**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,132,151 | : | |
| Issued: November 7, 2006 | : | |
| Application No. 10/480,785 | : | ON PETITION |
| Filed: December 15, 2003 | : | |
| Attorney Docket No. 50000-OR02 | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed February 18, 2011, 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), petitioner did not include a proper statement of unintentional delay as required by 37 CFR 1.378(c). 37 CFR 1.378(c) requires a statement that "the delay in payment of the maintenance fee was unintentional." Petition form PTO/SB/66 is enclosed.

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
Petitions Examiner
Office of Petitions

Enclosure: form 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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**ROBERT W STROZIER, P.L.L.C**
**PO BOX 429**
**BELLAIRE TX 77402-0429**

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MAY 17 2011
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| | | |
|---|---|---|
| In re Patent No. 7,132,151 | : | |
| Issued: November 7, 2006 | : | |
| Application No. 10/480,785 | : | ON PETITION |
| Filed: December 15, 2003 | : | |
| Attorney Docket No. 50000-OR02 | : | |

**REQUIREMENT FOR INFORMATION**

A renewed petition was filed on April 14, 2011 under 37 CFR 1.378 to accept the delayed payment of a maintenance fee for the above-identified patent.

A decision on this petition will be held in abeyance for a period of **TWO MONTHS** from the date of this communication to permit petitioner to address the following issues before a decision is rendered. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b).

Petitioner has submitted a renewed petition under 37 CFR 1.378(c), however, the petition did not include the required $400.00 reconsideration fee. Further, upon attempting to properly charge the three and one-half year $980.00 maintenance fee and $1,640.00 Surcharge fee the deposit account was shown to have insufficient funds to cover all the above fees. Additionally, the $2,620.00 originally charged to petitioner's deposit account on February 18, 2011 was automatically returned to the deposit account. Therefore, petitioner must now submit a total of $3,020.00 to cover all the above fees. Consequently, the renewed petition under 37 CFR 1.378(c), cannot be accepted at this time.

The response to this Requirement for Information should include a cover letter entitled "Response to Requirement for Information."

At the end of the two month period specified above, a decision will be rendered on the instant petition under 37 CFR 1.378 as supplemented by any information submitted in response to this Requirement for Information.

**In order to expedite reinstatement of this patent, petitioner may wish to consider submitting the reply to the requirement for information by facsimile transmission to the telephone number indicated below and to the attention of the undersigned.**

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 10-27-11

**TO SPE OF** : ART UNIT 2473

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/480953 Patent No.: 7876781

**CofC mailroom date:** 09-28-11

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**

**Note:** _____

_____

**Angela Green 571.272.9005**
**CofC 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:** _____

**SPE** /Kwang B. Yao/ **Art Unit** 2473

UNITED STATES PATENT AND TRADEMARK OFFICE

**UNITED STATES DEPARTMENT OF COMMERCE**
**United States Patent and Trademark Office**
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/481,053 | 05/25/2004 | Katarina E.A. Lindell | PUJ-0315 | 3124 |

23377 7590 11/21/2011
WOODCOCK WASHBURN LLP
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

| EXAMINER |
|---|
| FELTON, MICHAEL J |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1747 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 11/21/2011 | 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):

eofficemonitor@woodcock.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

---

*Ex parte* KATARINA E.A. LINDELL, NILS-OLOF LINDBERG, and
ROLAND OLSSON

---

Appeal 2010-007856
Application 10/481,053
Technology Center 1700

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DECISION ON PETITION

This is a decision on "APPELLANTS' PETITION FOR SUSPENSION OF RULES PURSUANT TO 37 C.F.R. § 1.183," filed September 30, 2011 ("Petition"). The Petition requests waiver of "the requirements of 37 C.F.R. § 41.52(a)(1) regarding the submission of a 'single request for rehearing' to permit entry of the attached 'Second Petition for Rehearing.'" (Petition 1). The petition fee of $400 pursuant to 37 C.F.R. § 1.17(f) was charged to Petitioners' deposit account on October 3, 2011.

FINDINGS

1) On December 16, 2003, Petitioners filed the instant application.

2) On December 6, 2006, a restriction requirement was mailed to Petitioners.

3) On December 28, 2006, Petitioners filed a response to the restriction requirement.

4) On February 16, 2007, a Non-Final Rejection was mailed to Petitioners.

5) On June 14, 2007, Petitioners filed an amendment.

6) On August 14, 2007, a Final Rejection was mailed to Petitioners.

7) On November 19, 2007, Petitioners filed a Request For Continued Examination with an amendment and a declaration pursuant to 37 C.F.R. § 1.132.

8) On January 30, 2008, a Non-Final Rejection was mailed to Petitioners.

9) On March 17, 2008, Petitioners filed an amendment.

10) On July 10, 2008, a Final Rejection was mailed to Petitioners.

11) On October 10, 2008, Petitioners filed a Notice Of Appeal.

12) On December 16, 2008, Petitioners filed an Appeal Brief.

13) On November 30, 2009, an Examiner's Answer was mailed to Petitioners.

14) On January 25, 2010, Petitioners filed a Reply Brief.

15) On April 14, 2011, Petitioners presented oral arguments before a Board panel.

16) On May 3, 2011, a Decision on Appeal was mailed to Petitioners.

17) On June 30, 2011, Petitioners filed a Request for Rehearing.

18) On August 1, 2011, a Decision on Request for Rehearing was mailed to Petitioners.

19) On September 30, 2011, Petitioners filed the instant Petition, along with a second Request for Rehearing.

## RELEVANT AUTHORITY

37 C.F.R. § 1.183 states

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the

> Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 41.52(a) states

> (1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.
>
> (2) Upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.
>
> (3) New arguments responding to a new ground of rejection made pursuant to § 41.50(b) are permitted.

*In re Leithem*, No. 2011-1030, 2011 WL 4351585, at *3-*4 (Fed. Cir. Sept. 19, 2011) states:

> The Board need not recite and agree with the examiner's rejection *in haec verba* to avoid issuing a new ground of rejection. [] Mere reliance on the same statutory basis and the same prior art references, alone, is insufficient to avoid making a new ground of rejection when the Board relies on new facts and rationales not previously raised to the applicant by the examiner. [] The thrust of the Board's rejection

changes when, as here, it finds facts not found by the examiner regarding the differences between the prior art and the claimed invention, and these facts are the principal evidence upon which the Board's rejection was based.

ARGUMENTS

Appellants, in their current Petition, argue:

1) "[T]o deny rehearing in this case is contrary to the Federal Circuit's subsequent opinion in *In re Leithem*, No. 2011-1030, _ F.3d _ (Fed. Cir. Sept. 19, 2011)." Petition 1.

2)

> [T]he Board suggested in its May 3, 2011 decision that placement of buffer and nicotine in the gum coating would have been obvious. Although the cited Cherukuri prior art reference (WO/0013662) does not teach locating buffer in the gum coating, the Board suggested that the reference teaches generally that pH modulation can improve nicotine delivery and that the reference allegedly teaches that "the buffering system heretofore described may be utilized with any type of confectionary formulation in which a controlled release under proper pH, and preferably alkaline pH conditions, is warranted" (Board May 3,2011 Op. at 5-6, citing Cherukuri at 36, lines 3-6). The examiner, however, never relied on this portion or interpretation of the Cherukuri reference during prosecution, and the Board's reliance on an interpretation that differs from the examiner's demonstrates the Board's implicit conclusion that the examiner's findings could not sustain the final rejections of appellants' claims.

Petition 2.

3) "Given that there are now three years of patent term at stake, appellants submit that the present case is one where justice requires the suspension of the rules so as to allow entry of appellants' second Request for Rehearing." Petition 3.

PROCEDURAL HISTORY

Claim 1 (emphasis added) reads as follows.

> 1. A coated chewing gum product comprising at least one buffered chewing gum core comprising at least one of nicotine in any form or a nicotine mimicking agent; at least one coating layer; and optionally one or more other additive(s); wherein said *coating layer is buffered* and comprises at least one of nicotine in any form or a nicotine mimicking agent; and wherein the coated chewing gum product is capable of effecting a $t_{max}$ of said nicotine or a nicotine mimicking agent in venous blood about 5 to 20 minutes after said coated chewing gum product is administered into the oral cavity of a subject and the nicotine in any form or nicotine mimicking agent in the coated chewing gum product is allowed to release in the saliva in the oral cavity and be absorbed by the subject.

Petitioners argued that the Examiner failed to present a prima facie case of obviousness as to the limitation that "said coating layer is buffered" and the Examiner's rejection should be reversed. Petitioners contend that "the Examiner leapt to the conclusion that one of ordinary skill in the art would understand from Cherukuri that if nicotine is included in the coating, buffer should be in the coating as well, despite the fact that the Cherukuri reference makes no such suggestion." Appeal Br. 4.

Petitioners contend that the Board's referral to Cherukuri 36 to describe this limitation is a new ground of rejection.

The Examiner initially found that Cherukuri described a buffered chewing gum core and coating layer containing nicotine, but that "Cherukuri does not expressly disclose the use of buffer in the coating layer," but "Cherukuri also discloses the importance of buffers wherever nicotine to be adsorbed [sic]," and "Cherukuri indicates the need to control pH in the mouth '. . . over the entire release period', which one of ordinary skill in the art, at the time of invention would also consider the release of nicotine from the coating." Ans. 3-4. The

Examiner then found "there is significant teaching within Cherukuri to lead one of ordinary skill to the conclusion, that everywhere nicotine is used for oral absorption, absorption is aided by the presence of a buffer. And because Cherukuri also teaches a coating containing nicotine for the express reason to give a rapid raise in absorbed nicotine, it would follow that one of ordinary skill could combine these teachings and use a buffer in the coating to facilitate additional nicotine absorption." Ans. 4.

On appeal, Petitioners argued that Cherukuri did not suggest that if nicotine is included in the gum coating then buffer should also be included in the coating. App. Br. 7. In response, the Examiner found "one would include buffer in the coating that contains nicotine because Cherukuri place [sic] nicotine there for rapid release," and "[t]here are also a limited number of locations for buffer to be used, which only include the gum core or the coating." Ans. 10-11. Petitioners then argued "nowhere does Cherukuri teach or even suggest that buffer should be located in a gum coating." Reply Br. 3.

On appeal, the panel found "that Cherukuri '662 discloses that the gum base may be coated with an edible 'confectionery-type shell', with or without any active nicotine ingredient (p. 24, 11.9-11)." Decision 5. This fact established that Cherukuri's gum base might have a confectionary shell, and that the shell itself might contain any active nicotine ingredient. Petitioners do not contend that this is a newly presented fact by the Board panel.

In the Request for Rehearing, Petitioners argue that the newly found fact by the Board panel is that Cherukuri "also provides that the buffering system heretofore described may be utilized with any type of confectionery formulation in which a controlled release under proper pH, and preferably alkaline pH conditions, is warranted." Req. Reh'g 5 (referring to Cherukuri 36:3-6). It is the linkage

between the confectionary shell and the buffer that Petitioners contend is a new ground of rejection on appeal. The Petitioners argue that

> the Board rested its decision on an interpretation of the prior art that the examiner had never advanced during prosecution (Op. at 5-6), and appellants have had no opportunity to respond to this interpretation. Moreover, by relying on a new interpretation of the prior art, the Board has impliedly conceded that the examiner's previous findings could not sustain the final rejections of appellants' claims, and the Board should reverse the examiner's unsustainable final rejections.

Req. for Reh'g 2.

In the Decision on Request for Rehearing, the Panel responded

> Cherukuri's page 36 teaching regarding the use of the buffer system with any type of confectionery formulation in which a controlled release under proper pH is warranted, merely reiterates the Examiner's position that Cherukuri's "significant teachings" would have led one skilled in the art to use a buffer system anywhere nicotine is used for oral absorption to aide in the uptake of the nicotine (Ans. 4). Moreover, Cherukuri's page 36 teaching regarding the buffer location is readily apparent from a cursory reading of the reference and is part of Cherukuri's disclosure taken as a whole.

Decision on Req. Reh'g 2-3.

Now, Petitioners request that in light of *In re Leithem*, No. 2011-1030, 2011 WL 4351585 (Fed. Cir. Sept. 19, 2011), the Board reconsider whether this fact constitutes a new ground of rejection. In *Leithem*, the Court found that "[t]he thrust of the Board's rejection changes when, [] it finds facts not found by the examiner [], and these facts are the principal evidence upon which the Board's rejection was based." *Id.* at *4.

Petitioners contend "The Board did not respond to appellants' arguments concerning that Board's nominal 'affirmance' of the examiner's rejection on a different factual basis from which the appeal was taken deprived appellants of their rightful patent term adjustment." Second Request for Rehearing 3. Petitioners

argue "the examiner never relied on this section of Cherukuri, and the Board's reliance on an interpretation that differs from that of the examiner demonstrates the Board's implicit conclusion that the examiner's findings could not sustain the final rejections of appellants' claims." *Id.* at 4-5.

DISCUSSION

The issues are (1) whether Petitioners' necessity for filing a Request for Continued Prosecution, which diminishes Petitioners' patent term adjustment, is an extraordinary situation warranting that the Board consider a second request for Rehearing, and (2) if so, whether the facts described on Cherukuri 36 are the principal evidence upon which the Board's rejection was based.

The answer to the first issue is negative, because every Board affirmance, unless successfully challenged in appeal, ordinarily diminishes patent term adjustment. Answering in the affirmative to the first issue would negate rule 37 C.F.R. § 41.52(a)(1) that "[n]o request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted." Petitioners have not shown an extraordinary situation.

This is dispositive of this Petition, but even if it were not, the Panel answered the second issue directly in the Decision on Request for Rehearing, in the passage cited *supra* that this fact "merely reiterates the Examiner's position." Req. Reh'g 3. Because Cherukuri 36 merely reiterates the Examiner's position, and the Examiner presented substantial evidence in the Answer in support of this position, Cherukuri 36 is not the principal evidence, but merely substantiating evidence, upon which the Board's affirmance of the Examiner's rejection was based. That

Cherukuri 36 describes one of nine exemplary embodiments of the generic teachings cited by the Examiner, and is not a teaching of generic principles itself, further demonstrates that the Board's citation of Cherukuri 36 follows the thrust of the Examiner's rejection, as one would be led to the examples for exemplary implementation details.

Accordingly, the Panel has responded to the Petitioners' arguments and a second Request for Rehearing is not appropriate in this instance.

DECISION

For the reasons set forth above, the Petition is DENIED.

James Donald Smith
Chief Administrative Patent Judge

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

**ERICSSON INC.**
**6300 LEGACY DRIVE**
**M/S EVR 1-C-11**
**PLANO TX 75024**

MAILED
DEC 15 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Frank Hundscheidt, et al. | : | |
| Application No. 10/481,078 | : | DECISION ON PETITION |
| Filed May 5, 2004 | : | |
| Atty. Docket No. P14977-US1 | : | |

This is a decision on the petition, filed September 30, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DISMISSED**.

The application was held abandoned for failure to reply in a timely manner to the Final Rejection, mailed June 23, 2009, which set a shortened statutory period for reply of three (3) months. A Notice of Abandonment was mailed September 24, 2010.

A timely reply to the Final Rejection of June 23, 2009 was filed August 24, 2009. However, it did not place the application in condition for allowance for reasons noted in the Advisory Action mailed on August 13, 2010. An acceptable reply to the Final Office action was due on or before September 23, 2009, or, on or before December 23, 2009, with an extension of time for three months. As no extensions of time were timely obtained, the application became abandoned, by law, on September 24, 2009. The filing of the Request for Continued Examination (RCE) and amendment on September 23, 2010, was after the application had already gone abandoned.

In view of the above, the petition requesting withdrawal of the holding of abandonment cannot be granted at this time.

If petitioner cannot supply the evidence necessary to withdraw the holding of abandonment, or simply does not wish to, petitioner should consider filing a petition under 37 CFR 1.137(b) stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has

been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the $1,620 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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

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

By 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

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

/Ramesh Krishnamurthy/
Ramesh Krishnamurthy
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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**ERICSSON INC.**
**6300 LEGACY DRIVE**
**M/S EVR 1-C-11**
**PLANO TX 75024**

**MAILED**

JAN 25 2011

**OFFICE OF PETITIONS**
ON PETITION

In re Application of :
Frank Hundscheidt, et al. :
Application No. 10/481,078 :
Filed: May 5, 2004 :
Attorney Docket No. P14977-US1 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 6, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of June 23, 2009. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is September 24, 2009. The Notice of Abandonment was mailed September 24, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810, and the submission required by 37 CFR 1.114; (2) the petition fee of $1,620; and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 2468 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

/Terri Johnson/
Terri Johnson
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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JOSEPH S. TRIPOLI
THOMSON LICENSING INC
PATENT DEPARTMENT
P.O. BOX 5312
PRINCETON, NJ 08543-5312

MAILED
JAN 21 2011
OFFICE OF PETITIONS

In re Application of :
Eric Diehl et al :
Application No. 10/481,202 : ON PETITION
Filed: December 18, 2003 :
Attorney Docket No. PF010071 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 7, 2010, to revive the above-identified application.

The petition is **GRANTED.**

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of April 3, 2009. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that prima facie places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is July 4, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810 the submission required by 37 CFR 1.114; (2) the petition fee of $1620 and (3) a proper statement of unintentional delay.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

This application is being referred to Technology Center AU 3714 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment filed December 7, 2010 submitted in accordance with 37 CFR 1.114.

Irvin Dingle
Petition Examiner
Office of Petitions

cc: Joel M. Fogelson
Two Independence Way, Suite 200
Princeton, NJ 08540

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P.O. Box 1450
Alexandria, VA 22313-1450
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KING & SPALDING
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036-4003

MAILED
SEP 28 2010
OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,365,205 | : ON PETITION |
| Ohta et al. | : UNDER 37 CFR 1.183 |
| Issue Date: April 29, 2008 | : and |
| Application No. 10/481,262 | : ON APPLICATION FOR |
| Filed: July 14, 2004 | : PATENT TERM ADJUSTMENT |
| Attorney Docket No. 13509.105007US2 | : |

This is a decision on the "REQUEST FOR RECONSIDERATION OF DISMISSAL OF PETITION UNDER 37 C.F.R. § 1.183 AND OF DISMISSAL OF REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR. 1.705 (d)", filed June 14, 2010, requesting reconsideration on the merits and revision of the patent term in accordance with Wyeth.

This petition is hereby **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.

The petition for recalculation/reconsideration of the USPTO's PTA determination for U.S. Patent No. 7,365,205 is dismissed as untimely. On February 1, 2010, the USPTO published a Federal Register notice that, *inter alia*, announced a limited waiver of the two-month deadline for filing a petition for reconsideration of a PTA determination under 37 CFR sec. 1.705(d). *See Interim Procedure for Patentees to Request a Recalculation of the Patent Term Adjustment to Comply with the Federal Circuit Decision in Wyeth v. Kappos Regarding Overlapping Delay Provisions of 35 U.S.C. sec. 154(b)(2)(A)*, 75 *Fed. Reg.* 5043 (Feb. 1, 2010) (notice).

Specifically, patent owners were permitted to request recalculation of a patent's PTA in view of the Federal Circuit decision Wyeth v. Kappos, 591 F.3d 1364 (Fed. Cir. 2010) up to 180 days after the grant of the patent. The USPTO determined not to accept <u>any</u> requests for PTA recalculation initially filed more than 180 days after patent grant, however, in view of the statutory judicial-review provisions of 35 U.S.C. sec. 154(b)(4), which require that any civil action to challenge the USPTO's PTA determination be brought within 180 days of patent grant. The USPTO believes that the statutory 180-day period for seeking court review of the USPTO's PTA determinations, particularly in view of the six-year statute of limitations that otherwise is applicable for actions under the Administrative Procedure Act, indicates a congressional intent that PTA issues be resolved shortly after a patent issues. The USPTO does not consider it likely that Congress created a scheme under which the time period to seek initial USPTO review of a

PTA determination extends beyond the time period provided for a dissatisfied patentee to seek judicial review of the USPTO's PTA determination. Thus, the USPTO believes that the 180-day period in 35 U.S.C. sec. 154(b)(4) represents the outer limit on the USPTO's ability to conclude its PTA determination.

The present renewed petition under 37 CFR 1.183 is granted to the extent that the decision of June 14, 2010 has been reconsidered; however, the renewed petition requesting suspension of the time limit for consideration of an application for patent term adjustment under 37 CFR 1.183 is **DENIED**.

Telephone inquiries specific to this matter should be directed to Charlema Grant, Attorney, Office of Petitions, at (571) 272-3215.

Anthony Knight
Director
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : January 26, 2010

**TO SPE OF** : ART UNIT 2626

**SUBJECT** : Request for Certificate of Correction for Appl. No.:10/481324 /Patent no. 7478046

Please respond to this request for a certificate of correction w
ithin 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:**

The corrections are approved for claims 20 and 26, corresponding to original (before renumbering) claims 29 and 48. These corrections arise due to a mistake of the Patent Office.
However, the corrections to claim 39 are not approved. Claim 39 corresponds to original (before renumbering) claim 46. The amendment filed 09 July 2008 presents the final allowed version of original claim 46, but does not include any limitations directed to a step (108) or a step (207). Claim 39, corresponding to original claim 46, appears to be correctly transcribed by the Patent Office, and any attempt to add the propose limitations by a Certificate of Correction would materially change the scope of the claim, and would be prohibited by 35 U.S.C. 255. See MPEP 1481. These changes could only be added by reissue.

/Richemond Dorvil/ SPE Art Unit 2626

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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Date Mailed : August 25, 2010

Serial no. : 10/0481324
Patent No. :7,478,046 B2
Patent Issued : January 13, 2009
Inventor(s) : Eiko Yamada, et al.
Title :SERVER-CLIENT TYPE SPEECH RECOGNITION APPARATUS AND METHOD

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..

Respecting the alleged error(s) noted in your request, the corrections are approved for claims 20 and 26, corresponding to original (before renumbering) claims 29 and 48. These corrections arise due to Office mistake. The corrections to claim 39 are not approved. Claim 39 corresponds to original (before renumbering) claim 46. The amendment filed July 9. 2008 presents the final allowed version of original claim 46, but does not include any limitations directed to a step (108) or a step (207). Claim 39, corresponding to original claim 46, appears to be correctly transcribed by the Patent Office, and any attempt to add the propose limitations by a Certificate of Correction would materially change the scope of the claim, and would be prohibited by 35 U.S.C. 255. See MPEP 1481. These changes could only be added by reissue.

In view of the foregoing your request in this matter is hereby denied.

A certificate of correction will issue for the remaining errors noted in your request.

Magdalene Talley
For Mary F. Diggs, Supervisor
Decision and Certificate
Of Correction Branch
(571)272-0423

Sughrue Mion, PLLC
2100 Penn. Avenue, NW, Ste. 800
Washington, DC 20037

UNITED STATES PATENT AND TRADEMARK OFFICE

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George E. Darby
Paradise Patent Services Inc
P O Box 893010
Mililani, HI 96789-3010

MAILED

MAR 10 2011

OFFICE OF PETITIONS

In re Application of
Mohammed Gomma Abutaleb, et. al.
Application No. 10/481,660
Filed: December 17, 2003
Attorney Docket No. DISW-US1

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 17, 2010, to revive the above-identified application.

The application became abandoned for failure to timely file a reply to the final Office action mailed June 8, 2009. A Notice of Abandonment was mailed on December 23, 2009.

The instant petition is not signed by an attorney of record. However, in accordance with 37 CFR 1.34(a), the signature of Scott D. Watkins 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.

Additionally, it is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must so notify the Office.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal with the $540 fee; (2) the petition fee of $1,620; and (3) a proper statement of unintentional delay. Therefore, the petition is **granted**.

**The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the $540 fee required by 37 CFR 41.20(b)(2)), runs from the 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. Thereafter, all future communications from the Office will be mailed to the address of record until otherwise instructed.

This application is being referred to Technology Center Art Unit 2618 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the above application.

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

Andrea Smith
Petitions Examiner
Office of Petitions

cc: Scott D. Watkins
Steptoe & Johnson, LLP
1330 Connecticut Avenue, NW
Washington, DC 20036

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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WEATHERLY KERVEN & SEIGEL LLC
115 PERIMETER CENTER PLACE
SUITE 1082
ATLANTA GA 30346-1245

**MAILED**
APR 05 2011
**PCT LEGAL ADMINISTRATION**

In re Application of :
FIERRO, Eduardo :
Application No.: 10/481,782 :
371(c) Date: May 28, 2004 : DECISION ON PETITION
Attorney Docket No.: 05-217 :
For: ADJUSTABLE AUTOFIXING SLING FOR :
TREATMENT OF URINARY :
INCONTINENCE

This decision is in response to applicants' "Petition to Accept Unintentionally Delayed Claim" filed December 23, 2010, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of priority to the prior-filed nonprovisional application set forth in the amendment filed December 23, 2010.

The petition under 37 CFR 1.78(a)(3) is **GRANTED**.

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

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

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(3) in that (1) a reference to the prior-filed nonprovisional applications has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) applicant's statement that "the entire delay from the filing of the Application through today in correcting the priority claim in the Application to include a claim of priority to U.S. Application No. 10/168,554 which was the National Stage of International Application No. PCT/EP00/13016 filed December 20, 2000, and now U.S. Patent No. 6,911,002 was unintentional" is construed as meaning that "the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional." If this is incorrect, petitioner must immediately notify the Office of PCT Legal Administration. As construed, petitioner's statement satisfied item (3) above. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed international application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that any Filing Receipt includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.***

Any inquiries concerning this decision may be directed to Anthony Smith, Attorney Advisor, at (571) 272-3298. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to the appropriate Technology Center Art Unit for action on the amendment filed December 23, 2010, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. §120 to the prior-filed nonprovisional application.

Bryan Lin

Bryan Lin
Legal Examiner
PCT Legal Administration

ATTACHMENT: Corrected Filing Receipt

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 :February 7, 2011

Patent No. :7842677
Inventor(s) :Shawn DeFrees and Zhi Guang Wang
Issued :November 30, 2010
Title :NOVEL SYNTHETIC GANGLIOSIDE DERIVATIVES AND COMPOSITIONS
:THEREOF

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.

Applicants' proposed request to change data on the Title Page; Item [54] Title is not warranted correction. The changes as presented in the Letters Patent is the result of a style change where certain words such as "A, Improvement etc.. are not included as the first word of the title.

In view of the forgoing applicants' request in this matter is hereby denied.

Any inquiry concerning this communication should be directed to Ms. A. Green at (703) 756-7541

A. Green

Mary Diggs, Supervisor
Decisions & Certificates
of Correction Branch
(703) 756--1580 or (703) 756- 1541

Tuan N,. Nguyen, Ph.D c/o Morgan, Lewis & Bocklus, LLP
One Market, Spear Street Tower
San Francisco, CA 94105

/arg

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No.

Martin Popp
Fichtestr. 8A
01109
Dresden
GERMANY

MAILED
JAN 10 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Popp et al. | : | |
| Application No. 10/482,328 | : | |
| Filed: August 13, 2004 | : | DECISION ON REQUEST |
| Title: FIELD EFFECT TRANSISTOR | : | TO REFUND PETITION FEE |
| AND METHOD FOR THE PRODUCTION | : | |
| THEREOF | : | |

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R § 1.113 in a timely manner to the final Office action mailed September 24, 2008, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 C.F.R § 1.136(a) were available, and no responses were received. Accordingly, the above-identified application became abandoned on December 25, 2008. A notice of abandonment was mailed on March 30, 2009.

On November 17, 2010, Petitioner filed a petition pursuant to 37 C.F.R. § 1.137(b) to revive the above-identified application, along with the petition fee, a Request for Continued Examination (RCE) along with the required fee, and an amendment.

On December 1, 2010, Petitioner submitted a communication, indicating that the aforementioned petition was filed by mistake and that "Applicants requests (sic) that the Petition to Revive be withdrawn and to keep the application status as abandoned."

Petitioner's request is **GRANTED** to the extent that the $1620 petition fee that was submitted on November 17, 2010 will be refunded to Deposit Account No. 50-0471 in due course.

The petition pursuant to 37 C.F.R. § 1.137(b) is withdrawn from consideration, since Applicants have expressly indicated on the record that it was their intent to abandon the application.

This decision pertains solely to the petition under 37 C.F.R. § 1.137(b) and the fee associated therewith. Any question pertaining to the processing of the RCE should be directed to the Technology Center.

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the amendment and the RCE that were concurrently filed on November 17, 2010 can be processed in due course. The Examiner will note that this application is abandoned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[1] All other inquiries concerning examination procedures should be directed to the Technology Center.

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 application, the change of correspondence address 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. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-

---

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).

identified application. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at http://www.uspto.gov/web/forms/sb0122.pdf.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

cc: Dicke, Billig & Czaja, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402

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

GE HEALTHCARE, INC.
IP DEPARTMENT 101 CARNEGIE
CENTER
PRINCETON NJ 08540-6231

MAILED
MAR 15 2012
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Luthra et al. | : | |
| Application No. 10/482540 | : | DECISION |
| Filing or 371(c) Date: 07/15/2004 | : | ON PETITION |
| Attorney Docket Number: PH0131 | : | |

This is a decision on the correspondence filed September 17, 2007, entitled Response to Abandonment Notification. The petition is properly treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Office communication, mailed August 9, 2006. The Office communication set a one (1) month period for reply. Petitioner filed a reply to the Office communication on September 7, 2006. The Office mailed a Notice of Abandonment on August 2, 2007, indicating as the reason for abandonment Applicant's failure to reply to an Office letter mailed on December 11, 2006.

In response to the Notice of Abandonment, Petitioner files the present petition and avers that no Office communication dated December 11, 2006 was received by the Applicant. In view thereof, petitioner asserts that the Notice of Abandonment was mailed in error, and that the status of the application is currently pending.

A review of the application file reveals that petitioner filed a timely reply to the Office communication, mailed August 9, 2006, on September 7, 2006.

In view of the foregoing, the petition is granted. The holding of abandonment is hereby withdrawn.

The application file is being referred to Technology Center Art Unit 1621 for examination in the normal course of business.

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

MAILED
AUG 05 2011
OFFICE OF PETITIONS

**Francis C Hand**
**Carella Byrne Bain Gilfillan Cecchi Stewar & Olstein**
**5 Becker Farm**
**Roseland NJ 07068**

| | | |
|---|---|---|
| In re Application of | : | |
| Achim KRISCHER | : | ON PETITION |
| Application No. 10/483,129 | : | |
| Filed: July 22, 2004 | : | |
| Atty. Docket No.: 76775.6 | | |

This is a decision on the petition under 37 CFR 1.137(b), filed July 19, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Notice of Allowance and Fee(s) Due mailed March 22, 2011 (Notice), which set a statutory period for reply of three (3) months. The application went abandoned on June 23, 2011. A Notice of Abandonment was mailed July 6, 2011.

The petition satisfies the conditions for revival pursuant to 37 CFR 1.137(b) by including (1) a reply in the form of payment of the Issue fee in accordance with the Notice, (2) a petition fee of $1620, and (3) a statement of unintentional delay. The reply to the Notice is accepted as having been unintentionally delayed.

Telephone inquires regarding this decision should be directed to Robert DeWitty, Petitions Attorney, Office of Petitions (571-272-8427).

The application file will be referred to Office of Data Management for further processing.

Ramesh Krishnamurthy
for 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

Browdy and Neimark PLLC
624 Ninth Street, NW
Suite 300
Washington DC 20001-5303

MAILED
SEP 30 2010
OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,432,978 | : |
| Storm | : DECISION UPON REMAND AND |
| Issue Date: October 07, 2008 | : RECONSIDERATION OF |
| Application No. 10/483,626 | : PATENT TERM ADJUSTMENT |
| Filed: June 29, 2004 | : AND NOTICE OF INTENT |
| Attorney Docket No. Storm1 | : TO ISSUE CERTIFICATE OF |
| Title: Portable device having a | : CORRECTION |
| torch and camera located | : |
| between the bulb and front face | |

This is a decision following remand from the District Court for the District of Columbia regarding the patent term adjustment indicated on the above-identified patent. The Court remanded this matter to the U.S. Patent and Trademark Office for recalculation of the patent term adjustment in accordance with the decision in Wyeth & Elan Pharma Int'l Ltd. v. Kappos, 591 F.3d 1364 (Fed. Cir. 2010).

The Office notes that patentee's calculation did not rely on the date of commencement to calculate the "B" delay. The Office calculated the "B" delay to be 626 days rather than applicant calculated delay of "466" days. The date of commencement was 1/20/2004. Accordingly, the patent term adjustment is the following: 568+626-28=1166 days.

The patent term adjustment indicated on the above-identified patent has been recalculated as directed by the Court. The term of the above-identified patent is extended or adjusted by eleven hundred and sixty-six (1166) days.

The application is being forwarded to the Certificates Branch for issuance of a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by eleven hundred and sixty-six (1166) days.

Telephone inquiries specific to this matter should be directed to Senior Legal Advisor Kery A. Fries at (571) 272-7757.

/Kery A. Fries/

Kery Fries
Senior Legal Advisor Attorney
Office of Patent Legal Administration
Office of Associate Commissioner
For Patent Examination Policy

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,432,978

DATED : **October 07, 2008** **DRAFT**

INVENTOR(S) : Storm

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 540 days

Delete the phrase "by 540 " and insert – by 1166 days--

Day : Wednesday

PALM INTRANET

Date: 9/29/2010
Time: 11:07:40

| PTA Calculations for Application: 10/483626 | | | |
|---|---|---|---|
| Application Filing Date: | 06/29/2004 | PTO Delay (PTO): | 568 |
| Issue Date of Patent: | 10/07/2008 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 28 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 1166 |
| PTO Delay Adjustment: | 626 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 77 | 09/29/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 626 | | |
| 76 | 09/29/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 626 | | |
| 75 | 09/29/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 626 | |
| 70.5 | 09/17/2008 | PTA 36 MONTHS | | | |
| 70 | 10/07/2008 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 69 | 08/25/2008 | EXPORT TO FINAL DATA CAPTURE | | | |
| 68 | 08/22/2008 | DISPATCH TO FDC | | | |
| 67 | 08/22/2008 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 66 | 08/21/2008 | ISSUE FEE PAYMENT VERIFIED | | | |
| 65 | 08/21/2008 | ISSUE FEE PAYMENT RECEIVED | | | |
| 64 | 06/11/2008 | FINISHED INITIAL DATA CAPTURE | | | |
| 63 | 05/26/2008 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 62 | 05/22/2008 | MAIL NOTICE OF ALLOWANCE | | | |
| 61 | 05/21/2008 | ISSUE REVISION COMPLETED | | | |
| 60 | 05/21/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 59 | 05/21/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 58 | 05/21/2008 | DOCUMENT VERIFICATION | | | |
| 57 | 05/21/2008 | NOTICE OF ALLOWABILITY | | | |
| 52 | 05/19/2008 | DATE FORWARDED TO EXAMINER | | | |
| 51 | 05/01/2008 | RESPONSE AFTER NON-FINAL ACTION | | 23 | 49 |
| 50 | 05/01/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 49 | 01/08/2008 | MAIL NON-FINAL REJECTION | | | |
| 48 | 01/07/2008 | NON-FINAL REJECTION | | | |
| 47 | 12/17/2007 | DATE FORWARDED TO EXAMINER | | | |

| | | | | | |
|---|---|---|---|---|---|
| 46 | 11/29/2007 | AMENDMENT AFTER FINAL REJECTION | | | |
| 45 | 09/05/2007 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 44 | 09/04/2007 | FINAL REJECTION | | | |
| 43 | 06/25/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 42 | 06/25/2007 | REFERENCE CAPTURE ON IDS | | | |
| 41 | 06/25/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 0 | 39 |
| 40 | 06/28/2007 | DATE FORWARDED TO EXAMINER | | | |
| 39 | 06/25/2007 | RESPONSE AFTER NON-FINAL ACTION | | 5 | 35 |
| 38 | 06/25/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 37 | 06/25/2007 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 36 | 06/25/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 35 | 03/20/2007 | MAIL NON-FINAL REJECTION | 568 | | -1 |
| 34 | 03/17/2007 | NON-FINAL REJECTION | | | |
| 33 | 08/06/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 32 | 02/09/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 31 | 11/20/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 30 | 11/07/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 29 | 07/05/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 28 | 07/05/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 27 | 07/05/2006 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 25 | 07/05/2006 | TRANSFER INQUIRY TO GAU | | | |
| 24 | 04/08/2006 | TRANSFER INQUIRY TO GAU | | | |
| 23 | 02/15/2006 | TRANSFER INQUIRY TO GAU | | | |
| 22 | 01/24/2006 | CASE CLASSIFIED BY OIPE | | | |
| 21 | 01/24/2006 | CASE CLASSIFIED BY OIPE | | | |
| 20 | 08/06/2004 | REFERENCE CAPTURE ON IDS | | | |
| 19.7 | 08/06/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 19 | 08/06/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 18 | 08/28/2004 | CLEARED BY OIPE CSR | | | |
| 17 | 06/29/2004 | 371 COMPLETION DATE | | | |
| 16 | 08/13/2004 | APPLICATION DISPATCHED FROM OIPE | | | |
| 15 | 08/13/2004 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| | | | | | |

| | | | | | |
|---|---|---|---|---|---|
| 4 | 06/29/2004 | A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC | | | |
| 3 | 08/11/2004 | CORRESPONDENCE ADDRESS CHANGE | | | |

**Search Another: Application#** Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to OASIS | Home page

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/483,690 | 01/12/2004 | Christopher Robert Lawrence | 03-1113 | 3842 |

20306 7590 08/30/2010
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

| EXAMINER |
|---|
| SHEWAREGED, BETELHEM |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1794 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/30/2010 | 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
www.uspto.gov

wk

Mailed :
In re Application of
Lawrence et al.
Serial No. 10/483,690
Filed: January 12, 2004
For: Security Label

AUG 30 2010

DECISION ON PETITION

This is a decision on Appellants' Petition under 37 CFR 1.181 filed June 12, 2009 requesting withdrawal of abandonment or in the alternative a petition under 37 CFR 1.137(b) for revival of an application abandoned unintentionally.

On October 29, 2008, Applicant filed an Appeal Brief. The Examiner issued a Notice of Non-Compliant Appeal Brief on December 2, 2008 because the Brief did not contain a concise statement of each ground of rejection presented from review ( 37 CFR 41.37( c )(1)(vi).

On December 12, 2008, Applicant filed a Corrected Appeal Brief. The Examiner on March 4, 2009 issued a second Notice of Non-Compliant Appeal Brief. The Examiner determined that a concise statement of each ground of rejection presented for review had not been provided. The Examiner also pointed out that specifically claim 2 was missing and claims 4, 6 and 9 were only obvious under 35 U.S.C 103 over Becker et al. in view of Mullen et al., and not obvious only over Becker et al. The Examiner further noted that references to unentered evidence were not permitted in the Brief.

Applicant on March 27, 2009 filed a Corrected Appeal Brief. The Appeal Brief continued to contain defects. Even though copies of the new evidences were taken out of the Appeal Brief, Applicant's arguments still relied upon the context of the new evidences. The Examiner issued a Notice of Abandonment on May 5, 2009.

37 CFR 41.37(d) states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

MPEP § 1205.03 states in part:

The Office may use the form paragraphs set forth below or form PTOL-462, "Notification of Non-Compliant Appeal Brief (37 CFR 41.37)" to notify appellant that the appeal brief is defective. The appeal will be dismissed if the appellant does not timely file an amended brief, or files an amended brief which does not overcome all the reasons for noncompliance of which the appellant was notified.

MPEP § 1215.04 states in part:

An appeal will also be dismissed if an applicant fails to timely and fully reply to a notice of noncompliance with 37 CFR 41.37(d). See MPEP § 1205.03 and 37 CFR 41.37(d). The applicant may petition to revive the application as in other cases of abandonment, and to reinstate the appeal.

Since the filed Appeal Briefs, did not overcome all the reasons for non-compliance of the original Appeal Brief, the Appeal were properly dismissed in accordance with 37 CFR 41.37(d). The fact pattern of this application falls completely within the rule as set forth in 37 CFR 41.37(d). Further, MPEP 1215.04 clearly establishes that if the response to the notice of non-compliance fails to fully reply to the notice then the application is abandoned. Since the Supplemental Briefs did not correct all the deficiencies set forth in the notice, the application became abandoned.

**DECISION**

The petition for withdrawal of abandonment is **DENIED**.

37 CFR 1.4(c) states that since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. Applicants' alternative request for a petition under 37 CFR 1.137(b) is held in abeyance. Applicant is requested to file the petition request as a separate paper.

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

MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO IL 60606

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

MAILED
MAR 09 2011
OFFICE OF PETITIONS

In re Application of :
Christopher Robert Lawrence, et al. :
Application No. 10/483,690 : DECISION ON PETITION
Filed: January 12, 2004 :
Attorney Docket No. 03-1113 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 30, 2010, to revive the above-identified application.

This application became abandoned as a result of petitioner's failure to file a complete and proper appeal brief within the time period provided in 37 CFR 41.37(a)(1). As a complete and proper appeal brief was not filed within one (1) month of the Notification of Non-Compliance with 37 CFR 41.37(c)(1), mailed March 4, 2009, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on April 5, 2009. See MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an appeal brief, (2) the petition fee of $1620, and (3) a proper statement of unintentional delay.

In view of the above, the petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642. Telephone inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 1794 for appropriate action by the Examiner in the normal course of business on the reply received September 30, 2010.

April M. Wise
Petitions Examiner
Office of Petitions

| Doc Code: PET.AUTO<br>Document Description: Petition automatically granted by EFS-Web | PTO/SB/64<br>U.S. Patent and Trademark Office<br>Department of Commerce |
|---|---|

| | |
|---|---|
| Electronic Petition Request | **PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)** |
| Application Number | 10483753 |
| Filing Date | 27-Sep-2004 |
| First Named Inventor | William Parker |
| Attorney Docket Number | 081874-0108 |
| Title | Target assignment projectile |

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus any extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:
(1) Petition fee;
(2) Reply and/or issue fee;
(3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
(4) Statement that the entire delay was unintentional

Petition Fee

- ○ Applicant claims SMALL ENTITY status. See 37 CFR 1.27.
- ○ Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).
- ◉ Applicant(s) status remains as SMALL ENTITY.
- ○ Applicant(s) status remains as other than SMALL ENTITY.

2. Reply and/or fee

- ○ I certify, in accordance with 37 CFR 1.4(d)(4) that the amendment and response have already been filed in the above-identified application on
- ○ Amendment and response are attached

RCE request,submission, and fee.

- ○ I certify, in accordance with 37 CFR 1.4(d)(4) that the RCE Request, Submission, and Fee have already been filed in the above-identified application on
- ◉ RCE Request, Submission, and Fee are attached

Notice of Appeal

○ I certify, in accordance with 37 CFR 1.4(d)(4) that the Notice of Appeal and Fee have already been filed in the above-identified application on

○ Notice of Appeal and Fee are attached

3. Terminal Disclaimer is not required, since the Electronic Petition format is not support for Design applications and applications filed before June 8, 1995. Please file using regular petition format for review by the Office of Petitions.

☒ STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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 who has been given power of attorney in this application.

◉ An attorney or agent registered to practice before the Patent and Trademark Office, acting in a representative capacity.

○ A sole inventor

○ A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors

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

○ The assignee of record of the entire interest that has properly made itself of record pursuant to 37 CFR 3.71

| | |
|---|---|
| Signature | /James Marc Leas/ |
| Name | James Marc Leas |
| Registration Number | 34372 |

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

Decision Date March 17, 2012

In re Application of William Parker

Application No. 10483753

Filed: 27-Sep-2004

Attorney Docket No. 081874-0108

DECISION ON PETITION

UNDER CFR 1.137(b)

This is an electronic decision on the petition under 37 CFR 1.137(b), March 17, 2012 , to revive the above-identified application.

The petition is GRANTED.

The above-identified application became abandoned for failure to reply in a timely manner to the outstanding final Office action. The date of abandonment is the day after the last day of the period set for reply in the Office action plus any applicable extensions of time properly requested.

The electronic petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment and/or response, Request for Continued Examination, and the filing fee required under 37 CFR 1.17(e); (2) the petition fee as set forth in 37 CFR 1.17 (m); and (3) the required statement of unintentional delay have been received. Accordingly, the Request for Continued Examination and the amendment and/or response are accepted as having been unintentionally delayed.

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

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

This application file is being directed to the Technology Center.

Office of Petitions

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#14

CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
1001 PENNSYLVANIA AVENUE, NW
WASHINGTON DC 20004-2595

**MAILED**

NOV 12 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| John MACDOUGALL | : | |
| Application No. 10/483,759 | : | DECISION ON PETITION |
| Filed: November 24, 2004 | : | |
| Attorney Docket No. 038665.51089C1 | : | |

This is a decision on the petition, filed August 24, 2009, under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application. A copy of the petition was also received on December 3, 2009.

The petition is **GRANTED**.

This application was held abandoned for failure to reply to the final Office action, mailed February 21, 2007, which set a six (6) month statutory period for reply. A Notice of Abandonment was mailed October 1, 2007 and again on August 24, 2009.

Petitioner asserts that a Notice of Appeal and appeal fee were previously filed on August 21, 2007. Petitioner provides evidence of this submission in the form of a copy of the previously-filed submission, credit card authorization form, and a post card receipt evidencing receipt of the same on August 21, 2007. Petitioner also asserts that a Request for Continued Examination (RCE) and RCE fee were timely filed on March 21, 2008. Petitioner provides evidence of this submission in the form of a copy of the previously-filed submission, credit card authorization form, and a post card receipt evidencing receipt of the same on March 21, 2008.

A review of the written record reveals that on February 21, 2007, a final Office action was mailed to petitioner. In response, petitioner filed a Notice of Appeal and appeal fee on August 21, 2007. Thereafter, petitioner filed an RCE accompanied by the RCE fee, a reply, and a petition for a five-month extension of time, as evidenced by the exhibits accompanying the instant petition.

Accordingly, the written record shows that the USPTO a) received the timely-filed Notice of Appeal and appeal fee from petitioners on August 21, 2007 and placed it in the application file; and b) received the RCE, RCE fee, petition for extension of time, and submission pursuant to 37 CFR 1.114(c) on March 21, 2008 but the documents were subsequently misplaced.

In view of the above, the Notices of Abandonment mailed October 1, 2007 and August 24, 2009 are hereby vacated as having been sent in error and the holding of abandonment withdrawn.

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

This application is being referred to the Technology Center technical support staff of Art Unit 3663 for further processing in view of the filing of the RCE and accompanying arguments from applicant in the instant application.

BethAnne Dayoan
PCT Legal Analyst
Office of PCT Legal Administration

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Alexandria, VA 22313-1450
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OFFICE OF PETITIONS

PARTNERS HEALTHCARE
RESEARCH AND LICENSING
DEPARTMENT
101 HUNTINGTON AVENUE 4TH
FLOOR
BOSTON MA 02199

| | |
|---|---|
| In re Patent No. 7,572,765 | : DECISION ON |
| Gardella, et al. | : REQUEST FOR RECONSIDERATION |
| Application No. 10/484,080 | : of PATENT TERM ADJUSTMENT |
| Issue Date: August 11, 2009 | : and |
| Filed: July 6, 2004 | : NOTICE OF INTENT TO ISSUE |
| Attorney Docket No. 00786/537003 | : CERTIFICATE OF CORRECTION |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT", filed May 20, 2010, requesting that the patent term adjustment indicated on the above-identified patent be corrected to one thousand nineteen (1019) days.

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

Patentees are correct that the proper amount of days over 36 months from the filing date of the application until the issue date was not included in the "B" delay period. Commencement began on January 23, 2004 (i.e. 30 months from the priority date of July 23, 2001). Accordingly, the over three year period began on January 24, 2007 and ended on July 23, 2008 (the RCE filing date), and is 548 days. See 35 U.S.C. 154(b)(1)(B)(i). Therefore, the "B" delay period is 548 days.

In view thereof, the correct number of days of patent term adjustment is 1019 days (578 days of "A"' delay and 548 days of "B" delay, reduced by 107 days of Applicant delay).

Receipt of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged.

The application is being forwarded to the Certificate of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand nineteen (1019)** days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Cliff Congo, at (571) 272-3207.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# DRAFT CERTIFICATE OF CORRECTION

PATENT : 7,572,765 B2

DATED : **August 11, 2009**

INVENTOR(S) : Gardella et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 471 days.

Delete the phrase "by 471 days" and insert – by 1019 days--

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ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON DC 20036

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent of Suh et al. | : | DECISION ON REQUEST |
| Patent No. 7,662,840 | : | FOR |
| Issue Date: February 16, 2010 | : | RECONSIDERATION OF |
| Application No. 10/484,094 | : | PATENT TERM ADJUSTMENT |
| Filed: January 16, 2004 | : | |
| Atty Docket No. 027707.00018 | : | |

This is a decision on the petition, filed May 17, 2010, requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one hundred fifty-five (155) days. The petition was timely filed within one month of the mailing of a Notice Concerning Improper Calculation of Patent Term Adjustment Based Upon USPTO Improperly Measuring Reduction Period Under 37 CFR 1.704(c)(10), mailed May 17, 2010. The Office acknowledges receipt of the required $200.00 fee under 37 CFR 1.18(e).

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one hundred fifty-five (155) days is **DISMISSED**.

Patentees assert the proper calculation of PTA for the application is derived as follows: 446 days A delay + 134 days B delay - 425 days Applicant delay.

The Office concurs that period of A delay is 446 days.

The Office does not concur that the period of B delay is 134 days. As the period from the filing date of the request for

continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on January 17, 2007, the day after three years after early processing requirements were met, and ends on May 29, 2007, the day before the RCE was filed, and is 133 (not 134) days. See 35 U.S.C. 154(b)(1)(B)(i).

The Office does not concur that the period of Applicant delay is 425 days. Patentees assert that only a 10 day reduction, not a 21 day reduction, should be charged for the delay associated with the filing of a Rule 312 amendment on December 23, 2009. However, the Office finds that, pursuant to 37 CFR 1.704(c)(10), the period of reduction is properly calculated as twenty-one (21) days, counting the number of days in the period beginning on the date the Rule 312 amendment was filed, December 23, 2009, and ending on January 12, 2010, the date the Office mailed a Response to Rule 312 Communication. Accordingly, the period of Applicant delay remains 436 (9 + 91 + 91 + 41 + 91 + 92 + 21) days.

The patent term adjustment calculation is 446 days A delay + 133 days B delay - 436 days Applicant delay, which totals 143 days.

It is noted that the Office issued a certificate of correction on December 28, 2010 listing the patent term adjustment as 143 days.

Telephone inquiries specific to this matter should 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

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United States Patent and Trademark Office
P.O. Box 1450
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Paper No.

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OFFICE OF PETITIONS

SOROKER-AGMON ADVOCATE AND PATENT ATTORNEYS
NOLTON HOUSE, 14 SHENKAR STREET
HERZELIYA PITUACH 46725
ISRAEL

| | | |
|---|---|---|
| In re Application of | : | |
| Freedman | : | DECISION ON APPLICATION |
| Application No. 10/484,107 | : | FOR |
| Filed: July 14, 2004 | : | PATENT TERM ADJUSTMENT |
| Patent No. 7,953,219 | : | |
| Issued: May 31, 2011 | : | |
| Attorney Docket No. : 4257/34 | : | |
| Title: METHOD APPARATUS AND | : | |
| SYSTEM FOR CAPTURING AND | : | |
| ANALYZING INTERACTION BASED | : | |
| CONTENT | : | |

This is a decision on the "REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT," filed July 18, 2011, requesting that the patent term adjustment determination for the above-identified patent be changed from one thousand, seven hundred and fourteen (1714) days to one thousand, nine hundred and thirty (1930) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand, nine hundred and thirty (1930) days is **DISMISSED.**

Submission of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

**BACKGROUND**

On May 31, 2011, the above-identified application matured into US Patent No. 7,953,219 with a patent term adjustment of 1714 days.

Patentee has indicated that this patent is not subject to a terminal disclaimer.[1]

**OPINION**

It is noted that the 371 acceptance letter (M903) mailed on August 2, 2004 indicates that the fulfillment date (the date of completion of all 35 U.S.C. § 371 requirements) is July 14, 2004, and the Priority Date is July 19, 2001.

37 CFR 1.703(a)(1) states that the term of an original patent shall be adjusted by "[t]he number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first." *Emphases added.*

This application fulfilled the requirements of 35 U.S.C. 371 in an international application on July 14, 2004, and a restriction requirement was mailed 14 months and 1202 days later on December 29, 2008, resulting in 1202 days of examination delay. Petitioner contests this finding and asserts that this mailing resulted in a delay of 534 days, as calculated from the application's filing date.

Petitioner's assertion regarding the inaccuracy of the 1202-day reduction is not persuasive. The delay is properly calculated as running from the *fulfillment date* until the mailing of the restriction requirement. Petitioner has erroneously *calculated the period of delay by beginning at the filing date (instead of the fulfillment date) and concluding with the date of the mailing of the restriction requirement.*

---

[1] Petition, page 2.

Moreover, 37 CFR 1.703(b) states that the patent term will be adjusted by "the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued... *Emphases added.*

This application is a national stage entry of PCT/IL02/00593, and this application has a commencement date of January 19, 2004 (the 30 month anniversary of the July 19, 2001 priority date). A Request for Continued Examination (RCE) was filed on October 29, 2010, which cut off the over-three year delay, pursuant to 37 C.F.R. § 1.703(b)(1). The RCE was filed three years and 1379 days after the three-year anniversary of the commencement date. As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on January 20, 2007 and ends on October 28, 2010, the day before the first RCE was filed, which amounts to 1378 days. See U.S.C. 154(b)(1)(B)(i).

Petitioner contests this finding and asserts that the over-three year period should be calculated from the application's filing date and results in a delay of 883 days.

Petitioner's assertion regarding the inaccuracy of the 1378-day period of B-delay is not persuasive. The delay is properly calculated as running from the three year anniversary of the *commencement date* until the filing of the RCE. Petitioner has erroneously *calculated the period of delay by beginning at the three year anniversary of the filing date (instead of the three year anniversary of the commencement date) and concluding with the issue date instead of the day prior to the filing of the RCE.* As a result, Petitioner has also calculated the period of overlap to be 534 days, instead of 710 days.

In view thereof, the patent term adjustment is 1714 (1202 examination delay + 1378 over three years - 710 overlap - 156 applicant delay) days.

**Conclusion**

In view thereof, no adjustment to the patent term will be made. It follows that a certificate of correction is not required.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. § 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. § 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3225.[2]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

[2] Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

UNITED STATES PATENT AND TRADEMARK OFFICE

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**JAMES RAY & ASSOCIATES**
**2640 PITCAIRN ROAD**
**MONROEVILLE PA 15146**

MAILED
NOV 05 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Peter James Brian Lamb | : | |
| Application No. 10/484,146 | : | DECISION ON PETITION |
| Filed: January 16, 2004 | : | |
| Attorney Docket No. ADM 04017 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 24, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a proper and timely manner to the final Office action mailed, March 6, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were timely obtained. Accordingly, the application became abandoned on June 7, 2010. A Notice of Abandonment was mailed September 11, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $405.00 and the submission required by 37 CFR 1.114; (2) the petition fee of $810.00; and (3) a proper statement of unintentional delay.

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

This matter is being referred to Technology Center AU 3761 for processing of the Request for Continued Examination under 37 CFR 1.114 and the Amendment filed with the instant petition.

Joan Olszewski
Petitions Examiner
Office of Petitions

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In re Patent No. 7056368
Issue Date: June 6,2006
Application No. 10484468
Filed: January 22,2004
Attorney Docket No. 766.40790X00

:

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

:

This is a decision on the electronic petition, filed November 15,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 15,2010 . 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) |
|---|---|---|---|---|
| 7,056,368 | 2006-06-06 | 10/484,468 | 2004-01-22 | 766.40790X00 |

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

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 | /Ronald J. Shore/ | Date (YYYY-MM-DD) | 2010-11-15 |
| Name | Ronald J. Shore | Registration Number | 28577 |

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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ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

MAILED
MAR 28 2011
OFFICE OF PETITIONS

In re Application of

Sowden, et al.

Application No. 10/484,485

Filed: July 15, 2004

Attorney Docket No.

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed February 15, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to file a proper response to the final Office action mailed July 21, 2010. The final Office action set a shortened statutory period for reply of three months from its mailing date. A proper response was not received within the allowable period, and the application became abandoned on October 21, 2010. A Notice of Abandonment was mailed December 20, 2010.

The Request for Continued Examination filed February 15, 2011, is noted.

The application file is being forwarded to Technology Center 1600, GAU 1614 for further processing.

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

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MORRISTOWN, NJ 07962-2245

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| | | |
|---|---|---|
| In re Application of | : | |
| Mark Flannery | : | |
| Application No. 10/484,556 | : | ON PETITION |
| Filed: January 21, 2004 | : | |
| Attorney Docket No. H0002831 | : | |

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the Issue fee and Publication Fee in a timely manner in reply to the Notice of Allowance mailed April 2, 2010, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on July 2, 2010.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the Issue fee and Publication Fee which was previously paid on July 6, 2010; (2) the petition fee; (3) the required statement of unintentional delay have been received. Accordingly, the issue fee is accepted as having been unintentionally delayed.

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

This matter is being referred to the Office of Data Management for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

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BORSON LAW GROUP, PC
1078 CAROL LANE, #200
LAFAYETTE CA 94549

MAILED
SEP 20 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Aldwell et al. | : | |
| Application No.: 10/484688 | : | DECISION |
| Filing or 371(c) Date: 06/30/2004 | : | ON PETITION |
| Patent No.: 7758869 | : | |
| Issue Date: 07/20/2010 | : | |
| Attorney Docket Number: ISOL-01000US0 | : | |

This is a decision on the "Petition Under 37 C.F.R. 1.183," filed August 26, 2011, to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction. The petition is properly treated as a petition under 37 CFR 3.81(b)[1].

The Petition is **granted**.

The petition was accompanied by a certificate of correction as required by 3.81(b), and the fee submitted with the present petition. Further, Office assignment records reflect that OTAGO INNOVATION LIMITED, ANIMAL HEALTH BOARD, and AGRESEARCH LIMITED, are the assignees of record. As the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to be processed.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a certificate of correction after issuance of this application into a patent.

/DLW/

Derek L. Woods
Attorney
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No**.:20110630-A

**DATE** : June 28, 2011

**TO SPE OF** : ART UNIT 1643

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,317,089

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:**

C of C mailroom date: 5-27-11

/MISOOK YU/
Supervisory Patent Examiner.Art Unit 1643

# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/484,945 | 08/09/2004 | Lee L. Rubin | CURGEN-0111 | 3392 |

23599 7590 07/29/2011
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

| EXAMINER |
|---|
| SZNAIDMAN, MARCOS L |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1628 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 07/29/2011 | 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):

docketing@mwzb.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

| | | |
|---|---|---|
| In re Application of: Lee L. Rubin | : | |
| Serial No: 10/484945 | : | DECISION |
| Filed: August 9, 2004 | : | ON |
| Attorney Docket No: CURGEN-0111 | : | PETITION |
| Title: MEDIATORS OF HEDGEHOG SIGNALING PATHWAYS, COMPOSITIONS AND USES RELATED THERETO | : | |

This letter is in response to the Petition under 37 C.F.R. 1.181 filed on October 29, 2010.

**BACKGROUND**

This application was filed under 35 U.S.C. 371 and as such is subject to PCT unity of invention practice.

Applicant filed a claim set on August 9, 2004 and RCE was filed on November 4, 2009.

On December 4, 2009, examiner issued a new restriction requirement on the amended pending claims 1-14, 16, 38-39 and 57-60. Examiner required applicant to elect an invention which corresponds to each one of the specifically claimed core compounds embraced by formula II, and further required an election of species within the elected group. Applicant is advised to include an identification of elected invention. On February 12, 2010, applicant elected the invention wherein G is fused benzene ring and A is NH, all claims read on the elected invention. On April 19, 2010, examiner withdrew the restriction mailed on December 4, 2009, and issued another new restriction. Applicant is required to elect an invention which corresponds to each one of the specifically claimed core compounds embraced by formula II. The election of R2, R3, X, Y, Z, J and A are no longer required for the CORE structure. Examiner identified two structures which are considered to be the CORE structures. On May 21, 2010 an election was filed with traverse. Applicant elected compounds wherein G is a benzene ring and R1 is benzene ring. On July 29, 2010, an Office action was issued and the restriction requirement was made

Final. On October 29, the present petition was filed requesting withdraw the restriction requirement.

**DISCUSSION**

Prosecution history and petition have been carefully reviewed. Instant application is a 371 application and lack of Unity practice should be followed.

PCT 13.2 states:

The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art

In the 2nd restriction dated April 21, 2010, examiner required an election of invention, NOT species but didn't set forth any groups. The examiner provided two structures embraced by the generic Claim 1. The examiner stated that those two structures are structurally different. The examiner failed to provide other reason and evidence to support that the special technical feature is not a contribution over the prior art.

On May 21, 2010 applicant made election with traverse. Applicant argued that the restriction violated proper procedure for examination of Markush claims as set forth in MPEP, especially 803.02. Instant application is a 371, so arguments under MPEP 803.02, which is directed to US restriction practice, are irrelevant.

MPEP 1850, III (B) Markush Practice States:

When the Markush grouping is for alternatives of chemical compounds, they should be regarded as being of a similar nature where the following criteria are fulfilled:

(A) All alternatives have a common property or activity; and

(B)(1) A common structure is present, i.e., a significant structure element is shared by all of the alternatives; or

(B)(2) In cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

On July 2, 2010, a non-final action was mailed. Examiner reiterated the reasons in the restriction requirement and maintained the restriction. No further explanation provided as to why the Markush grouping as claimed lacks unity of invention as described in MPEP 1850, III (B). The examiner indicated that the elected species is free of prior art, the examination was expanded and a 103 rejection was made. Sircar et al (US 6,303,645) has been reviewed for unity of invention purpose only. Sircar specifically requires that an amide (-N-C(=O)-) substituent

bounded to the fused benzene ring of the benzimidazole group. Instant compounds wherein the benzimidazol group is either not substituted on the fused benzene ring or has substituents which are distinct from amide or acylamino group. Thus, the prior art does not break the unity of invention.

The examiner failed to properly set forth the inventions/claims in the 2nd restriction and failed to provide evidence and/or to articulate the reasons why claims lack unity of invention.

The petition is GRANTED for the reasons set forth above.

It is noted in the response filed October 29, 2010, applicant amended the claims to further limit definitions of A, G and $R^1$ for the compounds of formula II, G is limited to phenyl or pyridyl. Applicants urge that no restriction should be made within the currently amended Claim 1. Applicants also express their willingness to discuss an intermediate scope. The examiner is advised to call attorney to discuss any amendment to put the claims under condition for allowance if no prior is found and the concern of the scope is the only remaining issue.

This application is being forwarded to examiner for further examination on the claims filed on October 29, 2010.

Should there be any questions about this decision, please contact Supervisory Patent Examiner Cecilia Tsang, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-0562 or by facsimile sent to the general Office facsimile number, 571-273-8300.

George C. Elliott

George Elliott
Director, Technology Center 1600

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MAR 25 2011

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Mark B Wilson
Fullbright & Jaworski
600 Congress Avenue
Suite 2400
Austin TX 78701

| | | |
|---|---|---|
| In re Patent of Kronenberg | : | DECISION ON REQUEST |
| Patent No. 7,842,463 | : | FOR RECONSIDERATION OF |
| Issue Date: November 30, 2010 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/485,039 | : | and |
| Filed: January 26, 2004 | : | NOTICE OF INTENT TO ISSUE |
| Docket No. SONN:047US | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on January 31, 2011, under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand eight hundred ninety-five (1895) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand eight hundred ninety-five (1895) days is **granted.**

The sole issue pertains to the three years to issue guarantee of 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) (hereinafter, "B delay"). The Office concurs with patentees' assertion that the maximum B delay period begins on January 27, 2007, which is one day after three years after the commencement date of this application on January 26, 2004, and ends on November 30, 2010, when the patent issued.

As stated in 35 U.S.C. 154(b)(1)(B)(ii), B delay does not include "any time consumed by appellate review by the Board of Patent Appeals and Interferences." The period of B delay does not include the 596 day period beginning on June 29, 2007, the date the Notice of Appeal was filed, and ending on February 13, 2009, the date the Board of Patent Appeals and Interferences issued a decision affirming the examiner in part. Excluding the

596 days consumed by appellate review and the 19 day overlapping period between the A Delay period and the B Delay period (November 9, 2009 to November 27, 2009) results in a period of B delay of 789 days (1404-596-19).

Although the 596 days consumed by appellate review is not part of the period of B delay, the 596 days does constitute delay under 35 U.S.C. 154(b)(1)(C) ("C delay"). In other words, the successful appellate period of 596 days is counted against the Office as a separate adjustment pursuant to 37 CFR 1.702(e) as C delay.

In light thereof, the correct patent term adjustment is 1895 days, which is the sum of 562 days of delay under 35 U.S.C. 154(b)(1)(A) and 789 days of B Delay and 596 days of C Delay, reduced by 52 days for Applicant delay.

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

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted **by one thousand eight hundred ninety-five (1895)** days.

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,842,463 B2

DATED : **November 30, 2010** **DRAFT**

INVENTOR(S) : Kronenberg

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 1730 days

Delete the phrase "by 1730 days" and insert – by 1895 days--

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

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**OFFICE OF PETITIONS**

In re Patent No. 8,030,348
Issue Date: October 4, 2011
Application No. 10/485,094
Filed: July 13, 2004
Attorney Docket No. NEPN-001/01US
(313663-2001)

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

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)", filed December 5, 2011. Patentee requests that the determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from 871 to 920 days.

The petition is **GRANTED** to the extent indicated herein.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of nine hundred twenty **(920)** days.

On October 4, 2011 the application matured into U.S. Patent No. 8,030,348 with a revised PTA thereon of 871 days. On December 5, 2011, patentee filed the instant request and disputes the reduction of seventy-two (72) days attributed to patentee for the submission of a paper filed July 25, 2011 after the Notice of Allowance was mailed.

This application is not subject to a terminal disclaimer.

The reduction of seventy-two (72) days pursuant to 37 C.F.R. § 1.704(c)(10) is at issue.

The reduction of 72 days has been found to be incorrect. A review of the application file supports a conclusion that the reduction should be from the filing of the Amendment

under 37 CFR § 1.312 on July 25, 2011 to the mailing of the response on August 17, 2011, not the issue date of the Patent on October 4, 2011. The period of delay pursuant to 37 C.F.R. § 1.704(c)(10) is therefore 23 days.

In view thereof, the patent term adjustment indicated in the patent should have been nine hundred twenty **(920)** days.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **nine hundred twenty (920) days**.

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 8,030,348 B2

DATED : October 4, 2011

INVENTOR(S) : Fotini Sampalis

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (871) days

Delete the phrase "by 871 days" and insert – by 920 days--

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/485,179 | 11/05/2004 | Aladar A. Szalay | 33316.04803.US01/4803US | 4794 |

13565 7590 08/03/2011
McKenna Long & Aldridge LLP
4435 Eastgate Mall
Suite 400
San Diego, CA 92121

| EXAMINER |
|---|
| SINGH, ANOOP KUMAR |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1632 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/03/2011 | 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.

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McKenna Long & Aldridge LLP
4435 Eastgate Mall
Suite 400
San Diego CA 92121

In re Application of:
Szalay et al.
Serial No.: 10/485,179
Filed: November 5, 2004
Attorney Docket No:
**33316.04803.US01/4803US**

: PETITION DECISION

This is in response to the petition filed on July 21, 2011 under 3 7 CFR 1.181 to correct the misclassification of submitted Information Disclosure Statements. Specifically, applicants request correction of the classification in PAIR of the Information Disclosure Statements submitted on December 19, 2008; October 9, 2009; and April 21, 2011 in connection with the above-referenced application and consideration by the Examiner of the documents and information contained therein.

Applicants argue the "Information Disclosure Statements were submitted in connection with the above-captioned application on December 19, 2008; October 9, 2009; and April 21, 2011. Each Information Disclosure Statement was prepared in accordance with 37 C.F.R 1.97 and 1.98. As required under 37 C.F.R 1.98, each Information Disclosure Statement contained 1) a list of all patents, publications, applications, or other information submitted for consideration by the Office, including a column that provides a space next to each document to be considered, for the examiner's initials and a heading that clearly indicates that the list is an Information Disclosure Statement; and 2) legible copies of all items listed. The items either were in English or a translation was provided. A copy of the misclassified Information Disclosure Statements filed on December 19, 2008; October 9, 2009; and April 21, 2011 is attached.

The submitted Information Disclosure Statement included a tabular Form PTO-1449, which was classified as an "IDS," and a written disclosure of information. In each instance, the written disclosure of information was misclassified in PAIR as a " Transmittal Letter" December 19, 2008, 16 pages; October 9, 2009, "Transmittal Letter" of 1 page and October 9, 2009, "Transmittal Letter" of 2 pages; and April 21,2011, "Transmittal Letter" of 2 pages). Consequently, the information contained therein may not be considered or reviewed by the Examiner."

Applicants' argument has been accorded careful consideration and is persuasive. PAIR will be corrected to reflect the misclassification of the submitted Information Disclosure Statements of December 19, 2008; October 9, 2009; and April 21, 2011.

**DECISION**

The petition is **GRANTED.**

The examiner is instructed to consider the IDS of December 19, 2008; October 9, 2009; and April 21, 2011 which was misclassified in PAIR as a " Transmittal Letter" (December 19, 2008, 16 pages; October 9, 2009, "Transmittal Letter" of 1 page and October 9, 2009, "Transmittal Letter" of 2 pages; and April 21,2011, "Transmittal Letter" of 2 pages).

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.

/MC Seidel/
Marianne C. Seidel, Quality Assurance Specialist
Technology Center 1600

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RatnerPrestia
One Westlakes Berwyn Suite 301
PO Box 980
Valley Forge PA 19482-0980

| | | |
|---|---|---|
| In re Patent No. 7,044,122 | : | |
| Issue Date: May 16, 2006 | : | |
| Application No. 10/485,184 | : | DECISION ON PETITION |
| Filed: January 28, 2004 | : | |
| Attorney Docket No. DEB-743US | : | |

This is a decision on the Request Correction Under 37 C.F.R. 3.81(b), filed on July 29, 2010, requesting correction on the Title Page of the subject patent to identify the correct assignee's name. The Request is being treated as a Petition Under 37 CFR §3.81(b). A completed Certificate of Correction Form (PTO/SB/44) was submitted with petition.

The petition under 37 CFR §3.81(b) is **GRANTED**.

Petitioner requests that the present Petition was submitted to correct the assignee's name on the previously submitted PTOL-85B and such error was a clerical error. Accordingly, petitioner requests that a Certificate of Correction (PTO/SB/44) be issued to correct assignee's name to the Title Page of the Letters Patent.

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

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

The requisite $100.00 fee (Fee Code 1811), as set forth under 37 CFR 1.20(a), and the requisite $130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), have been submitted. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR 3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the Form PTO/SB/44 submitted with petition.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

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

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,044,122.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 12/20/10

**TO SPE OF** : ART UNIT 1715

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10485580 Patent No.: 7836844

**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**
**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.

- [X] **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

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SPE Art Unit

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**251 NORTH AVENUE WEST**
**Suite 201**
**WESTFIELD NJ 07090**

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| | | |
|---|---|---|
| In re Application of | : | |
| Ursula Erhardt et al. | : | |
| Application No. 10/485,602 | : | DECISION ON PETITION |
| Filed: January 24, 2005 | : | |
| Attorney Docket No. SAR/US/0404 | : | |

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

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Restriction Requirement mailed April 11, 2008, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 12, 2008. A Notice of Abandonment was mailed on January 6, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an election and amendment, (2) the petition fee of $1,620, and (3) a proper statement of unintentional delay. Accordingly the election and amendment is accepted as being unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 1797 for appropriate action by the Examiner in the normal course of business on the reply received November 8, 2010.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

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**Suite 201**
**WESTFIELD NJ 07090**

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In Re application of
Ursula Erhardt et al.
Application No. 10/485,602
Filed: January 24, 2005
Attorney Docket No. SAR/US/0404

ON PETITION

This is a decision on the petition under 37 CFR 1.59(b), November 4, 2010 to expunge information from the above identified application.

The petition is **granted**.

Petitioner requests that the Submission of Supplemental ADS and Supplemental ADS, filed November 4, 2010, be expunged from the record.

The information in question has been determined by the undersigned to not be material to the examination of the instant application. The information was clearly intended to be filed in an unrelated application.

The expunged material has been removed from the official file.

In accordance with MPEP 724.05(III), no petition is needed since the papers in question were clearly identified for a different application. Therefore, the petition fee is refunded.

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

Carl Friedman
Petitions Examiner
Office of Petitions

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**HUNTON & WILLIAMS LLP**
**INTELLECTUAL PROPERTY DEPARTMENT**
**1900 K STREET, N.W.**
**SUITE 1200**
**WASHINGTON DC 20006-1109**

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| | | |
|---|---|---|
| In re Application of | : | |
| Pascal MOCK | : | |
| Application No. 10/485,611 | : | DECISION ON PETITION |
| Filed: August 18, 2004 | : | |
| Attorney Docket No. 58766.000048 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 27, 2010, to revive the above-identified application.

The petition is **GRANTED**.

**The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.**

This application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of April 26, 2010. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(II)(A)(2). A two (2) month extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is July 27, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal and fee; (2) the petition fee of $810; and (3) an adequate statement of unintentional delay.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required

by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

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 October 27, 2010, was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's Deposit Account No. 50-0206.

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

This application is being referred to Technology Center AU 3735 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

/DCG/
Diane C. Goodwyn
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 04-25-11

TO SPE OF : ART UNIT 1624

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/485636 Patent No.: 7125879

CofC mailroom date: 04-18-11

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.

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

**Comments:** _____

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600
SPE

1624
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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YOUNG & THOMPSON
209 Madison Street
Suite 500
Alexandria VA 22314

MAILED

AUG 30 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| **FRANCOIS JEROME ET AL.** | : | |
| Application No. 10/485,935 | : | DECISION ON PETITION |
| Filed: July 25, 2005 | : | |
| Attorney Docket No. **0512-1416** | : | |

This is a decision on the petition, filed March 4, 2009, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

The application was held abandoned for failure to reply in a timely manner to the Restriction Requirement, mailed June 18, 2008, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. A notice of Abandonment was mailed January 5, 2009.

Petitioner asserts that the Office action dated June 18, 2008, was not received.

A review of the written record indicates an irregularity in the mailing of the Office action of June 18, 2008. In this regard, the Office received a Power of Attorney on June 17, 2008, prior to the mailing of the Office action of June 18, 2008. However, the Power of Attorney was not accepted until June 24, 2008. Therefore, the Office records were not updated to reflect this new change of address. Accordingly, as the Office action was mailed to an incorrect address, the Notice of Abandonment mailed January 5, 2009, is hereby vacated and the holding of abandonment withdrawn.

Telephone inquires concerning this decision should be directed to JoAnne Burke at 571-272-4584.

This application is being referred to the technical support staff of Technology Center Art Unit 1624 for remailing the Office action of June 18, 2008, and resetting the period for reply.

Ramesh Krishnamurthy

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

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CAHN & SAMUELS LLP
1100 17th STREET NW
SUITE 401
WASHINGTON DC 20036

MAILED
OCT 22 2010
OFFICE OF PETITIONS

In re Application of
Michael G. Chez
Application No. 10/486,077
Filed: February 10, 2005
Attorney Docket No.: **229.0005**

ON PETITION

This is a decision on the petition filed September 23, 2010 under 37 CFR 1.137(b)[1], to revive the above-identified application.

The petition is **GRANTED**.

A Restriction Requirement mailed April 1, 2009 set the longer of one month or thirty days as the period for reply. No response to the April 1, 2009 Restriction Requirement having been timely filed, the application became abandoned May 5, 2009. Accordingly, a Notice of Abandonment was mailed on October 8, 2009.

The petition fee in the amount of $810.00 has been charged to the credit card provided.

The response to the Restriction Requirement filed September 23, 2010 will be referred to Technology Center 3747 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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[1]Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

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**Jordan & Hamburg**
**122 East 42nd Street**
**New York NY 10168**

**MAILED**

SEP 08 2010

**OFFICE OF PETITIONS**

In re Patent No. 7,291,423 :
Issue Date: November 6, 2007 :
Application No. 10/486,126 : ON PETITION
Filed: February 6, 2004 :
Attorney Docket No. F-8134 :

This is a decision on the petitions under 37 CFR 1.182, filed August 11, 2010, (a) requesting issuance of a duplicate Letters Patent and (b) for expedited consideration thereof for the above-identified patent.

The petitions under 37 CFR 1.182 are **GRANTED**.

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

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

Any questions concerning this matter may be directed to the undersigned at (571) 272-4584. Any questions concerning issuance of the duplicate Letters Patent should be directed to Niomi Farmer at (703)756-1556.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Niomi Farmer, P/ODM, Randolph Square Building, 9th Floor, 09/D30-B
FAX No. (571) 270-9753

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UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/486,278 | 06/23/2004 | Ellis L. Reinherz | 00530-100US1 | 7855 |

26161 7590 03/13/2012
FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

| EXAMINER |
|---|
| DEJONG, ERIC S |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1631 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 03/13/2012 | 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):

PATDOCTC@fr.com

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

| | | |
|---|---|---|
| In re Application of | : | |
| Ellis L. Reinherz, et al | : | NOTICE OF WITHDRAWAL |
| Serial No. 10/486278 | : | FROM ISSUE |
| Filed: June 23, 2004 | : | UNDER 37 CFR 1.313(b) |
| For: COMPUTER-BASED METHODS OF | : | |
| DESIGNING MOLECULES | : | |

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

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

PTO records reveal that the issue fee has not been paid. If the issue fee has been submitted, the applicant may request a refund or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Issue Fee Due, applicant may request that the previously submitted issue fee be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due. If the application is abandoned, applicant may request either a refund or a credit to a deposit account.

The application is being forwarded to the examiner for action.

Wanda L. Walker

Wanda L. Walker, Director
Technology Center 1600

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ARENT FOX LLP
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

**MAILED**

NOV 23 2010

**OFFICE OF PETITIONS**

In re Patent No. 7,215,358 :
Issue Date: May 8, 2007 :
Application No. 10/486,359 : NOTICE
Filed: February 27, 2004 :
Attorney Docket No. 101190-00038

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**.

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.

Inquiries related to this communication should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: James N. Baker
Kratz, Quintos & Hanson, LLP
GBU of Pittsburgh Bldg. Suite 308
4232 Brownville Road
Pittsburgh, PA 15227-3330

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ARLINGTON VA 22203

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APR 26 2011
OFFICE OF PETITIONS

In re Application of :
Mauro Ajani et al. :
Application No. 10/486,386 :
Filed: September 16, 2004 :
Attorney Docket No. 622-60 :

ON PETITION

This is a decision on the petitions under (a) the unintentional provisions of 37 CFR 1.137(b), filed April 20, 2011, to revive the above-identified application and (b) for expedited consideration under 37 CFR 1.182, filed April 21, 2011, thereof for the above-identified application .

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

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed February 27, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 28, 2010.

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

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a divisional application under 37 CFR 1.53(b); (2) the petition fee of $1,640; and (3) a proper statement of unintentional delay.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

Petitioner has stated in the in the instant petition that "[t]hrough inadvertent oversight, a one month extension fee was unintentionally not paid in the parent application." However, an extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. *See* In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $130 extension of time fee submitted with the petition on April 20, 2011, was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

This application is being revived solely for purposes of continuity. As continuity has been established by this decision, the application is again abandoned in favor of divisional application No. 12/653,712.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

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ARLINGTON VA 22203

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SEP 06 2011

**OFFICE OF PETITIONS**

In re Application of :
Mauro Ajani et al. :
Application No. 10/486,386 :
Filed: September 16, 2004 :
Attorney Docket No. 622-60 :

ON PETITION

This is a corrected decision on the petitions under (a) the unintentional provisions of 37 CFR 1.137(b), filed April 20, 2011, to revive the above-identified application and (b) for expedited consideration under 37 CFR 1.182, filed April 21, 2011, thereof for the above-identified application .

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

The application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed February 27, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 28, 2010.

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

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a divisional application under 37 CFR 1.53(b); (2) the petition fee of $1,640; and (3) a proper statement of unintentional delay.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

Petitioner has stated in the in the instant petition that "[t]hrough inadvertent oversight, a one month extension fee was unintentionally not paid in the parent application." However, an extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. *See* In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $130 extension of time fee submitted with the petition on April 20, 2011, was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

This application is being revived solely for purposes of continuity. As continuity has been established by this decision, the application is again abandoned in favor of divisional application No. **12/457,870**.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

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PATENTIQUE PLLC
PO Box 5803
Bellevue, WA 98006

Mail Date: 08/04/2010

| | | |
|---|---|---|
| **Applicant** | : Joseph D. Mosca | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7662608 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/486,415 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 02/06/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **676** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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**MARTINE PENILLA & GENCARELLA, LLP**
**710 LAKEWAY DRIVE**
**SUITE 200**
**SUNNYVALE CA 94085**

MAILED
SEP 13 2010
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| | | |
|---|---|---|
| In re Application of | : | |
| Yoshihiro Nakami et al | : | |
| Application No. 10/486,470 | : | DECISION GRANTING PETITION |
| Filed: February 9, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. MIPFP079 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed September 10, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on August 2, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 2622 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

/Karen Creasy/
Karen Creasy
Petitions Examiner
Office of Petitions

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

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FISH & RICHARDSON P.C. (BO)
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

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JUL 15 2011
OFFICE OF PETITIONS

In re Patent No. 7,781,210
Issued: August 24, 2010
Application No. 10/486,484
Filed: July 30, 2004
Attorney Docket No. 14875-0127US1 / C1-X0103P-US

:DECISION ON APPLICATION
:FOR PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)" filed October 22, 2010. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from 1108 to 1226 days.

The request for review of the patent term adjustment is **DISMISSED.**

Patentees are given **THIRTY (30) DAYS or ONE (1) MONTH, whichever is longer,** from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

On August 24, 2010, the above-identified application matured into U.S. Patent No. 7,781,210 with a revised patent term adjustment of 1108 days. On October 22, 2010, patentees timely submitted this application for patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 1226 days.

Applicants argue that "as outlined in Wyeth v. Kappos, 93 U.S.P.Q. 2d 1257 (Fed. Cir. Jan. 7, 2010, affirming Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008)), the period of "B delay" begins on the day after the date that is three years from the filing of the application and concludes upon the issuance of the patent" and further that "the period beginning on April 14, 2007 (the day after the date that is three years after the date on which the national phase commenced), and ending August 24, 2010 (the date the patent was issued), is 1229 days in length".

Applicants are advised that in this instance, the national stage commencement date is February 13, 2007 (not April 13, 2007, the date used by patentees for this calculation). The priority date of this application is August 13, 2001. As a request under 35 U.S.C. 371(f) for early processing was not expressly made, the completion date occurred at the 30-month commencement date. Thus the "B delay" began on February 14, 2007 and ended on August 24, 2010, the date the patent was issued, for a period of 1288 days.

Applicants argue however that "In each of these Notice of Appeal periods, the Examiner withdrew the finality of the rejections without filing an Examiner's answer. The case never proceeded to the jurisdiction of the Board, the Board never reviewed the case (nor could it before an Examiner's answer), and no decision was ever issued by the Board - either in favor of the Applicant or in favor of the Office. Clearly, no appellate review by the Board of Patent Appeals and Interferences occurred after the filing of either Notice of Appeal. As such, no reduction of"B Delay" is provided for by 35 U.S.C. § 154(b)(1)(B) in these instances."

Applicant's argument has been considered but is not persuasive. Applicants are advised that the period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii).

An appeal to the Board of Patent Appeals and Interferences commences with the filing of a notice of appeal. See 35 U.S.C. 134(a). Generally, an appeal to the Board of Patent Appeals and Interferences ends with either 1) a Board decision, 2) the examiner reopening prosecution and issuing another Office action, or 3) the applicant filing a request to withdraw the appeal and reopen prosecution (e.g. the filing of a request for continued examination). In this instance, The "B delay" however was consumed by two periods of appellate review, beginning on December 12, 2007 and ending on January 3, 2008, the date the non-Final Office Action was mailed and beginning on March 30, 2009 and ending September 1, 2009, the date the non-Final Office Action was mailed. The Office has also determined that the period of overlap is 33 days. Thus the "B delay" is 1288 days for over 3 year delay minus 177 days consumed by appellate review.

It is noted that the Office issued a Notice of proposed rulemaking entitled *Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review and Information Disclosure Statements*, 76 FR 18990 (April 6, 2011). To the extent that the final rule on *Revision of Patent Term Extension and Adjustment Provisions Relating to Appellate Review* revises the interpretation of appellate review applied in this decision, Patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the date of the final rule to file a request for reconsideration. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

As such, the patent term adjustment is 1108 (309 "A delay days" + 1111 "B delay days" (1288-177) - 33 overlap days minus 279 Applicant delay days) as previously indicated, not 1226 days.

In view thereof, the patent term adjustment indicated in the patent is properly reflected.

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

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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**FINNEGAN, HENDERSON, FARABOW,**
**GARRETT & DUNNER LLP**
**901 NEW YORK AVENUE, NW**
**WASHINGTON DC 20001-4413**

**MAILED**
**DEC 06 2010**
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,811,569 | : | |
| Issue Date: October 12, 2010 | : | |
| Application No. 10/486,703 | : | ON PETITION |
| Filed: August 23, 2004 | : | |
| Attorney Docket No. 06266.0004 | : | |

This is a decision on the petition filed November 3, 2010, 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 Diane Goodwyn at (571) 272-6735. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

/Thurman K. Page/
Thurman K. Page
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

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ANNE KINSMAN
WORLD EXCHANGE PLAZA
100 QUEEN STREET SUITE 1100
OTTAWA ON K1P 1J9 CA CANADA

**MAILED**

APR 26 2011

**OFFICE OF PETITIONS**

In re Patent No. 7,164,897 :
Issued: January 16, 2007 :
Application No. 10/486,830 : ON PETITION
Filed: August 2, 2004 :
Attorney Docket No: PAT 3272W-2 US :

This is a decision regarding your request for acceptance of a fee deficiency submission and loss of small entity status filed March 21, 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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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Paper No.

MAILED
SEP 20 2010
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BOZICEVIC, FIELD & FRANCIS LLP
1900 UNIVERSITY AVENUE
SUITE 200
EAST PALO ALTO CA 94303

| | | |
|---|---|---|
| In re Patent No. 7,718,376 | : | DECISION ON REQUEST |
| Simmons | : | FOR |
| Issue Date: May 18, 2010 | : | RECONSIDERATION OF |
| Application No. 10/486,845 | : | PATENT TERM ADJUSTMENT |
| Filed: July 19, 2004 | : | and |
| Atty Docket No. DVC-011 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition pursuant to 37 C.F.R. § 1.705(d), filed on July 19, 2010,[1] requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by nine hundred and three (903) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by seven hundred and fifty-eight (758) days is **GRANTED to the extent indicated herein**.

Patentee has indicated that this patent is not subject to a terminal disclaimer.[2]

This patent issued on May 18, 2010, with a patent term adjustment of 756 days.

The Office has determined that the patent term adjustment for the above-identified patent is **758 days**.

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[1] It is noted that July 18, 2010 fell on a Sunday.
[2] Petition, page 2.

The Office agrees with Petitioner that the period of B-delay totals 676 days. However, a notice of appeal was filed on July 31, 2008, and a Request for Continued Examination (RCE) was filed on December 23, 2008. The 145 days of the over three year period consumed by appellate review, beginning on July 31, 2008 and ending on December 22, 2008, the day before the RCE was filed, is not included in the B delay. See 35 U.S.C. § 154(b)(1)(B)(ii).

As such, the patent term adjustment is increased by 758 (486 days of examination delay plus 676 "B-delay" minus the aforementioned excluded 145 days minus 259 days of Applicant delay minus zero overlap) days, not 903 days.

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

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

This patent is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **seven hundred and fifty-eight (758) days**.

Telephone inquiries specific to this matter should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,718,376 B2

DATED : **May 18, 2010** **DRAFT**

INVENTOR(S) : Simmons

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 756 days

Delete the phrase "by 756 days" and insert – by 758 days--

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UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/487,203 | 06/02/2004 | Jari Natunen | 0933-0237PUS1 | 4484 |

2292 7590 09/20/2010
BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

| EXAMINER |
|---|
| AEDER, SEAN E |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1642 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 09/20/2010 | 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):

mailroom@bskb.com

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PO BOX 747
FALLS CHURCH VA 22040-0747

| | |
|---|---|
| In re Application of: | : |
| Natunen et al. | : |
| Serial No.: 10/487,203 | : SUSPENSION OF ACTION |
| Filed: June 2, 2004 | : |
| Attorney Docket No.: **0933-0237PUS1** | : |

This is in reply to the petition under 37 CFR 1.103(a) to suspend action in this application at applicants' request for a six month period of time, filed August 30, 2010.

BACKGROUND

Applicants request prosecution in this application be suspended for six months so that applicants can conduct studies required by the examiner.

DISCUSSION

**§ 1.103 Suspension of action by the Office.**

(a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
(1) A showing of good and sufficient cause for suspension of action; and
(2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office.

Applicants have replied to the last Office action by filing an appropriate response. Applicants have shown good and sufficient reason for suspension.

DECISION

In view of the above, the petition for suspension of action is **GRANTED** for a period of six months from the date of mailing of this decision.

**Should applicant obtain the requisite data prior to the expiration of the period of suspension, a submission of the results should be promptly forwarded to the Office so that prosecution may be resumed.**

Should there be any questions with respect to this action, please contact the examiner or Marianne Seidel, by mail addressed to: Director, Technology Center 1600, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at Office general facsimile number, 571-273-8300.

Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600

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

**DAVID P. DICKINSON**
**PO BOX 38 407**
**HOWICK AUCKLAND NZ NEW ZEALAND**

**MAILED**

AUG 30 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| **David Peter DICKINSON** | : | |
| Application No. 10/487,542 | : | DECISION ON PETITION |
| Filed: February 24, 2004 | : | UNDER 37 CFR 1.181 |
| Attorney Docket No. | : | |

This is a decision on the petition, filed December 7, 2009, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision should be filed within two (2) months from the mail date of this decision. *Note* 37 CFR 1.181(f). The request for reconsideration should include a cover letter and be entitled as a "Renewed Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment."

This application was held abandoned for failure to reply to the notice of non-compliant amendment mailed March 25, 2009, which set a one (1) month shortened statutory period for reply. A Notice of Abandonment was mailed on November 9, 2009.

Petitioner asserts that the Office action dated March 25, 2009 was not received.

A review of the written record indicates no irregularity in the mailing of the Office action, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

1. a statement from practitioner stating that the Office action was not received by the practitioner;

2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and

3. a copy of the docket record where the nonreceived Office action would have been entered had it been received must be attached to and referenced in the practitioner's statement.

*See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The petition fails to satisfy items (2) and (3) of the above-stated requirements.

Accordingly, absent the required evidence to establish non-receipt of the Office action of March 25, 2009, the petition requesting withdrawal of the holding of abandonment cannot be granted at this time.

If petitioner cannot supply the evidence necessary to withdraw the holding of abandonment, or simply does not wish to, petitioner should consider filing a petition under 37 CFR 1.137(b) stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the $1620 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

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

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

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

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

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253.

Thurman K. Page
Petitions Examiner
Office of Petitions

Cc: DAVID P. DICKINSON
HORWICK, AUCKLAND, NEW ZEALAND

**ATTACHMENT**: PTO/SB/122 Change of Correspondence Address

UNITED STATES PATENT AND TRADEMARK OFFICE

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**DAVID P. DICKINSON**
**P.O. BOX 38, 407**
**HOWICK AUCKLAND 2145NZ NEW ZEALAND**

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MAR 3 1 2011

OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| **David P. DICKINSON** | : | |
| Application No. 10/487,542 | : | DECISION ON PETITION |
| Filed: February 24, 2004 | : | UNDER 37 CFR 1.181 |
| Attorney Docket No. | : | |

This is a decision on the renewed petition, filed October 26, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to reply to the Notice of Non-Compliant Amendment mailed March 25, 2009, which set a three (3) month shortened statutory period for reply. A Notice of Abandonment was mailed on November 9, 2009.

Petitioner asserts that the Office action dated March 25, 2009 was not received.

A review of the written record indicates no irregularity in the mailing of the Office action, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

1. a statement from practitioner stating that the Office action was not received by the practitioner;

2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and

3. a copy of the docket record where the nonreceived Office action would have been entered had it been received and docketed must be attached to and referenced in the practitioner's statement.

*See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The petition satisfies the above-stated requirements. Accordingly, the application was not abandoned in fact.

In view of the above, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

This application is being referred to the Technology Center technical support staff of Art Unit 3633 for re-mailing the Office action of March 25, 2009. The period for reply will run from the mailing date of the Office action.

Thurman K. Page
Petitions Examiner
Office of Petitions

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Alexandria, VA 22313-1450
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**SUNSTEIN KANN MURPHY & TIMBERS LLP**
**125 SUMMER STREET**
**BOSTON MA 02110-1618**

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SEP 07 2010

OFFICE OF PETITIONS

In re Application of :
Christos C. Zouboulis :
Application No. 10/487,618 : DECISION ON PETITION
Filed: September 8, 2004 :
Attorney Docket No. 2757B/103 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 7, 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 final Office action mailed, December 5, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on March 6, 2009. A Notice of Abandonment was mailed July 7, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal and fee of $270.00; (2) the petition fee of $810.00; and (3) a proper statement of unintentional delay.

**The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.**

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office. Further, it is not apparent whether the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute this application. In accordance

with 37 CFR 1.34(a), the signature of 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. 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.

This matter is being referred to Technology Center AU 1635 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

Joan Olszewski

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Rosemary M. Miano
Mayer & Williams, PC
251 North Avenue West, 2nd Floor
Westfield, NJ 07090

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C/O ALSTON & BIRD LLP
BANK OF AMERICA PLAZA,
101 SOUTH TRYON STREET
SUITE 4000
CHARLOTTE NC 28280-4000

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FEB 14 2011
OFFICE OF PETITIONS

In re Application of :
Spooner :
Application No. 10/487,643 : DECISION
Filed/Deposited: 11 August, 2003 :
Attorney Docket No. CC-1-gw :

This is a decision on the papers filed on 22 March, 2010, considered as a petition pursuant to 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

**NOTE:**

The papers considered as the instant petition were received into the Office of Petitions for determination only at this writing.

The record is silent as to any action (e.g., Status Inquiry) by Petitioner since the filing of the papers considered as the instant petition, save that it appears that a revocation/power of attorney has been submitted and accepted.

Petitioner (former Counsel) appears to have ignored the clear language of the:

- guidance in the Commentary at MPEP §711.03(c )(I) as to the proper showing requirements for relief pursuant to 37 C.F.R. §1.181; and
- Rules of Practice (the regulations at 37 C.F.R. §1.2).

The petition pursuant to 37 C.F.R. §1.181 is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted.

The reconsideration request should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. §1.181."

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

As to the Request to Withdraw
the Holding of Abandonment

*Petitioner is directed to the Commentary at MPEP §711.03(c )(I) for guidance as to the proper showing requirements for relief pursuant to 37 C.F.R. §1.181.*

Petitioner appears not to comply with the guidance in the Commentary at MPEP §711.03(c )(I)—as discussed below, Petitioner has failed to satisfy the showing requirements set forth there. Petitioner may find it beneficial to review that material and move step-wise through that guidance in the effort to satisfy the showing requirements (statements and supporting documentation).

## BACKGROUND

The record reflects as follows:

Petitioner/former Counsel failed to reply timely and properly to the non-final Office action mailed on 14 November, 2008, with reply due absent extension of time on or before 14 February, 2009.

The application went abandoned by operation of law after midnight 14 February, 2009.

The Office mailed the Notice of Abandonment on 2 March, 2010.

On 22 March, 2010, Petitioner/former Counsel Mark D. Simpson (Reg. No. 32,942) filed the instant petition pursuant to 37 C.F.R. §1.181, and averred, *inter alia*, that he ignored the Rules of Practice—to wit: the regulations at 37 C.F.R. §1.2—and sought inappropriately and improperly to obtain from the Examiner a verbal commitment to:

- instruct Petitioner/former Counsel ignore the non-final Office action of 14 November, 2008; and
- further, agree to mail new Office action to replace the non-final Office action of 14 November, 2008.

Further, Petitioner/former Counsel:

- averred transmission of an Email by which to confirm the previously sought action by the Examiner; and
- evidenced that he obtained from his staff (a Ms. Lynn M. White) a confirmation of the foregoing.

Other than Petitioner/former Counsel's long-after-the-fact averments/submissions on petition, the record is silent as to any such events, discussions, commitments.

Thereafter, the record is silent as to any action (e.g. Status Inquiry) following the 22 March, 2010, submission, save for revocation/power of attorney filed on 2 April, 2010.

Thus, Petitioner/former Counsel failed to make the showing as discussed below in the citation from the Manual of Patent Examining Procedure (MPEP).

New Counsel may file a proper reply, and with it a petition to revive the application (with fee, reply and statement) pursuant to 37 C.F.R. §1.137(b)—and is cautioned to ensure that new Counsel has satisfied himself/herself/themselves as to the unintentional nature of the delay herein.

With regard to Petitioner's request to withdraw the holding of abandonment pursuant to 37 C.F.R. §1.181, the guidance in the Commentary at MPEP §711.03(c )(I) provides in pertinent part as to non-receipt:

***

> The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.
>
> Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.
>
> A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all

> replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.[1]

***

With regard to Petitioner's request to withdraw the holding of abandonment pursuant to 37 C.F.R. §1.181, the guidance in the Commentary at MPEP §711.03(c )(I) provides in pertinent part as to timely filing:

***

> 37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 C.F.R. §1.10(c), (d), (e), or (g) (see MPEP §513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.
>
> Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP §503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.
>
> Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. 1.8(b) and MPEP §512. As stated in 37 C.F.R. §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the

[1] *See*: MPEP §711.03(c ) (I)(A).

correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).

37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. §1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP §512. [2]

***

A Petitioner unable to comply with and/or otherwise satisfy these requirements may wish to revive the application: Petitioner may wish to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b). (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c )

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (*see*: 37 C.F.R. §1.181(f)), and 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.[3]

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.

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[2] *See*: MPEP §711.03(c ) (I)(B).

[3] 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).

## STATUTES, REGULATIONS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994). And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a Petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application.[4],[5]

Moreover, the Office has set forth in the Commentary at MPEP §711.03(c )(I) the showing and timeliness requirements for a proper showing for relief under 37 C.F.R. §1.181 in these matters.

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.[6]

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[4] See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

[5] The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. (Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.) Delays in responding properly raise the question whether delays are unavoidable. Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) And the Petitioner must be diligent in attending to the matter. Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care. (By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.))

[6] 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).

Allegations as to the Request to
Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how it is to be made and supported.

Petitioner appears not to have made the showing required.

## CONCLUSION

Accordingly, the petition pursuant to 37 C.F.R. §1.181 is **dismissed**.

## ALTERNATIVE VENUE

Should Petitioner wish to revive the application, Petitioner may wish to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay pursuant to 37 C.F.R. §1.137(b). (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c )

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply, the petition fee, a terminal disclaimer and fee where appropriate and a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional." (The statement is in the form available online.)

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

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[7]) 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

[7] 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
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Alexandria, VA 22313-1450
www.uspto.gov

**LICATA & TYRRELL P.C.**
**66 E. MAIN STREET**
**MARLTON NJ 08053**

MAILED
OCT 08 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Zaret et al. | : | |
| Application No. 10/487,878 | : | DECISION ON PETITION |
| Filed: September 20, 2004 | : | |
| Attorney Docket No. FCC-0006 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 11, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a proper and timely manner to the final Office action mailed, June 27, 2007, which set a shortened statutory period for reply of three (3) months. A one-month extension of time under the provisions of 37 CFR 1.136(a) was timely obtained. Accordingly, the application became abandoned on October 28, 2010. A Notice of Abandonment was mailed February 7, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $405.00 and the submission required by 37 CFR 1.114 (previously submitted September 27, 2007); (2) the petition fee of $770.00; and (3) a proper statement of unintentional delay.

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

This matter is being referred to Technology Center AU 1651 for processing of the Request for Continued Examination under 37 CFR 1.114 and the Amendment filed September 27, 2007.

Joan Olszewski

Joan Olszewski
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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JAN 28 2011

OFFICE OF PETITIONS

**LICATA & TYRRELL P.C.**
**66 E. MAIN STREET**
**MARLTON NJ 08053**

In re Application of
Kenneth S. Zaret et al
Application No. 10/487,878
Filed: February 25, 2004
Attorney Docket No. FCC-0006

DECISION ON REQUEST FOR REFUND

This is a decision on the Request For Refund filed January 19, 2011.

The request is **DISMISSED**.

Applicant files the above request for refund and states that "On February 11, 2008, a Petition For Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b) (Small Entity), Request for Continued Examination (RCE) and 3 months Extension of Time was filed on application 10/487,878 (copy attached). Our MasterCard ending in 2328 was charged $1,640.00 (one thousand six hundred and forty dollars) for $770.00 Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137 (b) (Small Entity) and $405.00 for the Request for Continued Examination (RCE) and $465.00 Extension of Time Fee.

Again, to our Deposit Account Statement dated October, 2010 (copy attached) we were charged on October 8, 2010 Fee Code 2453 Petition to Revive for $770.00 and October 8, 2010 Fee Code 2801 for $405.00, was erroneously charged in this patent application to Deposit Account No. 50-1619. We are therefore, respectfully requesting a credit of this $1,175.00 be made to Deposit Account No. 50-1619." However, Office finance records for the above application only show the payment of $405.00 with accounting date of October 8, 2010, mailroom date of February 11, 2008 and the petition fee of $770.00 with accounting date of October 8, 2010, mailroom date of February 11, 2008. There is no record of a duplicate payment in the above application.

In view of the above, the request for refund is dismissed for the above application.

Applicant may wish to file a request for refund in Application No. 09/869,741, as applicant had inadvertently filed the papers in application no. 09/869,741 instead of 10/487,878 (the cover sheet indicated the incorrect application number). Applicant later notified the Office of such and the application papers were placed in the correct application (10/487,878). However, Office finance records indicate that the fees in question were paid in application no. 09/869,741.

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
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ORGANON USA, INC.
c/o MERCK
2000 Galloping Hill Road
Mail Stop: K-6-1, 1990
Kenilworth NJ 07033

MAILED
MAR 09 2011
OFFICE OF PETITIONS

In re Patent No. 7,435,817 :
Issued: October 14, 2008 :
Application No. 10/487,884 : PATENT TERM ADJUSTMENT
Filing or 371(c) Date: September 24, 2004 :
Dkt. No.: 2001.666US :

This is a decision on the petition filed October 29, 2009 in response to the decision on petition mailed September 28, 2009. This matter is being properly treated pursuant to 37 CFR 1.181. Patentees herein assert that the patent is entitled to an overall patent term adjustment of 519 days.

The petition is hereby **DISMISSED**.

The above-identified application matured into U.S. Pat. No. 7,435,817 on October 14, 2008. The patent issued with 306 days of patent term adjustment. A request under 37 CFR 1.705(d) was timely filed December 15, 2008. A decision in response thereto was mailed September 28, 2009 indicating that the correct patent term adjustment at the time of allowance was 435 days. Patentees herein assert that the patent is entitled to an overall patent term adjustment of 519 days (84 days pursuant to 37 CFR 1.703(a)(1) + 122 days pursuant to 37 CFR 1.703(a)(2) + 50 days pursuant to 37 CFR 1.703(a)(6) + 599 days pursuant to 37 CFR 1.703(b) – 172 overlapping days – 164 days of applicant delay pursuant to 37 CFR 1.704).

The patent is entitled to an overall patent term adjustment of 435 days, as set forth on the Certificate of Correction mailed November 3, 2009.

Patentees' calculations are correct but for the calculation of adjustment pursuant to 37 CFR 1.703(a)(1). The instant application is not entitled to adjustment pursuant to 37 CFR 1.703(a)(1) because the first Office action on the merits was mailed less than 14 months from the date that the instant application fulfilled the requirements of 35 USC 371.

The application did not meet the requirement of 35 USC 371(f). Thus, the period of adjustment pursuant to 37 CFR 1.703(a)(1) commenced November 25, 2005, the day after the date that is fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. 371, and ended June 28, 2005, the date that the first Office action on the merits was mailed. See, 37 CFR 1.702(a)(1), 1.703(a)(2), and MPEP 1893.03(b). The fact that the non-final Office action was later re-mailed on February 16, 2006 does not negate the fact that an Office action was properly mailed within the meaning of 37 CFR 1.702(a)(1) and 1.703(a)(1) on June 28, 2005. Furthermore, the non-final Office action was not vacated from the record by the Group Director

of Technology Center 1600. Accordingly, for the purpose of determining adjustment pursuant to 37 CFR 1.702(a)(1), the first Office action on the merits is deemed to be the non-final Office action mailed June 28, 2005.

In view thereof, at the time of issuance, the patent was entitled to an overall adjustment of 435 days (122 days pursuant to 37 CFR 1.703(a)(2) + 53 days pursuant to 37 CFR 1.703(a)(6) + 599 days pursuant to 37 CFR 1.703(b) – 175 overlapping days pursuant to 37 CFR 1.703(f) – 164 days of applicant delay pursuant to 37 CFR 1.704).

In view thereof, no adjustment to the patent term will be made.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Telephone inquiries specific to this matter 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

Peter G. Carroll
Medlen & Carroll. LLP
101 Howard St.
suite 350
San Francisco CA 64105

MAILED

SEP 27 2010

OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,635,798 | : |
| Weglarz et al. | : DECISION ON REQUEST FOR |
| Issue Date: December 22, 2009 | : RECONSIDERATION OF |
| Application No. 10/487,901 | : PATENT TERM ADJUSTMENT |
| Filed: October 1, 2004 | : AND NOTICE OF INTENT |
| Attorney Docket No. DOW-08552 | : TO ISSUE CERTIFICATE OF |
| Title: NUCLEIC ACID | : CORRECTION |
| COMPOSITIONS CONFERRING ALTERED | : |
| METABOLIC CHARACTERISTICS | : |

This is a decision on the petition filed on May 17, 2010, which is being treated as a petition under 37 CFR 1.181 requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted. The petition was filed within one month of a decision by the Office mailed on April 21, 2010 granting applicants' request for reconsideration of PTA.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by **six hundred fifty-one (651)** days is **GRANTED.**

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by six hundred fifty-one (651) days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney, Charlema Grant at (571) 272-3215.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,635,798 B2

DATED : December 22, 2009 **DRAFT**

INVENTOR(S) : Weglarz et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 0 days

Delete the phrase "by 0 days" and insert – by 651 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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LEOPOLD PRESSER
SCULLY SCOTT MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530

**MAILED**

OCT 05 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,774,997 | : | |
| Issue Date: August 17, 2010 | : | |
| Application No. 10/488,122 | : | ON PETITION |
| Filed: February 27, 2004 | : | |
| Attorney Docket No.: 17380 | : | |

This is a decision on the petition filed August 23, 2010, 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 petition is not signed by a registered patent attorney or agent of record. However, in accordance with 37 CFR 1.34, the signature of Edward W. Grolz appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|---|---|---|---|
| **Applicant(s):** | Wolfgang Graf, et al. | **Examiner:** | Ryan D. Kwiecinski |
| **Serial No:** | 10/488,122 | **Art Unit:** | 3635 |
| **Filed:** | February 27, 2004 | **Docket:** | 17380 |
| **Patent No.** | 7,774,997 | **Granted:** | August 17, 2010 |
| **For:** | SYSTEM COMPRISING A GLAZING ELEMENT AND A GAS SUPPLY DEVICE | **Dated:** | August 23, 2010 |

**Confirmation No.:** 6545

Commissioner for Patents
Alexandria, VA 22313-1450

Attention: Office of Petitions

## PETITION UNDER 37 C.F.R. 1.183 (b) AND REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 C.F.R. § 1.323

Sir:

Applicants petition for the issuance of a Certificate of Correction for the above patent. A Certificate of Correction is enclosed.

Applicants inadvertently did not provide the complete Assignee information on the Issue Fee Transmittal.

Adjustment date: 10/06/2010 LDIEP1
08/24/2010 INTLFEW 00000002 191013 10488122
01 FC:1464 130.00 CR
02 FC:1811 100.00 CR

10/06/2010 LDIEP1 00000002 191013 7774997
01 FC:1828 130.00 DA
02 FC:1811 100.00 DA

The assignee is:

FRAUNHOFER GESELLSCHAFT ZUR FORDERUNG DER
ANGEWANDTEN FORSCHUNG E.V.
HANSASTRASSE 27C
MUNCHEN 80686
GERMANY

The Assignment was recorded on September 30, 2005, under Reel: 017046, Frame 0826.

The petition fee under 37 C.F.R. §1.117 (h) of $130.00 should be charged to deposit account 19-1013 SSMP. The Certificate of Correction Fee of $100.00 should also be charged to deposit account 19-1013 SSMP.

Issuance of a Certificate of Correction showing the above assignees is respectfully requested.

Respectfully submitted,

/Edward W. Grolz/

Edward W. Grolz
Registration No.: 33,705

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

EWG/bb

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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Paper No.

PATENT DEPARTMENT
TAYLOR, PORTER,
BROOKS & PHILLIPS, L.L.P
P.O. BOX 2471
BATON ROUGE LA 70821-2471

MAILED
AUG 26 2011
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| | | |
|---|---|---|
| In re Application of | : | |
| Woltering et al. | : | |
| Application No. 10/488,176 | : | LETTER REGARDING |
| Filed: August 16, 2004 | : | FEE DEFICIENCY PAYMENT |
| Attorney Docket No. | : | |
| WOLTERING 00M35-US | : | |

This is in response to CORRECTION OF FEES FILED AS SMALL ENTITY ERRONEOUSLY PAID IN GOOD FAITH UNDER 37 C.F.R. §1.28(c), INCLUDING DEFICIENCY PAYMENT filed August 8, 2011, which is properly treated as a notification of loss of entitlement to small entity status.

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 statement is signed by an attorney of record. The statement includes an itemization and payment of $2010 for the deficiency in payment of fees.

Your notification of a loss of entitlement to small entity status and fee deficiency submission under 37 CFR 1.28 is now **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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BACON & THOMAS, PLLC
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA, VA 22314-1176

MAILED
MAY 17 2011
OFFICE OF PETITIONS

In re Application of
Udo Grittke, et al.
Application No. 10/488,258
Filed: September 28, 2004
Attorney Docket No. GRIT3001/FJD

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 27, 2011, to revive the above-identified application.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. In accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts. However, if petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. All future correspondence regarding this application file will be directed solely to the address of record until otherwise instructed.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must so notify the Office.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed March 10, 2009, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were

terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on May 11, 2009. See MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an appeal brief (and fee as required by 37 CFR 41.20(b)(2), (2) the petition fee of $1620; and (3) an adequate statement of unintentional delay.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

In view of the above, the petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2434 for appropriate action by the Examiner in the normal course of business on the reply received April 27, 2011.

April M. Wise
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Stevens Davis
Miller & Mosher
Suite 850
1615 L Street NW
Washington DC 20036

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FEB 09 2011
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In re Patent No. 7,463,577 :
Issue Date: December 9, 2008 :
Application No. 10/488,610 : DECISION ON PETITION
Filed: March 4, 2004 :
Attorney Docket No. L9289.04119 :

This is a decision on the Request For Certificate Of Correction Pursuant To 35 USC 255, filed October 20, 2010, requesting correction on the Title Page of the subject patent to accept the omission of the second assignee's name and residence. The Request is being treated as a Petition Under 37 CFR §3.81(b). A completed Certificate of Correction Form (PTO/SB/44) was submitted with Petition.

The petition under 37 CFR §3.81(b) is **GRANTED**.

Petitioner requests that the present Petition was submitted to accept the omission of the second assignee's name and residence on the previously submitted PTOL 85B and such error was consequential. Accordingly, petitioner requests that a Certificate of Correction (PTO/SB/44) be issued to add the omitted second assignee's name and residence to the Title Page of the Letters Patent.

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

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

The requisite $100.00 fee (Fee Code 1811), as set forth under 37 CFR 1.20(a), has been submitted. However, the $130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), was accompanied deposit account authorization to charge any required fees. As such, the fee has been charged as authorized. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR §3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the Form (PTO/SB/44) submitted with the petition.

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.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

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

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,463,577.

Cheryl Gibson-Baylor

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

cc: Dickinson Wright PLLC
International Square
1875 Eye Street, N.W., Suite 1200
Washington, DC 20006

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. |
|---|---|---|---|---|
| 10/488,780 | 03/05/2004 | Ulrich Gartner | 740124-182 | 8387 |

25570 7590 02/18/2011
ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
Intellectual Property Department
P.O. Box 10064
MCLEAN, VA 22102-8064

| EXAMINER |
|---|
| KOSANOVIC, HELENA |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3749 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 02/18/2011 | 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):

lgallaugher@rmsclaw.com
dbeltran@rmsclaw.com
docketing@rmsclaw.com

UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

| APPLICATION NO./ CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR / PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 10488780 | 3/5/04 | GARTNER ET AL. | 740124-182 |

| EXAMINER |
|---|
| Helana Kosanovic |

| ART UNIT | PAPER |
|---|---|
| 3749 | 20110217 |

DATE MAILED:

ROBERTS MLOTKOWSKI SAFRAN & COLE, P.C.
Intellectual Property Department
P.O. Box 10064
MCLEAN, VA 22102-8064

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

**Commissioner for Patents**

Pursuant to the petition filed on Feb. 17, 2011, the requested relief is granted. The Offcie action mailed on Jan. 21, 2011 is hereby withdrawn. The requested 2 months of suspension of action as stated in the RCE filed on December 23, 2010 is also granted.

/Henry Yuen/
Ouality Assurance Specialist, TC 3700

2/17/2011

| Doc Code: PET.AUTO<br>Document Description: Petition automatically granted by EFS-Web | PTO/SB/140<br>U.S. Patent and Trademark Office<br>Department of Commerce |
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| Electronic Petition Request | **PETITION TO WITHDRAW AN APPLICATION FROM ISSUE AFTER PAYMENT OF THE ISSUE FEE UNDER 37 CFR 1.313(c)** |
| Application Number | 10488801 |
| Filing Date | 16-Dec-2004 |
| First Named Inventor | Michael McClurken |
| Art Unit | 3739 |
| Examiner Name | MICHAEL PEFFLEY |
| Attorney Docket Number | 2999.004000A |
| Title | FLUID-ASSISTED MEDICAL DEVICES, SYSTEMS AND METHODS |

An application may be withdrawn from issue for further action upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary.

APPLICANT HEREBY PETITIONS TO WITHDRAW THIS APPLICATION FROM ISSUE UNDER 37 CFR 1.313(c).

A grantable petition requires the following items:
(1) Petition fee; and
(2) One of the following reasons:
(a) Unpatentability of one or more claims, which must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;
(b) Consideration of a request for continued examination in compliance with § 1.114 (for a utility or plant application only); or
(c) Express abandonment of the application. Such express abandonment may be in favor of a continuing application, but not a CPA under 37 CFR 1.53(d).

Petition Fee

☐ Applicant claims SMALL ENTITY status. See 37 CFR 1.27.

☐ Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

☒ Applicant(s) status remains as SMALL ENTITY.

☐ Applicant(s) status remains as other than SMALL ENTITY

Reason for withdrawal from issue

○ One or more claims are unpatentable

◉ Consideration of a request for continued examination (RCE) (List of Required Documents and Fees)

○ Applicant hereby expressly abandons the instant application (any attorney/agent signing for this reason must have power of attorney pursuant to 37 CFR 1.32(b)).

RCE request,submission, and fee.

☐ I certify, in accordance with 37 CFR 1.4(d)(4) that : The RCE request ,submission, and fee have already been filed in the above-identified application on

☒ Are attached.

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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 who has been given power of attorney in this application.

○ An attorney or agent registered to practice before the Patent and Trademark Office, acting in a representative capacity.

○ A sole inventor

○ A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors

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

○ The assignee of record of the entire interest that has properly made itself of record pursuant to 37 CFR 3.71

| | |
|---|---|
| Signature | /Anbar Khal/ |
| Name | Anbar F. Khal |
| Registration Number | 59088 |

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

Decision Date : May 26,2011

In re Application of :

Michael McClurken

DECISION ON PETITION

UNDER CFR 1.313(c)(2)

Application No : 10488801

Filed : 16-Dec-2004

Attorney Docket No : 2999.004000A

This is an electronic decision on the petition under 37 CFR 1.313(c)(2), filed May 26,2011 , to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

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

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

This application file is being referred to Technology Center AU 3739 for processing of the request for continuing examination under 37 CFR 1.114 .

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

JUL 15 2011

PCT LEGAL ADMINISTRATION

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

| | |
|---|---|
| In re Application of | : DECISION ON |
| McClurken et al | : |
| Application No.: 10/488,801 | : PETITION UNDER |
| PCT No.: PCT/US02/28488 | : |
| Filing Date: 5 September 2002 | : 37 CFR 1.78(a)(3) |
| Priority Date: 5 September 2001 | : |
| Attorney's Docket No.: 2999.004000A | : and (a)(6) |
| For: Fluid-Assisted Medical... And Methods | : |

This is in response to applicants' communication "PETITION TO ACCEPT ON UNINTENTIONALLY DELAYED CLAIM UNDER 37 CFR 1.78(a)(3)," filed 07 March 2011, which is being treated as a petition under 37 CFR 1.78(a)(3) and (a)(6) to accept an unintentionally delayed claim under 35 U.S.C. §§120 and 119(e) for the benefit of the prior-filed applications set forth in the supplemental amendment filed on 16 June 2010.

The petition is **DISMISSED**.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3) and 1.78(a)(6).

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

1) the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;

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

(3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional where there is a question whether the delay was unintentional.

The petition complies with items (2) and (3) but not item (1) under 37 CFR 1.78(a)(3) and 1.78(a)(6).

(1) With regard to item (1), the amendment improperly incorporates by reference the prior-filed application with respect to 10/354,643 as this applications was incorporated after the international filing date of 5 September 2002 of aforementioned application. An incorporation by reference statement added after an application's filing date is not effective because no new matter can be added to an application after its filing date (*see* 35 U.S.C. § 132(a)). If an incorporation by reference statement is included in an amendment to the specification to add a benefit claim under 35 U.S.C. § 120 after the filing date of the application, the amendment would not be proper. When a benefit claim under 35 U.S.C. § 120 is submitted after the filing of an application, the reference to the prior application cannot include an incorporation by reference statement of the prior application. *See* Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980). *Note* MPEP §§ 201.06(c) and 608.04(b).

(2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and

(3) Regarding requirement (3), the statement that "[t]he entire delay between the date the claim was due under 37 CFR §1.78(a)(2)(ii) and the date that claim was filed was unintentional" is being construed as a statement that "[t]he entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct.

Any inquiries concerning this decision may directed to Rafael Bacares at (571) 272-3276. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center Art Unit 3739.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Boris Milef
Legal Examiner
Office of PCT Legal Administration

UNITED STATES PATENT and TRADEMARK OFFICE

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

MAILED
AUG 23 2011
PCT LEGAL ADMINISTRATION

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| McClurken et al | : | |
| Application No.: 10/488,801 | : | PETITION UNDER |
| PCT No.: PCT/US02/28488 | : | |
| Filing Date: 5 September 2002 | : | 37 CFR 1.78(a)(3) |
| Priority Date: 5 September 2001 | : | |
| Attorney's Docket No.: 2999.004000A | : | and (a)(6) |
| For: Fluid-Assisted Medical... And Methods | : | |

This is in response to the "RENEWED PETITION TO ACCEPT ON UNINTENTIONALLY DELAYED CLAIM UNDER 37 CFR 1.78(a)(3) and 1.78(a)(6)," filed on 03 August 2011.

The renewed petition is **GRANTED**.

The present nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3) and 1.78(a)(6).

A petition for acceptance of a claim for late priority under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) must be accompanied by:

**(1)** the reference required by 35 U.S.C. §§ 120 and 119(e) and 37 CFR §§ 1.78(a)(2)(i) and 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
**(2)** the surcharge set forth in § 1.17(t); and
**(3)** a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed on 24 May 2009 and the claim for benefit herein is submitted after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii) and 1.78(a)(5)(ii) . *See* 35 U.S.C. §§120, 365(c) and 119(e).

Regarding item (1), a proper reference to the prior-filed applications has been included in an amendment to the first sentence of the specification following the title.

Regarding item (2), the proper surcharge fee has been provided.

Regarding item (3), the proper statement has been provided.

Accordingly, having found that the petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §§ 120 and 119(e) to the prior-filed applications satisfies the conditions of 37 CFR §§ 1.78(a)(3) and 1.78(a)(6), the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR §§ 1.78(a)(3) and 1.78(a)(6) should not be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §§120 and 365(c) and 1.78(a)(1) and (a)(2) and under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.***

A corrected Filing Receipt, which includes the priority claim to the prior-filed applications, accompanies this decision on petition.

Any questions concerning this matter may be directed to Rafael Bacares at (571) 272-3276. All other inquires concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application will be forwarded to Technology Center Art Unit 3739 for consideration by the examiner of applicants' entitlement to claim benefit to the prior-filed applications.

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

Boris Milef
Legal Examiner
PCT Legal Administrative Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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Walter A Hackler
Patent Law Office
Suite B
2372 SE Bristol Street
Newport Beach CA 92660-0755

MAILED
JAN 30 2012
OFFICE OF PETITIONS

In re Application of :
Ralph Noninger et al. :
Application No. 10/488,809 :
Filed: August 13, 2004 :
Attorney Docket No. **3168** :

NOTICE

This is a notice regarding your request filed October 21, 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**.

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

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P.O. Box 1450
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TUROCY & WATSON, LLP
127 PUBLIC SQUARE
57TH FLOOR, KEY TOWER
CLEVELAND, OH 44114

**MAILED**
**FEB 15 2011**
**OFFICE OF PETITIONS**

In re Application of :
Rudy Susilo :
Application No. 10/488,904 : ON PETITION
Filed: August 10, 2004 :
Attorney Docket No. ARTHP104US :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 13, 2011, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed January 12, 2009, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on March 13, 2009. See MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $1801, and the submission required by 37 CFR 1.114; (2) the petition fee of $810; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-1642. All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 1615 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

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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MAILED
JUL 28 2011
OFFICE OF PETITIONS

**TUROCY & WATSON, LLP**
**127 PUBLIC SQUARE**
**57TH FLOOR, KEY TOWER**
**CLEVELAND OH 44114**

| | | |
|---|---|---|
| In re Application of | : | |
| SUSILO | : | |
| Application No. 10/488,915 | : | DECISION ON PETITION |
| Filed: August 18, 2004 | : | |
| Docket No. ARTHP105US | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 7, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, December 2, 2010, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on March 3, 2011. A Notice of Abandonment was mailed June 13, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1620; and (3) and the required statement of unintentional delay.

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

This application is being referred to Technology Center AU 2611 for appropriate action by the Examiner in the normal course of business.

/Diane C. Goodwyn/
Diane C. Goodwyn
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
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Lucas & Mercanti, LLP
475 Park Avenue South
New York, NY 10016

MAILED
SEP 20 2010
OFFICE OF PETITIONS

In re Application of :
Gerhard Wurm, et. al. :
Application No. 10/489,003 : ON PETITION
Filed: March 5, 2004 :
Attorney Docket No. HM-556PCT :

This is a decision on the petition under 37 CFR 1.137(b), filed July 30, 2010, to revive the above-identified application.

The application became abandoned for failure to file a proper reply to the final Office action mailed on September 22, 2009. A Notice of Abandonment was mailed June 10, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) along with the $810 fee and the submission under 37 CFR 1.114; (2) the petition fee of $1,620; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 3656 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

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

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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FEB 28 2011

OFFICE OF PETITIONS

SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street, NE
Atlanta GA 30309-3996

| | | |
|---|---|---|
| In re Patent No.7,858,967 | : | |
| Pfeiffer, et al. | : | DECISION FOR REQUEST |
| Issue Date: December 28, 2010 | : | FOR RECONSIDERATION |
| Application No. 10/489,131 | : | OF PATENT TERM |
| Filed: October 12, 2004 | : | ADJUSTMENT |
| Attorney Docket No. **17346-0089** | : | |

This is a decision on the "Request for Reconsideration of Patent Term Adjustment", filed January 25, 2011, which is properly treated under 37 CFR 1.705(d). Patentees requests recalculation of the patent term adjustment and assert that it should less than is currently accorded.

The request for reconsideration of the patent term adjustment under 37 CFR 1.705(d) is **DISMISSED**.

Patentee's are given TWO (2) MONTHS from the mail date of this decision to respond. No extension of time will be granted under 37 CFR 1.136.

Patentee asserts that the period of "B" delay, or over three year delay, is properly calculated using the date of October 12, 2004, which is the date the of completion of all 35 U.S.C. 371 requirements.

Patentees' argument has been considered and is not persuasive. It is noted that commencement occurs at thirty months from the priority date claimed in the international application and may only occur earlier if the requirements of 35 U.S.C. 371(f) are met. If the application has not met the requirements of 35 U.S.C. 371(f), the "B" delay period is calculated using the date of commencement of the national stage under 35 U.S.C. 371(b). In this particular instance, the fact that the application did not complete the requirement under 35 U.S.C. 371 until October 12, 2004, has no bearing on the determination of the "B" delay. As in this instance, where there requirements of 35 U.S.C. 371(f) are not met, the date of completion of October 12, 2004, is only relevant to the calculation of the "A" delay period. The national stage of commenced on August 20, 2004—which is the date that is thirty months from the priority date of February 20, 2002. See 35 U.S.C. 371(b). The "B" delay period is 44 days. In an international application, this period is based on the failure of the Office to issue a patent within three years after the national stage commenced under 35 U.S.C. 371(b) or (f). See 1.702(b). As the requirements for early commencement were not met, the national stage commenced in this application on August 20, 2004. Thus, "B" delay is 44 days, counting the number of days beginning on August 21, 2007,

and ending on the day before the date the Request for Continued Examination was filed October 3, 2007. See 1.703(b).

In view thereof, no change will be made to the patent term adjustment of 239 days.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Deposit account 19-5029 will be charged $200.00 for the fee set forth in 37 CFR 1.18(e). No additional fees are required.

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

By Mail: Mail Stop Petition
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
ATTN: Office of Petitions

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

Telephone inquiries specific to this matter 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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Alexandria, VA 22313-1450
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**DIEHL SERVILLA LLC**
**33 WOOD AVE SOUTH**
**SECOND FLOOR, SUITE 210**
**ISELIN, NJ 08830**

**MAILED**

OCT 20 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Yu et al. | : | DECISION ON PETITION |
| Application No. 10/489,157 | : | TO WITHDRAW |
| Filed: October 12, 2004 | : | FROM RECORD |
| Attorney Docket No. ANS0026-00US | : | |

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 30, 2010, which is being treated as a request to withdraw from employment in a proceeding before the Office under 37 C.F.R. § 10.40.

The request is **DISMISSED**.

A review of the file record indicates that Diehl Servilla LLC does not have power of attorney in this patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is not applicable.

The request to change the correspondence address of record is not accepted in view of Diehl Servilla LLC not having power of attorney. See MPEP §§ 601.03 and 405.

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

Currently, a Board of Patent Appeals and Interferences Docketing Notice was mailed May 7, 2010.

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

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: MOSER IP LAW GROUP/ANSELL LIMITED
1030 BROAD STREET, SUITE 203
SHREWSBURY NJ 07702

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No.

FOLEY & LARDNER LLP
150 EAST GILMAN STREET
P.O. BOX 1497
MADISON WI 53701-1497

MAILED
MAY 3 1 2011
OFFICE OF PETITIONS

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|---|---|
| In re Application of<br>Kuhl et al.<br>Application No. 10/489,269<br>Filed: September 29, 2004<br>Attorney Docket No. 088245-0981<br>Title: METHOD OF TRANSMITTING TIME-CRITICAL SCHEDULING INFORMATION BETWEEN SINGLE NETWORK DEVICES IN A WIRELESS NETWORK USING SLOTTED POINT-TO-POINT LINKS | DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT FOR PATENT APPLICATION UNDER 37 C.F.R. §1.705(b)," filed May 18, 2011. Applicant requests that the patent term adjustment indicated on the initial determination of patent term adjustment be corrected from eight hundred and two (802) days to one thousand four hundred and twenty-seven (1,427) days.

The application for patent term adjustment is **DISMISSED**.

On February 24, 2011, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 802 days. The instant application for patent term adjustment was timely filed[1] on or before payment of

[1] PALM records indicate that the issue fee was received on May 18, 2011.

the issue fee. Applicant disputes the initial determination of patent term adjustment on the basis that 1) the Office should have awarded 811 days instead of 805 days under § 1.702(a)(1), and 2) the Office failed to include 625 days of additional PTA accumulated for the Office taking in excess of three years to issue the patent after the application commencement date.

With respect to the 805-day adjustment pursuant to 37 CFR 1.702(a)(1), applicant is incorrect. The correct adjustment is 805 days not 811 days. 37 CFR 1.702(a)(1) states that the term of an original patent shall be adjusted by the failure of the Office to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application fulfilled the requirements of 35 U.S.C. 371 in an international application.

It is undisputed that this application fulfilled the requirements of 35 U.S.C. 371 in an international application on September 29, 2004. A non-final Office action was mailed 14 months and 805 days later on February 12, 2008, resulting in 805 days of examination delay. Applicant's calculation is wrong inasmuch as they use the incorrect date of February 18, 2008 as the mailing date of the first Office action. Consequently, applicant miscalculates this delay as 811 days, instead of correctly as 805 days.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance remains 802 days.

With respect to the calculation pursuant to 37 CFR 1.702(b), the request for reconsideration is premature. To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of

issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee .

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

Submission of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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GLAXOSMITHKLINE
GLOBAL PATENTS
FIVE MOORE DR., PO BOX 13398
MAIL STOP: C2111.2F
RESEARCH TRIANGLE PARK NC 27709-3398

| | | |
|---|---|---|
| In re Patent No. 8,063,078 | : | DECISION ON REQUEST |
| Rami, et al. | : | FOR |
| Issue Date: November 22, 2011 | : | RECONSIDERATION OF |
| Application No. 10/489,277 | : | PATENT TERM ADJUSTMENT |
| Filed: August 11, 2007 | : | and |
| Atty Docket No. P32894A | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on January 9, 2012, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand, eight hundred and eighty (1,880) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand, eight hundred and eighty (1,880) days is **GRANTED**.

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

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand, eight hundred and eighty (1,880)** days.

Telephone inquiries specific to this matter should be directed to the undersigned, at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**DRAFT COPY**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 8,063,078 B2

DATED : Aug. 11, 2007

INVENTOR(S) : Rami et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (1362) days

Delete the phrase "by 1362 days" and insert – by 1880 days--

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

| | | |
|---|---|---|
| In re Application of | : | |
| Morioka et al. | : | DECISION ON REQUEST |
| Patent Number: 7,459,020 | : | FOR RECONSIDERATION OF |
| Issue Date: 12/02/2008 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/489316 | : | and |
| Filing or 371(c) Date: 03/18/2004 | : | NOTICE OF INTENT TO ISSUE |
| Attorney Docket Number: 249578US0PCT | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on January 16, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by nine hundred thirty (930) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by nine hundred thirty (930) days is **GRANTED to the extent indicated herein**.

As to the "B" delay, the period is 322 days, not 323 days. Patentee calculated this period based on the date of June 30, 3005, to February 4, 2008, the date that a request for continued examination ("RCE") was filed. Pursuant to a request for immediate examination, and compliance with the relevant requirements, the date of commencement is March 18, 2004. However, as the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on March 19, 2007, and ends on February 3, 2008, and is 322 days. See, 35 U.S.C. 154(b)(1)(B)(i). As such, the patent term adjustment is 929 days.

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

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

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by nine hundred twenty-nine **(929)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods
Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,459,020 B2

DATED : December 2, 2008

INVENTOR(S) : Morioka et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 631 days.

Delete the phrase "by 631 days" and insert – by 929 days--

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Banner & Witcoff, LTD.
Ten South Wacker Drive
Suite 3000
Chicago, IL 60606

| | |
|---|---|
| In re Patent No. 7,481,031 | : |
| Boxall et al. | : DECISION UPON REMAND AND |
| Issue Date: January 27, 2009 | : RECONSIDERATION OF |
| Application No. 10/489,380 | : PATENT TERM ADJUSTMENT |
| Filed: March 12, 2004 | : AND NOTICE OF INTENT |
| Attorney Docket No. | : TO ISSUE CERTIFICATE OF |
| 010770.00030 | : CORRECTION |
| Title: LOAD TRANSFER PLATE FOR | : |
| IN SITU CONCRETE SLABS | |

This is a decision following remand from the District Court for the District of Columbia regarding the patent term adjustment indicated on the above-identified patent. The Court remanded this matter to the U.S. Patent and Trademark Office for recalculation of the patent term adjustment in accordance with the decision in Wyeth & Elan Pharma Int'l Ltd. v. Kappos, 591 F.3d 1364 (Fed. Cir. 2010).

The patent term adjustment indicated on the above-identified patent has been recalculated as directed by the Court. The term of the above-identified patent is extended or adjusted by ONE THOUSAND AND SEVEN (1007) days.

The application is being forwarded to the Certificates Branch for issuance of a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by ONE THOUSAND AND SEVEN (1007) days.

Telephone inquiries specific to this matter should be directed to Senior Legal Advisor, Kery A. Fries at (571) 272-7757.

/Kery A. Fries/

Kery A. Fries
Senior Legal Advisor Attorney
Office of Patent Legal Administration
Office of Associate Commissioner
For Patent Examination Policy

Enclosure: Copy of DRAFT Certificate of Correction
Copy of adjusted PTA calculation

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,481,031

DATED : **March 12, 2004** **DRAFT**

INVENTOR(S) : Boxall et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 352 days

Delete the phrase "by 352 days" and insert – by 1007 days--

Day : Wednesday

PALM INTRANET

Date: 11/3/2010
Time: 09:42:27

| PTA Calculations for Application: 10/489380 | | | |
|---|---|---|---|
| Application Filing Date: | 03/12/2004 | PTO Delay (PTO): | 687 |
| Issue Date of Patent: | 01/27/2009 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 335 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 1007 |
| PTO Delay Adjustment: | 655 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 68 | 11/03/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 655 | | |
| 61.5 | 01/07/2009 | PTA 36 MONTHS | 32 | | |
| 61 | 01/27/2009 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 60 | 12/24/2008 | EXPORT TO FINAL DATA CAPTURE | | | |
| 59 | 12/23/2008 | FINISHED INITIAL DATA CAPTURE | | | |
| 58 | 12/23/2008 | DISPATCH TO FDC | | | |
| 57 | 11/18/2008 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 56 | 11/18/2008 | WORKFLOW - QUERY REQUEST - FINISH | | | |
| 55 | 11/06/2008 | WORKFLOW - DRAWINGS FINISHED | | 83 | |
| 54 | 11/06/2008 | ISSUE FEE PAYMENT VERIFIED | | | |
| 53 | 11/06/2008 | ISSUE FEE PAYMENT RECEIVED | | | |
| 52 | 09/16/2008 | MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT | | | |
| 51 | 09/15/2008 | MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT | | | |
| 49 | 08/19/2008 | PUBS CASE REMAND TO TC | | | |
| 48 | 08/21/2008 | WORKFLOW - QUERY REQUEST - BEGIN | | | |
| 47 | 08/11/2008 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 46 | 08/08/2008 | MAIL NOTICE OF ALLOWANCE | | | |
| 45 | 08/08/2008 | ISSUE REVISION COMPLETED | | | |
| 44 | 08/08/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 43 | 08/06/2008 | DOCUMENT VERIFICATION | | | |
| 42 | 07/23/2008 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | 84 | 28 |
| | | ELECTRONIC INFORMATION DISCLOSURE | | | |

| | | | | | |
|---|---|---|---|---|---|
| 41 | 05/06/2008 | STATEMENT | | | |
| 40 | 07/23/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 39 | 07/09/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 37 | 07/07/2008 | NOTICE OF ALLOWABILITY | | | |
| 36 | 02/15/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 35 | 04/10/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 34 | 05/06/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 33 | 05/06/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 32 | 02/15/2008 | REFERENCE CAPTURE ON IDS | | | |
| 31 | 02/15/2008 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | | |
| 30 | 04/10/2008 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | | |
| 29 | 05/05/2008 | DATE FORWARDED TO EXAMINER | | | |
| 28 | 04/30/2008 | RESPONSE AFTER NON-FINAL ACTION | | 75 | 25 |
| 27 | 04/28/2008 | MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT | | | |
| 26 | 04/26/2008 | DATE FORWARDED TO EXAMINER | | | |
| 25.1 | 02/15/2008 | INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION | | | |
| 25 | 02/15/2008 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 24 | 04/10/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 23 | 02/15/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 22 | 11/15/2007 | MAIL NON-FINAL REJECTION | | | |
| 21 | 11/13/2007 | NON-FINAL REJECTION | | | |
| 20 | 08/28/2007 | DATE FORWARDED TO EXAMINER | | | |
| 19 | 08/27/2007 | RESPONSE AFTER NON-FINAL ACTION | | 93 | 17 |
| 18 | 08/27/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 17 | 02/26/2007 | MAIL NON-FINAL REJECTION | 655 | | -1 |
| 16 | 02/20/2007 | NON-FINAL REJECTION | | | |
| 15 | 03/12/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 14 | 03/07/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |

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|---|---|---|---|---|---|
| 13 | 08/24/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 12 | 09/15/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 11 | 06/13/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 10 | 03/07/2005 | REFERENCE CAPTURE ON IDS | | | |
| 9.7 | 03/07/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 9 | 03/07/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 8 | 07/02/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 7 | 03/12/2004 | REFERENCE CAPTURE ON IDS | | | |
| 6.7 | 03/12/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 6 | 03/12/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 5 | 06/18/2004 | CLEARED BY OIPE CSR | | | |
| 4 | 03/12/2004 | 371 COMPLETION DATE | | | |
| 3 | 06/03/2004 | APPLICATION DISPATCHED FROM OIPE | | | |
| 2 | 06/03/2004 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 1 | 03/12/2004 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to OASIS | Home page

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c/o Compute Patent Annuities North America
225 Reinekers Lane
Suite 400
Alexandria, VA 22314

| | | |
|---|---|---|
| In re Patent No. 6,969,120 | : | |
| Issued: November 29, 2005 | : | |
| Application No.: 10/489,582 | : | ON PETITION |
| Filed: March 12, 2004 | : | |
| Attorney Docket No: **GALG0101PUSA** | : | |

This is a regarding the communication filed December 14, 2009.

The request is acknowledged and dismissed as moot.

A review of the file history reveals that the 3.5-year maintenance was paid on November 30, 2009, at the large entity rate of $1,110.00. On December 2, 2009, a "Notice of Overpayment of Patent Maintenance Fee" was mailed indicating that USPTO records noted the inventive entity as having small entity status and, as such the 3.5-year maintenance fee appeared to be overpaid. The notice indicated that, absent a timely reply to the notice, the USPTO would apply the small entity maintenance fee payment amount to the patent and refund the overpayment amount. Further, the notice stated that patentee need not reply to the notice if the patentee was entitled to small entity status.

On December 14, 2009, patentee filed the instant communication asserting that patentee was entitled to small entity status, but instructed, in error, to pay the large entity rate. Patentee states that the payment of $555.00 should have been charged to the deposit account for the 3.5-year maintenance fee.

A review of Office finance records reveals that the amount of $490.00 was charged to a deposit account for the 3.5-year maintenance fee as was a $65.00 surcharge for payment of the maintenance fee in the later 6 months. There does not appear to be any further remedy that can provided. The request is dismissed as moot, accordingly.

Any further questions regarding the 3.5-year maintenance fee payment should be directed to the Maintenance Fee Department or the Office of Finance.

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

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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**BROWDY AND NEIMARK, PLLC**
**1625 K STREET, N.W.**
**SUITE 1100**
**WASHINGTON DC 20006**

MAILED
JUN 06 2011
OFFICE OF PETITIONS

In re Application of :
Mia Levite :
Application No. 10/489,861 : DECISION ON PETITION
Filed: March 24, 2004 :
Attorney Docket No. LEVITE6 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 9, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the nonfinall Office action mailed August 30, 2010, is accepted as having been unintentionally delayed.

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

This application is being referred to Technology Center AU 1644 for appropriate action by the Examiner in the normal course of business.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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OFFICE OF PETITIONS

YOUNG & THOMPSON
209 Madison Street
Suite 500
Alexandria VA 22314

In re Application of :
Muller et al. :
Application No. 10/489,967 :
Filed: August 17, 2004 :
Attorney Dkt. No. 0508-1099 :
For: PHOSPHORYLATED DERIVATIVES :
OF A U1-70K PEPTIDE AND THEIR :
USE IN THE TREATMENT OF :
AUTOIMMUNE PATHOLOGIES :

ON APPLICATION FOR
PATENT TERM ADJUSTMENT

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)" filed October 6, 2010. Applicants request that the determination of patent term adjustment be corrected from nine hundred eighty-five (985) days to one thousand eight hundred fifty-six (1,856) days. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

The $200.00 petition fee set forth in 37 CFR 1.18(e) has been assessed. No additional fees are required.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the

computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months

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[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

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. Madsen 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. Madsen 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. Madsen, the petitioner herein.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.

Anthony Knight
Director
Office of Petitions

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PCT LEGAL ADMINISTRATION

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK NY 10004

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| VORBACH, Martin | : | |
| Application No.: 10/490,081 | : | |
| PCT No.: PCT/EP02/10572 | : | PETITION UNDER |
| Int. Filing Date: 12 June 2006 | : | |
| Attorney's Docket No.: 87305.1560 | : | |
| For: RECONFIGURABLE ELEMENTS | : | 37 CFR 1.78(a)(3) |

This is in response to applicants' communication "PETITION UNDER 37 CFR 1.78(a)(3) UNINTENTIONALLY DELAYED CLAIMUNDER 35 U.S.C. §120" filed 04 August 2010.

The petition is **DISMISSED.**

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

(1) the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior filed application, unless previously submitted:

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

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

The petition satisfies items (2) and (3) but not item (1).

Regarding requirement (1), applicants' amendment filed on 04 August 2010, which states that, "[t]his is a national stage of International Patent Application No. PCT/EP02/10572, filed September 19, 2002; and is a continuation-in-part of U.S. Patent Application Serial No. 09/494,567..., the contents of all of which are incorporated herein by reference in their entirety" is improper. The subject matter of the later amended references to applications 09/494,567 and 08/946,998 may not be incorporated by reference subsequent to filing the above application.

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

Regarding requirement (2), the surcharge set forth in 37 CFR 1.17(t) has been charged to petitioner's Deposit Account No.: 11-0600.

Regarding requirement (3), the statement that, "[t]he entire delay between the date the priority claim was due under 37 CFR §1,78(a)(2)(ii) and the date the Amendment attached hereto was filed (reciting the priority claim as required by 35 U.S.C. § 120 and 37 CFR § 1.78(a)(2)) was unintentional" is being construed as a statement that "the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) of this section and the date the claim was filed was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct.

## CONCLUSION

For the reason above, the petition under 37 CFR 1.78(a)(3) is **DISMISSED**.

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

Any inquiries concerning this decision may directed to Rafael Bacares at (571) 272-3276. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center Art Unit 2183.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
Legal Examiner
PCT Legal Administrative Office
Telephone: (571) 272-3276
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Bryan Lin
Legal Examiner
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AUG 23 2011

PCT LEGAL ADMINISTRATION

KENYON & KENYON LLP
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NEW YORK NY 10004

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| In re Application of | : | DECISION ON |
| VORBACH, Martin | : | |
| Application No.: 10/490,081 | : | |
| PCT No.: PCT/EP02/10572 | : | PETITION UNDER |
| Int. Filing Date: 12 June 2006 | : | |
| Attorney's Docket No.: 87305.1560 | : | |
| For: RECONFIGURABLE ELEMENTS | : | 37 CFR 1.78(a)(3) |

This is in response to applicant's communication "RENEWED PETITION UNDER 37 CFR 1.78(a)(3)" filed 20 June 2011.

## BACKGROUND

In a decision from this Office on 19 May 2011, the petition under 37 CFR §1.178(a)(3) was dismissed because item (2) was not satisfied.

On 20 June 2011, petitioner filed a renewed petition under 37 CFR 1.78(3) to claim benefit under 35 USC 120 from international application PCT/EP02 /10572. The amendment filed on 20 June 2011 deletes the incorporation by reference.

## DISCUSSION

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

> (1) the reference required by 35 U.S.C. 120 and paragraph (a)(2) of this section to the prior filed application, unless previously submitted:
>
> (2) the surcharge set forth in § 1.17(t); and
>
> (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) of this section and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Regarding requirement (1) a proper reference to the prior-filed applications is included in the amendment filed on 20 June 2011 to the first sentence of the specification following the title as it deletes the incorporation by reference. The amendment complies with 37 CFR 1.78(a)(2)(iii).

Regarding requirement (2), the surcharge has been provided.

Regarding requirement (3), the proper statement has been provided.

Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C.§§120 and 365(c) to the prior-filed international application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

***The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that this application is entitled to the benefit of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether this application is entitled to the benefit of the earlier filing date.***

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.78(a)(3) is **GRANTED**.

Any questions concerning this matter may be directed to Rafael Bacares at (571) 272-3276. All other inquires concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application will be forwarded to Technology Center Art Unit 2183 for appropriate action.

Bryan Lin

Bryan Lin
Legal Examiner
Office of PCT Legal Administration

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EL SEGUNDO CA 90245

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|---|---|---|
| In re Patent No. 7,797,552 | : | |
| Issue Date: September 14, 2010 | : | |
| Application No. 10/490,261 | : | ON PETITION |
| Filed: August 5, 2004 | : | |
| Attorney Docket No. PD-200176A | : | |

This is a decision on the petition, filed April 4, 2011, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of one of the assignees on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Deposit account no. 50-0383 will be charged the required $130.00 processing fee. Petitioner has paid the $100.00 certificate of correction fee.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3230. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

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[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

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**MINNEAPOLIS MN 55440-1022**

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| In re Application of | : | |
| Jim Haseloff et al. | : | |
| Application No. 10/490,285 | : | DECISION ON PETITION |
| Filed: September 24, 2004 | : | |
| Attorney Docket No. 11696-144US1 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 29, 2011, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before June 20, 2011, as required by the Notice of Allowance and Fee(s) Due, mailed March 18, 2011. Accordingly, the date of abandonment of this application is June 21, 2011. A Notice of Abandonment was mailed on July 8, 2011.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $1,510 and the publication fee of $300, (2) the petition fee of $1,620, and (3) a proper statement of unintentional delay. Accordingly, the issue and publication fees are accepted as being unintentionally delayed.

The Notice of Allowability mailed on June 10, 2011, set an extended time period for response of three(3) months from the mailing date of this Office action. The office action does state that "the notice of allowance filed on 3/18/11 is vacated". This is a typographical error, "allowance", instead of "allowability". This action does not extend the time as set in the Notice of Allowance mailed March 18, 2011 to pay the issue and publication fees.

Also, note the first paragraph of the Notice of Allowability mailed June 10, 2011, which mentions that "If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course". The abandonment of this case is proper.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

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

/Kimberly A. Inabinet/

Kimberly A. Inabinet
Petitions Examiner
Office of Petitions

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| In re Application of | : | |
| Jim Haseloff et al. | : | |
| Application No. 10/490,285 | : | DECISION ON PETITION |
| Filed: September 24, 2004 | : | |
| Attorney Docket No. 11696-144US1 | : | |

This is a decision on the petition filed October 10, 2011 under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition under 37 CFR 1.181 is **DISMISSED AS BEING MOOT.**

This application (now Patent No. 8,034,915), became abandoned for failure to timely pay the issue and publication fees on or before June 20, 2011, as required by the Notice of Allowance and Fee(s) Due, mailed March 18, 2011. Petitioner filed a petition to revive an abandoned application under 37 CFR 1.137(b) on July 29, 2011. The petition was granted in a petition decision mailed August 19, 2011.

The instant petition argues that the abandonment was not proper, that the Office should rescind the Notice of Abandonment and refund the 37 CFR 1.137(b) petition fee.

The application was revived and the patent issued on October 11, 2011. As the application was revived from abandoned status as per the petition decision mailed August 19, 2011, there is no purpose to applicants' filing of a petition to withdraw the holding of abandonment under 37 CFR 1.181 as was done here. The application is not in abandoned status and thus any petition to withdraw the holding of abandonment is moot.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at 571-272-4618.

/Carl Friedman/
Carl Friedman
Petitions Examiner
Office of Petitions

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| In re Patent No. 8,034,915 | : DECISION ON APPLICATION FOR |
| Issued: October 11, 2011 | : PATENT TERM ADJUSTMENT and |
| Application No. 10/490,285 | : NOTICE OF INTENT TO ISSUE |
| Filing or 371(c) Date: September 24, 2004 | : CERTIFICATE OF CORRECTION |
| Dkt. No.: 11696-144US1 | : |

This is a decision on the application for patent term adjustment under 37 CFR 1.705(d) filed on December 12, 2011 requesting a decrease in patent term adjustment from 254 days to 491 days.

The petition for reconsideration of the patent term adjustment is **GRANTED TO THE EXTENT INDICATED HEREIN**.

The above-identified application matured into U.S. Patent No. 8,034,915 on October 11, 2011. The patent issued with a patent term adjustment of 254 days. The instant application for patent term adjustment was timely filed December 12, 2011.

Patentee asserts entitlement to an adjustment of 353 days, rather than 341 days, pursuant to 37 CFR 1.703(a)(1) in connection with the mailing of the restriction requirement on October 31, 2006.

With respect to the request for an adjustment of 353 days rather than 341 days in connection with the mailing of the restriction requirement on October 31, 2006, patentees' arguments have been carefully considered, but are hereby DISMISSED.

Patentees are advised that any request for reconsideration under 37 CFR 1.705(d) that raises issues that were raised, or could have been raised, in an application for patent term adjustment under 37 CFR 1.705(b) shall be dismissed as untimely as to those issues. As the two day reduction contested by patentees could have been raised under 37 CFR 1.705(b), patentees' request for reconsideration of said reduction is dismissed as untimely.

Even assuming arguendo that the request for reconsideration of the 341 days of patent term adjustment had been timely filed, the request would be subject to dismissal on the merits. In this regard, the adjustment commenced November 25, 2005, the day after the date that is 14 months after the application fulfilled the requirements of 35 U.S.C. 371 in an international application (the declaration was submitted September 24, 2004), and ended 341 days later when the restriction requirement was mailed on October 31, 2006.

Patentees properly advise that the patent is subject to an adjustment of 62 days, not 59 days, with respect to the abandonment of the application pursuant to 37 CFR 1.704(c)(3)(i). The adjustment commenced June 19, 2011, the date of abandonment, and ended August 19, 2011, the date that the decision reviving the application was mailed. As the 20 days of reduction assessed in connection with the date of submission of the issue fee under 37 CFR 1.704(b) overlaps with the adjustment of 62 days, said reduction has been restored.

Patentees also dispute the 322 days accorded pursuant to 37 CFR 1.703(b). Patentees assert that the period beginning on March 23, 2007 (the day after the date that is three years after the date that national stage commenced), and ending October 11, 2011 (the date the patent was issued), is 1,664 days in length. With respect to the request for continued examination filed on February 8, 2008, patentees assert that the Director erred in subtracting from "B Delay" a period of time that was not "consumed by continued examination of the application. Patentees argue that no continued examination took place during the 208 day period from March 18, 2011 (the mailing date of the Notice of Allowance), until October 11, 2011 (the date the patent was issued). Accordingly, patentees assert that the patent is entitled to an additional 208 days of "B Delay."

Patentees' arguments have been considered, but not found persuasive.

35 USC 154(b)(1)(B) states in relevant part:

> Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including — (i) any time consumed by continued examination of the application requested by the applicant under section 132(b).

37 CFR 1.702(b) states in relevant part:

> Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including: (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b).

37 CFR 1.703(b) states in relevant part:

> The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the sum of the following periods: (1) The number of days, if any, in the period beginning on the date on which a request for continued examination of

the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

Thus, counting the period of time excluded from the "B delay" for the filing of a request for continued examination under 35 U.S.C. 132(b), from the date on which the request for continued examination is filed to the date the patent is issued is proper. Patentee does not dispute that time consumed by continued examination of an application under 35 U.S.C. 132(b) is properly excluded and that the calculation of the excluded period begins on the date of filing of the request for continued examination. At issue is what further processing or examination beyond the date of filing of the request for continued examination is not any time consumed by continued examination of the application under 35 U.S.C. 132(b). The USPTO indicated in September of 2000 in the final rule to implement the patent term adjustment provisions of the AIPA that once a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. 132(b) and CFR 1.114. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term, 65 Fed. Reg. 56366, 56376 (Sept. 18, 2000) (response to comment 8). Thus, the excluded period begins with the filing of the request for continued examination and ends with the issuance of the patent.

Patentee's argument that the period of time after the issuance of a notice of allowance on a request for continued examination is not "any time consumed by continued examination requested by the applicant under section 132(b)" within the meaning of 35 U.S.C. 154(b)(1)(B)(i) is not availing. This limitation is not supported by the statutory language. Garcia v. United States, 469 U.S. 70, 75 (1984) ("only the most extraordinary showing of contrary intentions from [legislative history] would justify a limitation on the 'plain meaning' of the statutory language"). BP Am. Prod. Co. v. Burton, 549 U.S. 84, 91 (2006) ("Unless otherwise defined, statutory terms are generally interpreted in accordance with their ordinary meaning"). The statute provides for a guarantee of no more than 3-year application pendency, by providing for an adjustment in the patent term:

First, "Subject to the limitations of paragraph (2)," means that the limitations of paragraph 2 apply to this paragraph's adjustment of patent term. That is, the day-to-day extension of patent term for pendency beyond the 3 year period is restricted as follows: 1) "B delay" cannot accrue for days of "A delay" that overlap, 2) the patent term cannot be extended beyond disclaimed term, and 3) the period of adjustment, including accrued "B delay," will be reduced for applicant delay.

Second, "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States," meaning that the condition must first occur that the issuance of an original patent (35 U.S.C. 153), not merely the issuance of a notice of allowance, is delayed due to the Office's failure to issue a patent (sign and record a patent grant in the name of the United States), not merely mail a notice of allowance, within 3 years after the actual filing date of the application in the United States. This provision gives the Office a three-year period to

issue a patent (sign and record a patent grant in the name of the United States) after the application filing date before an adjustment will accrue for "B delay."
Third, "not including- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b); (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), meaning that the three-year period does not include "any time consumed by" or "any delay in processing," as specified in clauses (i)-(iii). This language correlates to 35 U.S.C. 154(b)(1)(A) which likewise provides the basis for determining the period given the Office to take the specified actions before an adjustment will accrue for "A delay" (e.g., extended for 1 day after the day after the period specified in clauses (i)-(iv)).

Furthermore, these clauses are interpreted using their ordinary meanings. Nonetheless, the context of the legislation should be considered. As stated in Wyeth v. Dudas, No. 07-1492, 2008 U.S. Dist. LEXIS 76063 (D.D.C., September 30, 2008), because the clock for calculating the 20-year patent term begins to run on the filing date, and not on the day the patent is actually granted, some of the effective term of a patent is consumed by the time it takes to prosecute the application. To mitigate this effect, the statute, *inter alia*, grants adjustments of patent term whenever the patent prosecution takes more than three years, regardless of the reason. The time consumed by prosecution of the application includes every day the application is pending before the Office from the actual filing date of the application in the United States until the date of issuance of the patent. The time it takes to prosecute the application ends not with the mailing of the notice of allowance, but with the issuance of the patent.

Thus, not including "any time consumed by" means not including any days used to prosecute the application as specified in clauses (i)-(ii)[1]. Clause (i) specifies "any time consumed by continued examination of the application requested by the applicant under section 132(b)." Clause (ii) specifies "any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court." "Time" in the context of this legislation throughout refers to days. "Consumed by" means used by or used in the course of. *Websters Collegiate Dictionary*, (11th ed.). The "any" signifies that the days consumed by are "any" of the days in the pendency of the application, and not just days that occur after the application has been pending for 3 years. As such, "any time consumed by" refers to any days used in the course of 1) continued examination of the application under section 132(b)(the filing of a request for continued examination), 2) interference proceedings, 3) secrecy orders, and 4) appellate review. Thus, that 3-year period given to the Office to issue a patent before an adjustment will accrue for "B delay" does not include any days used in the course of or any time

[1] Clause (iii) provides for not including (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued. It is noted that paragraph (3)(C) allows with an adequate showing by applicant for reinstatement of no more than 3 months of the patent term reduced for applicant delay in taking in excess of three months to respond.

consumed by clauses (i)-(ii), including any time consumed by the filing of a request for continued examination.

Fourth, "the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued" meaning that the consequence of this failure is that after "the end of that 3-year period" an additional 1 day of patent term will accrue for each day that the application is pending until the day the patent is issued.

The "time consumed by" or used in the course of the continued examination of the application requested by the applicant under section 132(b) does not end until issuance of the patent. 35 U.S.C. 132(b) was enacted under the same title, the "American Inventors Protection Act of 1999," as 35 U.S.C. 154(b). Section 4403 of the AIPA amended 35 U.S.C. § 132 to provide, at the request of the applicant, for continued examination of an application for a fee (request for continued examination or RCE practice), without requiring the applicant to file a continuing application under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d). Thus, clause (i) is different from clause (ii) in that clause (i) refers to an examination process whereas clause (ii) refers to time consumed by proceedings (interferences, secrecy orders and appeals) in an application.

By nature, the time used in the course of the examination process continues to issuance of the patent. The examination process involves examining the application to ascertain whether it appears that the applicant is entitled to a patent under the law. See 35 U.S.C. 131 ("[t]he Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor"). If on examination it appears that the applicant is entitled to a patent, the USPTO issues a notice of allowance. See 35 U.S.C. 151 ("[i]f it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant"). If on examination it appears that the applicant is not entitled to a patent, the USPTO issues a notice (an Office action) stating the applicable rejection, objection, or other requirement, with the reasons therefor. See 35 U.S.C. 132 ("[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application"). Neither the issuance of a notice of allowance nor the insurance of an Office action terminates the examination process. If after the issuance of an Office action under 35 U.S.C. 132 it subsequently appears that the applicant is entitled to a patent (e.g., in response to an argument or amendment by the applicant), the USPTO will issue a notice of allowance. Conversely, if after the issuance of a notice of allowance under 35 U.S.C. 151 it subsequently appears that the applicant is not entitled to a patent (e.g., in response to information provided by the applicant or uncovered by the USPTO), the USPTO will withdraw the application from issuance and issue an Office action under 35 U.S.C. 132 stating the applicable rejection, objection, or other requirement, with the reasons therefor.

As held in Blacklight Power, the USPTO's responsibility to issue a patent containing only patentable claims does not end with the issuance of a notice of allowance under 35 U.S.C. 151.

See, BlackLight Power, Inc. v. Rogan, 295 F.3d 1269, 1273 (Fed. Cir. 2002). Rather, if there is any substantial, reasonable ground within the knowledge or cognizance of the Director as to why an application should not issue, it is the USPTO's duty to refuse to issue the patent even if a notice of allowance has previously been issued for the application. See, In re Drawbaugh, 9 App. D.C. 219, 240 (D.C. Cir 1896).

Moreover, the applicant continues to be engaged in the examination process after the mailing of the notice of allowance. 37 CFR 1.56 makes clear that the applicant has a duty to disclose information material to patentability as long as the application is pending before the USPTO (i.e., until a patent is granted or the application is abandoned). See, 37 CFR 1.56(a) ("[t]he duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned"). 37 CFR 1.97 and 1.98 provide for the consideration of information submitted by the applicant after a notice of allowance has been mailed. See 37 CFR 1.97(d). In addition, 37 CFR 1.312 provides for the amendment of an application after a notice of allowance has been mailed. In fact, the request for examination procedures[2] permit the filing of a request for continued examination under 37 CFR 1.114 even after the issuance of a notice of allowance under 35 U.S.C. 151. See 37 CFR 1.114(a)(1).

As the examination process does not terminate with the mailing of the notice of allowance, the time consumed by continued examination requested by the applicant under section 132(b) does not terminate with the mailing of the notice of allowance. All the time the application is pending from the date of filing of the request for continued examination to the mailing of the notice of allowance through issuance of the patent is a consequence of the filing of the request for continued examination. Further action by the Office is pursuant to that request. Applicant has gotten further prosecution of the application without having to file a continuing application under 37 CFR 1.53(b).

All of the continued examination pursuant to the filing of the request by the applicant is properly excluded from the delay attributed to the Office. 35 U.S.C. 154(b)(1)(B)'s guarantee of a total application pendency of no more than three years provides for adjustment of the patent term for delay due to the Office's failure to issue the patent within three years, but does not include "any time consumed by continued examination requested by the applicant under 35 U.S.C. 132(b)." It is not necessary to mitigate the effect on the 20-year term to the extent that applicant has requested that the Office continue to examine the application via a request for continued examination, in lieu of, the filing of a continuing application under 37 CFR 1.53(b).

Accordingly, in the instant matter, the period of adjustment under § 1.702(b) is 322 days, the period from February 8, 2008, the date that the RCE was filed, to October 11, 2011, the date that the patent issued, being excluded from the period of adjustment under 37 CFR 1.702(b).

[2] Thus, on occasion, even where a request for continued examination has already been filed and a notice of allowance issued pursuant to that request, applicant may file a further request for continued examination.

In view thereof, at the time of issuance, the patent was entitled to an overall patent term adjustment of 271 days (663 days under 37 CFR 1.702 less 392 days of applicant delay under 37 CFR 1.704).

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days,** whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136. See 37 CFR 1.323(a)(4).

The application is being forwarded to the Certificates of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by 271 days.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

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

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

*/ALESIA M. BROWN/*

Alesia M. Brown
Attorney Advisor
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 8,034,915

DATED : October 11, 2011 **DRAFT**

INVENTOR(S) : Haseloff, et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 254 days

Delete the phrase "by 254 days" and insert – by 271 days--

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. : 7875342 B2
Application No.: 10/490492
Inventor(s) : Smith, et al.
Issued : 01/25/2011
Title : POROUS CERAMIC COMPOSITE BONE GRAFTS
Attorney Docket No. : P0029906.06

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: 571-273-0025
ATTN: Office of Petitions

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

A certificate of correction will be issued to correct the remaining errors noted on the request.

**Tasneem Siddiqui**
For Mary Diggs (Supervisor)
Decisions & Certificates of Correction Branch
(703) **756-1593** or (703) 756-1814
Date: 03/17/2011

Address: G. Scott Dorland
Medtronic
IP Legal Department
2600 Sofamor Danek Drive
Memphis, TN 38132

ts/md

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FULBRIGHT & JAWORSKI L.L.P.
600 CONGRESS AVE.
SUITE 2400
AUSTIN TX 78701

**MAILED**

AUG 03 2010

**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of: | : |
| Claudia Preininger | : ON APPLICATION FOR |
| Application No. 10/490543 | : PATENT TERM ADJUSTMENT |
| Filing or 371(c) Date: 03/24/2004 | : |
| Atty. Docket No.: | : |
| SONN:051US | : |

This letter is in response to the "LETTER OF GOOD FAITH AND CANDOR," filed March 15, 2010. The Letter is properly treated as an Application for Patent Term Adjustment under 37 C.F.R. § 1.705(b).

The application for patent term adjustment is **GRANTED TO THE EXTENT INDICATED.**

The Office has updated the PALM and PAIR screens to reflect that the Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **zero (0) days.** A copy of the updated PALM screen, showing the correct determination, is enclosed.

On January 28, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is one hundred **(100)** days.

On March 15, 2010, applicant timely submitted the present application for patent term adjustment[1]. Applicant notes that the PTO delay of 255 days is believed to be in error and that there should be no delay counted against this Office for the date of mailing of the first Office action. Applicant also notes that Office records do not indicate an Applicant delay of four (4) days from January 28, 200[6] (three months after the mail date of the final Office action, mailed October 28, 2005), to February 1, 2006, the filing date of the response.

A review of Office records confirms that the application fulfilled the requirements of 35 U.S.C. 371 on March 24, 2004. The Office mailed a notification under 35 U.S.C. 132 on April 5, 2005, twelve months and 12 days after the application fulfilled the requirements of 35 U.S.C. 371. As such, the adjustment of 255 days is in error and has been removed.

[1] Office records show that the Issue Fee payment was received in the Office on April 26, 2010.

A further review of Office records reveals that the Office mailed a final Office action on October 28, 2005. Applicant filed a reply to the Office action on February 1, 2006, three months and four (4) days after the mailing of the final Office action. Accordingly, a reduction of four (4) days pursuant to 37 CFR 1.704(b) is properly attributed to Applicant.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is **zero (0)** days (61 days Office delay - 220 days Applicant delay.

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

The application is being forwarded to the Publications Division for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Attorney Derek L. Woods at (571) 272-3232.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of Adjustment PAIR Calculations

PALM INTRANET

Day : Monday
Date: 8/2/2010
Time: 08:18:30

| PTA Calculations for Application: 10/490543 | | | |
|---|---|---|---|
| Application Filing Date: | 03/24/2004 | PTO Delay (PTO): | 470 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 216 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 0 |
| PTO Delay Adjustment: | -259 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 168 | 08/02/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 510 | |
| 167 | 08/02/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 4 | |
| 166 | 08/02/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | 255 | | |
| 145 | 07/27/2010 | MAIL NOTICE OF ALLOWANCE | 154 | | 84 |
| 144 | 07/27/2010 | MAIL EXAMINER'S AMENDMENT | | | |
| 143 | 01/19/2010 | ISSUE REVISION COMPLETED | | | |
| 142 | 01/19/2010 | DOCUMENT VERIFICATION | | | |
| 141 | 07/23/2010 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 140 | 07/23/2010 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 139 | 07/23/2010 | NOTICE OF ALLOWABILITY | | | |
| 138 | 01/28/2010 | DATE FORWARDED TO EXAMINER | | | |
| 137 | 01/28/2010 | MAIL APPEALS CONF. REOPEN PROSEC. | | | |
| 135 | 07/20/2010 | NOT INHERITED | | | |
| 134 | 07/20/2010 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 129 | 07/08/2010 | CASE INHERITED | | | |
| 128 | 07/08/2010 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 107 | 01/21/2010 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 103 | 01/14/2010 | PRE-APPEALS CONFERENCE DECISION - REOPEN PROSECUTION | | | |
| 100 | 12/31/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 86 | 12/31/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 85 | 10/23/2009 | REQUEST FOR PRE-APPEAL CONFERENCE FILED | | | |
| 84 | 10/23/2009 | NOTICE OF APPEAL FILED | | 29 | 82 |
| 83 | 10/23/2009 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 82 | 06/24/2009 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 81 | 06/22/2009 | FINAL REJECTION | | | |
| 65 | 04/08/2009 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 64 | 04/14/2009 | DATE FORWARDED TO EXAMINER | | | |
| 63 | 04/08/2009 | RESPONSE AFTER NON-FINAL ACTION | | 29 | 61 |
| 62 | 04/08/2009 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 61 | 12/10/2008 | MAIL NON-FINAL REJECTION | | | |
| 60 | 12/08/2008 | NON-FINAL REJECTION | | | |
| 58 | 09/12/2008 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 57 | 10/09/2008 | DATE FORWARDED TO EXAMINER | | | |
| 56 | 09/12/2008 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 55 | 10/09/2008 | DATE FORWARDED TO EXAMINER | | | |
| 54 | 09/12/2008 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 29 | 50 |
| 53 | 10/09/2008 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 52 | 09/12/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 51 | 09/12/2008 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 50 | 05/14/2008 | MAIL FINAL REJECTION (PTOL - 326) | 5 | | 45 |
| 49 | 05/12/2008 | FINAL REJECTION | | | |
| 46 | 02/13/2008 | DATE FORWARDED TO EXAMINER | | | |
| 45 | 01/09/2008 | RESPONSE AFTER NON-FINAL ACTION | | 30 | 43 |
| 44 | 01/09/2008 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 43 | 09/10/2007 | MAIL NON-FINAL REJECTION | 56 | | 33 |
| 42 | 09/04/2007 | NON-FINAL REJECTION | | | |
| 38 | 08/21/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 37 | 07/01/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 36 | 07/01/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 35 | 05/02/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 34 | 03/20/2007 | DATE FORWARDED TO EXAMINER | | | |
| 33 | 03/16/2007 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 32 | 12/19/2006 | MAIL NON-FINAL REJECTION | | | |

| | | | | | |
|---|---|---|---|---|---|
| 31 | 12/11/2006 | NON-FINAL REJECTION | | | |
| 30 | 09/21/2006 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 29 | 09/28/2006 | DATE FORWARDED TO EXAMINER | | | |
| 28 | 09/21/2006 | RESPONSE AFTER NON-FINAL ACTION | | 65 | 26 |
| 27 | 09/21/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 26 | 04/18/2006 | MAIL NON-FINAL REJECTION | | | |
| 25 | 04/17/2006 | NON-FINAL REJECTION | | | |
| 24 | 02/04/2006 | DATE FORWARDED TO EXAMINER | | | |
| 23 | 02/01/2006 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 22 | 02/04/2006 | DATE FORWARDED TO EXAMINER | | | |
| 21 | 02/01/2005 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 20 | 02/04/2006 | DISPOSAL FOR A RCE / CPA / R129 | | | |
| 19 | 02/01/2006 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 18 | 10/28/2005 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 17 | 10/27/2005 | FINAL REJECTION | | | |
| 16 | 08/17/2005 | DATE FORWARDED TO EXAMINER | | | |
| 15 | 08/08/2005 | RESPONSE AFTER NON-FINAL ACTION | | 34 | 13 |
| 14 | 08/08/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 13 | 04/05/2005 | MAIL NON-FINAL REJECTION | 255 | | 1 |
| 12 | 04/04/2005 | NON-FINAL REJECTION | | | |
| 11 | 09/24/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 10 | 09/24/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 9 | 07/06/2004 | REFERENCE CAPTURE ON IDS | | | |
| 8.7 | 07/06/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 8 | 07/06/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 7 | 03/24/2004 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | | |
| 6 | 03/24/2004 | PRELIMINARY AMENDMENT | | | |
| 5 | 09/12/2004 | CLEARED BY OIPE CSR | | | |
| 4 | 03/24/2004 | 371 COMPLETION DATE | | | |
| 3 | 08/27/2004 | APPLICATION DISPATCHED FROM OIPE | | | |
| 2 | 08/27/2004 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 1 | 03/24/2004 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** [ ] Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

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Paper No.

Gary S Morris
Kenyon & Kenyon
Suite 700
1500 K Street NW
Washington DC 20005

MAILED

JUL 28 2011

OFFICE OF PETITIONS

In re Application of
Pulfer
Application No. 10/490,621
Patent No.: 7,295,957
Filed: March 25, 2004
Issued: November 13, 2007
Title: DYNAMIC PROCESS MANAGEMENT FOR THE RECORDING, MODELING, DOCUMENTATION AND VALIDATION OF COMPLEX PROCESSES AND SYSTEMS

DECISION ON PETITION PURSUANT TO 37 C.F.R. § 1.28(c)

This is a notice regarding your request for acceptance of a fee deficiency submission pursuant to 37 C.F.R. § 1.28, received on July 5, 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 $490 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.[1]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

cc: Dennemeyer & Co LTD
Regent House
Heaton Lane
Stockport Cheshire
SK4 1BB
ENGLAND

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).

2/5/11 . P/O 99605 P343

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- 2 AUG 2011
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United States Patent and Trademark Office
P.O. Box 1450
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Paper No.

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DEC 2 0 2011
OFFICE OF PETITIONS

Gary S Morris
Kenyon & Kenyon
Suite 700
1500 K Street NW
Washington DC 20005

MAILED
JUL 28 2011
OFFICE OF PETITIONS

In re Application of :
Pulfer :
Application No. 10/490,621 :
Patent No.: 7,295,957 : DECISION ON PETITION
Filed: March 25, 2004 : PURSUANT TO
Issued: November 13, 2007 : 37 C.F.R. § 1.28(c)
Title: DYNAMIC PROCESS :
MANAGEMENT FOR THE RECORDING, :
MODELING, DOCUMENTATION AND :
VALIDATION OF COMPLEX PROCESSES :
AND SYSTEMS :

This is a notice regarding your request for acceptance of a fee deficiency submission pursuant to 37 C.F.R. § 1.28, received on July 5, 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 $490 has been received.

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.[1]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

cc: Dennemeyer & Co LTD
Regent House
Heaton Lane
Stockport Cheshire
SK4 1BB
ENGLAND

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

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

MAILED
NOV 04 2010
OFFICE OF PETITIONS

In re Application of :
Zhang et al. :
Application No. 10/490,976 : ON APPLICATION FOR
Filed: July 21, 2009 : PATENT TERM ADJUSTMENT
Docket No. 2584.0440001/RWE/GER :

This is in response to the Request For Reconsideration Of Patent Term Adjustment Determination Under 37 C.F.R. § 1.705(b), filed January 14, 2010. Applicants submit that the patent term adjustment to be indicated on the patent is four hundred fifty-nine (459) days, not zero (0) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment.

The application for patent term adjustment is **DISMISSED**.

On October 15, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 0 days. Applicants argue a 448 day period of adjustment should be entered, pursuant to 37 CFR 1.702(a)(1), in connection with the restriction requirement mailed on August 16, 2006. Applicants argue that a period of adjustment under 37 CFR 1.703(a)(2) of 11 days should be entered in connection with the mailing of an Office action on March 25, 2008. In addition, applicants disclose a total of 255 days of Applicant delay.

A Notice of Acceptance was mailed in this application on July 6, 2004. The application was accorded a § 371 days of March 25, 2004. While rendering a decision on a Rule 78 petition, the Office determined that the declaration filed under PCT Rule 4.17(iv) was improper. A decision on the Rule 78 petition was mailed on July 23, 2008. The Office vacated the July 6, 2004

Notice of Acceptance in the decision. A Notice of Missing Requirements was mailed on September 26, 2008 that required a new declaration. A new declaration was filed on July 21, 2009. A Notice of Acceptance was mailed on August 7, 2009 that listed a new § 371 days of July 21, 2009.

Applicants filed a petition under 37 CFR 1.182 on January 14, 2010 that requested the Office accept the Rule 4.17(iv) declaration and that the original March 25, 2004 § 371 date be reinstated.

The Office dismissed the petition under 37 CFR 1.182 on October 19, 2010.

Applicants' request the March 25, 2004 § 371 date be used to calculate PTA under 37 CFR 1.703(a)(1). Applicants' arguments have been considered, but not found persuasive. The Office has determined that the § 371 date is July 21, 2009, not March 25, 2004. As discussed in the decisions of July 23, 2008 and October 19, 2010, the March 25, 2004 declaration under PCT Rule 4.17(iv) is not acceptable. Applicants did not submit an acceptable declaration until July 21, 2009.

Applicants are informed that the date of completion of all 35 U.S.C. 371 requirements is relevant for purposes of patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)(II) and 37 CFR 1.702(a)(1) when the Office has failed to mail a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than 14 months after the date on which the requirements under 35 U.S.C. 371 were fulfilled. This date is the latest of:

(A) the date of submission of the basic national fee;
(B) the date of submission or communication of the copy of the international application;
(C) the date of submission of the translation of the international application if the international application is not in the English language;
(D) the date of submission of an oath or declaration of the inventor in compliance with 35 U.S.C. 371(c)4)
(E) the earlier of 30 months from the priority date or the date of request for early processing under 35 U.S.C. 371(f) if requested prior to 30 months from the priority date;
(F) if a request for early processing has not been requested prior to 30 months from the priority date, the date of submission of any translation of the annexes to the

international preliminary examination report if the translation of the annexes are filed within the time period set in a Notification of Missing Requirements requiring either an English translation of the international application or an oath or declaration; and

(G) the date of submission of any surcharge for submitting the oath or declaration later than 30 months form the priority date.

The date of completion in this application is July 21, 2009. It is the date that applicants filed an acceptable declaration. This is the latest of the above-listed events. A Notice of Allowance was mailed on October 15, 2009, within 14 months of the application's completion date.

Therefore, the Office properly entered zero (0) days of adjustment in connection with mailing of the October 15, 2009 Notice of Allowance.

Applicants argue it would be unfair to calculate the PTA under 37 CFR 1.703(a)(1) using the 2009 371 date because the Office delayed 4 years in informing applicants that the March 25, 2004 declaration was unacceptable. However, applicants are responsible for knowing and following patent rules. Applicants have not shown how they were prevented from following the rules at the time the March 25, 2004 declaration was filed.

Applicants argue that denying the application PTA under 37 CFR 1.703(a)(1) on the ground that the declaration filed on March 25, 2004 was deemed to be unacceptable would unfairly penalize applicants for having chosen to pursue patent protection via the U.S. national stage, instead of via filing an application under 35 U.S.C. 111(a). However, it was applicants' choice to pursue protection via the U.S. national stage. Presumably applicants knew the pros and cons of filing a U.S. national stage application with respect to patent term adjustment. Unfortunately, applicants failed to file a proper declaration until July 21, 2009. Applicants' failure to file a proper declaration until July 21, 2009 caused applicants to lose patent term adjustment.

Applicants argue that a period of adjustment under 37 CFR 1.703(a)(2) of 11 days should be entered in connection with the mailing of an Office action on March 25, 2008. The Office disagrees, as no period was running against the Office. The first Office action on the merits is determined in relation to the 371 date of the application. As discussed above, a notice of

allowance under 35 U.S.C. 151 was mailed on October 15, 2009, within 14 months of the 371 date of the application. The March 25, 2008 Office action was mailed prior to the 371 completion date. As such, no period was running against the Office when it mailed the March 25, 2008 Office action. No adjustments are made prior to the first Office action on the merits.

Applicants disclose a total of 255 days of Applicant delay. However, applicants do not elaborate on the specific reductions. The Office has conducted a review of the PTA Calculations for the application and has not found 255 days of Applicant delay.

No changes to the patent term calculation will be made.

In view thereof, the determination of patent term adjustment at the time of the mailing of the notice of allowance remains zero (0) days.

The Office acknowledges receipt of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JUAN CARLOS A. MARQUEZ
C/O STITES & HARBISON PLLC
1199 NORTH FAIRFAX STREET
SUITE 900
ALEXANDRIA, VA 22314-1437

**MAILED**

NOV 23 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,008,232 | : | |
| Issue Date: March 7, 2006 | : | |
| Application No. 10/490,954 | : | ON PETITION |
| Filed: August 6, 2004 | : | |
| Patentee(s) Friedhelm Brassel | : | |

This is a decision on the petition filed October 14, 2010, which is being 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 **GRANTED**.

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

MAILED

OCT 19 2010

United States Patent and Trademark Office

PCT LEGAL ADMINISTRATION

Commissioner for Patents
United States Patent and Trademark Office
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www.uspto.gov

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

| | | |
|---|---|---|
| In re Application of | : | |
| Zhang et al. | : | |
| Application No.: 10/490,976 | : | DECISION |
| PCT No.: PCT/US02/05234 | : | |
| Int. Filing Date: 20 February 2002 | : | ON |
| Priority Date: 26 September 2001 | : | |
| Attorney Docket No.: 2584.0440001/RWE/GER | : | PETITION |
| For: Whitefly Ecdysone Receptor Nucleic | : | |
| Acids, Polypeptides And Uses Thereof | : | |

This is in response to the petition under 37 CFR 1.182 filed on 14 January 2010.

## BACKGROUND

In a Decision mailed on 23 July 2008, the declaration under PCT Rule 4.17(iv) was not accepted because it did not properly identify the international application to which it was directed, and because it "is an improper composite document, consisting of two of Page 1 and one of Page 2."

In a Decision mailed on 30 July 2009, a renewed petition under 37 CFR 1.47(a) filed on 21 July 2009 was dismissed as moot because, on 21 July 2009, applicants filed a declaration which, "taken together with the declaration filed on 25 March 2009, ... complies with 37 CFR 1.497(a) and (b)."

On 07 August 2009, a Filing Receipt and a Notice of Acceptance (Form PCT/DO/EO/903) showing a 35 U.S.C. 371(c)(1), (2) and (4) date of "07/21/2009" were mailed.

## DISCUSSION

Petitioner requests that the Rule 4.17(iv) declaration "filed in the international application be accepted, and that the original. March 25, 2004, § 371 date be reinstated." Petitioner argues that the international application number appears on the top right corner of each page of the declaration. However, it is not clear that these indications of the international application number were present on the sheets at the time they were executed (rather than recorded thereon later, e.g., pursuant to Administrative Instruction 308(b)). It is noted that the sheets indicate that the declaration "is directed to international application No. PCT/ to be assigned." As such, it is not clear that the declaration adequately indicated which application the inventors were executing at the time it was signed.

With respect to the composite nature of the declaration, counsel argues that composite documents are permissible. However, applicants' attention is respectfully drawn to MPEP 605.04(a), which explains that

> While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. >Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration (by combining the signature pages).<

Meanwhile, MPEP 201.03 states (in part) that

> While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

Since the declaration in question was not presented in complete form, but rather as a composite document, it is not clear that each inventor signed a complete copy of the declaration.

Petitioner argues that enforcement of the policy described above would result in an unfair outcome, but petitioner has not shown, e.g, why applicants were prevented from following the practice described in the MPEP excerpts *supra* at the time the declaration was filed during the international phase. For these reasons, it would not be appropriate to grant the requested relief on the basis of the present record.

## DECISION

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

Any request for reconsideration must be filed within **TWO (2) MONTHS** from the mailing date of this Decision. Extensions of time under 37 CFR 1.136(a) are available.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No**.:20101210

**DATE** : December 07, 2010

**TO SPE OF** : ART UNIT 3657

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7806790

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:**

/ROBERT A SICONOLFI/
Supervisory Patent Examiner.Art Unit 3657

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 :February 16, 2012

Patent No. :7079621
Inventor(s): :10491078
Issued :July 18, 2006
Title :VERTICAL TRANSMISSION DIFFRACTION ANALYSIS

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 Rules 1.322 and 1.323.

With respect to the alleged error concerning the deletion of inventors' names; the inventors are printed in accordance with the Declaration and/or ADS submitted at the time of filing the application or the filing of a petition during pendency. Review of the application file does not reveal a petition/amendment that meet the requirement of changing the inventorship. Accordingly, correction is not warranted under 1.322 or 1.323 as filed.

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

However, your attention is directed to 37 C.F.R. 1.324, wherein a request is being made to add or delete inventor(s), after issuance of the patent.

Any inquiry concerning this communication should be directed to Ms. A. Green at (571) 272-9005

Mary Diggs, Supervisor
Decisions & Certificates
of Correction Branch
(703) 756-1580 or (571) 272-9005

John S. Sopko, HOFFMANN 7 BARON, LLP
6900 Jericho Turnpike
Syosset, NY 11791

/arg

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

**LUCAS & MERCANTI, LLP**
**475 PARK AVENUE SOUTH**
**15TH FLOOR**
**NEW YORK NY 10016**

MAILED
AUG 16 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,618,664 | : | |
| Issue Date: November 17, 2009 | : | |
| Application No. 10/491,197 | : | ON PETITION |
| Filed: March 26, 2004 | : | |
| Attorney Docket No. 310.1039 | : | |

This is a decision on the petition filed July 14, 2011, under 37 CFR 3.81(b) to correct the name of the assignee on the front page of the above-identified patent by way of a certificate of correction.

The petition is **DISMISSED**.

Petitioner requests issuance of a certificate of correction in the name of " Purac Biochem B.V."

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 [emphasis added]. *See also* MPEP 1481.01.

U.S. Patent and Trademark Office assignment records disclose that an assignment to Purac Biochem B.V. was recorded on May 7, 2010, and corrected again on July 1, 2010, **after the date of issuance of this patent**. Accordingly, since the assignment was not submitted for recordation until after issuance of this patent, issuance of a certificate of correction would not be proper.

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

/KOC/
Karen Creasy
Petitioner 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

MAILED
FEB 09 2012
OFFICE OF PETITIONS

ADAMS & WILKS
17 BATTERY PLACE
SUITE 1231
NEW YORK, NY 10004

| | | |
|---|---|---|
| In re Patent No. 5,953052 | : | |
| Issue Date: August 15, 2006 | : | |
| Application No.: 10/491,258 | : | ON PETITION |
| Filed: March 30, 2004 | : | |
| Attorney Docket No.: M013-5245 (PCT) | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed January 11, 2012, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on August 15, 2010 for failure to pay the first 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 3 ½ year maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3204.

/SDB/

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/491,274 | 03/31/2004 | Roger Leslie Gray | 59098.US | 9279 |

7590 07/14/2011
Luedeka Neely & Graham
P O Box 1871
Knoxville, TN 37901

| EXAMINER |
|---|
| GISHNOCK, NIKOLAI A |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3715 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 07/14/2011 | 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

---

BEFORE THE
BOARD OF PATENT APPEALS AND INTERFERENCES

---

*Ex parte* ROGER LESLIE GRAY, IAN MICHAEL ROSS,
STUART MALCOLM GREENGRASS and DANIEL MARK WALLAKER

---

Appeal No. 2011-010074
Application 10/491,274
Technology Center 3700

---

DECISION ON PETITION

This is a decision on the "Petition Pursuant to 37 C. F. R. § 1.183" filed June 13, 2011 ("Petition"). The Petition requests "a suspension of the rules in order to file the enclosed Reply Brief more than two months after the Examiner's Answer."

FINDINGS

1) On August 24, 2010, Appellants filed a Notice of Appeal and a Pre-Appeal Brief Request for Review.
2) On October 13, 2010, a Notice of Panel Decision from Pre-Appeal Brief Review was mailed to Appellants.
3) On November 9, 2010, Appellants filed an After Final Amendment.
4) On December 13, 2010, Appellants filed an Appeal Brief.
5) On December 16, 2010, an Advisory Action was mailed to Appellants, entering their After Final Amendment filed November 9, 2010.
6) On March 3, 2011 an Examiner's Answer was mailed to Appellants.
7) On June 13, 2011, Appellants filed their petition and their Reply Brief.
8) Appellants, through their counsel, made the following statement:

> While Applicant was aware that the Reply Brief was due within two months from the date of the Examiner's Answer pursuant to 37 C.F.R.§41.41, Applicant mistakenly believed that it could file a request for extension of time after the two months with the appropriate fee. Only after the two months had passed did Applicant realize 37 C.F.R. §1.136(b) applies to extensions of time to file reply briefs and requires that the request "must be filed on or before the day on which such reply is due."

Petition 2.

9) Appellants further state:

> As justice requires the Board to have the opportunity to review Applicants' comments with respect to the Examiner's Answer for properly considering the appeal and efficiently rendering an informed decision. Applicants hereby submit this petition under 37 C.F.R. §1.183 for a suspension of the rules in order to file the enclosed Reply Brief more than two months after the Examiner's Answer.

*Id.*

10) Appellants also state:

> Further, the present circumstance is "an extraordinary situation" as there is no significant, if any, delay in the appeal process by allowing Applicants to file their Reply Brief. Applicants are submitting their Reply Brief herewith, or within 45 days of the original deadline. Further, justice is served because Applicants' comments on the Examiner's Answer would be helpful to the Board in considering the appeal and efficiently rendering an informed opinion.

*Id.* at 2-3.

11) On June 21, 2011, a Board of Patent Appeals and Interferences Docketing Notice was mailed to Appellants, giving the Application appeal number 2011-010074.

12) 37 CFR § 1.183 states:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of

> the interested party, subject to such other requirements as may be imposed.

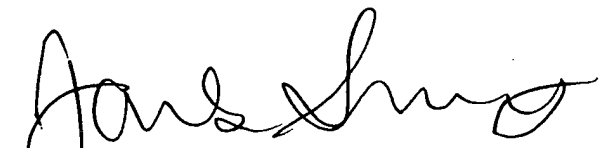
13) 37 CFR § 41.41(a)(1) states: "Appellant **may** file a reply brief to an examiner's answer within two months from the date of the examiner's answer." (*Emphasis added*).

DISCUSSION

The Appellants have not demonstrated that there exists here an extraordinary situation, which is the justification 37 CFR §1.183 specifically requires. Additionally, a showing that justice will be subverted in the absence of the Reply Brief being considered also has not been demonstrated. Accordingly, even if it would help the Board to consider the Reply Brief the extension cannot be granted. The Petition must be **denied.**

DECISION

In view of the foregoing, the Petition is DENIED.



James D. Smith
Chief Administrative Patent Judge

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450

**NOVAK DRUCE DELUCA + QUIGG LLP**
**300 NEW JERSEY AVENUE NW**
**FIFTH FLOOR**
**WASHINGTON DC 20001**

MAILED
APR 05 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,074,965 | : | |
| Issue Date: July 11, 2006 | : | |
| Application No. 10/491,419 | : | ON PETITION |
| Filed: April 1, 2004 | : | |
| Attorney Docket No. 52940 | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed January 14, 2011, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED.**

This patent expired on July 11, 2010 for failure to pay the three and one-half year maintenance fee.

37 CFR 1.378(d) requires any petition under 37 CFR 1.378 to be signed by an attorney or agent registered to practice before the United States Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.

In the present petition, there is no indication that the person signing the instant petition is authorized to practice before the United States Patent and Trademark Office, or given a power of attorney or authorization of agent to prosecute the above-identified application. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address of currently of record until such time as appropriate instructions are received to the contrary.

Furthermore, there is no evidence as to whether the signer is an assignee, or other party in interest.

If this petition is not renewed or if renewed and not granted, then petitioner may request a refund of the maintenance fee 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 PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

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

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

General inquiries relating to this decision should be directed to Robert DeWitty (571-272-8427).

David Bucci
Petitions Examiner
Office of Petitions

cc : Anton Bory
Muenchener Straβe 14
85540 Haar
GERMANY

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450

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JUN 29 2011
OFFICE OF PETITIONS

**NOVAK DRUCE DELUCA + QUIGG LLP**
**300 NEW JERSEY AVENUE NW**
**FIFTH FLOOR**
**WASHINGTON DC 20001**

| | | |
|---|---|---|
| In re Patent No. 7,074,965 | : | |
| Issue Date: July 11, 2006 | : | |
| Application No. 10/491,419 | : | ON PETITION |
| Filed: April 1, 2004 | : | |
| Attorney Docket No. 52940 | : | |

This is a decision on the renewed petition under 37 CFR 1.378(c), filed May 11, 2011, to accept the delay payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED.**

The patent expired on July 11, 2010 for failure to pay the three 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 mailing date of this decision.

Any petition for reconsideration of 37 CFR 1.378(c) decision must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f). Petitioner's deposit account DA 505065 will be charged $400, as authorized.

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 the paying the maintenance fee under 37 CFR 1.378(c) was intentional, petitioner must notify the Office.

Telephone inquires regarding this decision should be directed to Robert DeWitty, Petitions Attorney, Office of Petitions (571-272-8427).

Anthony Knight
Director
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 4/20/09 Paper No.: _____

TO SPE OF : ART UNIT 3769 FARAH, Ahmed

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/491426 Patent No.: 7409954

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

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

Certificates of Correction Branch
703-308-9390 ext. _____

**Thank You For Your Assistance**

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

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

**Comments:** the term "or continuous-wave" in the Certificate of Correction is a new matter. Therefore, the indicated correction for Col. 5, line 45 is denied and should not be entered.

Primary Examiner
A. Farah 4/16/12

SPE

3769
Art Unit

PTOL-306 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 12/23/2011

TO SPE OF : ART UNIT 1774 Griffin Walter (SPE)

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/491512 Patent No.: 7481572

CofC mailroom date: _____

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:** _____

_____

Certificates of Correction Branch

**571-272-8680** _____

**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:** _____

/Walter D. Griffin/ — **SPE**

1774 — **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

MAILED
OCT 04 2011
OFFICE OF PETITIONS

PERKINS COIE LLP
P.O. BOX 1208
SEATTLE WA 98111-1208

In re Patent No. 7,358,060 :
Issued : April 15, 2008 : ON PETITION
Application No. 10/491,523 :
Filed: June 17, 2004 :
Attorney Docket No. **76644-8004.US00** :

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

**MAILED**

FEB 03 2011

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,344,123 | : | |
| Issued: March 18, 2008 | : | |
| Application No. 10/491,718 | : | ON PETITION |
| Filed: August 5, 2004 | : | |
| Attorney Docket No. P08214US00/DEJ | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed December 7, 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 **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.

Additionally, petitioner has submitted an unnecessary additional $1,550.00 payment. This amount will be refunded to petitioner's credit card in due course.

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

Joan Olszewski
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No**.:20101017

**DATE** : October 18, 2010

**TO SPE OF** : ART UNIT 1636

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,767,416

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:**

/ Christopher S. F. Low /
Supervisory Patent Examiner, Art Unit 1636

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

MAILED
DEC 30 2010
OFFICE OF PETITIONS

In re Patent No. 7,718,575 :
Issue Date: May 18, 2010 :
Application No. 10/491,891 : ON PETITION
Filed: October 14, 2004 :
Attorney Docket No. 251858US0XPCT :

This is a decision on the petition filed November 30, 2010, 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 Diane Goodwyn at (571) 272-6735. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Thurman K. Page
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and 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
www.uspto.gov

Browdy and Neimark PLLC
1625 K street NW
Suite 1100
Washington DC 20006

MAILED
FEB 02 2011
OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,522,615 | : |
| Binder | : DECISION UPON REMAND AND |
| Issue Date: April 21,2009 | : RECONSIDERATION OF |
| Application No. 10/491,989 | : PATENT TERM ADJUSTMENT |
| Filed: April 7, 2004 | : AND NOTICE OF INTENT |
| Attorney Docket No. Binder22 | : TO ISSUE CERTIFICATE OF |
| Title: Addressable Outlet and | : CORRECTION |
| Network Using Same | : |

This is a decision following remand from the District Court for the District of Columbia regarding the patent term adjustment indicated on the above-identified patent. The Court remanded this matter to the U.S. Patent and Trademark Office for recalculation of the patent term adjustment in accordance with the decision in Wyeth & Elan Pharma Int'l Ltd. v. Kappos, 591 F.3d 1364 (Fed. Cir. 2010).

The patent term adjustment indicated on the above-identified patent has been recalculated as directed by the Court. The term of the above-identified patent is extended or adjusted by one thousand four hundred and fourteen (1414) days.

The application is being forwarded to the Certificates Branch for issuance of a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand four hundred and fourteen (1414) days.

Telephone inquiries specific to this matter should be directed to Senior Legal Advisor Kery A. Fries at (571) 272-7757.

/Kery A. Fries/

Kery Fries
Senior Legal Advisor Attorney

Office of Patent Legal Administration
Office of Associate Commissioner
For Patent Examination Policy

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,522,615 B2

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

INVENTOR(S) : Binder

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 1287 days

Delete the phrase "by 1287 days" and insert – by 1414 days--

Day : Tuesday
Date: 1/25/2011

PALM INTRANET

Time: 12:37:43

| PTA Calculations for Application: 10/491989 | | | |
|---|---|---|---|
| Application Filing Date: | 04/07/2004 | PTO Delay (PTO): | 1287 |
| Issue Date of Patent: | 04/21/2009 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 0 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 1414 |
| PTO Delay Adjustment: | 127 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 88 | 01/25/2011 | ADJUSTMENT OF PTA CALCULATION BY PTO | 127 | | |
| 77.5 | 04/01/2009 | PTA 36 MONTHS | | | |
| 77 | 04/21/2009 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 76 | 03/11/2009 | EXPORT TO FINAL DATA CAPTURE | | | |
| 75 | 03/10/2009 | DISPATCH TO FDC | | | |
| 74 | 03/10/2009 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 73 | 03/10/2009 | TC RETURN TO PUBS | | | |
| 72 | 03/06/2009 | ISSUE FEE PAYMENT VERIFIED | | | |
| 71 | 03/06/2009 | STATEMENT FILED INDICATING A LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS | | | |
| 70 | 03/06/2009 | ISSUE FEE PAYMENT RECEIVED | | | |
| 69 | 02/12/2009 | FINISHED INITIAL DATA CAPTURE | | | |
| 68 | 12/19/2008 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 65 | 12/15/2008 | MAIL NOTICE OF ALLOWANCE | 1287 | | -1 |
| 64 | 12/10/2008 | ISSUE REVISION COMPLETED | | | |
| 63 | 12/10/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 62 | 12/08/2008 | DOCUMENT VERIFICATION | | | |
| 61 | 12/08/2008 | NOTICE OF ALLOWABILITY | | | |
| 57 | 11/14/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 56 | 11/14/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 55 | 01/14/2008 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 54 | 06/14/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 53 | 06/14/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 52 | 05/25/2007 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 51 | 12/21/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 50 | 11/28/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 49 | 06/15/2006 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 48 | 04/07/2004 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 47 | 09/11/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 46 | 09/09/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 43 | 04/11/2008 | TRANSFER INQUIRY TO GAU | | | |
| 42 | 04/11/2008 | TRANSFER INQUIRY TO GAU | | | |
| 41 | 04/11/2008 | TRANSFER INQUIRY TO GAU | | | |
| 38 | 01/14/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 37 | 01/14/2008 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 36 | 10/01/2007 | PRELIMINARY AMENDMENT | | | |
| 35 | 09/12/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 34 | 05/25/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 33 | 11/28/2006 | REFERENCE CAPTURE ON IDS | | | |
| 31 | 06/14/2007 | ELECTRONIC INFORMATION DISCLOSURE STATEMENT | | | |
| 30 | 05/25/2007 | REFERENCE CAPTURE ON IDS | | | |
| 29 | 05/25/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 28 | 06/14/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 27 | 06/14/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 26 | 05/25/2007 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 25 | 05/03/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 24 | 09/08/2004 | PRELIMINARY AMENDMENT | | | |
| | | | | | |

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|---|---|---|---|---|---|
| 23.7 | 11/28/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 23 | 11/28/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 22 | 02/08/2007 | TRANSFER INQUIRY TO GAU | | | |
| 21 | 12/21/2006 | REFERENCE CAPTURE ON IDS | | | |
| 20.7 | 12/21/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 20 | 12/21/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 19 | 04/07/2004 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | | |
| 18 | 04/07/2004 | PRELIMINARY AMENDMENT | | | |
| 17 | 04/07/2004 | REFERENCE CAPTURE ON IDS | | | |
| 16.7 | 04/07/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 16 | 04/07/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 15 | 11/10/2006 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 14 | 06/15/2006 | REFERENCE CAPTURE ON IDS | | | |
| 13.7 | 06/15/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 13 | 06/15/2006 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 12 | 06/15/2006 | TRANSFER INQUIRY TO GAU | | | |
| 11 | 10/14/2005 | MISCELLANEOUS INCOMING LETTER | | | |
| 10 | 09/08/2004 | PRELIMINARY AMENDMENT | | | |
| 9 | 02/22/2005 | OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL) | | | |
| 8 | 05/03/2005 | REFERENCE CAPTURE ON IDS | | | |
| 7.7 | 05/03/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 7 | 05/03/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 6 | 09/08/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 5 | 08/21/2004 | CLEARED BY OIPE CSR | | | |
| 4 | 04/07/2004 | 371 COMPLETION DATE | | | |
| 3 | 08/03/2004 | APPLICATION DISPATCHED FROM OIPE | | | |
| 2 | 08/03/2004 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 1 | 04/07/2004 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to OASIS | Home page

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Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 7144234
Issue Date: December 5,2006
Application No. 10491990
Filed: April 7,2004
Attorney Docket No. 042175

:
: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 3.5 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.

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) |
|---|---|---|---|---|
| 7,144,234 | 2006-12-05 | 10/491,990 | 2004-04-07 | TS/PIES 1101 US-PAT |

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

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 | /Norman B. Thot/ | Date (YYYY-MM-DD) | 2011-04-07 |
| Name | Norman B. Thot | Registration Number | 47993 |

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
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) |
|---|---|---|---|---|
| 7,034,673 | 2006-04-25 | 10/492,097 | 2004-04-08 | 16565.0003USWO |

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

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 | /Dianna Goldenson/ | Date (YYYY-MM-DD) | 2010-11-18 |
| Name | Dianna Goldenson | Registration Number | 52949 |

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. 7034673
Issue Date: April 25,2006
Application No. 10492097
Filed: April 8,2004
Attorney Docket No. AP10230

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

This is a decision on the electronic petition, filed November 18,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 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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ALEXANDRIA, VA 22313-1450
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MCCARTER & ENGLISH, LLP BOSTON
265 FRANKLIN STREET
BOSTON MA 02110

**MAILED**

NOV 17 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Watier et al. | : | |
| Application Number: 10/492,183 | : | DECISION ON APPLICATION |
| Filed: 04/09/2004 | : | FOR |
| Attorney Docket No. | : | PATENT TERM ADJUSTMENT |
| 118553-21501 | : | |

This is a decision on the APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.705(B), filed on August 17, 2010, requesting correction of the determination of patent term adjustment at the mailing of the notice of allowance.

The application for patent term adjustment patent is **GRANTED**.

The Office has updated the PALM and PAIR screens to reflect that the Patent Term Adjustment (PTA) at the time of the mailing of the Notice of Allowance is 0 days. A copy of the updated PAIR screen, showing the revised determination, is enclosed.

On May 17, 2010, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date was 0 days (248 days of Office delay and 477 days of applicant delay).

The subject application for patent term adjustment was timely filed on August 17, 2010.[1]

[1] A review of Office PALM records indicates that the issue fee was paid on August 17, 2010.

Applicants assert that the period of adjustment for Office delay under 37 CFR 1.702(a)(1) should be 320 days, rather than 247 days, because the Office action mailed on April 25, 2006, was mailed 320 days after the day after the date fourteen months after April 9, 2004, the date the application fulfilled the requirements of 35 U.S.C. 371.

Applicants' argument has been considered, and is persuasive. The completion date under 35 U.S.C. 371 for the subject application is April 9, 2004, not June 21, 2004. As the first Office action was mailed on April 25, 2006, fourteen months and 320 days after the date the application fulfilled the requirements of 35 U.S.C. 371, the 247 day period of Office delay will be removed and a 320 day period of Office delay will be entered.

The patent term adjustment is updated to 0 days (321 (320 + 1) days of Office delay less 477 days of applicant delay).

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

The application is being forwarded to the Office of Data Management for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

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

DWood

Douglas I. Wood
Director
Office of Petitions

Encl: Updated PAIR Calculation

## Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/492,183

| | | | |
|---|---|---|---|
| Filing or 371(c) Date: | 04-09-2004 | Overlapping Days Between {A and B} or {A and C}: | 0 |
| Issue Date of Patent: | - | Non-Overlapping USPTO Delays: | 248 |
| A Delays: | 248 | PTO Manual Adjustments: | 73 |
| B Delays: | 0 | Applicant Delays: | 477 |
| C Delays: | 0 | Total PTA Adjustments: | 0 |

**Patent Term Adjustment History** **Explanation Of Calculations**

| Number | Date | Contents Description | PTO(Days) | APPL (Days) | Start |
|---|---|---|---|---|---|
| 112 | 11-17-2010 | Adjustment of PTA Calculation by PTO | 320 | | 0 |
| 111 | 11-17-2010 | Adjustment of PTA Calculation by PTO | | 247 | 0 |
| 93 | 05-17-2010 | Mail Notice of Allowance | | | 0 |
| 92 | 05-14-2010 | Issue Revision Completed | | | 0 |
| 91 | 05-14-2010 | Document Verification | | | 0 |
| 90 | 05-14-2010 | Notice of Allowance Data Verification Completed | | | 0 |
| 89 | 05-10-2010 | Examiner's Amendment Communication | | | 0 |
| 88 | 05-10-2010 | Notice of Allowability | | | 0 |
| 87 | 04-26-2010 | Affidavit(s) (Rule 131 or 132) or Exhibit(s) Received | | | 0 |
| 86 | 04-26-2010 | Information Disclosure Statement (IDS) Filed | | 56 | 77 |
| 85 | 04-26-2010 | Information Disclosure Statement considered | | | 0 |
| 84 | 03-04-2010 | Information Disclosure Statement considered | | | 0 |
| 82 | 04-26-2010 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 81 | 03-04-2010 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 80 | 03-04-2010 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 79 | 03-04-2010 | Date Forwarded to Examiner | | | 0 |
| 78 | 03-01-2010 | Amendment Submitted/Entered with Filing of CPA/RCE | | | 0 |
| 76 | 03-04-2010 | Disposal for a RCE / CPA / R129 | | | 0 |
| 75 | 03-01-2010 | Request for Extension of Time - Granted | | | 0 |
| 74 | 03-01-2010 | Workflow - Request for RCE - Begin | | | 0 |
| 73 | 01-20-2010 | Change in Power of Attorney (May Include Associate POA) | | | 0 |
| 72 | 01-15-2010 | Correspondence Address Change | | | 0 |
| 71 | 01-15-2010 | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 70 | 01-12-2010 | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 69 | 07-27-2009 | Notice of Appeal Filed | | 90 | 65 |
| 68 | 07-27-2009 | Request for Extension of Time - Granted | | | 0 |
| 67 | 07-30-2009 | Change in Power of Attorney (May Include Associate POA) | | | 0 |
| 66 | 07-27-2009 | Correspondence Address Change | | | 0 |
| 65 | 01-28-2009 | Mail Final Rejection (PTOL - 326) | | | 0 |
| 64 | 01-27-2009 | Final Rejection | | | 0 |
| 63 | 10-29-2008 | Information Disclosure Statement considered | | | 0 |
| 62 | 10-28-2008 | Information Disclosure Statement (IDS) Filed | | 0 | 60 |
| 61 | 11-24-2008 | Date Forwarded to Examiner | | | 0 |
| 60 | 10-28-2008 | Response after Non-Final Action | | 60 | 56 |
| 59 | 10-28-2008 | Request for Extension of Time - Granted | | | 0 |
| 58 | 11-24-2008 | CRF Is Good Technically / Entered into Database | | | 0 |
| 57 | 10-29-2008 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 56 | 05-29-2008 | Mail Non-Final Rejection | 1 | | 52 |
| 55 | 05-27-2008 | Non-Final Rejection | | | 0 |
| 53 | 03-12-2008 | Date Forwarded to Examiner | | | 0 |
| 52 | 01-28-2008 | Response after Non-Final Action | | 32 | 49 |

| | | | | | |
|---|---|---|---|---|---|
| 51 | 01-28-2008 | Request for Extension of Time - Granted | | | 0 |
| 49 | 09-27-2007 | Mail Non-Final Rejection | | | 0 |
| 48 | 09-26-2007 | Non-Final Rejection | | | 0 |
| 47 | 07-25-2007 | Date Forwarded to Examiner | | | 0 |
| 46 | 07-23-2007 | Amendment Submitted/Entered with Filing of CPA/RCE | | | 0 |
| 45 | 07-25-2007 | Date Forwarded to Examiner | | | 0 |
| 44 | 07-23-2007 | Request for Continued Examination (RCE) | | 92 | 40 |
| 43 | 07-25-2007 | Disposal for a RCE / CPA / R129 | | | 0 |
| 42 | 07-23-2007 | Request for Extension of Time - Granted | | | 0 |
| 41 | 07-23-2007 | Workflow - Request for RCE - Begin | | | 0 |
| 40 | 01-22-2007 | Mail Final Rejection (PTOL - 326) | | | 0 |
| 39 | 01-16-2007 | Final Rejection | | | 0 |
| 38 | 01-03-2007 | Date Forwarded to Examiner | | | 0 |
| 37 | 12-19-2006 | Response after Non-Final Action | | 55 | 34 |
| 36 | 11-20-2006 | Mail Notice of Informal or Non-Responsive Amendment | | | 0 |
| 35 | 11-01-2006 | Date Forwarded to Examiner | | | 0 |
| 34.1 | 10-25-2006 | Informal or Non-Responsive Amendment after Examiner Action | | | 0 |
| 34 | 10-25-2006 | Response after Non-Final Action | | 92 | 32 |
| 33 | 10-25-2006 | Request for Extension of Time - Granted | | | 0 |
| 32 | 04-25-2006 | Mail Non-Final Rejection | 247 | | 9 |
| 31 | 04-24-2006 | Non-Final Rejection | | | 0 |
| 30 | 08-08-2005 | Information Disclosure Statement considered | | | 0 |
| 28 | 12-05-2005 | Case Docketed to Examiner in GAU | | | 0 |
| 27 | 08-08-2005 | Reference capture on IDS | | | 0 |
| 26.7 | 08-08-2005 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 26 | 08-08-2005 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 25 | 01-08-2005 | IFW TSS Processing by Tech Center Complete | | | 0 |
| 24 | 01-08-2005 | Case Docketed to Examiner in GAU | | | 0 |
| 21 | 12-15-2004 | Cleared by OIPE CSR | | | 0 |
| 20 | 12-15-2004 | Cleared by OIPE CSR | | | 0 |
| 19 | 12-15-2004 | Cleared by OIPE CSR | | | 0 |
| 18 | 12-15-2004 | Cleared by OIPE CSR | | | 0 |
| 17 | 12-15-2004 | Cleared by OIPE CSR | | | 0 |
| 16 | 12-15-2004 | Cleared by OIPE CSR | | | 0 |
| 15 | 10-22-2004 | Oath or Declaration Filed (Including Supplemental) | | | 0 |
| 9 | 06-21-2004 | 371 Completion Date | | | 0 |
| 8 | 11-26-2004 | Application Dispatched from OIPE | | | 0 |
| 7 | 11-29-2004 | Notice of DO/EO Acceptance Mailed | | | 0 |
| 3 | 10-06-2004 | CRF Is Good Technically / Entered into Database | | | 0 |
| 2 | 08-10-2004 | Sequence disclosure problems | | | 0 |

**Close Window**

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20110531

**DATE** : May 31, 2011

**TO SPE OF** : ART UNIT 1645

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7868144

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:**

/GARY NICKOL/
Supervisory Patent Examiner.Art Unit 1645

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**FRISHAUF, HOLTZ, GOODMAN & CHICK, PC**
**220 FIFTH AVENUE**
**16TH FLOOR**
**NEW YORK NY 10001-7708**

MAILED
AUG 02 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,450,158 | : | |
| Application No. 10/492,260 | : | |
| Filed: April 12, 2004 | : | ON PETITION |
| Issued: November 11, 2008 | : | |
| Attorney Docket No. 03693/LH | : | |

This is a decision on the renewed petition filed July 19, 2010, which is being treated as a request under 37 CFR 3.81(b)[1] to add the names of the second and third assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

This matter is being referred to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-7751. Inquiries regarding the certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

Joan Olszewski

Joan Olszewski
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

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D. Whitlow Bivens
Musick Peeler & Garrett
Suite 1900
225 Broadway
San Diego CA 92101

MAILED

JAN 06 2011

PCT LEGAL ADMINISTRATION

In re Application of: BEHM, Joseph
U.S. Application No.: 10/492,284
PCT No.: PCT/US02/32395
International Filing Date: 10 October 2002
Priority Date: 10 October 2001
Attorney Docket No.: 05473.002
For: SMALL-BATCH COFFEE BEAN ROASTER AND COUNTER-TOP OVEN APPLIANCE

DECISION ON PETITION
(37 CFR 1.181)

This decision is issued in response to the "Petition To Withdraw Holding Of Abandonment Pursuant To 37 CFR 1.181(a)" filed 15 November 2010. No petition fee is required.

## BACKGROUND

On 10 October 2001, applicant filed international application PCT/US02/32395. The international application claimed a priority date of 10 October 2001, and it designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 10 April 2004.

On 09 April 2004, applicant filed a Transmittal Letter requesting entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and an executed declaration.

On 08 June 2004, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements" indicating that an additional $27 in fees was required for the inclusion of three total claims over 20.

On 09 August 2004, applicant filed a response to the Notification Of Missing Requirements indicating that a check in the amount of $27 was enclosed. The response also asserted that the fee was not properly required because the application did not include more than 20 total claims.

On 19 September 2005, applicant filed a Preliminary Amendment directed to the claims.

On 20 February 2007, the DO/EO/US mailed a "Notification Of Defective Response" (Form PCT/DO/EO/916) indicating that additional fees of $75 were required for the inclusion of three total claims over 20.

On 26 March 2007, applicant filed a response to the Notification Of Defective Response that included payment of the required $75. The response also argued that the fees should not be required because applicants had already submitted payment for the additional claims fees in response to the original Notification Of Missing Requirements.

On 01 November 2010, the DO/EO/US mailed a Notification Of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned based on applicant's purported failure to file a response to the Notification Of Missing Requirements mailed 08 June 2004.

On 15 November 2010, applicant filed the "Petition To Withdraw Holding Of Abandonment Pursuant To 37 CFR 1.181(a)" considered herein.

## DISCUSSION

A review of the application file confirms that, on 09 August 2004, applicants filed a timely response to the Notification of Missing Requirements mailed on 08 June 2004, and such response included payment of the $27 in fees required by the Notification of Missing Requirements.[1]

In view of applicant's submission of a timely and complete response to the Notification of Missing Requirements, the holding of abandonment, based as it was on applicant's purported failure to file a proper response to the Notification Of Missing Requirements, is appropriately withdrawn, as requested by applicant in the present petition.

The Notification Of Defective Response mailed 20 February 2007, which was also based on applicant's purported failure to file a proper response to the Notification Of Missing Requirements, is also appropriately vacated.[2]

Finally, it is noted that applicant has argued herein that the application does not include more than 20 total claims and that the additional fees required in the Notification Of Missing Requirements and the Notification Of Defective Response were therefore not properly required. However, while the present application does not include more than 20 numbered claims, the application includes multiple dependent claims which count as more than a single claim for fee calculation purposes. See 37 CFR 1.75(c). See also MPEP section 608.01(n)(I). Based on the presence of the multiple dependent claims, for fee calculation purposes, the present application includes more than 20 total claims.

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[1] This fee payment was incorrectly allocated to the international application filed, PCT/US02/32395. The fee payment has now been applied to the present application file.

[2] It is noted that applicant filed a timely response to the Notification Of Defective Response that included payment of the $75 in fees required by such Notification.

## CONCLUSION

The petition to withdraw the holding of abandonment under 37 CFR 1.181 is **GRANTED**.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 01 November 2010 and the Notification Of Defective Response (Form PCT/DO/EO/916) mailed 20 February 2007 are hereby **VACATED**.

This application is being returned to the National Stage Processing Branch of the Office of PCT operations for further processing in accordance with this decision, including a determination as to whether all required fees have been submitted herein.

/RichardMRoss/

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

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DEC 09 2010

PCT LEGAL ADMINISTRATION

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

| | | |
|---|---|---|
| In re Application of | : | |
| GALEAZZI et al | : | |
| Application No.: 10/492,368 | : | DECISION ON PETITION |
| PCT Filing Date: September 9, 2002 | : | UNDER 37 CFR 1.78(a)(3) |
| Attorney Docket No.: PET-1973 | : | |

This is a decision on the petition under 37 CFR 1.78(a)(6), filed April 30, 2010, to accept an unintentionally delayed claim under 35 U.S.C. 120 for the benefit of priority to the prior-filed provisional application set forth in the application data sheet (ADS) filed concurrently with the instant petition.

The petition is **DISMISSED**.

A petition for acceptance of a late claim for priority under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(6) must be accompanied by:

(1) the reference required by 35 U.S.C. 119(e) and 37 CFR 1.78(a)(5)(i) of the prior-filed application, unless previously submitted;
(2) the surcharge set forth in 37 CFR 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The petition does not satisfy item (1) above. Specifically, the ADS improperly indicates that the present application is "A Provisional of" application number 60/331,572. An application cannot be a provisional of another application. Applicant may wish to refer to the fillable PDF version of the ADS which can be found at http://www.uspto.gov/forms/sb0014_fill.pdf and which identifies the acceptable types of continuity in a drop down menu. It is further noted that the ADS filed on April 30, 2010 contains an improper foreign priority claim to the international application. Since the present national stage application is merely a different stage of the same

international application, it would not be proper for the present application to, in effect, claim priority to itself.

Before the petition under 37 CFR 1.78(a)(3) can be granted, a renewed petition and either a supplemental ADS (37 CFR 1.76(a)(5)) or a proper amendment (complying with the provisions of 37 CFR 1.121) to correct the above matters are required. Applicant is advised that since the issue fee has already been paid in the present application, entry of an ADS or amendment at this time is not permitted. See 37 CFR 1.312 and MPEP 201.11, p. 200-67, bottom right column. Accordingly, applicant may wish to consider filing an appropriate petition under 37 CFR 1.313(c)(2) along with a request for continued examination under 37 CFR 1.114.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

BryanLin

Bryan Lin
Legal Examiner
Office of PCT Legal Administration
(571) 272-3303

UNITED STATES PATENT AND TRADEMARK OFFICE

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**2200 CLARENDON BLVD.**
**SUITE 1400**
**ARLINGTON VA 22201**

**MAILED**

JAN 05 2011

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Renaud Galeazzi et al | : | |
| Application No. 10/492,368 | : | DECISION GRANTING PETITION |
| Filed: April 12, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. PET-1973 | : | |

This is a decision on the petition filed January 3, 2011, which is properly being treated under 37 CFR 1.313(c)(2), to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on June 9, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 1797 for processing of the request for continued examination under 37 CFR 1.114. The Petition to Accept Unintentionally Delayed Claim of Priority will be considered by the Office of PCT Legal.

/Karen Creasy/
Karen Creasy
Petitions Examiner
Office of Petitions

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

| Doc Code: PET.AUTO<br>Document Description: Petition automatically granted by EFS-Web | PTO/SB/140<br>U.S. Patent and Trademark Office<br>Department of Commerce |
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| | |
|---|---|
| Electronic Petition Request | **PETITION TO WITHDRAW AN APPLICATION FROM ISSUE AFTER PAYMENT OF THE ISSUE FEE UNDER 37 CFR 1.313(c)** |
| Application Number | 10492387 |
| Filing Date | 09-Apr-2004 |
| First Named Inventor | Christian Guion |
| Art Unit | 3694 |
| Examiner Name | JOHN ANDERSON |
| Attorney Docket Number | 71.03961 |
| Title | BILLING METHOD AND DEVICE IN A CELLULAR PACKET RADIOCOMMUNICATION NETWORK |

An application may be withdrawn from issue for further action upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary.

APPLICANT HEREBY PETITIONS TO WITHDRAW THIS APPLICATION FROM ISSUE UNDER 37 CFR 1.313(c).

A grantable petition requires the following items:
(1) Petition fee; and
(2) One of the following reasons:
(a) Unpatentability of one or more claims, which must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;
(b) Consideration of a request for continued examination in compliance with § 1.114 (for a utility or plant application only); or
(c) Express abandonment of the application. Such express abandonment may be in favor of a continuing application, but not a CPA under 37 CFR 1.53(d).

Petition Fee

- ☐ Applicant claims SMALL ENTITY status. See 37 CFR 1.27.
- ☐ Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).
- ☐ Applicant(s) status remains as SMALL ENTITY.
- ☒ Applicant(s) status remains as other than SMALL ENTITY

Reason for withdrawal from issue

○ One or more claims are unpatentable

◉ Consideration of a request for continued examination (RCE) (List of Required Documents and Fees)

○ Applicant hereby expressly abandons the instant application (any attorney/agent signing for this reason must have power of attorney pursuant to 37 CFR 1.32(b)).

RCE request,submission, and fee.

☐ I certify, in accordance with 37 CFR 1.4(d)(4) that : The RCE request ,submission, and fee have already been filed in the above-identified application on

☒ Are attached.

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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 who has been given power of attorney in this application.

○ An attorney or agent registered to practice before the Patent and Trademark Office, acting in a representative capacity.

○ A sole inventor

○ A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors

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

○ The assignee of record of the entire interest that has properly made itself of record pursuant to 37 CFR 3.71

| | |
|---|---|
| Signature | /Pehr B. Jansson/ |
| Name | Pehr B. Jansson |
| Registration Number | 35759 |

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

Decision Date : February 22, 2012

In re Application of :

Christian Guion

DECISION ON PETITION

UNDER CFR 1.313(c)(2)

Application No : 10492387

Filed : 09-Apr-2004

Attorney Docket No : 71.03961

This is an electronic decision on the petition under 37 CFR 1.313(c)(2), filed February 22, 2012 , to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

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

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

This application file is being referred to Technology Center AU 3694 for processing of the request for continuing examination under 37 CFR 1.114 .

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

WYETH LLC
PATENT LAW GROUP
5 GIRALDA FARMS
MADISON NJ 07940

**MAILED**
MAR 13 2012
**OFFICE OF PETITIONS**

In re Patent No. 8,101,194 :
Issue Date: January 24, 2012 :
Application No. 10/492,427 : ON PETITION
Filed: October 7, 2004 :
Attorney Docket No. **PC55647B** :

This is a decision on the petition filed February 23, 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**.

Petitioner states that the correct assignee's name is "Wyeth Holdings Corporation" and that the incorrect assignee's name was included on the Fee(s) Transmittal form PTOL-85(b) at the time of payment of the issue fee. Accordingly, petitioner requests that a certificate of correction be issued to reflect the correct assignee on the front page of the Letters Patent in the patent to be issued from the application.

As authorized, the $130 fee for the petition under 37 CFR 1.381(b) has been assessed to petitioner's deposit account.

Telephone inquiries concerning this decision may be directed to the JoAnne Burke at (571) 272-4584. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

JoAnne Burke
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and 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
www.uspto.gov

Gregory J Lavorgna
Drinker Biddle & Realth
One Logan Square
18th and Cherry Streets
Philadelphia PA 19103

| | | |
|---|---|---|
| In re Patent No. 7,271,814 | : | |
| Issued: September 18, 2007 | : | |
| Application No. 10/492,472 | : | NOTICE |
| Filed: April 12, 2004 | : | |
| Attorney Docket No. 195825 (45584-1) | : | |

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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Gregory J Lavorgna
Drinker Biddle & Realth
One Logan Square
18th and Cherry Streets
Philadelphia PA 19103

MAILED
MAR 08 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,271,814 | : | |
| Issued: September 18, 2007 | : | |
| Application No. 10/492,472 | : | NOTICE |
| Filed: April 12, 2004 | : | |
| Attorney Docket No. 195825 (45584-1) | : | |

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
www.uspto.gov

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

**MAILED**

OCT 06 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,745,699 | : | DECISION ON REQUEST |
| Nakajima et al. | : | FOR |
| Issue Date: 06/29/2010 | : | RECONSIDERATION OF |
| Application No. 10/492,928 | : | PATENT TERM ADJUSTMENT |
| Filing or 371(c) Date: 04/19/2004 | : | |
| Atty Docket No. | : | |
| 023174-0110 | : | |

This is a decision on the petition filed on July 12, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by seven hundred twenty-five (725) days.

The petition to correct the patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. § 154(b) of five hundred seventy-two (572) days.

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on April 20, 2007, the day after the date three years after the date the application commenced the national stage under 35 U.S.C. 371, and ends on February 4, 2009, the day before the RCE was filed, and is 657 days. See 35 U.S.C. 154(b)(1)(B)(i). Any time consumed by appellate review, however, is not included in the calculation of 37 CFR 1.702(b). See 35 U.S.C. 154(b)(1)(B)(ii). On September 5, 2008, a notice of appeal was filed. On February 5, 2009, the RCE was filed. Accordingly, the excluded period for appeal is 153 days, and the "B" delay period is 504 (657 – 153) days.

Accordingly, no change will be made to the patent term adjustment of 572 (444 days Office delay + 504 days three years delay – 376 days of applicant delay) days indicated on the face of the issued patent.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under

35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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

GREGORY TUROCY
AMIN & TUROCY
24TH FLOOR, NATIONAL CITY CENTER
1900 EAST 9TH STREET
CLEVELAND OH 44114

MAILED

AUG 08 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Horres, et al. | : | |
| Application No. 10/493,157 | : | ON PETITION |
| Filed: April 15, 2004 | : | |
| Attorney Docket No. ARTHP106US | : | |

This is a decision on the petition to revive under 37 CFR 1.137(b), filed July 21, 2011.

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

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is due on renewed petition. This is **not** a final agency decision within the meaning of 5 USC 704.

The above-identified application became abandoned for failure to timely file a reply in response to the non-final Office action mailed May 20, 2008. This Office action set a shortened statutory period for reply of three months. No reply having been received, the application became abandoned on August 21, 2008. The Office mailed a Notice of Abandonment on February 26, 2009.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d).

The instant petition does not meet requirement (3) above.

As the instant application has been abandoned for an extended period of time, petitioner must account for the delay in filing the petition to revive.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

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

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

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

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

cc: Gregory Turocy
57th Floor
127 Public Square
Cleveland, Ohio 44114

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

TUROCY & WATSON LLP
127 PUBLIC SQUARE
57TH FLOOR, KEY TOWER
CLEVELAND OH 44114

MAILED
OCT 12 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Horres, et al. | : | |
| Application No. 10/493,157 | : | ON PETITION |
| Filed: April 15, 2004 | : | |
| Attorney Docket No. ARTHP106US | : | |

This is a decision on the renewed petition to revive under 37 CFR 1.137(b), filed September 28, 2011.

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

The above-identified application became abandoned for failure to timely file a reply in response to the non-final Office action mailed May 20, 2008. This Office action set a shortened statutory period for reply of three months. No reply having been received, the application became abandoned on August 21, 2008. The Office mailed a Notice of Abandonment on February 26, 2009. Applicants filed a petition to revive under 37 CFR 1.137(b) on July 21, 2011. However, the petition was dismissed in a decision mailed on August 8, 2011. The decision requested that petition explain the extended delay between the mailing of the Notice of Abandonment and the filing of the petition to revive.

With the instant petition, petitioner has accounted for the delay. The other requirements for a grantable petition were previously satisfied with the petition filed on July 21, 2011. The application is being forwarded to Group Art Unit 1615 for

consideration of the Amendment, filed July 21, 2011.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/493,210 | 04/21/2004 | Markus Matuschek | 12810-00044-US | 6707 |

23416 7590 12/17/2010
CONNOLLY BOVE LODGE & HUTZ, LLP
P O BOX 2207
WILMINGTON, DE 19899

| EXAMINER |
|---|
| SAIDHA, TEKCHAND |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1652 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 12/17/2010 | 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.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20101213

**DATE** : December 13, 2010

**TO SPE OF** : ART UNIT 1652

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7314739

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:**

/JON P WEBER/
Supervisory Patent Examiner.Art Unit 1657

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.

**MAILED**

JAN 25 2011

**OFFICE OF PETITIONS**

MERCK
P O BOX 2000
RAHWAY NJ 07065-0907

| | |
|---|---|
| In re Patent No. 7169780 | : DECISION ON REQUEST |
| Crescenzi et al. | : FOR |
| Issue Date: 01/30/2007 | : RECONSIDERATION OF |
| Application No. 10/493280 | : PATENT TERM ADJUSTMENT |
| Filed: 04/20/2004 | : and |
| Atty Docket No. | : NOTICE OF INTENT TO ISSUE |
| ITR0034YP | : CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on January 27, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by three hundred forty-seven (347) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by three hundred forty-seven (347) days is **GRANTED**.

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

The Office thanks patentees for their good faith and candor in bringing this to the attention of the Office.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **three hundred forty-seven (347)** days.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,169,780 B2

DATED : **Jan. 30, 2007** **DRAFT**

INVENTOR(S) : Crescenzi et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 353 days.

Delete the phrase "by 353 days" and insert – by 347 days--

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

JUN 13 2011

OFFICE OF PETITIONS

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

In re Patent No. 7,936,779
Issued: May 3, 2011.
Application No. 10/493,658
Filing or 371(c) Date: October 29, 2004
Dkt. No.: 43315-203224

: DECISION ON APPLICATION FOR
: PATENT TERM ADJUSTMENT

This is a decision on the application for patent term adjustment under 37 CFR 1.705(d) filed on June 2, 2011 requesting an increase in patent term adjustment from 935 days to 1121 days.

The petition for reconsideration of the patent term adjustment is **DISMISSED**.

The above-identified application matured into U.S. Patent No. 7,936,779 on May 3, 2011. The patent issued with a patent term adjustment of 935 days. The instant application for patent term adjustment was timely filed June 2, 2011.

Patentees contest the determination of overlap between the periods of adjustment under 37 CFR 1.702(a) and 1.702(b). Patentees assert that the calculation of adjustment is the result of 802 days under 37 CFR 1.702(a) + 760 days under 37 CFR 1.702(b) - 308 days under 37 CFR 1.704 - 133 overlapping days.

The calculation of adjustment has been carefully reviewed and no error has been found. The period of adjustment under 37 CFR 1.702(a) is 802 days. The period of adjustment under 37 CFR 1.702(b) is 730. Considering the excluded period, the Office has determined that there are 319 days of overlap (from April 27, 2007 to March 10, 2008).

As patentees have not been granted the relief requested, no adjustment to the patent term will be made.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

Telephone inquiries specific to this matter 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

K&L GATES LLP
P.O. BOX 1135
CHICAGO, IL 60690

**MAILED**

**NOV 08 2010**

**OFFICE OF PETITIONS**

In re Application of
Rolf Muller et al
Application No. 10/493,684
Filed: September 29, 2004
Attorney Docket No. 3712161.00092

ON PETITION

This is a decision on the petition, filed November 4, 2010 under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

**Petitioner is advised that the issue fee paid on October 14, 2010 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 1623 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

/Irvin Dingle/
Irvin Dingle
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAILED
DEC 16 2010
OFFICE OF PETITIONS

**BUCHANAN, INGERSOLL & ROONEY PC**
**POST OFFICE BOX 1404**
**ALEXANDRIA VA 22313-1404**

| | | |
|---|---|---|
| In re Patent No. 7,396,614 | : | |
| Issue Date: July 8, 2008 | : | |
| Application No. 10/493,758 | : | ON PETITION |
| Filed: April 26, 2004 | : | |
| Attorney Docket No. 0070601-000002 | : | |

This is a decision on the petition filed December 2, 2009, 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) 272-3208. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No.

NOVARTIS
CORPORATE INTELLECTUAL
PROPERTY
ONE HEALTH PLAZA 101/2
EAST HANOVER NJ 07936-1080

MAILED
JUN 03 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Griffin et al. | : | DECISION ON APPLICATION |
| Application No. 10/493,786 | : | FOR |
| Filed: September 15, 2004 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. 4-32212A | : | |

This is a decision on the "APPLICANT FOR PATENT TERM ADJUSTMENT-PRE-GRANT," filed May 18, 2011. Applicants request that the initial determination of patent term adjustment be corrected from one hundred eighteen (118) days to two hundred twenty-six (226) days.

The application for patent term adjustment is **DISMISSED**.

On March 24, 2011, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 118 days. The instant application for patent term adjustment was timely filed[1]. Applicants maintain that the period of reduction in association with the filing of a response on September 17, 2007 is 92 days, not 200 days.

Applicants are incorrect. This period of reduction is properly calculated as 200 days pursuant to 37 C.F.R. 1.704(c)(7)(not 1.704(b)). 37 C.F.R. §1.704(c)(7) provides that:

> Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission

[1] PALM records indicate that the Issue Fee was received on May 18, 2011.

was filed and ending on the date that the reply or other paper correcting the omission was filed.

The reply was bona fide, but nonetheless reflected an omission and a Notice reflecting such was mailed pursuant to 1.135(c). Accordingly, pursuant to 37 C.F.R. § 1.704(c)(7), a period of reduction of 200 days is warranted for the period beginning on February 20, 2007 and ending on September 7, 2007, the date of filing of the response correcting the omission.

The initial determination of patent term adjustment at the time of the mailing of the notice of allowance remains one hundred eighteen (118) days.

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

The Office of Data Management has been advised of this decision. The application is thereby forwarded for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and if applicable, for the Office taking in excess of three years to issue the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson

Nancy Johnson
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| In re Patent No. 7,973,031 | : |
| Griffin et al. | : DECISION ON REQUEST FOR |
| Issue Date: July 5, 2011 | : RECONSIDERATION OF |
| Application No. 10/493,786 | : PATENT TERM ADJUSTMENT |
| Filed: September 15, 2004 | : |
| Attorney Docket No. 4-32212A | : |
| | : |
| | : |

This is a decision on the petition filed on August 31, 2011, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand six hundred forty (1640) days, or in the alternative, by nine hundred ninety-one (991) days.

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

Patentees' arguments have been considered, but not found persuasive. The calculation of delay pursuant to 37 CFR 1.702(b) is based on a national stage commencement date of April 30, 2004 Further, the period of delay, pursuant to 37 CFR 1.702(b), is counting beginning on the day after the date three years from the commencement date, April 31, 2007. Therefore, the patent term adjustment for B delay was properly calculated

as 601 days, beginning on May 1, 2007 and ending on December 21, 2008, the day before the date of the filing of the first request for continued examination (RCE).

The Office's calculation of "B delay" is correct. The "B delay" is an adjustment entered if the issuance of the patent was delayed due to the failure of the Office to issue a patent within three years after the date on which the application was filed. However, the adjustment does not include, among other things, any time consumed by continued examination of the application at the request of the applicant under 35 U.S.C. 132(b). So, with respect to calculating the "B delay" where applicant has filed a request for continued examination, the period of adjustment is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued, but not including the number of days in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. 132(b) was filed and ending on the date the patent was issued.

Further, counting the period of time excluded from the "B delay" for the filing of a request for continued examination under 35 U.S.C. 132(b), from the date on which the request for continued examination is filed to the date the patent is issued is proper. Patentee does not dispute that time consumed by continued examination of an application under 35 U.S.C. 132(b) is properly excluded and that the calculation of the excluded period begins on the date of filing of the request for continued examination. At issue is what further processing or examination beyond the date of filing of the request for continued examination is not any time consumed by continued examination of the application under 35 U.S.C. 132(b). The USPTO indicated in September of 2000 in the final rule to implement the patent term adjustment provisions of the AIPA that once a request for continued examination under 35 U.S.C. 132(b) and 37 CFR 1.114 is filed in an application, any further processing or examination of the application, including granting of a patent, is by virtue of the continued examination given to the application under 35 U.S.C. 132(b) and CFR 1.114. See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term*, 65 Fed. Reg. 56366, 56376 (Sept. 18, 2000) (response to comment 8). Thus, the

excluded period begins with the filing of the request for continued examination and ends with the issuance of the patent.

Patentee's implicit argument that the period of time after the issuance of a notice of allowance on each request for continued examination is not "any time consumed by continued examination requested by the applicant under section 132(b)" within the meaning of 35 U.S.C. 154(b)(1)(B)(i) is not availing. This limitation is not supported by the statutory language. Garcia v. United States, 469 U.S. 70, 75 (1984) ("only the most extraordinary showing of contrary intentions from [legislative history] would justify a limitation on the 'plain meaning' of the statutory language"). BP Am. Prod. Co. v. Burton, 549 U.S. 84, 91 (2006) ("Unless otherwise defined, statutory terms are generally interpreted in accordance with their ordinary meaning"). The statute provides for a guarantee of no more than 3-year application pendency, by providing for an adjustment in the patent term:

First, "Subject to the limitations of paragraph (2)," means that the limitations of paragraph 2 apply to this paragraph's adjustment of patent term. That is, the day-to-day extension of patent term for pendency beyond the 3 year period is restricted as follows: 1) "B delay" cannot accrue for days of "A delay" that overlap, 2) the patent term cannot be extended beyond disclaimed term, and 3) the period of adjustment, including accrued "B delay," will be reduced for applicant delay.

Second, "if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States," meaning that the condition must first occur that the issuance of an original patent (35 U.S.C. 153), not merely the issuance of a notice of allowance, is delayed due to the Office's failure to issue a patent (sign and record a patent grant in the name of the United States), not merely mail a notice of allowance, within 3 years after the actual filing date of the application in the United States. This provision gives the Office a three-year period to issue a patent (sign and record a patent grant in the name of the United States) after the application filing date before an adjustment will accrue for "B delay."

Third, "not including- (i) any time consumed by continued examination of the application requested by the applicant under

section 132(b); (ii) any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court; or (iii) any delay in the processing of the application by the United States Patent and Trademark Office requested by the applicant except as permitted by paragraph (3)(C), meaning that the three-year period does not include "any time consumed by" or "any delay in processing," as specified in clauses (i)-(iii). This language correlates to 35 U.S.C. 154(b)(1)(A) which likewise provides the basis for determining the period given the Office to take the specified actions before an adjustment will accrue for "A delay" (e.g., extended for 1 day after the day after the period specified in clauses (i)-(iv)).

Furthermore, these clauses are interpreted using their ordinary meanings. Nonetheless, the context of the legislation should be considered. As stated in Wyeth v. Dudas, 580 F.Supp.2d 138, 139, 88 U.S.P.Q.2d, 1538 (D.D.C. 2008), because the clock for calculating the 20-year patent term begins to run on the filing date, and not on the day the patent is actually granted, some of the effective term of a patent is consumed by the time it takes to prosecute the application. To mitigate this effect, the statute, inter alia, grants adjustments of patent term whenever the patent prosecution takes more than three years, regardless of the reason. The time consumed by prosecution of the application includes every day the application is pending before the Office from the actual filing date of the application in the United States until the date of issuance of the patent. The time it takes to prosecute the application ends not with the mailing of the notice of allowance, but with the issuance of the patent.

Thus, not including "any time consumed by" means not including any days used to prosecute the application as specified in clauses (i)-(ii) . Clause (i) specifies "any time consumed by continued examination of the application requested by the applicant under section 132(b)." Clause (ii) specifies "any time consumed by a proceeding under section 135(a), any time consumed by the imposition of an order under section 181, or any time consumed by appellate review by the Board of Patent Appeals and Interferences or by a Federal court." "Time" in the context of this legislation throughout refers to days. "Consumed by" means used by or used in the course of. Webster's

Collegiate Dictionary, (11th ed.). The "any" signifies that the days consumed by are "any" of the days in the pendency of the application, and not just days that occur after the application has been pending for 3 years. As such, "any time consumed by" refers to any days used in the course of 1) continued examination of the application under section 132(b)(the filing of a request for continued examination), 2) interference proceedings, 3) secrecy orders, and 4) appellate review. Thus, that 3-year period given to the Office to issue a patent before an adjustment will accrue for "B delay" does not include any days used in the course of or any time consumed by clauses (i)-(ii), including any time consumed by the filing of a request for continued examination.

Fourth, "the term of the patent shall be extended 1 day for each day after the end of that 3-year period until the patent is issued" meaning that the consequence of this failure is that after "the end of that 3-year period" an additional 1 day of patent term will accrue for each day that the application is pending until the day the patent is issued.
The "time consumed by" or used in the course of the continued examination of the application requested by the applicant under section 132(b) does not end until issuance of the patent. 35 U.S.C. 132(b) was enacted under the same title, the "American Inventors Protection Act of 1999," as 35 U.S.C. 154(b). Section 4403 of the AIPA amended 35 U.S.C. § 132 to provide, at the request of the applicant, for continued examination of an application for a fee (request for continued examination or RCE practice), without requiring the applicant to file a continuing application under 37 CFR 1.53(b) or a continued prosecution application (CPA) under 37 CFR 1.53(d). Thus, clause (i) is different from clause (ii) in that clause (i) refers to an examination process whereas clause (ii) refers to time consumed by proceedings (interferences, secrecy orders and appeals) in an application.

By nature, the time used in the course of the examination process continues to issuance of the patent. The examination process involves examining the application to ascertain whether it appears that the applicant is entitled to a patent under the law. See 35 U.S.C. 131 ("[t]he Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor"). If on examination it appears

that the applicant is entitled to a patent, the USPTO issues a notice of allowance. See 35 U.S.C. 151 ("[i]f it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant"). If on examination it appears that the applicant is not entitled to a patent, the USPTO issues a notice (an Office action) stating the applicable rejection, objection, or other requirement, with the reasons therefor. See 35 U.S.C. 132 ("[w]henever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application"). Neither the issuance of a notice of allowance nor the insurance of an Office action terminates the examination process. If after the issuance of an Office action under 35 U.S.C. 132 it subsequently appears that the applicant is entitled to a patent (e.g., in response to an argument or amendment by the applicant), the USPTO will issue a notice of allowance. Conversely, if after the issuance of a notice of allowance under 35 U.S.C. 151 it subsequently appears that the applicant is not entitled to a patent (e.g., in response to information provided by the applicant or uncovered by the USPTO), the USPTO will withdraw the application from issuance and issue an Office action under 35 U.S.C. 132 stating the applicable rejection, objection, or other requirement, with the reasons therefor.

As held in Blacklight Power, the USPTO's responsibility to issue a patent containing only patentable claims does not end with the issuance of a notice of allowance under 35 U.S.C. 151. See BlackLight Power, Inc. v. Rogan, 295 F.3d 1269, 1273 (Fed. Cir. 2002). Rather, if there is any substantial, reasonable ground within the knowledge or cognizance of the Director as to why an application should not issue, it is the USPTO's duty to refuse to issue the patent even if a notice of allowance has previously been issued for the application. See In re Drawbaugh, 9 App. D.C. 219, 240 (D.C. Cir 1896).

Moreover, the applicant continues to be engaged in the examination process after the mailing of the notice of allowance. 37 CFR 1.56 makes clear that the applicant has a duty to disclose information material to patentability as long as the application is pending before the USPTO (i.e., until a

patent is granted or the application is abandoned). See 37 CFR 1.56(a) ("[t]he duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned"). 37 CFR 1.97 and 1.98 provide for the consideration of information submitted by the applicant after a notice of allowance has been mailed. See 37 CFR 1.97(d). In addition, 37 CFR 1.312 provides for the amendment of an application after a notice of allowance has been mailed. In fact, the request for examination procedures permit the filing of a request for continued examination under 37 CFR 1.114 even after the issuance of a notice of allowance under 35 U.S.C. 151. See 37 CFR 1.114(a)(1).

As the examination process does not terminate with the mailing of the notice of allowance, the time consumed by continued examination requested by the applicant under section 132(b) does not terminate with the mailing of the notice of allowance. All the time the application is pending from the date of filing of the request for continued examination to the mailing of the notice of allowance through issuance of the patent is a consequence of the filing of the request for continued examination. Further action by the Office is pursuant to that request. Applicant has gotten further prosecution of the application without having to file a continuing application under 37 CFR 1.53(b).

All of the continued examination pursuant to the filing of the first request by the applicant is properly excluded from the delay attributed to the Office. 35 U.S.C. 154(b)(1)(B)'s guarantee of a total application pendency of no more than three years provides for adjustment of the patent term for delay due to the Office's failure to issue the patent within three years, but does not include "any time consumed by continued examination requested by the applicant under 35 U.S.C. 132(b)." It is not necessary to mitigate the effect on the 20-year term to the extent that applicant has requested that the Office continue to examine the application via a request for continued examination, in lieu of, the filing of a continuing application under 37 CFR 1.53(b).

In this instance, a request for continued examination was first filed on December 22, 2008, and the patent ultimately issued by virtue of that request on July 5, 2011. Pursuant to 35 U.S.C. 154(b)(1)(B)(i), the period beginning on December 22, 2008 and

ending on July 5, 2011 is not included in calculating Office delay.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required. The fee set forth in 37 CFR 1.18(e) is a requirement and will not be refunded.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

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|---|---|---|
| In re Patent No. 6,930,479 | : | |
| Issue Date: 16 August, 2005 | : | |
| Application No. 10/493,841 | : | DECISION ON PETITION |
| Filed: 28 April. 2004 | : | |
| Attorney Docket No. 904.0100.U1(US) | : | |

This is a decision on the petition filed on 13 February, 2012, 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 (as associated with the Customer Number) 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 associated with the Customer Number on the petition.

It is noted that Petitioner attempted to change the address of record, however, in the absence of the proper submission (*e.g.*, revocation/power of attorney, with a certificate pursuant to 37 C.F.R. §1. 3.73(b), which does not appear to be of record), all future correspondence is directed to the correspondence address of record.

(The Office raises this in particular due to Petitioner's averment that the address of record was not correct.)

Notably, the correspondence address may or may not be the Fee Address, and it is the Fee Address with which post-issue communications may be directed.

[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.

It is noted that Petitioner failed to include in the petition a mailing address or other contact information. The address set forth below (CC) was obtained from Office records for the Petitioner based upon Customer Number.

The petition pursuant to 37 C.F.R. §1.378(b) 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.

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. 6,930,479 (the '479 patent) issued on 16 August, 2005. The first maintenance fee could have been paid during the period from 16 August, 2008, through midnight 16 February, 2009, or, with a surcharge, during the period from 17 February, 2009, through midnight 16 August, 2009. Accordingly, the patent expired after midnight 16 August, 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 13 February, 2012.

## 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

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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)).

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]

Petitioner's Contentions
as to Unavoidable Delay

Petitioner Alan L. Stern (Reg. No. 59,071) sought relief on behalf of averred assignee pursuant to the regulations at 37 C.F.R. §1.378, averring unavoidable delay.

Patent No. 6,930,479 (the '479 patent) issued on 16 August, 2005. The first maintenance fee could have been paid during the period from 16 August, 2008, through midnight 16 February, 2009, or, with a surcharge, during the period from 17 February, 2009, through midnight 16 August, 2009. Accordingly, the patent expired after midnight 16 August, 2009, for failure to pay timely the first maintenance fee.

Petitioner filed of record with 64 pages of materials. On review of those materials, however, the content appeared to be:

- A five- (5) page petition by Petitioner, with a one- (1-) page transmittal;
- A three- (3-) page statement by Michelle Sullivan (Ms. Sullivan), who is unidentified at the outset of the statement other than "employed by Brown University since October 2007," but whose Email (Exhibit L) identifies her as an "IP Paralegal" and in Item 18 (page 3) of her statement as the only paralegal";[8]
- A two- (2-) page statement by Petitioner that does little more than outline some of his actions between 16 January, 2012, and 8 February, 2012;
- Some twenty-eight (28) pages (Exhibit A) purporting to be a copy of the '479 patent;
- A one- (1-) page change of correspondence address dated 14 June, 2007 (Exhibit B) over the signature of Harry Smith (Reg. No. 32,493) (Mr. Smith) at the office/law firm of Petitioner (Harrington and Smith LLP( Harrington Firm), 4 Research Dr., Shelton, CT 06484);

[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).
[8] Ms. Sullivan's statement, Item 18, page 3.

- A one- (1-) page copy of the two sides of the return receipt card (*see*: MPEP §503[9]) for the change of correspondence address (Exhibit C);

- Copies of six (6) pages of data from the Office website, to wit: Exhibits D (1 page) patent bibliography, E (1 page) file transaction history, F (2 pages) available documents, G (1 page) application correspondence address, and H (1 page) Ms. Cserr's registration data;

- Copies of what appear to be screen shots or the like from Ms. Cserr's website (10 pages: Exhibits I,J and K);

- A two- (2-) page Email exchange of 20 and 21 September, 2011, between Ms. Sullivan and someone identified only as Gail Conway at the Harrington Firm;

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[9] MPEP §503 provides in pertinent part:

**§503 Application Number and Filing Receipt**

* * *

A return postcard should be attached to *each* patent application for which a receipt is desired. It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO). It should be recognized that the identification of an application by application number does not necessarily signify that the USPTO has accepted the application as complete (37 C.F.R. §1.53(a)).

* * *

**RETURN POSTCARD**

If a receipt for any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. To ensure the receipt of return receipt postcards, users must either: (A) purchase already stamped postcards from the United States Postal Service (USPS) or affix postage stamps to their postcards; or (B) if a postage meter is used, ensure that the meter postmark does not show the date. Any return receipt postcard containing a dated meter postmark may not be delivered by the USPS to the address provided on the postcard. Users are reminded that they are solely responsible for placing the proper postage on self-addressed postcards that are submitted to the USPTO for the purpose of obtaining a receipt for correspondence being filed in the USPTO. Users should check with the USPS regarding postage and what size cards are acceptable to the USPS. Any return receipt postcard that does not contain sufficient postage or is not acceptable may not be delivered by the USPS to the address provided on the postcard, and, if returned to the USPTO, may be discarded.

The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which a receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as *prima facie*evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.

Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO.

>For acknowledgement receipt that is automatically and electronically sent to the person filing correspondence via the USPTO electronic filing system (EFS-Web), see MPEP § 502.05.< (Emphasis supplied.)

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- Three (3) more pages of Office website screen shots addressing the guidance at MPEP §2590;

- A two- (2-) page Google search result (Exhibit M) that in fact is an Email exchange of 17 and 21 September, 2011, between Ms. Sullivan and Ms. Cserr;

all for a total (6 plus 58) of 64 pages.

The essence of the matter, as presented by Petitioner, is that:

- The '479 patent issued in August of 2005;

- Brown University Research Foundation (Brown University) is the averred assignee of the '479 patent;[10]

- At an unspecified date in 2007 "Brown University assumed responsibility for payment of the maintenance fees for its US patents";[11]

- Thereafter, in June of 2007 an employee (identified as Luann Cserr (Ms. Cserr))—who was the Director of Intellectual Property of the averred assignee Brown University—allegedly changed the correspondence address to a Customer Number averred by Petitioner to be Ms. Cserr's address—notably, however, the supporting documentation evidences that the request for the change (Exhibit B) was made over the name and registration number of Harry Smith (Reg. No. 32,493) at the office/law firm of Petitioner (Harrington and Smith LLP, 4 Research Dr., Shelton, CT 06484) and the date-stamped ("JUN 21 2007") receipt card was in turn date-stamped ("JUN 25 2007") (Exhibit C) as received back at the law firm;

- "When Ms. Cserr was let go from Brown University on March 30, 2009, the parting was not amicable *per se*";[12]

- Petitioner complains that because of the change of address by Ms. Cserr, the assignee Brown University did not receive Notice of the expiration (what Petitioner improvidently describes as the "abandonment" of the '479 patent; [13]

- "From April to December 2009 [Ms. Sullivan] attempted to ascertain deadlines using the [Brown University database]. [She] found the system to be very unreliable." [14]

- The '479 patent went expired after midnight 16 August, 2009;

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[10] Petition, at page 3.
[11] Ms. Sullivan's statement, Item 2, page 1 (unnumbered).
[12] Petition, at page 4; Ms. Sullivan's statement, Item 2, page 1 (unnumbered).
[13] Petitioner, as one registered to practice before the Office, is well aware that the Office is under no obligation to Notice a patentee/assignee of maintenance fees due and/or patent expiration. The calendaring of such matters are the responsibility exclusively of the patentee/assignee.
[14] Petition, at page 4; Ms. Sullivan's statement, Item 4, page 1 (unnumbered).

- Ms. Sullivan "was unable to obtain from [the Office] a list of cases linked to the [C]ustomer [N]umber (55135) [that Ms. Sullivan averred] Ms. Cserr used for Brown University files (patents and patent applications) while employed by Brown University";[15]

- "In August 2009, Brown hired MS. KATHERINE GORDON as the Managing Director of the Technology Ventures Office. Ms. Gordon started in September 2009";[16]

- "Via an e-mail dated September 17, 2009, [Ms. Sullivan] asked Ms. Cserr to provide a list of cases associated with her attorney number. In an e-mail dated September 21, 2009, Ms. Cserr stated that she did not have the information";[17]

- "In November 2009, [Ms. Sullivan] e-mailed new guidelines to outside counsel requesting that they pay annuities unless instructed otherwise by Brown University";[18]

- "In December 2009, Brown University implemented a new database (Inteum) for tracking its patent portfolio. [Ms. Sullivan] e-mailed a request to outside counsel for docket reports";[19]

- "In September 2011, while conducting an audit of Brown University's license agreement[, Ms. Sullivan] learned that the '479 patent had gone [expired] due to nonpayment of maintenance fees. [She] further noticed that although the attorney/agent information listed MR. GERALD STANTON (of HARRINGTON & SMITH, ATTORNEYS AS LAW, LLC, [***]), the correspondence address was for CSERR PATENTS 7 STRATEGIC COUNSELING. *See Exhibit G.*";[20]

- "On September 20, 2011, [Ms. Sullivan] sent an e-mail to Harrington & Smith to inquire concerning revival [(sic)] of the '479 patent. I received a reply from MRS. GAIN CONWAY on September 21, 2011. *See Exhibit L.*";[21]

- "Between September 21, 2011[,] and January 13, 2012, [Ms. Sullivan] conducted thorough searches of all of [the Brown University] electronic correspondence dating back to Fall 2007, which was when [Ms. Sullivan] started working for Brown University. This search was further complicated due to a change of e-mail systems in Summer 2010. E-mail prior to that change was stored in archived files that needed to be obtained and separately searched";[22]

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[15] Petition, at page 4; Ms. Sullivan's statement, Item 5, page 1 (unnumbered).
[16] Ms. Sullivan's statement, Item 7, page 2.
[17] Ms. Sullivan's statement, Item 6, page 1 (unnumbered).
[18] Ms. Sullivan's statement, Item 8, page 2.
[19] Ms. Sullivan's statement, Item 9, page 2.
[20] Ms. Sullivan's statement, Item 10, page 2.
[21] Ms. Sullivan's statement, Item 11, page 2.
[22] Ms. Sullivan's statement, Item 12, page 2.

- "Also during the period of time from September 21, 2011[,] to January13, 2012, I had scheduled vacation time";[23]

- "Brown University was closed for Winter break from December 23, 2011[,] to January1, 2012";[24]

- Ms. Sullivan detailed in Items 15, 16 and 17 her communications about the instant matter with Petitioner on 19 and 31 January, 2012, and again on 3 February, 2012;[25]

- "The Brown University Technology Ventures Office, which manages all of the brown University invention disclosures, patent applications, patents and licensing, is very small. [Ms. Sullivan is] the only paralegal for the Office."[26]

There appear to have been no further statement(s) or documents from Petitioner, the assignee or any firm.

(A review of Office records as to assignments indicates an assignment recordation in 2004, prior to issue of the patent.)

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.

What is clear, however, is that assignee Brown University was aware at least as early April 2009—four (4) months before the '479 application went expired—that its docketing system was "very unreliable."[27] And, while

- Brown University hired Ms. Katherine Gordon as the Managing Director of the Technology Ventures Office in August, 2009 and Ms. Gordon started in September 2009,[28] and

- Ms. Sullivan was unable to obtain from Ms. Cserr in late September 2009 as list of cases associated with Ms. Cserr's attorney number,[29]

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[23] Ms. Sullivan's statement, Item 13, page 3.
[24] Ms. Sullivan's statement, Item 14, page 3.
[25] Ms. Sullivan's statement, Items 15, 16 and 17, page 3.
[26] Ms. Sullivan's statement, Item 18, page 3.
[27] Petition, at page 4; Ms. Sullivan's statement, Item 4, page 1 (unnumbered).
[28] Ms. Sullivan's statement, Item 7, page 2.
[29] Ms. Sullivan's statement, Item 6, page 1 (unnumbered).

it was not until September 2011 that an audit by Ms. Sullivan of Brown University's license agreement(s) that the expiration of the '479 patent was discovered.[30]

The Office will not characterize the actions and/or inactions of the assignee Brown University. The record submitted by assignee Brown University through Petitioner evidences that:

- In the presence of knowledge that "[w]hen Ms. Cserr was let go from Brown University on March 30, 2009, the parting was not amicable *per se*";[31]
- The recognition as early as April 2009 that the Brown University docketing system was "very unreliable";[32]
- Brown University was unable to obtain from Ms. Cserr in late September 2009 as list of cases associated with Ms. Cserr's attorney number;[33] and
- It was not until September 2011 that an audit by Ms. Sullivan of Brown University's license agreement(s) that the expiration of the '479 patent was discovered,[34] then

the diligence of assignee Brown University in the matter of the '479 patent was questionable at best.

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, as noted above 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.[35] 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.

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[30] Ms. Sullivan's statement, Item 10, page 2.
[31] Petition, at page 4; Ms. Sullivan's statement, Item 2, page 1 (unnumbered).
[32] Petition, at page 4; Ms. Sullivan's statement, Item 4, page 1 (unnumbered).
[33] Ms. Sullivan's statement, Item 6, page 1 (unnumbered).
[34] Ms. Sullivan's statement, Item 10, page 2.
[35] *See Commissariat A. L'Energie Atomique v. Watson*, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960).

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.[36]

This Petitioner and/ or assignee has/have not done.

At bottom, the question is one of diligence.[37]

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.[38] 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.[39] 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.[40]

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 <u>unavoidable</u> 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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[36] *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.*

[37] *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.*

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

[39] *Id.*

[40] *See* <u>Changes to Patent Practice and Procedure; Final Rule Notice</u>, 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.[41] 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.[42]

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.[43] (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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[41] *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).

[42] *Pratt, supra.*

[43] 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. 6,930,479
Application No. 10/493,841

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[44]) 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
29683
HARRINGTON & SMITH
4 RESEARCH DRIVE, SUITE 202
SHELTON, CT 06484-6212

[44] The regulations at 37 C.F.R. §1.2 provide:
**§1.2 Business to be transacted in writing.**
All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of Petitioners or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAILED
JUN 24 2011
OFFICE OF PETITIONS

**MORRISON & FOERSTER LLP**
**425 MARKET STREET**
**SAN FRANCISCO CA 94105-2482**

| | | |
|---|---|---|
| In re Application of<br>Larrick et al.<br>Application No. 10/493,909<br>Filed: July 21, 2005<br>Attorney Docket No. 415142000401 | :<br>:<br>:<br><br>:<br>: | DECISION ON PETITION<br>TO WITHDRAW FROM RECORD |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed May 24, 2011.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. The Office will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40 (c).

The request was signed by Michael R. Ward, on behalf of all attorneys/agents of record who are associated with Customer Number 20872.

All attorneys/agents associated with the Customer Number 20872 have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

All future correspondence will be directed to the assignee at the address indicated below.

Currently, there is an outstanding Office action mailed May 20, 2011 that requires a reply.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

/Joan Olszewski/
Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Planet Biotechnology, Inc.
25571 Clawiter Road
Hayward, CA 94545

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

JAN 12 2011

PCT LEGAL ADMINISTRATION

PEARL COHEN ZEDEK LATZER, LLP
1500 BROADWAY 12TH FLOOR
NEW YORK NY 10036

In re Application of:
BELLOMO, Stephen, E., et al.
U.S. Application No.: 10/494,244
PCT No.: PCT/IL02/00879
International Filing Date: 05 November 2002
Priority Date: 05 November 2001
Attorney's Docket No.: P-6687-US1
For: METHOD AND APPARATUS FOR PRODUCTION OF A SKIN GRAFT AND THE GRAFT PRODUCED THEREBY

DECISION ON REQUEST FOR CORRECTED FILING RECEIPT (37 CFR 1.181)

This decision is issued in response to applicants' "Request For Corrected Filing Receipt" filed on 30 August 2010, treated herein as a petition under 37 CFR 1.181 to correct the 35 U.S.C. 371(c) date for the present application. No petition fee is required.

## BACKGROUND

The procedural background for this application was set forth in previous decisions mailed 13 July 2004, 13 April 2006, 26 September 2006, 18 January 2007, and 02 March 2007.

The most recent decision, mailed 02 March 2007, granted applicants' request to correct inventorship under 37 CFR 1.497(d) and applicants' request for status under 37 CFR 1.42 with respect to deceased inventor Leonard I. GARFINKEL. The 02 March 2007 decision stated that the date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) for the present application was 04 January 2007, that is, the date on which applicants first filed herein complete, acceptable declarations executed by the ten surviving inventors and on behalf of the deceased inventor by his legal representative.

On 04 April 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Acceptance" (Form PCT/DO/EO/903) identifying the "Date Of Receipt Of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) Requirements" and the "Date Of Completion Of All 35 U.S.C. 371 Requirements" as 04 January 2007. Also on 04 April 2007, a filing receipt was issued that identified the 35 U.S.C. 371(c) date as 04 January 2007.

On 18 April 2007, applicants filed a "Request For Corrected Filing Receipt" requesting correction of the "Filing Date Or 371(c) Date" listed on the filing receipt.

On 30 August 2007, applicant filed a second "Request For Corrected Filing Receipt," again requesting correction of the "Filing Date Or 371(c) Date" listed on the filing receipt.

## DISCUSSION

Applicants' 30 August 2007 submission requests that the "Filing Date or 371(c) Date" listed on the filing receipt be corrected from 04 January 2007 to 05 November 2002, the international filing date of the international application upon which the present national stage application is based. Applicants' previous request to correct the filing receipt, filed 18 April 2007, requested that the "Filing Date or 371(c) Date" listed on the filing receipt be corrected to 03 May 2004, the date on which the materials initiating the present national stage application were first filed.

As explained in detail in MPEP section 1893.03(b), the "Filing Date or 371(c) Date" listed on the filing receipt in a national stage application filed under 35 U.S.C. 371 is the date of completion of the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4). As noted above and in the previous decision, the date of completion of the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) in the present application was 04 January 2007, the date on which the acceptable declarations satisfying the requirement of 35 U.S.C. 371(c)(4) were first filed. Thus, the filing receipt mailed on 04 April 2007 was correct in identifying the "Filing Date or 371(c) Date" as 04 January 2007, and applicants' request that this date be corrected to a date prior to the filing of the acceptable declaration is appropriately dismissed.

It is noted that, although the "Filing Date or 371(c) Date" listed on the filing receipt is the date of completion of the requirements of 35 U.S.C. 371(c)(1), (c)(2), and (c)(4), as stated in MPEP section 1893.03(b): "For most legal purposes, the filing date [in a national stage application filed under 35 U.S.C. 371] is the PCT international filing date."

## CONCLUSION

The petition to correct the "Filing Date or 371(c) Date" listed on the filing receipt from 04 January 2007 to an earlier date is **DISMISSED** without prejudice.

The Notification Of Acceptance and filing receipt mailed 04 April 2007 both properly identify the 35 U.S.C. 371(c) date herein as 04 January 2007, the date on which applicants filed the acceptable declarations required by 35 U.S.C. 371(c)(4).

/RichardMRoss/

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

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United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/494,505 | 05/04/2004 | Edouard Gendrot | P1047/20013 | 1331 |

3000 7590 03/21/2011
CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.
11TH FLOOR, SEVEN PENN CENTER
1635 MARKET STREET
PHILADELPHIA, PA 19103-2212

| EXAMINER |
|---|
| LOVE, TREVOR M |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1611 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 03/21/2011 | 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):

patents@crbcp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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COHEN & POKOTILOW, LTD.
11TH FLOOR, SEVEN PENN CENTER
1635 MARKET STREET
PHILADELPHIA PA 19103-2212

| | |
|---|---|
| In re Application of: | : |
| Gendrot et al. | : |
| Serial No.: 10/494,505 | : PETITION DECISION |
| Filed: May 4, 2004 | : |
| Attorney Docket No.: **P1047/20013** | : |

This is in response to the "request" filed February 14, 2011, which request is being treated as a petition under 37 CFR § 1.181, requesting withdrawal of the Office action of January 21, 2011.

BACKGROUND

Relevant parts of the prosecution history are summarized below.

The examiner mailed to applicants a non-final Office action on January 21, 2011. Claims 11-19, 24, 25, 27 and 28 were pending and claims 11-19, 24 and 25 were rejected. Claims 27-28 were withdrawn from consideration. Claims 11-16, 24, 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al (U.S. Patent number 6,287,596, Patent issued Sept. 11, 2001; filed July 10, 1997; Published (WIPO) Jan. 22, 1998) in view of Depui et al (U.S. Patent number 6,365,184, Patent issued Apr. 2, 2002, filed Dec. 23, 1999), Rudnic (Oral Solid Dosage Forms, 1990, pages 1633-1665) (previously of record), Shimizu et al (WO 99/59544, Published Nov. 25, 1999), and Estevenel et al(U.S. Patent number 3,922,338, Patent issued Nov. 25, 1975). Claims 11-16, 24, 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Murakami et al (U.S. Patent number 6,287,596, Patent issued Sept. 11, 2001; filed July 10, 1997; Published (WIPO) Jan. 22, 1998) in view of Depui et al (U.S. Patent number 6,365,184, Patent issued Apr. 2, 2002, filed Dec. 23, 1999), Rudnic (Oral Solid Dosage Forms, 1990, pages 1633-1665) (previously of record), Shimizu et al (WO 99/59544, Published Nov. 25, 1999), and Estevenel et al (U.S. Patent number 3,922,338, Patent issued Nov. 25, 1975) as applied to claims 11-16, 24, 25 above, and further in view of Hughes et al (U.S. Patent number 4,199,610, Patent issued Apr. 22, 1980).

In response thereto, applicants filed this petition on February 14, 2011 under 37 CFR § 1.181, requesting withdrawal of the Office action of January 21, 2011.

DISCUSSION

The petition and the file history have been carefully considered.

In the petition filed on February 14, 2011, applicants "...request that the Examiner withdraw the January 21, 2011 Office action for failure to evidence complete consideration and examination of all the pending and elected claims. In particular, no grounds are given for rejecting claims 17-19, even though the Office Action concludes with the statement that "No claims [are] allowed" and includes these claims within the list of claims identified as rejected on page 1. Pursuant to MPEP 710.06, Applicants respectfully request that the Examiner withdraw the January 21, 2011 Office Action, and issue a new Office Action with a new mailing date, in which all claim rejections are addressed in detail."

Applicant's points are well-taken and are persuasive that the Office action of January 21, 2011 is not clear.

**DECISION**

The petition is **GRANTED.**

The Office action mailed January 21, 2011 is hereby vacated and withdrawn. This application will be forwarded to the examiner to take an action consistent with the decision herein, namely issuance of a new and complete Office action wherein all claims are addressed in detail.

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.

Jacqueline Stone
Director, Technology Center 1600

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NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA VA 22304

**MAILED**

NOV 23 2010

**OFFICE OF PETITIONS**

In re Patent No. 6,981,484 :
Issue Date: January 3, 2006 :
Application No. 10/494,520 :
Filed: October 19, 2004 :
Attorney Docket No. GRIF0011UPCT-US :

ON PETITION

This is a decision on the petition under 37 CFR 1.378(c), filed September 20, 2010, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on January 4, 2010 for failure to pay the 3.5 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.

Pursuant to petitioner's request deposit account no. 50-2106 will be charged the $490.00 maintenance fee and the $1,640 surcharge.

There is no indication that the person signing the present petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the present petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted.

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

/Charlema Grant/

Charlema Grant
Petitions Attorney
Office of Petitions

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30 ROCKEFELLER PLAZA
44TH FLOOR
NEW YORK NY 10112-4498

**MAILED**
JUN. 15 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Shih-Fu Chang et al. | : | |
| Patent No. 7,339,992 | : | |
| Issued: March 4, 2008 | : | NOTICE |
| Application No. 10/494,739 | : | |
| Filed: May 8, 2004 | : | |
| Attorney Docket No. **00638643** | : | |

This is a notice regarding your request filed June 3, 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**.

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) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

17 SEP 2010

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David S. Resnick
NIXON PEABODY LLP
100 Summer Street
Boston, MA 02110-2131

In re Application of
CHILDREN'S MEDICAL CORPORATION
U.S. Patent No. 7790845 (formerly U.S. Application No. 10/494,783)
PCT No.: PCT/US2002/035395
Int. Filing Date: 05 November 2002
Priority Date: 08 November 2001
Attorney's Docket No.: 70103905171
For: BACTERIAL ION CHANNEL AND A METHOD FOR SCREENING ION CHANNEL MODULATORS

**DECISION**

This decision is in response to applicant's "Petition to Provide Missing Page from Published PCT Application" filed with the United States Receiving Office (RO/US) on 20 July 2010. This petition is considered under 37 CFR 1.181. No fee is required.

## BACKGROUND

On 05 November 2002, applicant filed the above-captioned international application with the RO/US claiming priority to a U.S. provisional application filed 08 November 2001.

On 27 November 2002, the record copy was forwarded by the RO/US to the International Bureau (IB).

On 15 May 2003, the IB published the subject application. However, sheet No. 49 of the description was missing from the published application.

On 06 May 2004, applicant filed U.S. application No. 10/494,783 as the national stage of PCT/US2002/035395.

On 20 July 2010, applicant filed the subject petition.

On 03 August 2010, a complete copy of the international application filed 05 November 2002 (including sheet No. 49 of the description) was placed in U.S. application No. 10/494,783.

On 07 September 2010, patent No 7790845 was issued from U.S. Application

No. 10/494,783. Sheet No. 49 of the description was included in the published patent.

## DISCUSSION

In the subject petition, applicant requests to have sheet (page) 49 of the specification in the subject international application (and missing from the international publication) be considered as part of the U.S. national phase application No. 10/494, 783 (now Patent No. 7790845).

A review of the documents filed with the RO/US on 05 November 2002 show that applicant originally submitted 55 sheets of the description (including sheet No. 49). However, the international publication omitted page 49 of the description.

This was a mistake. Sheet No. 49 of the description should have been included in the international publication and is part of the international application.

## CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**.

A copy of this decision will be placed in patent No 7790845 for the record.

This decision will be forwarded to the IB along with a copy of the missing sheet of the description.

James Thomson

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302

Atch: Sheet No. 49 of the Description for PCT/US2002/035395

cc: The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20
Switzerland

PCT/US02/35395

110. O'Leary, M.E., L.Q. Chen, R.G. Kallen, and R. Horn. 1995. A molecular link between activation and inactivation of sodium channels. J Gen Physiol. 106:641-658.

111. O'Reilly, J.P., S.Y. Wang, R.G. Kallen, and G.K. Wang. 1999. Comparison of slow inactivation in human heart and rat skeletal muscle Na+ channel chimaeras. J Physiol. 515 ( Pt 1):61-73.

112. O'Reilly, J.P., S.Y. Wang, and G.K. Wang. 2000. A point mutation in domain 4-segment 6 of the skeletal muscle sodium channel produces an atypical inactivation state. Biophys J. 78:773-784.

113. O'Reilly, J.P., S.Y. Wang, and G.K. Wang. 2001. Residue-specific effects on slow inactivation at V787 in D2-S6 of Na(v)1.4 sodium channels. Biophys J. 81:2100-2111.

114. Ostermeier, C., S. Iwata, B. Ludwig, and H. Michel. 1995. Fv fragment-mediated crystallization of the membrane protein bacterial cytochrome c oxidase. Nat Struct Biol. 2:842-846.

115. Papazian, D.M., and F. Bezanilla. 1999. Voltage-dependent activation of ion channels. Adv Neurol. 79:481-491.

116. Penzotti, J.L., H.A. Fozzard, G.M. Lipkind, and S.C. Dudley, Jr. 1998. Differences in saxitoxin and tetrodotoxin binding revealed by mutagenesis of the Na+ channel outer vestibule. Biophys J. 75:2647-2657.

117. Perez-Garcia, M.T., N. Chiamvimonvat, E. Marban, and G.F. Tomaselli. 1996. Structure of the sodium channel pore revealed by serial cysteine mutagenesis. Proc Natl Acad Sci U S A. 93:300-304.

118. Perez-Garcia, M.T., N. Chiamvimonvat, R. Ranjan, J.R. Balser, G.F. Tomaselli, and E. Marban. 1997. Mechanisms of sodium/calcium selectivity in

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

**MAILED**

DEC 06 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Ronald Erwin Boch, et al. | : | DECISION ON PETITION |
| Application No. 10/494,786 | : | TO WITHDRAW |
| Filed: December 15, 2004 | : | FROM RECORD |
| Attorney Docket No. **273012013600** | : | |

This is a decision on the request to withdraw as attorney of record under 37 CFR § 1.36, filed November 8, 2010.

The request is **NOT APPROVED**.

The request cannot be approved because it lacks a forwarding correspondence address of the first named inventor or a properly intervening assignee.

If the forwarding correspondence address is to the assignee, the Office will only accept correspondence address changes to the most current address information provided for the assignee of the entire interest *that properly became of record under 37 CFR 3.71.* 37 CFR 3.71(c) states:

> *An assignee becomes of record either in a national patent application or a reexamination proceeding by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee.*

The assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, the statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation pursuant to § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

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

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-2991.

Terri Johnson
Petitions Examiner
Office of Petitions

cc: **QLT INC.**
**887 GREAT NORTHERN WAY**
**SUITE 101**
**VANCOUVER, BC V5T 4T5**
**CANDA**

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SEP 02 2010

OFFICE OF PETITIONS

**NASA AMES RESEARCH CENTER**
**ATTN: PATENT COUNSEL**
**MAIL STOP 202A-4**
**MOFFETT FIELD CA 94035-1000**

| | | |
|---|---|---|
| In re Application of | : | |
| Jonathan D. Trent et al. | : | |
| Application No. 10/494,853 | : | DECISION ON PETITION |
| Filed: May 6, 2004 | : | |
| Attorney Docket No. ARC-14744-1 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed July 15, 2010, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before June 24, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed March 24, 2010. Accordingly, the date of abandonment of this application is June 25, 2010. A Notice of Abandonment was mailed on July 14, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $1,510 and the publication fee of $300, (2) the petition fee of $1,620, and (3) a proper statement of unintentional delay. Accordingly, the issue and publication fees are accepted as being unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 1656 for appropriate action by the Examiner in the normal course of business on the reply received July 15, 2010.

/Kimberly A. Inabinet/

Kimberly A. Inabinet
Petitions Examiner
Office of Petitions

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**5025 ADAMS AVENUE**
**SUITE 300**
**OGDEN UT 84403**

MAILED

MAY 18 2011

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| | | |
|---|---|---|
| In re Application of | : | |
| Clark H Gates, II | : | |
| Application No. 10/494,857 | : | DECISION ON PETITION |
| Filed: May 6, 2004 | : | |
| Attorney Docket No. PGATEC-EBPCT | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 4, 2011, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed December 21, 2009, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on February 22, 2009. See MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Appeal Brief, (2) the petition fee of $810, and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 3781 for appropriate action by the Examiner in the normal course of business on the reply received.

/Terri Johnson/
Terri Johnson/
Petitions Examiner
Office of Petitions

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

MAILED

AUG 22 2011

OFFICE OF PETITIONS

In re Patent No. 7,691,639 :
Issued: 04/06/2010 :
Application No. 10/494,906 : NOTICE
Filed: 09/07/2004 :
Attorney Docket No. 070538-0117 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed August 2, 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.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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Docket Administrator - Room 3D-201
Alcatel-Lucent USA Inc.
600-700 Mountain Avenue
Murray Hill NJ 07974-0636

MAILED
MAY 04 2011
OFFICE OF PETITIONS

In re Patent of Naim et al :
Patent No. 7,263,354 :
Issued: August 28, 2007 : NOTICE
Application Number: 10/494,912 :
Filed: May 7, 2004 :
Attorney Docket Number: 139378USPCT

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed April 12, 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) 272-3231.

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

CC: A J PEACH
DENNEMEYER & CO LTD
REGENT HOUSE HEATON LANE
STOCKPORT CHESHIRE
ENGLAND SK4 1BB

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Date Mailed : September 1, 2010

Serial no. : 10/495315
Patent No. : 7,236,234 B2
Patent Issued : June 26, 2007
Inventor(s) : Walter Hagleitner, et al.
Title :OPTICAL SENSOR ARRANGEMENT

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..

Respecting the alleged error(s) noted in your request, the office cannot issue a certificate of correction for the Patent Term Adjustment; you must file a petition under 37 C.F.R. 1.705.

In view of the foregoing your request in this matter is hereby denied.

Any request under 37 CFR 1.705. should be directed to the following address or facsimile number:

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

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

By fax: (571) 273-0025
ATTN: Office of Petitions

A certificate of correction will issue for the remaining errors noted in your request.

Magdalene Talley
For Mary F. Diggs, Supervisor
Decision and Certificate
Of Correction Branch
(571)272-0423

Walter F. Fasse
P.O. Box 726
Hampden, ME 04444-0726

MD/mt

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 11/02/11

**TO SPE OF** : ART UNIT 3754

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10495324 Patent No.: 7806297

**CofC mailroom date:** 10/28/11

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 Directors/SPE response to 571-273-3421*

**Note:** **Should the changes in the claims be approved?**

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.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

☒ **Approved** — **All** changes apply.

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

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

**Comments:** _____

_____

_____

_____

_____

Kevin Shaver — 3754

**SPE** — **Art Unit**

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**NEW YORK NY 10112-4498**

MAILED
DEC 21 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Shinichiro Hashimoto et al. | : | |
| Application No. 10/495,406 | : | DECISION ON PETITION |
| Filed: May 12, 2004 | : | |
| Attorney Docket No. A36239PCT USA-074224.0135 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 9, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliant Amendment mailed February 19, 2010, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on March 20, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1,620, and (3) a proper statement of unintentional delay. Accordingly the amendment is accepted as being unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 3635 for appropriate action by the Examiner in the normal course of business on the reply received November 9, 2010.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

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**GREENBLUM & BERNSTEIN, P.L.C.**
**1950 ROLAND CLARKE PLACE**
**RESTON VA 20191**

MAILED

SEP 22 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Fujio Hirano | : | |
| Application No. 10/495,434 | : | DECISION ON PETITION |
| Filed: May 24, 2004 | : | |
| Attorney Docket No. P25385 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 23, to revive the above-identified application and a decision on the petition to expedite under 37 CFR 1.182 filed August 31, 2010.

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

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

This application became abandoned as a result of petitioner's failure to file an reply brief within two (2) months of the Examiner's Answer of November 12, 2008. No extensions of time are allowed under the provisions of 37 CFR 1.136(a) and none were obtained under 1.136(b). As stated in MPEP 1215.04, the application became abandoned at midnight, on January 12, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a reply, (2) the petition fee of $1,620, and (3) a proper statement of unintentional delay.

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

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

This application is being referred to Technology Center AU 1795 for appropriate action by the Examiner in the normal course of business on the reply received.

/Terri Johnson/
Terri Johnson
Petitions Examiner
Office of Petitions

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1950 ROLAND CLARKE PLACE
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MAILED

AUG 04 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,410,980 | : | DECISION ON REQUEST |
| Uchida et al. | : | FOR |
| Issue Date: August 12, 2008 | : | RECONSIDERATION OF |
| Application No. 10/495,437 | : | PATENT TERM ADJUSTMENT |
| Filed: July 1, 2005 | : | and |
| Atty Docket No. IP-0216-US | : | NOTICE OF INTENT TO ISSUE |
| (01-00020) | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on January 27, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by six hundred six (606) days.

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

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.** The patent term adjustment is corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand one hundred eighty-eight **(1188)** days.

This is an international application. In an international application, the 1.702(b) period is based on the failure of the Office to issue a patent within three years after the national stage commenced under 35 U.S.C. 371(b) or (f). See 1.702(b). The priority date of this application is November 29, 2001. As the requirements for early commencement were not met, the national stage commenced in this application at the end of the thirty-month period. Further, as the expiration of the 30-month period pursuant to 35 U.S.C. 371(b) fell on a Saturday, the period expired on the subsequent business day. See PCT Rule 80.5. Accordingly, the commencement date is Tuesday, June 1, 2004 (Monday, May 31, 2004 was a federal holiday). Thus, the over 3 year period is 893 days, counting the number of days beginning on June 2, 2007, the day after the date three years

after the national stage commenced under 35 U.S.C. 371(b) and ending on November 10, 2009, the date of issuance of the patent. Further, a Notice of Appeal was filed on March 20, 2008 and on April 8, 2008, a notice of allowance was sent. The 20 days of the over three year period consumed by appellate review, beginning on March 20, 2008 and ending on April 8, 2008, is not included in the "B" delay. *See* 35 U.S.C. § 154(b)(1)(B)(ii). Thus, the "B" delay is 873 (893 - 20) days.

In view thereof, the patent term adjustment is increased by 873 days to 1188 days.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e).

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

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand one hundred eighty-eight (1188) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,410,980 B2

DATED : **August 12, 2008** **DRAFT**

INVENTOR(S) : Uchida et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 356 days

Delete the phrase "by 356 days" and insert – by 1188 days--

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.

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON VA 20191

MAILED

OCT 01 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,410,980 | : | |
| Uchida et al. | : | |
| Issue Date: August 12, 2008 | : | COMMUNICATION REGARDING |
| Application No. 10/495,437 | : | ISSUANCE OF |
| Filed: July 1, 2005 | : | CERTIFICATE OF CORRECTION |
| Atty Docket No. IP-0216-US | : | |
| (01-00020) | : | |

This is in response to the communication filed on August 31, 2010, to correct an error in the draft certificate of correction issued with the decision of August 31, 2010.

The request is **GRANTED**.

By decision mailed August 4, 2010, the Office notified patentee that the patent term adjustment of three hundred fifteen (315) days indicated on the patent would be corrected to one thousand one hundred eighty-eight **(1188)** days. However, the draft certificate of correction mailed with the decision erred in correcting the patent term adjustment from "356 days" to "1188 days." Patentee requests correction of this error[1].

This request is timely filed within one month of the decision on patent term adjustment and notice of intent to issue certificate of correction. As discussed above, the relief requested is warranted.

---

[1] Pursuant to an earlier call from patentee, the undersigned entered a corrected certificate of correction in the record, the "COCIN" document dated August 12, 2010.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction correcting the patent term adjustment at issuance of three hundred fifteen (315) days. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand one hundred eighty-eight (1188) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,410,980 B2

DATED : **August 12, 2008** **DRAFT**

INVENTOR(S) : Uchida et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 315 days

Delete the phrase "by 315 days" and insert – by 1188 days--

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No. _____

DATE 11/2/09

TO SPE OF ART UNIT 2629 Lefkowitz, Sumati (SP)

SUBJECT Request for Certificate of Correction for Appl. No. 10/495588 Patent No. 7621760

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 it's 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 – 3D18-A
Pelm Location 7580

Certificates of Correction Branch
703-756-1571

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Please be assured to 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 ERRORS REQUESTED BY THE REQUEST FOR CERTIFICATE OF CORRECTION FILED 08/27/2009 ARE APPROVED. JUN / 07-18-2011

SPE 2629
SPE Art Unit

PTO/SB/ Rev. 1/08 U.S. DEPARTMENT OF COMMERCE 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) |
|---|---|---|---|---|
| 7038926 | 2006-05-02 | 10/495,624 | 2004-05-14 | 1054.0002 |

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

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 | /Ashok K. Mannava/ | Date (YYYY-MM-DD) | 2011-01-11 |
| Name | Ashok K. Mannava | Registration Number | 45301 |

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. 7038926
Issue Date: May 2,2006
Application No. 10495624
Filed: May 14,2004
Attorney Docket No. 955-1004

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

This is a decision on the electronic petition, filed January 11,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 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

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAILED
JAN 11 2012
OFFICE OF PETITIONS

NIXON PEABODY, LLP
300 S. RIVERSIDE PLAZA, 16TH FLOOR
CHICAGO, IL 60606-6613

In re Application of :
Paul Andrew Boustead, et al. :
Application No. 10/495,819 : ON PETITION
Filed: April 18, 2005 :
Attorney Docket No. S02-271/US :

This is a decision on the petition under 37 CFR 1.137(b), filed November 23, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for a failure to timely respond to a Notice to File Corrected Application Papers (Notice) mailed August 16, 2011. On October 31, 2011, a Notice of Abandonment was mailed. On November 23, 2011, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1,860; and (3) an adequate statement of unintentional delay.

The application is being referred to the Office of Data Management to be processed into a patent.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to processing as a patent should be directed to (571) 272-4200.

/ SDB/

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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FULBRIGHT & JAWORSKI L.L.P.
600 CONGRESS AVE.
SUITE 2400
AUSTIN, TX 78701

MAILED
SEP 29 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent of Ludwig Deml | : | DECISION ON REQUEST |
| Patent No. 7,659,058 | : | FOR RECONSIDERATION OF |
| Issue Date: February 9, 2010 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/495,843 | : | AND NOTICE OF INTENT TO |
| Filing Date: December 9, 2004 | : | ISSUE CERTIFICATE OF |
| Attorney Docket No. DEBE:036US | : | CORRECTION |

This is a decision on the request filed May 19, 2010, which asserts the correct patent term adjustment is six hundred sixty-two (662) days.

The request is **GRANTED to the extent indicated herein.**

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

No portion of this decision should be construed as a waiver of the requirement, set forth in 35 U.S.C. § 154(b)(4), that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. § 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The patent issued February 9, 2010. The patent included a patent term adjustment of 1,046 days.

Applicant filed a "Request for Reconsideration of Patent Term Adjustment in View of *Wyeth*" on March 25, 2010.

The Office issued a decision in response to the March 25, 2010 request on April 21, 2010. The decision stated the patent term adjustment is 513 days.

The instant request for reconsideration was timely filed on May 19, 2010. The instant request asserts the correct patent term adjustment is 662 days. Specifically, Applicant asserts the period

of delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") is 406 days, not 252 days, and asserts the period of delay under 35 U.S.C. § 154(b)(2)(C) ("Applicant Delay") is 152 days, not 147 days.

A review of the request indicates Applicant is including the time period consumed by appellate review as part of the period of B Delay. However, pursuant to 35 U.S.C. § 154(b)(1)(B)(ii), B Delay does not include any time period consumed by appellate review. Therefore, B Delay does not include the 154 days consumed by appellate review as a result of the Notice of Appeal filed January 28, 2008. In other words, the period of B Delay is 252 days, which is 406 days reduced by 154 days.

The Office issued a non-final Office action on April 17, 2007. Office computer records used to calculate patent term adjustment indicate a reply to the Office action was filed on September 12, 2007, which is three months and 147 days after the date the Office issued the non-final Office action. As a result, the Office entered a 147-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b). Applicant states a reply to the April 17, 2007 Office action was actually not filed until September 17, 2007, which is three months and 152 days after the date the Office issued the non-final Office action. Based on the prior facts, the request asserts the period of Applicant Delay should be changed from 147 days to 152 days. A review of the record indicates Applicant is correct and the Office agrees the proper period of Applicant Delay under 37 C.F.R. § 1.704(b) is 152 days, not 147 days.

In view of the prior discussion, the patent term adjustment is 508 days, which is sum of 408 days of delay under 35 U.S.C. § 154(b)(1)(A) and 252 days of B Delay reduced by 0 days of overlap between A Delay and B Delay and reduced by 152 days of Applicant Delay.

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

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the patent is extended or adjusted by **five hundred eight (508)** days.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**UNITED STATES PATENT AND TRADEMARK OFFICE**

# CERTIFICATE OF CORRECTION

| | | |
|---|---|---|
| PATENT NO. | : | 7,659,058 B2 |
| APPLICATION NO. | : | 10/495,843 |
| DATED | : | February 9, 2010 |
| INVENTOR(S) | : | Ludwig Deml |

**DRAFT**

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

On the Title page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 333 days.

Delete the phrase "by 333 days" and insert -- by 508 days--

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CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON MA 02110

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NOV 23 2010
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| | |
|---|---|
| In re Application of | : ON APPLICATION FOR |
| Chang, et al. | : PATENT TERM ADJUSTMENT |
| Application No. 10/495,889 | : |
| Filed: September 24, 2004 | : |
| Atty Docket No.50125/035002 | : |

This decision is in response to the "APPLICTION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705," filed September 22, 2010. This matter is being properly treated as an application for patent term adjustment pursuant to 37 CFR §1.705(b).

Applicants submit that the correct patent term adjustment to be indicated on the patent is one thousand four hundred twelve (1412) days, not five hundred forty (540) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction solely on the basis that the Office will take in excess of three years to issue this patent[1].

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent

[1] Applicants reference September 24, 2004 as the actual filing date upon which the 37 CFR 1.702(b) calculation is to be made. See p.4, petition. The over three year delay will, in this instance, be calculated based on the application commencement date, which is May 19, 2004. See 35 U.S.C. 371(b).

within 3 years. See § 1.702(b). This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected or even the filing date of the request for continued examination issuance date of the patent is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[2].

---

[2] For example, if an applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Pursuant to applicants' authorization, deposit account no. 03-2095 will be charged the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Doc Code: PET.RELIEF
Document Description: Certification and Request for Disaster Relief

PTO/SB/425 (03-11)

# CERTIFICATION AND REQUEST FOR RELIEF DUE TO EVENTS OF MARCH 11, 2011, IN JAPAN (Page 1 of 2)

| Nonprovisional Application Number or Control Number (if applicable): 10/495,902 | Patent Number (if applicable): |
|---|---|
| First Named Inventor: Toshiyuki MURAKAMI | Title of Invention: FREE CUTTING TOOL |

**APPLICANT/PATENTEE/REEXAMINATION PARTY HEREBY CERTIFIES AND REQUESTS THE FOLLOWING FOR THE ABOVE-IDENTIFIED APPLICATION/PATENT/REEXAMINATION PROCEEDING.**

1. FOR PATENT APPLICATIONS AND REEXAMINATION PROCEEDINGS PENDING IN THE USPTO AS OF MARCH 11, 2011, IN WHICH A COMMUNICATION FROM THE USPTO IS SOUGHT TO BE REMAILED:

   a. One or more inventors, an assignee, or a correspondence address (for the application/proceeding) is in an area of Japan affected by the earthquake and/or tsunami of March 11, 2011.

   b. A reply or response to an Office action (final, non-final, or other), a notice of allowance, or other Office notice (hereinafter collectively referred to as "Office communication") is outstanding on March 11, 2011.

   c. The statutory or non-statutory time period set for response has not yet expired.

   d. Withdrawal and reissuance of the Office communication is requested.

   e. It is acknowledged that if this request is not made within sufficient time so that withdrawal and reissuance of the Office communication occur prior to expiration of the statutory or non-statutory time period (as permitted to be extended under 37 CFR 1.136(a), or as extended under 37 CFR 1.550(c) or 1.956), this request may not be granted.

   f. The need for the reissuance of the Office communication was due to the effects of the earthquake and/or tsunami of March 11, 2011.

   g. This request is being sent via EFS-Web or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

2. FOR PATENTEES WHO WERE UNABLE TO TIMELY PAY A PATENT MAINTENANCE FEE DURING THE SIX-MONTH GRACE PERIOD FOLLOWING THE WINDOW TO PAY THE MAINTENANCE FEE:

   a. The original window of time to pay the maintenance fee without the surcharge required by 37 CFR 1.20(h) expired on or after March 11, 2011.

   b. The delay in paying the fee was due to the effects of the earthquake and/or tsunami of March 11, 2011.

   c. The USPTO is requested to *sua sponte* waive the surcharge in 37 CFR 1.20(h) for paying a maintenance fee during the six-month grace period following the window to pay the maintenance fee.

   d. This request and payment of the maintenance fee during the six-month grace period following the window to pay the maintenance fee is being mailed to: Director of the United States Patent and Trademark Office, Attn: Maintenance Fee, 2051 Jamieson Avenue, Suite 300, Alexandria, VA 22314; or being transmitted via facsimile to: 571-273-6500.

## CERTIFICATION AND REQUEST FOR RELIEF DUE TO EVENTS OF MARCH 11, 2011, IN JAPAN (Page 2 of 2)

3. FOR PATENTEES WHO NEED TO FILE A PETITION TO ACCEPT A DELAYED MAINTENANCE FEE PAYMENT UNDER 37 CFR 1.378(c):

   a. The maintenance fee payment was required to have been paid after March 10, 2011.

   b. A petition under 37 CFR 1.378(c) (using USPTO form PTO/SB/66 – Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c))) is being promptly filed accompanied by the applicable maintenance fee payment (but not the surcharge under 37 CFR 1.20(i)).

   c. The delay in payment of the maintenance fee was due to the effects of the earthquake and/or tsunami of March 11, 2011.

   d. The USPTO is requested to *sua sponte* waive the surcharge in 37 CFR 1.20(i) for accepting a delayed maintenance fee payment.

   e. It is acknowledged that the petition to accept a delayed maintenance fee payment under 37 CFR 1.378(c) must be filed by March 11, 2012, in order to be entitled to a waiver of the surcharge under 37 CFR 1.20(i).

   f. It is acknowledged that the petition to accept a delayed maintenance fee payment under 37 CFR 1.378(c) must be filed within twenty-four months from the expiration date of the patent. *See* 35 U.S.C 41(c).

   g. This request and the petition to accept a delayed maintenance fee payment under 37 CFR 1.378(c) is being submitted via EFS-Web or by mail directed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

4. FOR NONPROVISIONAL PATENT APPLICATIONS FILED WITHOUT AN EXECUTED OATH OR DECLARATION OR PAYMENT OF THE BASIC FILING FEE, SEARCH FEE, AND/OR EXAMINATION FEE:

   a. The nonprovisional patent application was filed on or after March 11, 2011, and prior to April 12, 2011.

   b. The late filing of the oath or declaration or the basic filing fee, search fee, or examination fee was due to the effects of the earthquake and/or tsunami of March 11, 2011.

   c. The USPTO is requested to *sua sponte* waive the surcharge set forth in 37 CFR 1.16(f) for the late filing of the oath or declaration or basic filing fee, search fee, and/or examination fee.

   d. This request, together with the executed oath or declaration or the basic filing fee, search fee, or examination fee, as well as the reply to the Notice to File Missing Parts, is being submitted via EFS-Web or by mail directed to Mail Stop Missing Parts, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

| | |
|---|---|
| Signature | Date April 27, 2011 |
| Name (Print/Typed) Richard S. Barth | Practitioner Registration Number 28,180 |

***Note:*** *Signatures of all the inventors, § 1.41(b) applicants, or assignees of record of the entire interest or their representative(s), or reexamination requesters at the appeal stage are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below*.*

☐ *Total of _____ forms are submitted.

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

**HOLTZ, HOLTZ, GOODMAN & CHICK PC**
**220 FIFTH AVENUE**
**16TH FLOOR**
**NEW YORK NY 10001-7708**

MAILED
APR 29 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Murakami et al. | : | |
| Application No. 10/495,902 | : | DECISION ON PETITION |
| Filed: October 12, 2004 | : | |
| Attorney Docket No. 04294/HG | : | |

This is a decision on the request filed April 27, 2011, seeking relief under the provisions of "Relief Available to Patent and Trademark Applicants, Patentees and Trademark Owners Affected by the Catastrophic Events of March 11, 2011 in Japan," 1365 Off. Gaz. Pat. Office 170 (April 19, 2011).

The request for relief is **GRANTED**.

In the above-identified application, an Office action was mailed on February 15, 2011. The instant petition was filed prior to the expiration of the period for reply and the certifications for granting of relief are considered to be met by the submission of the request.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

This application is being referred to the Technology Center, Art Unit 1734 for re-mailing the Office action of February 15, 2011. The period for reply will run from the mailing date of the Office action.

/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) |
|---|---|---|---|---|
| 7331301 | 2008-02-19 | 10496045 | 2004-12-10 | 4014-0002-B |

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

| 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 | /Lonnie D. Schnell/ | Date (YYYY-MM-DD) | 2012-03-26 |
| Name | Lonnie D. Schnell | | |
| Enter Reel and Frame Number | | Remove | |
| Reel Number | 016075 | Frame Number | 0076 |
| Enter Reel and Frame Number | | Remove | |
| Reel Number | 027882 | Frame Number | 0196 |
| 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. 7331301
Issue Date: February 19,2008
Application No. 10496045
Filed: December 10,2004
Attorney Docket No. 65008-045

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

This is a decision on the electronic petition, filed March 26,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 26,2012 .
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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Alexandria, VA 22313-1450
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Pearl Cohen Zedek Latzer, LLP
1500 Broadway
12th Floor
New York NY 10036

MAILED
SEP 09 2010
OFFICE OF PETITIONS

In re Patent No. 7,678,442 :
Issue Date: March 16, 2010 :
Application No. 10/496,048 : DECISION ON PETITION
Filed: September 2, 2004 :
Attorney Docket No. P-73925-US :

This is a decision on the Request To Issue Patent In Name Of Assignee Under 37 C.F.R. 3.81(b); Request For Certificate Of Correction, filed on July 19, 2010, requesting correction on the Title Page of the subject patent to identify the correct assignee's name and residence. The Requests are being treated as a Petition Under 37 CFR §3.81(b). A completed Certificate of Correction Form (PTO/SB/44) was submitted with Petition.

The petition under 37 CFR §3.81(b) is **GRANTED**.

Petitioner requests that the present Petition was submitted to correct the assignee's name and residence on the previously submitted PTOL-85B and such error was inadvertent. Accordingly, petitioner requests that a Certificate of Correction (PTO/SB/44) be issued to correct assignee's name and residence to the Title Page of the Letters Patent.

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

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

The requisite $100.00 fee (Fee Code 1811), as set forth under 37 CFR 1.20(a), and the requisite $130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), have been submitted. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR 3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the Form PTO/SB/44 submitted with Petition.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

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

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,678,442.

Cheryl Gibson-Baylor

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20110511

**DATE** : May 11, 2011

**TO SPE OF** : ART UNIT 1783

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7678442

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:**

/DAVID R SAMPLE/
Supervisory Patent Examiner.Art Unit 1783

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 2-15-11 **Paper No.:** _____

**TO SPE OF** : ART UNIT 1793

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/496,246 Patent No.: 7556668

**CofC mailroom date:** 2-8-11

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

**FOR IFW FILES:** Check drawings

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**

Ennis Yaub
**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:** Approved.
N. Mai
Examiner.

_____ **SPE**

1733 **Art Unit**

PAGE 3/3 * RCVD AT 11/30/2010 3:24:56 PM [Eastern Standard Time] * SVR:USPTO-EFXRF-6/3 * DNIS:2709990 * CSID:5712730200 * DURATION (mm-ss):00-50

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 11/28/10

**TO SPE OF** : ART UNIT 1644

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10496284 Patent No.: 7618629

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (C of C)**
**Randolph Square 9D40-D**
**Palm Location 7580**
[redacted]

*Lamonte Newsome*
**Certificates of Correction Branch**
**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:** _____

RAM R. SHUKLA, PH.D.
SUPERVISORY PATENT EXAMINER
SUPERVISOR

1644
**Art Unit**

PTOL-306 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

11/30/2010 16:22 5712730200 PAGE 03/03

| Issue Classification | Application/Control No. | Applicant(s)/Patent under Reexamination | |
|---|---|---|---|
| | 10/496,385 | FREDRIKSSON, SIMON | |
| | Examiner | Art Unit | |
| | FRANK LU | 1634 | |

# ISSUE CLASSIFICATION

| ORIGINAL | | | | | | CROSS REFERENCE(S) | | | | | | | |
|---|---|---|---|---|---|---|---|---|---|---|---|---|---|
| CLASS | | | | SUBCLASS | CLASS | SUBCLASS (ONE SUBCLASS PER BLOCK) | | | | | | | |
| 536 | | | | 23.1 | 536 | 24.3 | 24.33 | | | | | | |
| INTERNATIONAL CLASSIFICATION | | | | | 435 | 6 | 91.1 | 91.2 | 91.52 | 810 | | | |
| C | 0 | 7 | H | 21/02 | 436 | 94 | | | | | | | |
| C | 0 | 7 | H | 21/04 | | | | | | | | | |
| C | 1 | 2 | Q | 1/68 | | | | | | | | | |
| C | 1 | 2 | P | 19/34 | | | | | | | | | |
| G | 0 | 1 | N | 33/00 | | | | | | | | | |

| | | |
|---|---|---|
| (Assistant Examiner) (Date) | /Frank W Lu/ 4/15/2011 | Total Claims Allowed: 18 |
| (Legal Instruments Examiner) (Date) | (Primary Examiner) (Date) | O.G. Print Claim(s): 1 / O.G. Print Fig.: None |

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47

| Final | Original | Final | Original | Final | Original | Final | Original | Final | Original | Final | Original | Final | Original |
|---|---|---|---|---|---|---|---|---|---|---|---|---|---|
| | 1 | | 31 | | 61 | | 91 | | 121 | | 151 | | 181 |
| | 2 | | 32 | 17 | 62 | | 92 | | 122 | | 152 | | 182 |
| | 3 | | 33 | | 63 | | 93 | | 123 | | 153 | | 183 |
| | 4 | | 34 | | 64 | | 94 | | 124 | | 154 | | 184 |
| | 5 | | 35 | | 65 | | 95 | | 125 | | 155 | | 185 |
| | 6 | | 36 | | 66 | | 96 | | 126 | | 156 | | 186 |
| | 7 | | 37 | | 67 | | 97 | | 127 | | 157 | | 187 |
| | 8 | | 38 | | 68 | | 98 | | 128 | | 158 | | 188 |
| | 9 | | 39 | | 69 | | 99 | | 129 | | 159 | | 189 |
| | 10 | | 40 | | 70 | | 100 | | 130 | | 160 | | 190 |
| | 11 | 1 | 41 | | 71 | | 101 | | 131 | | 161 | | 191 |
| | 12 | 2 | 42 | | 72 | | 102 | | 132 | | 162 | | 192 |
| | 13 | 3 | 43 | | 73 | | 103 | | 133 | | 163 | | 193 |
| | 14 | 4 | 44 | | 74 | | 104 | | 134 | | 164 | | 194 |
| | 15 | 5 | 45 | | 75 | | 105 | | 135 | | 165 | | 195 |
| | 16 | 6 | 46 | | 76 | | 106 | | 136 | | 166 | | 196 |
| | 17 | | 47 | | 77 | | 107 | | 137 | | 167 | | 197 |
| | 18 | 7 | 48 | | 78 | | 108 | | 138 | | 168 | | 198 |
| | 19 | 8 | 49 | | 79 | | 109 | | 139 | | 169 | | 199 |
| | 20 | 9 | 50 | | 80 | | 110 | | 140 | | 170 | | 200 |
| | 21 | | 51 | | 81 | | 111 | | 141 | | 171 | | 201 |
| | 22 | 10 | 52 | | 82 | | 112 | | 142 | | 172 | | 202 |
| | 23 | 11 | 53 | | 83 | | 113 | | 143 | | 173 | | 203 |
| | 24 | 12 | 54 | | 84 | | 114 | | 144 | | 174 | | 204 |
| | 25 | 13 | 55 | | 85 | | 115 | | 145 | | 175 | | 205 |
| | 26 | 18 | 56 | | 86 | | 116 | | 146 | | 176 | | 206 |
| | 27 | | 57 | | 87 | | 117 | | 147 | | 177 | | 207 |
| | 28 | 14 | 58 | | 88 | | 118 | | 148 | | 178 | | 208 |
| | 29 | 15 | 59 | | 89 | | 119 | | 149 | | 179 | | 209 |
| | 30 | 16 | 60 | | 90 | | 120 | | 150 | | 180 | | 210 |

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MR. AND MRS. JOSE RODRIQUEZ
1108 SUGAR MAPLE DRIVE
GREENWOOD IN 46143

**MAILED**

MAR 24 2011

**OFFICE OF PETITIONS**

In re Application of
Jose Rodriguez et al.
Application No. 10/496,415
Filed: May 21, 2004
Title of Invention: **SYSTEM PROCESS AND LOGIC ELEMENT FOR PROVIDING AND MANAGING RECORD KEEPING APPLICATIONS**

ON PETITION

This is a decision on the petition filed February 18, 2011 to withdraw the holding of abandonment, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513. The petition is being treated under 37 CFR 1.181.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181," or, as explained in more detail below, "...under 37 CFR 1.137(a)" or (b). This is not a final agency decision.

This application became abandoned on December 22, 2010 after the applicant failed to pay the issue fee in response to the Notice of Allowance mailed September 21, 2010. Accordingly, a Notice of Abandonment was mailed January 5, 2011.

Petitioner, argues that the Notice of Allowance mailed September 21, 2010 was not received.

A review of the file reveals that the Notice of Allowance was mailed to the address of record on September 21, 2010, the same address to which the Notice of Abandonment was mailed. There doesn't appear to have been any irregularity in the mailing and there is no evidence presented to show that the Notice of Allowance wasn't received. In the absence of any irregularity in the mailing, there is a strong presumption that the Notice of Allowance was properly mailed to the address of record. This presumption may be overcome by a showing that the Notice of Allowance was not in fact received. The

showing required to establish the failure to receive an Office communication must include a statement from the inventor that the Office communication was not received and attesting to the fact that a search of the docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must also be attached to and referenced in petitioner's statement.[1]

It is understood that petitioner is prosecuting this application as a *pro se* inventor and that *pro se* applicants may not have as elaborate a docketing system as a law firm. This does not warrant a total waiver of the requirement of a showing that includes copies of docket records or an adequate proxy for such copies. A *pro se* applicant should have some written records evidencing receipt of communications from and mailing of communications to the Office available to provide proof of non-receipt. It is suggested that pro se applicants maintain a log of communications from and to the Office, with dates of receipt, due dates and mailing dates of responses and other papers filed noted. Furthermore, applicants may maintain entries on the file jackets noting these important dates. Absent such evidence, applicants may not be able to overcome the presumption that the correspondence was properly mailed and received at the correspondence address of record and thereafter, misplaced by applicants.

**ALTERNATIVE VENUE**

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(b),[2] which now provides that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b).

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[1]M.P.E.P. § 711.03(c); See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

[2]Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MR. AND MRS. JOSE RODRIQUEZ
1108 SUGAR MAPLE DRIVE
GREENWOOD IN 46143

MAILED

JUN 17 2011

OFFICE OF PETITIONS

In re Application of
Jose Rodriguez et al.
Application No. 10/496,415
Filed: May 21, 2004
Title of Invention: **SYSTEM PROCESS AND LOGIC ELEMENT FOR PROVIDING AND MANAGING RECORD KEEPING APPLICATIONS**

ON PETITION

This is a decision on the petition filed June 9, 2011 under 37 CFR 1.137(b),[1] to revive the above-identified application.

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

This application became abandoned on December 22, 2010 after the applicant failed to pay the issue fee in response to the Notice of Allowance mailed September 21, 2010. Accordingly, a Notice of Abandonment was mailed January 5, 2011.

The issue fee in the amount of $755.00 and the publication fee in the amount of $300 were paid on February 18, 2011. All other requirements of 37 CFR 1.137(b) having now been met, this matter is being referred to the Publishing Division to be processed into a patent.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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[1]Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

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Alexandria, VA 22313-1450
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**CORPORATE PATENT COUNSEL**
**PHILIPS ELECTRONICS NORTH AMERICA CORPORATION**
**P.O. BOX 3001**
**BRIARCLIFF MANOR NY 10510**

MAILED
JAN 03 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,054,243 | : | |
| Issue Date: May 30, 2006 | : | |
| Application No. 10/496,486 | : | ON PETITION |
| Filed: May 24, 2004 | : | |
| Attorney Docket No. NL 010881 | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed September 1, 2010, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on May 31, 2010 for failure to pay the first 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 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.

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

MAILED

AUG 12 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,608,750 | : | DECISION ON REQUEST |
| Akira et al. | : | FOR |
| Issue Date: October 27, 2009 | : | RECONSIDERATION OF |
| Application No. 10/496,501 | : | PATENT TERM ADJUSTMENT |
| Filed: July 28, 2004 | : | and |
| Atty Docket No. 024918-0116 | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on December 18, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by five hundred sixty-nine (569) days.

The petition to correct the patent term adjustment indicated on the above-identified patent is **GRANTED to the extent indicated herein.** The patent term adjustment is corrected to indicate that the term of the above-identified patent is extended or adjusted by **five hundred sixty-six (566)** days.

The "B" delay period is 318 days, not 321 days. The national stage commencement date of this application is Monday, May 24, 2004. The priority date of this application is November 22, 2001. As the requirements for early commencement were not met, the national stage commenced in this application at the end of the thirty-month period. As the expiration of the 30-month period pursuant to 35 U.S.C. 371(b) fell on a Saturday, the period expired on the subsequent business day. See PCT Rule 80.5. Accordingly, the commencement date is Monday, May 24, 2004. Thus, the over 3 year period is 318 days, counting the number of days beginning on May 25, 2007 and ending on April 6, 2008, the day *before* the date a request for continued examination was filed. See 35 U.S.C. § 154(b)(1)(B)(i).

However, patentee is correct that the Office miscalculated the period of Office delay pursuant to 37 CFR 1.702(a)(4) as 124 days rather than 129 days. A review of the record reveals that the issue fee payment was received and all outstanding requirements met as of February 20, 2009 and the patent issued on October 27, 2009, four months and 129 days later. Accordingly, the period of Office delay of 124 days has been removed and a period of Office delay of 129 days has been entered.

In view thereof, the patent term adjustment is increased by 318 days to a total of 566 (432 + 129 + 318 - 313) days.

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

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by five hundred sixty-six (566) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,608,750 B2

DATED : **October 27, 2009** **DRAFT**

INVENTOR(S) : Akira et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 243 days

Delete the phrase "by 243 days" and insert – by 566 days--

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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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**HOLLINGSWORTH & FUNK**
**8500 NORMANDALE LAKE BLVD, SUITE 320**
**MINNEAPOLIS MN 55437**

MAILED

AUG 23 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Juhani Tuovinen | : | |
| Application No. 10/496,601 | : | DECISION GRANTING PETITION |
| Filed: May 25, 2004 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. IHN.009.WUS | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed August 19, 2010, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on July 27, 2010 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

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

This application is being referred to Technology Center AU 2614 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

/Karen Creasy/
Karen Creasy
Petitions Examiner
Office of Petitions

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

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No.

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA VA 22304

MAILED

OCT 14 2010

OFFICE OF PETITIONS

In re Patent No. 7,025,036 :
Issue Date: April 11, 2006 :
Application No. 10/496,641 : DECISION ON PETITION
Filed: September 23, 2004 :
Atty Docket No.GRIF0012UPCT-US:

This is a decision on 37 CFR 1.378(c) REQUEST FOR ACCEPTANCE OF DELAYED PAYMENT OF MAINTENANCE FEE IN EXPIRED PATENT TO REINSTATE PATENT, filed September 21, 2010.

The petition is **GRANTED**.

The patent issued April 11, 2006. The grace period for paying the 3-½ year maintenance fee provided in 37 CFR 1.362(e) expired at midnight on April 11, 2010, with no payment received.

This petition was timely filed within twenty-four months after the expiration of the six-month grace period. As required, petitioner submitted with the petition the required maintenance fee, the surcharge for accepting an unintentionally delayed maintenance fee after expiration, and a statement that the delay in payment of the maintenance fee was unintentional. In addition, the facts and circumstances of the delay in filing the petition and in submitting the first maintenance were set forth. This showing is adequate to support a conclusion that the entire delay was unintentional.

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.

Telephone inquiries related to this decision may 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
www.uspto.gov

| | | |
|---|---|---|
| In re Patent No. | 7209497 | : |
| Issue Date: | April 24,2007 | |
| Application No. | 10497064 | :DECISION GRANTING PETITION |
| Filed: | November 18,2004 | :UNDER 37 CFR 1.378(c) |
| Attorney Docket No. | P-7653-US | : |

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 3.5 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.

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) |
|---|---|---|---|---|
| 7209497 | 2007-04-24 | 10497064 | 2004-11-18 | P-7653-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

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 | /Caleb Pollack, Reg. No. 37,912/ | Date (YYYY-MM-DD) | 2012-01-09 |
| Name | Caleb Pollack | Registration Number | 37912 |

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

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

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/497,127 | 09/30/2004 | Gabriel Heller | 2635-1-001 PCT/US | 6527 |

23565 7590 08/26/2010
KLAUBER & JACKSON
411 HACKENSACK AVENUE
HACKENSACK, NJ 07601

| EXAMINER |
|---|
| PHONGSVIRAJATI, POONSIN |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3686 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/26/2010 | 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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AUG 26 2010

KLAUBER & JACKSON
411 HACKENSACK AVENUE
HACKENSACK, NJ 07601

| | | |
|---|---|---|
| In re Application of<br>Gabriel Heller et al.<br>Application No. 10/497,127<br>Filed: September 30, 2004<br>For: METHODS AND APPARATUS FOR AUTOMATED INTERACTIVE MEDICAL MANAGEMENT | : | DECISION ON PETITION TO RESTART TIME PERIOD |

This is a decision in response to applicants' Renewed Petition received April 18, 2010.

The petition is **GRANTED**.

There is a strong presumption that Office communication properly addressed and delivered to the United States Postal Services, was in fact delivered to the addressee. An allegation that the Office communication was not received must be overcome by a showing that it was not received.

The showing required to establish non-receipt of an Office communication must include all of the following requirements:

(1) A statement from the practitioner stating the Office communication was not received by the practitioner;

(2) A statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and

(3) A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

A petition to restart the time period was filed on January 4, 2010. That petition was dismissed in a decision mailed on February 17, 2010 wherein it was held that the petitioner failed to comply with requirements (1), (2) and (3) above.

Applicant's renewed petition includes a statement from the practitioner stating that the Office communication was not received by the practitioner, a statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. Additionally, a copy of docket records showing all actions due by the firm of Klauber & Jackson with a due date of around September 30, 2009 was received.

The application is being forwarded to the Supervisory Legal Instruments Examiner with instructions to redate and remail the Office action of June 30, 2009 based on the reasoning in the case of *Delgar v. Schuyler*, 172 USPQ 513.

Wynn Coggins, Director
Patent Technology Center 3600
(571) 272-5350

WG/tl: 08/23/10

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.

RENNER OTTO BOISSELLE & SKLAR, LLP
1621 EUCLID AVENUE
NINETEENTH FLOOR
CLEVELAND OH 44115

MAILED
AUG 11 2010
OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7643831 | : |
| Jeffrey Wilson | : DECISION ON REQUEST |
| Issue Date: Jan. 5, 2010 | : TO WITHDRAW REQUEST FOR |
| Application No. 10/497,224 | : REQUEST FOR RECONSIDERATION |
| Filed: Jan. 18, 2005 | : OF PATENT TERM ADJUSTMENT |
| Attorney Docket No. | : |
| DYOUP0273US | : |

This is a decision in response to the "REPLY TO DECISION ON REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF WYETH," filed on April 29, 2010, which is treated as a petition under 37 CFR 1.705(d).

The petition is **DISMISSED**.

On January 5, 2010 the patent issued with a Patent Term Adjustment of 630 days. On March 30, 2010, patentees filed the subject Request for Recalculation of Patent Term Adjustment In View of *Wyeth*, and on April 21, 2010, the Request for Recalculation was granted, and the Patent Term Adjustment was revised to 481 days.

Patentee requests that the decision mailed on April 21, 2010 be vacated, and that the patent term adjustment remain as set forth on the face of the patent.

The Decision mailed on April 21, 2010, stated that patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. However, rather than file a timely request for reconsideration, patentee filed the subject request to withdraw the Request filed on March 30, 2010.

Patentees were not forced, but voluntarily filed the Request for Recalculation on March 30, 2010.[1] Further, if the recalculation results in fewer days of PTA, patentee cannot simply request

[1] See 75 Fed. Reg. 5043, 5044 (Feb. 1, 2010)(noting that the filing of a Request for Recalculation is an optional procedure).

that the old calculation be reinstituted, but must show how the USPTO erred in the recalculation.[2] Accordingly, the request must be dismissed.

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

[2] See *Questions and Answers related to Wyeth v. Kappos*, Question 24. http://www.uspto.gov/patents/law/aipa/pta/wyeth_faqs_20100422.pdf

UNITED STATES PATENT AND TRADEMARK OFFICE

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**DANN, DORFMAN, HERRELL & SKILLMAN**
**1601 MARKET STREET**
**SUITE 2400**
**PHILADELPHIA PA 19103-2307**

**MAILED**
AUG 11 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Jeffrey R. MUNK | : | |
| Application No. 10/497,255 | : | NOTICE UNDER 37 CFR. 1.28(c) |
| Filed: November 26, 2004 | : | |
| Patent No. 7,040,572 | : | |
| Issue Date: May 09, 2006 | | |
| Attorney Docket No. 1025-P03449US0 | | |

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

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

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

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

Inquiries related to this communication should be directed to Michelle R. Eason at (571) 272-4231.

Thurman K. Page
Petitions Examiner
Office of Petitions

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05 DEC 2005

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PAUL RAGUSA
BAKER BOTTS LLP
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

BAKER BOTTS LLP
RECEIVED
DEC 09 2005
065855.0302

In re Application of
CHARLES
Application No.: 10/497,269
PCT No.: PCT/US02/41068
Int. Filing Date: 23 December 2002
Priority Date: 11 January 2002
Attorney Docket No.: A34929-PCT-USA
(065855.03
For: METHOD AND SYSTEM FOR RAPIDLY PROJECTING AND FORECASTING PHARMACEUTICAL MARKET INFORMATION

DECISION

BAKER BOTTS LLP
05 DEC 12 PM 1:04
MJT

This decision is in response to applicants' submission filed via facsimile transmission in the United States Patent and Trademark Office (USPTO) on 26 October 2005.

**BACKGROUND**

On 23 December 2002, applicants filed international application PCT/US02/41068, which designated the U.S. and claimed a priority date of 11 January 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 24 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 12 July 2004 (11 July 2004 being a Sunday).

On 27 May 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date.

On 23 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that applicant must provide an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b). The NOTIFICATION set a two-month extendable period for reply.

On 19 September 2005, applicants submitted a petition under 37 CFR 1.137(b), which was accompanied by, *inter alia*, a declaration of inventors.

Docketed
2 15 12006 by
Non-ext.

On 14 October 2005, a decision was mailed dismissing applicants' petition under 37 CFR 1.137(b) without prejudice. Specifically, it was noted that the required reply, namely a declaration of the inventor in compliance with 37 CFR 1.497(a)-(b), had not been provided.

On 26 October 2005, the instant submission was filed via facsimile transmission. The submission included, *inter alia*, a copy of a request under PCT Rule 92bis filed in PCT/US02/41068 to change the name of the inventor from Paul Charles Paul to Paul Charles.

## DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), the declaration of inventors filed 19 September 2005 is still not in compliance with 37 CFR 1.497(a)-(b). Even assuming arguendo that applicant's name was changed in the international application to Paul Charles under PCT Rule 92bis, the declaration of the inventor still identifies him as Paul Richard Charles. Because this difference in names is more than a mere typographical error or a phonetic misspelling of applicant's legal name, a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of $400 as well as a statement from the inventor. This statement should set forth that he is a joint inventor of the subject matter of the present application and should set forth the circumstances surrounding the difference in names on the international application and the declaration.

As to item (2), applicant submitted the petition fee on 19 September 2005.

As to item (3), a grantable petition has not yet been filed.

## CONCLUSION

The petition under 37 CFR 1.137(b) is **DISMISSED**, without prejudice, for the reasons set forth above.

Applicant is hereby given the time limit of **TWO (2) MONTHS** from the mail date of this communication in order to file a proper response.

**Failure to timely file a proper response to this decision in a timely manner will result in abandonment of the application with regards to national stage prosecution in the United States.**

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

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

#6

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05 DEC 2005

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MAR 31 2011

PAUL RAGUSA
BAKER BOTTS LLP
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

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| In re Application of | : | DECISION |
| CHARLES | : | |
| Application No.: 10/497,269 | : | |
| PCT No.: PCT/US02/41068 | : | |
| Int. Filing Date: 23 December 2002 | : | |
| Priority Date: 11 January 2002 | : | |
| Attorney Docket No.: A34929-PCT-USA | : | |
| (065855.03 | : | |
| For: METHOD AND SYSTEM FOR RAPIDLY | : | |
| PROJECTING AND FORECASTING | : | |
| PHARMACEUTICAL MARKET INFORMATION | | |

This decision is in response to applicants' submission filed via facsimile transmission in the United States Patent and Trademark Office (USPTO) on 26 October 2005.

## BACKGROUND

On 23 December 2002, applicants filed international application PCT/US02/41068, which designated the U.S. and claimed a priority date of 11 January 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 24 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 12 July 2004 (11 July 2004 being a Sunday).

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On 19 September 2005, applicants submitted a petition under 37 CFR 1.137(b), which was accompanied by, *inter alia*, a declaration of inventors.

On 14 October 2005, a decision was mailed dismissing applicants' petition under 37 CFR 1.137(b) without prejudice. Specifically, it was noted that the required reply, namely a declaration of the inventor in compliance with 37 CFR 1.497(a)-(b), had not been provided.

On 26 October 2005, the instant submission was filed via facsimile transmission. The submission included, *inter alia*, a copy of a request under PCT Rule 92bis filed in PCT/US02/41068 to change the name of the inventor from Paul Charles Paul to Paul Charles.

## DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), the declaration of inventors filed 19 September 2005 is still not in compliance with 37 CFR 1.497(a)-(b). Even assuming arguendo that applicant's name was changed in the international application to Paul Charles under PCT Rule 92bis, the declaration of the inventor still identifies him as Paul Richard Charles. Because this difference in names is more than a mere typographical error or a phonetic misspelling of applicant's legal name, a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of $400 as well as a statement from the inventor. This statement should set forth that he is a joint inventor of the subject matter of the present application and should set forth the circumstances surrounding the difference in names on the international application and the declaration.

As to item (2), applicant submitted the petition fee on 19 September 2005.

As to item (3), a grantable petition has not yet been filed.

## CONCLUSION

The petition under 37 CFR 1.137(b) is **DISMISSED**, without prejudice, for the reasons set forth above.

Applicant is hereby given the time limit of **TWO (2) MONTHS** from the mail date of this communication in order to file a proper response.

**Failure to timely file a proper response to this decision in a timely manner will result in abandonment of the application with regards to national stage prosecution in the United States.**

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

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
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14 OCT 2005

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| In re Application of | : | DECISION |
| CHARLES | : | |
| Application No.: 10/497,269 | : | |
| PCT No.: PCT/US02/41068 | : | |
| Int. Filing Date: 23 December 2002 | : | |
| Priority Date: 11 January 2002 | : | |
| Attorney Docket No.: A34929-PCT-USA | : | |
| (065855.03 | : | |
| For: METHOD AND SYSTEM FOR RAPIDLY | : | |
| PROJECTING AND FORECASTING | : | |
| PHARMACEUTICAL MARKET INFORMATION | | |

BAKER BOTTS LLP
05 OCT 19 AM 11:05
MJT

This decision is in response to applicants' petition under 37 CFR 1.137(b) filed in the United States Patent and Trademark Office (USPTO) on 19 September 2005.

**BACKGROUND**

On 23 December 2002, applicants filed international application PCT/US02/41068, which designated the U.S. and claimed a priority date of 11 January 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 24 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 12 July 2004 (11 July 2004 being a Sunday).

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On 19 September 2005, applicants submitted the instant petition under 37 CFR 1.137(b), which was accompanied by, *inter alia*, a declaration of inventors.

Docketed
For 12 / 14 /2005 by HG

## DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), the declaration of inventors filed 19 September 2005 is not in compliance with 37 CFR 1.497(a)-(b). The sole inventor is identified in the international application as Paul Charles Paul while the declaration of inventors identifies him as Paul Richard Charles. Because this difference in names is more than a mere typographical error or a phonetic misspelling of applicant's legal name, a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of $400 as well as a statement from the inventor. This statement should set forth that he is a joint inventor of the subject matter of the present application and should set forth the circumstances surrounding the difference in names on the international application and the declaration.

As to item (2), applicant submitted the petition fee on 19 September 2005.

As to item (3), a grantable petition has not yet been filed.

## CONCLUSION

The petition under 37 CFR 1.137(b) is **DISMISSED**, without prejudice, for the reasons set forth above.

Applicant is hereby given the time limit of **TWO (2) MONTHS** from the mail date of this communication in order to file a proper response.

**Failure to timely file a proper response to this decision in a timely manner will result in abandonment of the application with regards to national stage prosecution in the United States.**

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14 OCT 2005

#9

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| In re Application of | : | DECISION |
| CHARLES | : | |
| Application No.: 10/497,269 | : | |
| PCT No.: PCT/US02/41068 | : | |
| Int. Filing Date: 23 December 2002 | : | |
| Priority Date: 11 January 2002 | : | |
| Attorney Docket No.: A34929-PCT-USA | : | |
| (065855.03 | : | |
| For: METHOD AND SYSTEM FOR RAPIDLY | : | |
| PROJECTING AND FORECASTING | : | |
| PHARMACEUTICAL MARKET INFORMATION | | |

This decision is in response to applicants' petition under 37 CFR 1.137(b) filed in the United States Patent and Trademark Office (USPTO) on 19 September 2005.

**BACKGROUND**

On 23 December 2002, applicants filed international application PCT/US02/41068, which designated the U.S. and claimed a priority date of 11 January 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 24 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 12 July 2004 (11 July 2004 being a Sunday).

On 27 May 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date.

On 23 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that applicant must provide an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b). The NOTIFICATION set a two-month extendable period for reply.

On 19 September 2005, applicants submitted the instant petition under 37 CFR 1.137(b), which was accompanied by, *inter alia*, a declaration of inventors.

## DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(2) The petition fee;
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), the declaration of inventors filed 19 September 2005 is not in compliance with 37 CFR 1.497(a)-(b). The sole inventor is identified in the international application as Paul Charles Paul while the declaration of inventors identifies him as Paul Richard Charles. Because this difference in names is more than a mere typographical error or a phonetic misspelling of applicant's legal name, a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of $400 as well as a statement from the inventor. This statement should set forth that he is a joint inventor of the subject matter of the present application and should set forth the circumstances surrounding the difference in names on the international application and the declaration.

As to item (2), applicant submitted the petition fee on 19 September 2005.

As to item (3), a grantable petition has not yet been filed.

## CONCLUSION

The petition under 37 CFR 1.137(b) is **DISMISSED**, without prejudice, for the reasons set forth above.

Applicant is hereby given the time limit of **TWO (2) MONTHS** from the mail date of this communication in order to file a proper response.

**Failure to timely file a proper response to this decision in a timely manner will result in abandonment of the application with regards to national stage prosecution in the United States.**

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

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty

Legal Administration
Telephone: (571) 272-3301
Facsimile: (571) 273-0459

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BAKER BOTTS LLP
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NEW YORK, NY 10112

In re Application of
CHARLES
Application No.: 10/497,269
PCT No.: PCT/US02/41068
Int. Filing Date: 23 December 2002
Priority Date: 11 January 2002
Attorney Docket No.: A34929-PCT-USA
(065855.03
For: METHOD AND SYSTEM FOR RAPIDLY PROJECTING AND FORECASTING PHARMACEUTICAL MARKET INFORMATION

DECISION

FOR J. Chen

This decision is in response to applicants' submission filed 03 January 2006, which has properly been treated as a petition under 37 CFR 1.182, and applicants' submission filed 21 September 2006.

## BACKGROUND

On 23 December 2002, applicants filed international application PCT/US02/41068, which designated the U.S. and claimed a priority date of 11 January 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 24 July 2003. The thirty-month period for paying the basic national fee in the United States expired at midnight on 12 July 2004 (11 July 2004 being a Sunday).

On 27 May 2004, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date.

On 23 September 2004, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that applicant must provide an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b). The NOTIFICATION set a two-month extendable period for reply.

CPI UPDATED
8/14/08 by ECC

On 19 September 2005, applicants submitted a petition under 37 CFR 1.137(b), which was accompanied by, *inter alia*, a declaration of inventors.

On 14 October 2005, a decision was mailed dismissing applicants' petition under 37 CFR 1.137(b) without prejudice. Specifically, it was noted that the required reply, namely a declaration of the inventor in compliance with 37 CFR 1.497(a)-(b), had not been provided.

On 26 October 2005, a submission was filed via facsimile transmission. The submission included, *inter alia*, a copy of a request under PCT Rule 92bis filed in PCT/US02/41068 to change the name of the inventor from Paul Charles Paul to Paul Charles.

On 05 December 2005, a decision was mailed dismissing without prejudice applicants' petition under 37 CFR 1.137(b). The decision indicated that even "assuming arguendo that applicant's name was changed in the international application to Paul Charles under PCT Rule 92bis, the declaration of the inventor still identifies him as Paul Richard Charles. Because this difference in names is more than a mere typographical error or a phonetic misspelling of applicant's legal name, a proper petition under 37 CFR 1.182 is required in order to resolve the matter. Such a petition must be accompanied by the requisite petition fee of $400 as well as a statement from the inventor. This statement should set forth that he is a joint inventor of the subject matter of the present application and should set forth the circumstances surrounding the difference in names on the international application and the declaration."

On 03 January 2006, applicants filed a submission including a declaration of Paul Richard Charles, a check in the amount of $400, and an authorization to charge any additional fees required to Deposit Account 02-4377. This submission has properly been treated as a petition under 37 CFR 1.182.

On 24 August 2006, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned as to the United States of America for failure to respond to the NOTIFICATION OF MISSING REQUIREMENTS mailed 23 September 2004 within the time period set therein.

On 21 September 2006, applicants filed an "OMNIBUS PETITION UNDER 37 CFR 1.181, 1.137(B), AND 1.182 TO: (1) WITHDRAW NOTICE OF ABANDONMENT; AND (2) CONFIRM APPLICANT'S NAME".

## DISCUSSION

Petition Under 37 CFR 1.182

As noted above, the submission filed 03 January 2006 has properly been treated as a petition under 37 CFR 1.182.

The submission purportedly included a check for the $400 petition fee. However, no indication has been found that the check was received by the USPTO. Accordingly, the petition fee has been charged to Deposit Account 02-4377. Thus, the petition fee has ben paid. The statement of Paul Richard Charles is accepted. The declaration of inventors filed 19 September 2005 is in compliance with 37 CFR 1.497(a)-(b).

Petition Under 37 CFR 1.137(b)

A petition to revive the present application under 37 CFR 1.137(b) must include:

(1) The required reply;

(2) The petition fee;

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

As to item (1), as noted above, the declaration of inventors filed 19 September 2005 is now in compliance with 37 CFR 1.497(a)-(b).

As to item (2), applicant submitted the petition fee on 19 September 2005.

As to item (3), the required statement has been provided.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate. Accordingly, the NOTIFICATION OF ABANDONMENT mailed 24 August 2006 is hereby VACATED.

Submission filed 21 September 2006

In view of applicants' submission filed 03 January 2006, the submission filed 21 September 2006 is moot.

**CONCLUSION**

The petition under 37 CFR 1.182 is **GRANTED** for the reasons set forth above.

The petition under 37 CFR 1.137(b) is **GRANTED** for the reasons set forth above.

The NOTIFICATION OF ABANDONMENT mailed 24 August 2006 is hereby VACATED for the reasons set forth above.

The submission filed 21 September 2006 is **MOOT** for the reasons set forth above.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web or if mailed should be addressed to Mail Stop PCT, Commissioner for Patents, Office

of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application.

/Daniel Stemmer/

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**YOUNG & THOMPSON**
**209 Madison Street**
**Suite 500**
**Alexandria VA 22314**

MAILED

OCT 22 2010

OFFICE OF PETITIONS

In re Application of :
Gakushi Aota :
Application No. 10/497,319 : ON PETITION
Filed: June 2, 2004 :
Attorney Docket No. 8071-1002 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 7, 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 final Office action mailed, January 6, 2010, which set a shortened statutory period for reply of three (3) months. A three month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on July 7, 2010. A Notice of Abandonment was mailed on August 9, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal, with the required fee of $270 (2) the petition fee of $810, and (3) a proper statement of unintentional delay. Accordingly, the Notice of Appeal is accepted as being unintentionally delayed.

**The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.**

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to the Board of Patent Appeals and Interferences for appropriate action in the normal course of business for processing of the Reply received September 7, 2010.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

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**OFFICE OF PETITIONS**

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| In re Patent No. 7,157,278 | : | |
| Issue Date: January 2, 2007 | : | |
| Application No. 10/497,508 | : | ON PETITION |
| Filed: June 3, 2004 | : | |
| Attorney Docket No. 56001/02062 | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed February 10, 2011, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on January 3, 2011 for failure to pay the first 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 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

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

MAILED
AUG 03 2010
OFFICE OF PETITIONS

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

This is a decision on the petition filed on May 12, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand, two hundred and fifteen (1,215) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand, two hundred and fifteen (1,215) days is **GRANTED**

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

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

The application is being forwarded to the Certificates of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by one thousand, two hundred and fifteen (1,215) days.

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

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**DRAFT COPY**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,582,778 B2

DATED : Sep. 1, 2009

INVENTOR(S) : Gaedicke et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (578) days

Delete the phrase "by 578 days" and insert – by 1,215 days--

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

| | | |
|---|---|---|
| In re Patent No. 7,653,389 | : | DECISION ON REQUEST |
| Eales, et al. | : | FOR |
| Issue Date: January 26, 2010 | : | RECONSIDERATION OF |
| Application No. 10/497,552 | : | PATENT TERM ADJUSTMENT |
| Filed: November 8, 2004 | : | and |
| Atty Docket No.084625-000400US | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on May 21, 2010, and in supplement on June 2, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by four hundred and sixty-four (464) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by four hundred and sixteen (416) days[1] is **GRANTED to the extent indicated herein.**

---

[1] The "B" delay period, before any period is excluded, is 501 days, not 362 days. Patentee calculated this period based on the date this application fulfilled the requirements of 35 U.S.C. 371. However, in an international application, this period is based on the failure of the Office to issue a patent within three years after the national stage commenced under 35 U.S.C. 371(b) or (f). See 1.702(b). The national stage commenced in this application on June 21, 2004. Thus, "B" delay is 501 days, counting the number of days beginning on June 22, 2007 and ending on November 3, 2008, the day before the date the Request for Continued Examination was filed. See 1.703(b).

37 CFR 1.703(b) indicates that the period of adjustment under 37 CFR 1.702(b) ("over three year period") is the number of days, if any, in the period beginning on the day after the date that is three years after the actual filing date of the application and ending on the date a patent was issued. 35 U.S.C. 154(b)(1)(B). However, 37 CFR 1.703(b) also sets forth the limitations on patent term adjustment specified in 35 U.S.C. 154(b)(1)(B)(i) and (ii). Specifically, 37 CFR 1.703(b)(4) provides that the period of adjustment of the term of a patent shall not include the period equal to the sum of the period of pendency consumed by appellate review under 35 U.S.C. 134, 141, 145, whether successful or unsuccessful (35 U.S.C. 154(b)(1)(B)(ii)).

Patentees failed to account for the filing of the notices of appeal on July 10, 2007 and October 20, 2008. The Office reminds patentee that the period consumed by appellate review, whether successful or not, is excluded from the calculation of B delay. See 35 U.S.C. 154(b)(1)(B)(ii). In this instance, the total period consumed by appellate review is 187 days, beginning on the date on which the notices of appeal to the Board of Patent Appeals and Interferences were filed, July 10, 2007, and October 20, 2008, respectively, and ending on the day the non-final Office action was mailed, December 27, 2007, and the day the Request for Continued Examination was mailed, November 4, 2008, respectively.[2] Accordingly, the patent term adjustment is 416 days (128 days of A delay + 314 days of B delay - 0 days of overlap - 26 days of applicant delay).

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

[2] It is noted that a Notice of Appeal was also filed on April 6, 2009. The appeal period noted henceforth from the April 6, 2009, was not considered in this patent term adjustment because this Notice of Appeal was filed after the conclusion of the over three year period which occurred on November 3, 2008, the day before the date the Request for Continued Examination was filed.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

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

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **four hundred and sixteen (416) days**.

Telephone inquiries specific to this matter should be directed to Kenya A. McLaughlin, Petitions Attorney at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**DRAFT COPY**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,653,389 B2

DATED : Jan. 26, 2010

INVENTOR(S) : Eales et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (476) days

Delete the phrase "by 476 days" and insert – by 416 days--

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) |
|---|---|---|---|---|
| 7051688 | 2006-05-30 | 10497646 | 2004-06-04 | MESS.2889 |

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

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 Smith-Hill/ | Date (YYYY-MM-DD) | 2011-03-29 |
| Name | John Smith-Hill | Registration Number | 27730 |

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. 7051688
Issue Date: May 30,2006
Application No. 10497646
Filed: June 4,2004
Attorney Docket No. MESS 2889

:

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

:

This is a decision on the electronic petition, filed March 29,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 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.

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
DEC 02 2010
OFFICE OF PETITIONS

THE FARRELL LAW FIRM, LLP
290 Broadhollow Road
Suite 210E
Melville NY 11747

| | | |
|---|---|---|
| In re Patent No. 7,153,541 | : | |
| Issue Date: December 26, 2006 | : | |
| Application No. 10/497,769 | : | DECISION ON PETITION |
| Filed: October 8, 2004 | : | |
| Attorney Docket No. 788-25 PCT US | : | |

This is a decision on the Request To Correct The Assignee Under 37 C.F.R. 1.323 And 3.81(b), filed September 24, 2010, which is being treated as a Petition Under 37 CFR §3.81(b), to accept the omission of both assignees' name and residence. A completed Certificate of Correction Form (PTO/SB/44) was submitted with Petition.

The petition under 37 CFR §3.81(b) is **GRANTED**.

Petitioner requests that the present Petition was submitted to add the omission of both assignees' name and residence on the previously submitted PTOL-85B. Accordingly, petitioner requests that a Certificate of Correction (PTO/SB/44) be issued to add both omitted assignees' name and residence to the Title Page of the Letters Patent.

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

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

The requisite $100.00 fee (Fee Code 1811), as set forth under 37 CFR 1.20(a), has been submitted. However, the $130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), was accompanied deposit account authorization to charge any required fees. As such, the fee has been charged as authorized. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR §3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the Form (PTO/SB/44) that accompanied the petition.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

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

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,153,541.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions

**Doc Code: PET.PTA.RCAL**
**Document Description: Request for Recalculation in view of Wyeth**

PTO/SB/131 (02-10)
Approved for use through 02/28/2011. OMB 0651-0020
U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH**

| | |
|---|---|
| Attorney Docket Number: 555255-012386 | |
| Application Number: 10/497,803 | Filing Date (or 371(b) or (f) Date): 06/03/2004 |
| Patent Number: 7,664,515 | Issue Date: 02/16/2010 |
| First Named Inventor: Mihal LAZARIDIS | |
| Title: ADVANCED USER INTERFACE OPERATIONS IN A DUAL-MODE WIRELESS DEVICE | |

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-*WYETH* INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

**Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

| | |
|---|---|
| Signature /John V. Biernacki/ | Date 08/13/2010 |
| Name (Print/Typed) John V. Biernacki | Registration Number 40511 |

***Note**: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below**.*

☑ *Total of 1 forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 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: 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.*

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.

# Instruction Sheet for: REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH**

(Not to be Submitted to the USPTO)

**This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A).**

**This form must be filed within 180 days of the day the patent was granted,** with the following exception:

> Patentees who received a decision from the USPTO under the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A) may file a request for reconsideration of that decision if such a request for reconsideration is filed within **two months** of the date of the decision (37 CFR 1.181(f)). If the patentee's sole basis for requesting reconsideration of the decision is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A), the request for reconsideration need only state that reconsideration is being requested in view of Wyeth (this form may be used for this purpose if it is filed within **two months** of the date of the decision from the USPTO).

**Do not use this form if the application has been allowed, but not yet issued as a patent.**

1. **For patents issued before March 2, 2010:** A request for reconsideration under 37 CFR 1.705(d) and the fee set forth in 37 CFR 1.18(e) are not required, provided that the patentee's sole basis for requesting recalculation of the PTA in the patent is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A) and this form is filed within 180 days of the day the patent was granted.

2. **For patents issued on or after March 2, 2010 (do not use this form):** Patentees seeking a revised PTA in a patent issued on or after March 2, 2010, must file a request for reconsideration under 37 CFR 1.705(d) that complies with the requirements of 37 CFR 1.705(b)(1) and (b)(2) within two months of the day the patent issued.

For more information, see "Notice Concerning Calculation of the Patent Term Adjustment With Respect to the Overlapping Delay Provision of 35 U.S.C. 154(b)(2)(A)" available on the USPTO Web site at http://www.uspto.gov/patents/law/notices/2010.jsp.

**Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

# 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.

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PATENT GROUP 2N
JONES DAY
NORTH POINT
901 LAKESIDE AVENUE
CLEVELAND, OH 44114

Mail Date: 08/23/2010

| | | |
|---|---|---|
| **Applicant** | : Mihal Lazaridis | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7664515 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/497,803 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/03/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **454** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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**NEIFELD IP LAW, PC**
**4813-B EISENHOWER AVENUE**
**ALEXANDRIA VA 22304**

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SEP 10 2010
OFFICE OF PETITIONS

In re Application of :
Tim Klapka et al. :
Application No. 10/497,852 : ON PETITION
Filed: June 7, 2004 :
Attorney Docket No. PIP-93-KLAP-US :

This is a decision on the petition filed March 25, 2010, which is being treated as a petition under 37 CFR 1.181 to review the decision of the Technology Center Director mailed July 21, 2009 and under 37 CFR 1.59 requesting that various Office communications and applicant responses, be expunged from the record.

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

The petition under 37 CFR 1.59 is **DENIED**.

In petitioner's statement of the relief requested, two requests are made. First, petitioner requests reinstatement of applicants' Appeal Brief filed December 6, 2008. Second, petitioner requests that three Office communications and three responses by applicants be "withdrawn" from consideration.

It would appear that petitioner is under the impression that by withdrawing the papers indicated, the Office would, in effect, turn back the examination process to the Appeal Brief filed December 6, 2008. Thus, the request to withdraw papers must be considered first.

As to the petition filed under 37 CFR 1.59:

Petitioner requests that the following papers be "withdrawn" from consideration:

Notice of Non-Compliant Appeal Brief, mailed April 16, 2009

The Non-Final Office action mailed April 21, 2009

The response to the Notice of Non-Compliant Brief, filed May 12, 2009

The Appeal Brief filed July 17, 2009

The Examiner's Answer mailed January 22, 2010

The Reply Brief filed March 3, 2010

The above listed papers, both the Office communications and the responses, were intended for the above identified application and are properly part of the application file. The only mechanism to withdraw them from consideration at this point in prosecution is to have them expunged from the file. Accordingly, the only way to consider petitioner's request is to treat is as a request to expunge papers under 37 CFR 1.59.

37 CFR 1.59 provides for the applicant's request for expungement of information in a patent application, other than the original papers upon which the filing date was granted. However, under the terms of the rule, petitioner "must ...establish to the satisfaction of the Director that the expungement of the information is appropriate..." See 37 CFR 1.59(b). Under the circumstances of this case, petitioner has not met his burden of proof.

The requested expungement of the contested Office communications would have the effect of vacating those actions. However, vacatur of an Office action is an extreme act and is appropriate only in exceptional situations such as where the examiner clearly lacked jurisdiction of the case at the time that the contested Office communication was issued. See Ex Parte Brunner, 1872 Dec. Comm'r Pat. 62, 63 (Comm'r Pat. 1872) (Commissioner vacating examiner's Office action which reopened prosecution as the examiner then lacked jurisdiction of the case). Merely because an applicant contends that a given action contains an improper rejection or requirement per se is not an adequate reason for removing that action in its entirety from the administrative record, but is merely the basis for seeking reconsideration of the action, see, e.g. 37 CFR 1.111(b).

The exchange of communications (Office actions and replies by the applicant) form the prosecution history of the issued patent, which is relied upon by the courts and the public to determine the scope and meaning of the patent. See, e.g., Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005). Therefore, the Office has a long-established practice of expunging information from the file record of an application only in very limited situations. Indeed, expungement of an Office communication would only be justified where that Office communication contained inappropriate statements that were not suitable for retention in the administrative record. *Cf.* 37 CFR 1.3, which requires that applicants must conduct their business with the USPTO with decorum and courtesy. Even where expungement is warranted for an Office communication, a redacted version is maintained in the file; only the offensive language is removed.

While petitioner may disagree with some of the contents of the contested Office communications, the USPTO has also long held that a mere difference in opinion does not warrant expungement of part or all of a contested communication from the file record. See e.g.,

Ex Parte Fox, 1910 Dec. Commissioner Pat. 123 (Comm'r Pat. 1910). The MPEP makes clear that the expungement of record information should occur in very limited situations. See MPEP § 724.05. That particular section of the MPEP and referenced-sections (e.g., MPEP § 724.02) address the following types of information as subject (or susceptible) to possible expungement:

1) trade secret information;
2) proprietary information;
3) protective order material;
4) unintentionally-submitted information; and
5) information submitted in a wrong application.

The above situations are the only known types of circumstances which have led to information expungement. Clearly none of the above apply here. Petitioner has not alleged that the contested Office communications include any trade secret, are proprietary in nature, are subject to a protective order, or contains language that is inconsistent with the USPTO's own requirement for courtesy and decorum in the written record. It is also evident that the information was not wrongly submitted, and the examiner had jurisdiction of the case at the time the contested communication was issued.

Likewise, applicants' listed responses to be removed from consideration are not seen to meet the above criteria for expungement based on information provided in the instant petition. Should petitioner consider the filed responses as unintentionally-submitted information, it should be noted that MPEP 724.05 II. (B) requires:

> It is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;

Petitioner made no such statement in the petition. There is no indication of any irreparable harm to the party that submitted the responses. Accordingly, no adequate basis is given or apparent for expunging the contested Office communications.

For the reasons given above, the petition under 37 CFR 1.59 to expunge the Office communications and responses identified in the petition, is **denied**.

The fee for a petition filed under 37 CFR 1.59 has been charged to petitioner's deposit account.

As to the petition filed under 37 CFR 1.181:

Petitioner requests reinstatement of the Appeal Brief filed December 6, 2008.
Petitioner's argument with respect to 37 CFR 41.31 is noted. However, petitioner's position that an amendment and an appeal can be filed in response to a second Office action is not well taken. Once an amendment is received from applicant the period for response is tolled and reexamination must occur, see 35 USC 132.

The rules, practices and procedures provide for a method of orderly examination of a patent application and despite his intentions otherwise, it would not be proper to file both a reply to an outstanding Office action in the form of an amendment under 37 CFR 1.111 and an appeal brief. Either one of these responses exclusive of the other would have been an appropriate response to the non-final action mailed July 25, 2008. It was not proper procedure to file both responses and reference is made to the TC Director's petition decision of July 21, 2009 for a discussion of this issue.

Since the request to withdraw from consideration (expunge) the various Office communications and applicants' responses filed after the December 6, 2008 Appeal Brief is dismissed, the Appeal Brief filed December 6, 2008 cannot be reinstated as it has been superseded by the Appeal Brief filed September 11, 2009 and the Reply Brief filed March 3, 2010.

For the reasons set forth above, the petition to reinstate the Appeal Brief filed December 6, 2008 is **denied**.

Petitioner raises the issue of loss of Patent Term Adjustment (PTA) on page 9 of the petition. The patent term adjustment consequences are a result of petitioner's actions during the prosecution of this application. Therefore, patent term adjustment issues are not a basis for granting the requested relief.

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

Robert W. Bahr
Acting Associate Commissioner
For Patent Examination Policy

ak/cf

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**Foley and Lardner, LLP**
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**Washington, DC 20007**

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| In re Application of | : | |
| Anthony Breslin et al. | : | |
| Application No. 10/497,908 | : | DECISION ON PETITION |
| Filed: April 18, 2005 | : | TO WITHDRAW |
| Attorney Docket No. 097158-0107 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 30, 2010.

The request is **moot because a revocation of power of attorney has been previously filed.**

A review of the file record indicates that the power of attorney to Stephen A. Bent and all attorneys/agents associated with customer number 22428 has been revoked by the assignee of the patent application on August 12, 2010. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to Kimberly Inabinet at 571-272-4618.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Gardere Wynne Sewell LLP
Intellectual Property Section
3000 Thanksgiving Tower
1601 Elm Street
Dallas, TX 75201-4761

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1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

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PCT LEGAL ADMINISTRATION

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|---|---|---|
| In re Application of | : | DECISION ON |
| SIRPA et al | : | |
| Application No.: 10/497,991 | : | |
| PCT No.: PCT/FI03/00010 | : | |
| Int. Filing Date: 08 January 2003 | : | PETITION UNDER |
| Priority Date: 09 January 2002 | : | |
| Attorney's Docket No.: P2006J047-US2 | : | |
| For: METHOD FOR MAKING SILICA SHAPED | : | |
| BODIES | : | 37 CFR 1.181 |

This Decision is in response to applicants' "PETITION UNDER 37 CFR 1.181 ....for PTO Error" filed on 13 September 2010, which requests corrections to the Electronic File Wrapper record.

The petition under 37 CFR 1.181 is **GRANTED** as follows:

A review of the application file record shows that on 08 June 2004, applicants filed a transmittal letter for entry into the national stage in the United States Patent and Trademark Office (USPTO), which was accompanied by, *inter alia*, an application data sheet identifying a domestic benefit claim to U.S. provisional application 60/346,288. As such, the benefit claim was timely submitted under 37 CFR 1.78(a).

The electronic file wrapper record has been corrected.

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

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|---|---|---|
| In re Application of<br>Gary M Katz et al.<br>Application No. 10/498,003<br>Filed: June 14, 2004<br>For: SYSTEM AND METHOD FOR PROVIDING RELATIVE PRICE POINT INCENTIVES BASED UPON PRIOR CUSTOMER PURCHASE BEHAVIOR | : | RESPONSE TO PETITION UNDER 37 CFR § 1.181(a) |

This is a response to the petition under 37 CFR § 1.181(a), filed October 29, 2009 to expunge, and if not expunge then withdraw, the improper notice of non-compliant amendment dated June 11, 2009 from the above identified application.

The petition is **GRANTED**

The record reflects that on June 11, 2009 a notice of non-compliant amendment was mailed, which stated "The Applicant needs to submit a clean amendment without any markings or underlines because the Amendment filed March 18, 2009 has so many corrections that the scanner is not able to scan the amendment without making too many errors. For further explanation of the amendment format required by 37 CFR 1.121, see MPEP 714."

On June 30, 2009, the applicant filed a clean amendment as requested by the examiner including an argument that "the amendment submitted March 18, 2009 is in compliance with 37 CFR 1.121 and MPEP 714, so the requirement in the notice of non-compliant amendment mailed June 11, 2009 is clearly not based upon lack of compliance with any rule, it is for the convenience of the USPTO."

On October 20, 2009 a final Office action was mailed which did not address the applicant's June 30, 2009 request that the USPTO acknowledge that the notice of non-compliant amendment mailed June 11, 2009 was improper.

On August 15, 2010 applicant submitted a supplemental appeal brief.

37 CFR 1.121(c) (2) see MPEP 714 clearly indicates that the text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. Thus, the amendment filed on

March 18, 2009 was in compliance with 37 CFR 1.121(c) (2). As such the notice of non-compliant amendment mailed June 11, 2009 is hereby withdrawn.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Lynda Jasmin at (571) 272-6782.

Wynn Coggins, Director
Patent Technology Center 3600
(571) 272-5150

lj/lm: 08/15/2010

LM

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**EDWARDS ANGELL PALMER & DODGE LLP**
**P.O. BOX 55874**
**BOSTON MA 02205**

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| | | |
|---|---|---|
| In re Application of | : | |
| Lawrence Hofmann | : | |
| Application No. 10/498,035 | : | DECISION ON PETITION |
| Filed: June 07, 2004 | : | |
| Attorney Docket No. **56381(71699)** | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 03, 2011, 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, September 11, 2009, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on December 12, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application under 37 CFR 1.53(b); (2) the petition fee of $810; and (3) a proper statement of unintentional delay.

This application is being revived solely for purposes of continuity. As continuity has been established by this decision, the application is again abandoned in favor of continuing application No. 13/040,126.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at (571) 272-2783.

Ramesh Krishnamurthy

Ramesh Krishnamurthy
Petitions Examiner
Office of Petitions

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**YOUNG & THOMPSON**
**209 Madison Street**
**Suite 500**
**Alexandria VA 22314**

| | | |
|---|---|---|
| In re Patent No. 6,993,928 | : | |
| Issue Date: February 7, 2006 | : | |
| Application No. 10/498,057 | : | ON PETITION |
| Filed: June 9, 2004 | : | |
| Attorney Docket No. 2450-1013 | : | |

This is a decision on the petition filed September 22, 2010, which will be treated as a petition 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 8, 2010, for failure to pay the three 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.

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

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OLIFF & BERRIDGE, PLC
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ALEXANDRIA VA 22320-4850

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JAN 25 2011

OFFICE OF PETITIONS

In re Patent No. 7,743,965 :
Issue Date: June 29, 2010 :
Application No. 10/498,115 : ON PETITION
Filed: June 9, 2004 :
Attorney Docket No. 120025 :

This is a decision on the petition filed November 5, 2010, 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) 272-3230. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

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MOLINS MICHAEL
MOLINS & CO.
SUITE 5 KEVEL 6
139 MACQUARIE STREET
SYDNEY NSW 2000 AU AUSTRALIA

| | | |
|---|---|---|
| In re Patent No. 7,053,769 | : | |
| Issue Date: May 30, 2006 | : | |
| Application No. 10/498,129 | : | ON PETITION |
| Filed: June 9, 2004 | : | |
| Patentee(s) David Vassallo | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed June 17, 2010, 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.

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 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.

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.

Inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Jay S. Cinamon
Abelman Frayne & Schwab
666 Third Avenue, 10th Floor
New York, NY 10017

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SUITE 3400
CHICAGO IL 60661

| | | |
|---|---|---|
| In re Patent No.7,915,831 | : | |
| Allitt, et al. | : | DECISION FOR REQUEST |
| Issue Date : March 29, 2011 | : | FOR RECONSIDERATION |
| Application No. 10/498,340 | : | OF PATENT TERM |
| Filed: December 2, 2004 | : | ADJUSTMENT |
| Attorney Docket No. 75144-011100 | : | |

This is a decision on the "Application for Reconsideration of the Patent Term Adjustment under 35 U.S.C. § 154(b) Indicated in the Patent (37 CFR 1.705(d))," filed May 27, 2011. Patentees request that the patent term adjustment indicated on the face of the Letters of Patent be corrected from two hundred and ninety-four (294) days to two hundred and ninety-five (295) days.

The request for reconsideration of the patent term adjustment under 37 CFR 1.705(d) is **DISMISSED**.

Patentees are given ONE (1) MONTH from the mail date of this decision to respond. No extension of time will be granted under 37 CFR 1.136.

On March 29, 2011, the above-identified application matured into U.S. Patent No. 7,915,831 with a revised patent term of 294 days. The instant petition under 37 CFR 1.705(d) was filed within two months of the issuance of the patent and is timely.

Patentees' assert that the Office's calculation of the "B" delay period is inaccurate because the "B" delay period was calculated beginning the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) and ending on the day before the date the Request for Continued Examination was filed. Patentees maintain that said period should end on the day the Request for Continued Examination was filed.

It is noted that 35 U.S.C. 154 authorizes the Director to establish the procedures for the application for and the determination of patent term adjustments. Those procedures include the calculation of the period of adjustment as set forth in 37 CFR 1.702(b) and 37 CFR 1.703(b). 35 U.S.C. § 154(b)(3) provides that the USPTO shall: (1) prescribe regulations establishing procedures for the application for and determination of patent term adjustments under 35 U.S.C. § 154(b); (2) make a determination of any patent term adjustment under 35 U.S.C. § 154(b) and transmit a notice of that determination with the notice of allowance under 35 U.S.C. § 151; and (3) provide the applicant one opportunity to request reconsideration of any patent term

adjustment determination. Pursuant to the mandate and authority in 35 U.S.C. § 154(b)(3), the USPTO promulgated 37 C.F.R. § 1.705, which provides that: (1) the notice of allowance will include notification of any patent term adjustment under 35 U.S.C. § 154(b)(37 C.F.R. § 1.705(a)); (2) any request for reconsideration of the patent term adjustment indicated in the notice of allowance (except as provided in 37 C.F.R. § 1.705(d)) must be by way of an application for patent term adjustment filed no later than the payment of the issue fee and accompanied by (inter alia) the fee set forth in 37 C.F.R. § 1.18(e)(37 C.F.R. § 1.705(b)); and (3) if the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued.

As such, it is evident that 35 U.S.C. 154 gives the USPTO rulemaking authority relative to the determination of patent term adjustments and the authority to implement and interpret said rules. Accordingly, 37 CFR 1.702(b) and 37 CFR 1.703(b)(1) is interpreted to mean that the period of adjustment to the patent term for failure to issue the patent within three years of after the date the application was filed under 35 U.S.C. 111(a) begins on the day after the date that is three years after the date on the which the application was filed under 35 U.S.C. 111(a), and ends on the day before the date the Request for Continued Examination was filed.

Accordingly, as the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on December 3, 2007, and ends on June 11, 2008, the day before the RCE was filed, and is 192 days.

In view thereof, no change to the revised patent term adjustment is warranted.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

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

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

By Mail: Mail Stop Petition
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
ATTN: Office of Petitions

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

Telephone inquiries specific to this matter 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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Alexandria, VA 22313-1450
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Robert D. Shedd, Patent Operations
THOMSON Licensing LLC
P.O. Box 5312
Princeton NJ 08543-5312

MAILED
APR 25 2011
OFFICE OF PETITIONS

In re Application of

Ramaswamy, et al.

Application No. 10/498,402

Filed: June 10, 2004

Attorney Docket No. PU010298

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 23, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to file a proper response to the final Office action mailed March 23, 2010. The final Office action set a shortened statutory period for reply of three months from its mailing date. No response was received and the application became abandoned on June 24, 2010. Notice of Abandonment was mailed on September 29, 2010.

The Request for Continued Examination filed March2 3, 2011, is noted.

The application file is being forwarded to Technology Center 2400, GAU 2472for further processing.

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

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**YOUNG & THOMPSON**
**209 MADISON STREET**
**SUITE 500**
**ALEXANDRIA, VA 22314**

MAILED

APR 08 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Tourrette et al. | : | DECISION ON PETITION |
| Application No. 10/498,492 | : | TO WITHDRAW |
| Filed: January 31, 2005 | : | FROM RECORD |
| Attorney Docket No. 0579-1045 | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed February 11, 2011.

The request is **NOT APPROVED**.

The Office strongly encourages practitioner(s) requesting withdrawal from representation as practitioner of record in an application to review the record to determine whether he or she is, in fact, of record and how he or she was made of record. For example, the practitioner(s) should determine whether he or she was appointed by naming each practitioner individually or through the use of a Customer Number.

In the instant application, the practitioner(s) were appointed via Customer Number however the request does not designate a Customer Number to be withdrawn by. The request was signed by Liam McDowell on behalf of all the practitioners (with registration numbers) of record listed on the attached papers.

Further, the Office will require the practitioner(s) to certify that he, she or they have: (1) given reasonable notice to the client, prior to the expiration of the reply period, which the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any replies that may be due and the time frame within which the client must respond, pursuant to 37 CFR 10.40(c).

The current request does not properly withdraw practitioners via Customer Number as it does not set forth all of the above certifications. Therefore, the request cannot be approved at this time. Any subsequent request must withdraw all associated practitioner(s) in the same manner as appointed and provide all of the above listed certifications pursuant to 37 CFR 10.40(c).

Petitioner should note, pursuant to the Official Gazette: Change in Procedure for Requests to Withdraw from Representation in a Patent Application, any Requests filed after a patent has issued will be placed in the file but will generally not be treated on their merits. Sections 2540 and 2542 of

the Manual of Patent Examining Procedure (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 file and to direct notices, receipts and other communications relating to maintenance fees. Sections 2540 and 2542 of the MPEP recommend the designation of a "fee address" or the submission of a change in the 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. The change in practice in this notice applies to Requests filed on or after May 12, 2008.

There are no outstanding Office actions that require a reply from the applicant.

All future communications from the Office will be directed to above-listed address until otherwise properly notified by the applicant or a proper change of correspondence address have been submitted.

A. Kelley

Alicia Kelley
Petitions Examiner
Office of Petitions

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**DANN, DORFMAN, HERRELL & SKILLMAN**
**1601 MARKET STREET**
**SUITE 2400**
**PHILADELPHIA PA 19103-2307**

MAILED

JAN 03 2011

OFFICE OF PETITIONS

In re Patent No. 7,077,378 :
Issue Date: July 18, 2006 :
Application No. 10/498,615 :
Filed: June 10, 2004 :
Attorney Docket No. 1025-P03462USO :

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 on August 27, 2010.

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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**Joseph S Tripoli**
**Thomson Multimedia Licensing Inc**
**PO Box 5312**
**Princeton NJ 08543-5312**

MAILED
MAY 09 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Jens Cahnbley, et al. | : | |
| Application No. 10/498,737 | : | ON PETITION |
| Filed: June 15, 2004 | : | |
| Attorney Docket No. PU010304 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 28, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of July 8, 2010. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is October 9, 2010.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810, and the submission required by 37 CFR 1.114; (2) the petition fee of $1,620; and (3) a proper statement of unintentional delay.

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

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application.

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

This application is being referred to Technology Center AU 2424 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

/Terri Johnson/
Terri Johnson
Petitions Examiner
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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Paper No.

US Philips Corporation
Intellectual Property Department
PO Box 3001
Briarcliff Manor NY 10510

MAILED

AUG 26 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Dufour et al. | : | |
| Application No. 10/498,764 | : | DECISION ON PETITION |
| Filed: June 15, 2004 | : | PURSUANT TO 37 C.F.R. |
| Attorney Docket No.: FR 010182 | : | § 1.181 |
| Title: VIDEO CODING AND | : | |
| DECODING METHOD | : | |

This is a decision on the petition pursuant to 37 C.F.R. § 1.181, filed on April 2, 2009, requesting that the holding of abandonment in the above-identified application be withdrawn.

The petition pursuant to 37 C.F.R. § 1.181 is **GRANTED**.

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed August 22, 2007, which set a shortened statutory period for reply of three months. On November 16, 2007, a response was received, asserting that the Office Action is defective and containing a request to restart the period for response. No further response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on November 23, 2007. A notice of abandonment was mailed on March 11, 2008.

RELEVANT PORTION OF THE MPEP

MPEP § 710.06 sets forth, *in pertinent part*:

Where the citation of a reference is incorrect or an Office action contains some other error that affects applicant's ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. If the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. For example, if the error is brought to the attention of the Office 5 weeks after mailing the action, then the Office would set a new 2-month period for reply. The new period for reply must be at least 1 month and would run from the date the error is corrected. See MPEP § 707.05(g) for the manner of correcting the record where there has been an erroneous citation

Emphases added.

## ANALYSIS

With this petition, Petitioner has asserted that the Office should have restarted the period for response.

Petitioner's argument has been considered, and has been deemed to be persuasive. The non-final Office action was mailed on August 22, 2007, and set a three-month period for response, which expired on November 22, 2007. The request to restart the period for response was received on November 16, 2007, which was "within the period for reply set in the Office action but more than 1 month after the date of the Office action," and as such, the Office should have "set a new period for reply" that was "1 month" in length, running "from the date the error is corrected."[1]

## CONCLUSION

Accordingly, this petition pursuant to 37 C.F.R. § 1.181(a) is **GRANTED**. The holding of abandonment is **WITHDRAWN**.

No fee is required on petition pursuant to 37 C.F.R. § 1.181(a).

The Technology Center will be notified of this decision, and jurisdiction over this application is transferred to the Technology Center, so that the application may receive further processing. The Technology Center will re-mail the non-final Office action of August 22, 2007 with the correct citation and a copy of the reference, and Applicant will be given a one month extendable period to respond.

---

1 MPEP § 710.06

Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the withdrawal of the holding of abandonment has been acknowledged by the Technology Center in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center where that change of status must be effected - **the Office of Petitions cannot effectuate a change of status**.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.[2] All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

2 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any of Petitioner's further action(s).

UNITED STATES PATENT AND TRADEMARK OFFICE

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**MORRISON & FOERSTER LLP**
**425 MARKET STREET**
**SAN FRANCISCO, CA 94105-2482**

MAILED
JAN 3 1 2011
OFFICE OF PETITIONS

In re Application of :
**Torbjorn BACKSTROM**, et *al.* :
Application No. 10/499,214 : DECISION GRANTING PETITION
Filed: April 28, 2005 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. **514862001400** :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed January 26, 2011, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

***Petitioner is advised that the issue fee paid on January 6, 2011 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries should be directed to the undersigned at (571) 272-7253.

This application is being referred to Technology Center AU 1612 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

/Monica A. Graves/
Petitions Examiner, Office of Petitions

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

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Paper No.

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

MAILED
AUG 17 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,763,641 | : | DECISION ON REQUEST |
| Vendeville et al. | : | FOR |
| Application No. 10/499,221 | : | RECONSIDERATION OF |
| Issue Date: July 27, 2010 | : | PATENT TERM ADJUSTMENT |
| Filed: April 12, 2005 | : | and |
| Atty Docket No.TIP0030US/PCT | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on July 26, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by one thousand, seven hundred and fourteen (1714) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand, six hundred, and twenty-nine (1629) days is **GRANTED to the extent indicated herein**.

The $200.00 fee set forth in 37 CFR 1.18(e) will be charged to Deposit Account No. 10-0750 in due course, as set forth on the first page of this petition.

Patentee disputes both the 575-day reduction associated with the mailing of the restriction requirement on January 8, 2008 and the delay associated with the Office taking in excess of three years to issue the patent.

With respect to the delay associated with the mailing of the restriction requirement on January 8, 2008, Patentee has argued that the adjustment of 575 days based on the fulfillment date of

April 12, 2005 is erroneous, and has asserted that the correct fulfillment date is not April 12, 2005, but rather June 17, 2004 (resulting in an adjustment of 874 days, not 575 days). This argument will not be considered on the merits.

On November 4, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 573 days. This determination included calculation of the disputed adjustment of 575 days for Office delay associated with the mailing of the restriction requirement on January 8, 2008. PALM records indicate that the issue fee payment was received in the Office on February 4, 2010. No filing of an application for patent term adjustment under 37 CFR 1.705(b) which raised the issue of the disputed fulfillment date preceded the payment of the issue fee.[1] The period for filing an application for patent term adjustment requesting reconsideration of the initial determination of patent term adjustment at the time of mailing of the notice of allowance ended (Thursday) February 4, 2010. Accordingly, to the extent the present application requests reconsideration of the 575-day adjustment, it is appropriate to dismiss this petition as untimely filed.

With respect to the delay associated with the failure of the Office to issue the patent within 3 years, the patent issued 3 years and 1145 days after the 30-month anniversary of the priority date (December 21, 2001). However, it is noted that two periods of adjustment (89 days of "A" delay beginning on November 9, 2008 and ending on February 5, 2009 and 53 days of "A" delay beginning on June 5, 2010 and ending on July 27, 2010) overlap with the period of B-delay. As such, considering the overlap of 142 days, the period of "B" delay is 1003 (1145 - 142) days, and thus, the revised patent term adjustment is 1629 days (575 + 89 + 53 - 91 + 1003).

---

[1] Office records reflect that a petition pursuant to 37 C.F.R. 1.705(b) was filed prior to the payment of the issue fee, and was dismissed via the mailing of a decision on June 24, 2010. This petition has been reviewed, and it is noted that the petition is directed solely towards the failure of the Office to issue the patent within three years, and does not raise the issue of the disputed fulfillment date and the resulting discrepancy as to the proper period of adjustment that is associated with the mailing of the restriction requirement on January 8, 2008.

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

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand, six hundred, and twenty-nine (1629) days**.

Telephone inquiries specific to this matter should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,763,641 B2

DATED : **July 27, 2010** **DRAFT**

INVENTOR(S) : Vendeville et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 1415 days

Delete the phrase "by 1415 days" and insert – by 1629 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/499,245 | 06/17/2004 | Hohyung Lee | 10-10061 | 8946 |

36212 7590 05/10/2011
LAW OFFICES OF DAVID L. HOFFMAN
28494 WESTINGHOUSE PLACE
SUITE 204
VALENCIA, CA 91355

| EXAMINER |
|---|
| ROJAS, HAJIME S |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3627 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 05/10/2011 | 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):

David@DLHpatent.com
DLHpatent@sbcglobal.net
Ruth@DLHpatent.com

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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MAY 9 2011

Law Offices of David L. Hoffman
28494 Westinghouse Place
Suite 204
Valencia, CA 91355

| | | |
|---|---|---|
| In re application of<br>Hohyung Lee<br>Application No. 10/499,245<br>Filed: June 17, 2004<br>For: DIRECT DISTRIBUTION SYSTEM FOR CONSUMER GOODS AND SERVICES | :<br>:<br>:<br>:<br>:<br>: | **DECISION ON PETITION FOR ADVANCED EXAMINATION** |

This is in response to the petition filed on March 15, 2007 requesting that the application be advanced out of turn for examination. The delay in treating this petition is regretted.

The petition is **DISMISSED as MOOT**.

A review of the application file indicates that a first Office Action on the merits was mailed November 18, 2008. The application is currently on the examiner's Special Amended Docket as a Request for Continued Examination was filed November 5, 2010. As the instant petition is not a petition to make the application special, the application will await it's normal order of examination.

Any inquiry regarding this decision should be directed to Teri Luu at (571) 272-7045.

/Teri P. Luu/
Teri P. Luu
Quality Assurance Specialist
Technology Center 3600

TL/tl: 05/05/11

| Doc Code: PET.AUTO<br>Document Description: Petition automatically granted by EFS-Web | PTO/SB/140<br>U.S. Patent and Trademark Office<br>Department of Commerce |
|---|---|

| | |
|---|---|
| Electronic Petition Request | **PETITION TO WITHDRAW AN APPLICATION FROM ISSUE AFTER PAYMENT OF THE ISSUE FEE UNDER 37 CFR 1.313(c)** |
| Application Number | 10499411 |
| Filing Date | 10-Feb-2005 |
| First Named Inventor | Per Aas |
| Art Unit | 3653 |
| Examiner Name | MARK BEAUCHAINE |
| Attorney Docket Number | SCAN-PT001 |
| Title | APPARATUS METHOD AND SYSTEM FOR RECEIVING AND DISTRIBUTING COINS AND NOTES |

An application may be withdrawn from issue for further action upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary.

APPLICANT HEREBY PETITIONS TO WITHDRAW THIS APPLICATION FROM ISSUE UNDER 37 CFR 1.313(c).

A grantable petition requires the following items:
(1) Petition fee; and
(2) One of the following reasons:
(a) Unpatentability of one or more claims, which must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;
(b) Consideration of a request for continued examination in compliance with § 1.114 (for a utility or plant application only); or
(c) Express abandonment of the application. Such express abandonment may be in favor of a continuing application, but not a CPA under 37 CFR 1.53(d).

Petition Fee

☐ Applicant claims SMALL ENTITY status. See 37 CFR 1.27.

☐ Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

☒ Applicant(s) status remains as SMALL ENTITY.

☐ Applicant(s) status remains as other than SMALL ENTITY

Reason for withdrawal from issue

○ One or more claims are unpatentable

◉ Consideration of a request for continued examination (RCE) (List of Required Documents and Fees)

○ Applicant hereby expressly abandons the instant application (any attorney/agent signing for this reason must have power of attorney pursuant to 37 CFR 1.32(b)).

RCE request,submission, and fee.

☐ I certify, in accordance with 37 CFR 1.4(d)(4) that : The RCE request ,submission, and fee have already been filed in the above-identified application on

☒ Are attached.

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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 who has been given power of attorney in this application.

○ An attorney or agent registered to practice before the Patent and Trademark Office, acting in a representative capacity.

○ A sole inventor

○ A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors

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

○ The assignee of record of the entire interest that has properly made itself of record pursuant to 37 CFR 3.71

| | |
|---|---|
| Signature | /Anthony S. Volpe/ |
| Name | Anthony S. Volpe |
| Registration Number | 28377 |

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

Decision Date : July 11,2011

In re Application of :

Per Aas

DECISION ON PETITION

UNDER CFR 1.313(c)(2)

Application No : 10499411

Filed : 10-Feb-2005

Attorney Docket No : SCAN-PT001

This is an electronic decision on the petition under 37 CFR 1.313(c)(2), filed July 11,2011 , to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

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

Telephone inquiries concerning this decision should be directed to the Patent Electronic Business Center (EBC) at 866-217-9197.

This application file is being referred to Technology Center AU 3653 for processing of the request for continuing examination under 37 CFR 1.114 .

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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In re Patent No. 7310042
Issue Date: December 18,2007
Application No. 10499461
Filed: June 18,2004
Attorney Docket No. 4018-001

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

This is a decision on the electronic petition, filed January 27,2012 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 27,2012 .
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
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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) |
|---|---|---|---|---|
| 7310042 | 2007-12-18 | 10/499,461 | 2004-06-18 | 4018-001 |

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 | | 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 | /JiNan Glasgow/ | Date (YYYY-MM-DD) | 2012-01-27 |
| Name | JiNan Glasgow | Registration Number | 42585 |

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.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 1/11/2011 Paper No.: —

TO SPE OF : ART UNIT 3742

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/499508 Patent No.: 7687738 B2

CofC mailroom date: 1/5/2011

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**

**Virginia Tolbert**
**Certificates of Correction Branch**
**571-272-0460**

**Thank You For Your Assistance**

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

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

**Comments:** AE

Henry O. Yuen
Supervisory Patent Examiner
Group 3700

SPE

3742
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO, CA 92121

MAILED
FEB 18 2011
OFFICE OF PETITIONS

In re Application of :
Alan Andrew Smith, et al. :
Application No. 10/499,759 : ON PETITION
Filed: October 7, 2005 :
Attorney Docket No.: 020211 :

This is a decision on the petition, filed December 13, 2010, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for a failure to reply in a timely manner to the Office action under Ex parte Quale, 1935 Dec. Comm'r Pat. 11 (1935), mailed May 28, 2010, which set a shortened statutory period for reply of two (2) months. A Notice of Abandonment was subsequently mailed on October 12, 2010. On December 13, 2010, present petition were filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) a proposed reply; (2) the petition fee of $1,620; and (3) an adequate statement of unintentional delay.

The application file is being forwarded to Technology Center AU 2617 for consideration of the response filed December 13, 2010.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. All other inquiries regarding this application should be directed to the Technology Center.

/SDB/

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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HORST M KASPER
13 FOREST DRIVE
WARREN NJ 07059

**MAILED**
DEC 12 2011
**OFFICE OF PETITIONS**

In re Patent No. 7,390,245 :
Issue Date: June 24, 2008 :
Application No. 10/499,864 : NOTICE
Filed: April 15, 2005 :
Attorney Docket No. MSA 259

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

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

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

Inquiries related to this communication should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

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May 5, 2011

Marc F. Malooley
Brooks Kushman P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238

Patent No: 7,905,107 B2
Application No: 10/500,053
Applicant: Mordechai Forkosh, et al.
Issued: March 15, 2011
Title: **HIGH EFFICIENCY DEHUMIDIFIERS AND COMBINE DEHUMIDIFYING/AIR-CONDITIONING SYSTEMS**

Request for Certificate of Correction:

Consideration has been given to your request for the issuance of a certificate of correction for the above- identified patent under the provisions of Rule 1.322.

The error purported to be in column 13, line 44 cannot be found in the printed patent.

In view of the foregoing your request in this matter is hereby **denied**.

Further correspondence concerning this matter should be directed to Decisions and Certificate of Correction Branch.

*/Virginia Tolbert/*
Virginia Tolbert
For Mary Diggs, Supervisor
Decisions and Certificate of Correction
(571) 272-0460

vt

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WHITEFORD, TAYLOR & PRESTON, LLP
ATTN: GREGORY M STONE
SEVEN SAINT PAUL STREET
BALTIMORE, MD 21202-1626

MAILED
DEC 2 0 2010
OFFICE OF PETITIONS

In re Application of :
Anne D. Frame :
Application No. 10/500,098 :
Filed: June 24, 2004 :
Attorney Docket No. 083622.00003 :

DECISION ON APPLICATION
FOR PATENT TERM ADJUSTMENT

This is a decision responding to the "Request for Reconsideration of Patent Term Adjustment Under 37 C.F.R. §1.705" filed August 27, 2010. Applicant requests the initial determination of patent term adjustment be corrected from zero (0) days to one hundred sixteen (116) days.

The application for patent term adjustment is **dismissed**.

The Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) on May 27, 2010, advising Applicant of a patent term adjustment to date of 0 days. In response, Applicant timely filed this application for patent term adjustment with payment of the issue fee on August 27, 2010.

Applicant disputes the Office's calculation of the total period of delay under 37 C.F.R. § 1.704 ("Applicant Delay"). Specifically, Applicant objects to the Office's entry of:

1. A 15-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8),
2. A 29-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b),
3. A 59-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b), and
4. A 91-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8).

<u>The 15-Day Reduction in Patent Term Adjustment Under 37 C.F.R. § 1.704(c)(8)</u>

The Office issued a non-final Office action on March 25, 2008.

Applicant filed a reply on June 24, 2008.

Applicant filed a second reply in the form of an amendment on July 9, 2008, in order to correct Applicant's failureo show the term "cobaltacene-octgomet" was deleted and to indicate the term "cobaltocene-octomethyl" was being added in Table 5 of Exhibit 2 filed June 24, 2008

The Office issued a non-final Office action on July 22, 2008.

The Office entered a 15-day reduction in patent term adjustment as a result of Applicant filing the July 9, 2008 amendment, 15 days after filing a prior reply to the March 25, 2008 Office action.

Applicant states the July 22, 2008 Office action did not address the changes made in the July 9, 2008 amendment and states the Office did not issue a supplemental Office action addressing the changes. Applicant then states, "Thus, under 37 C.F.R. 1.704, paragraph 6, this is not a delay for which the Applicant has to pay in patent term adjustment."

The Office agrees the previously cited facts do not warrant a reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(6). However, the Office entered the 15-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8), not 37 C.F.R. § 1.704(c)(6).

Pursuant to 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

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

The July 9, 2008 amendment was filed after Applicant had already filed a reply to the March 25, 2008 Office action and the record fails to indicate the examiner expressly requested the submission of the July 9, 2008 amendment. Therefore, the previously discussed facts warrant entry of a reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8).

Applicant asserts, if a reduction is warranted, the reduction should be 14 days instead of 15 days because any period of reduction should begin on the day after the date the initial reply was filed. Applicant's assertion would be correct if the supplemental reply had been filed on July 8, 2008 as stated in the petition. However, the supplemental reply was actually filed on July 9, 2008. The number of days beginning June 25, 2008, the day after the initial reply was filed, and ending on July 9, 2008, the date the supplemental amendment was filed, is 15 days. Therefore, the 15-day reduction in patent term adjustment was proper.

<u>The 29-Day Reduction in Patent Term Adjustment Under 37 C.F.R. § 1.704(b)</u>

Applicant objects to a 29-day reduction in patent term adjustment entered by the Office. Applicant states,

> The Office mailed a Non-Final rejection on July 22, 2008 [and] Applicant timely filed a response on September 9, 2008. However, the Patent Term Adjustment History ... incorrectly [uses the language] Amendment Crossed in Mail [to refer to the response] presumably in reference to the Final Rejection issued on September 30, 2008.... The

> USPTO Patent Term Adjustment History starts counting [a period of Applicant delay] on September 30, 2008 when the Final rejection was mailed.

Applicant appears to misunderstand the Office's factual and legal basis for entering the 29-day reduction in patent term adjustment.

The 29-day reduction in patent term adjustment was based on the following facts:

1. The Office mailed a final Office action on September 30, 2008; and
2. A proper reply to the final Office action was not filed until January 28, 2009.

The 29-day reduction in patent term adjustment was based on 37 C.F.R. § 1.704(b), which states,

> [A]n applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

The number of days beginning December 31, 2008, the day after the date three months after the date the Office mailed the final Office action, and ending on January 28, 2009, is 29 days. Therefore, the entry of a 29-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b) was proper.

<u>The 59-Day Reduction in Patent Term Adjustment Under 37 C.F.R. § 1.704(b)</u>

The Office issued a non-final Office action on April 14, 2009.

Applicant filed a response on September 11, 2009.

The Office entered a 59-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b) based on the preceding facts.

Applicant asserts the Office should have entered a 58-day reduction.

The period of reduction in patent term adjustment under 37 C.F.R. § 1.704(b) is the number of days beginning on the day after the date that is three months after the date the Office issued the rejection or Office action and ending on the date a reply is filed.

The number of days beginning July 15, 2009, the day after the date three months after the Office mailed the final Office action, and ending on September 11, 2009, the date a reply was filed in

response to the Office action, is 59 days. Therefore, the entry of a 59-day, rather than a 58-day, reduction in patent term adjustment was proper.

The 91-day Reduction in Patent Term Adjustment Under 37 C.F.R. § 1.704(c)(8)

The Office entered a 91-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8) as a result of Applicant filing an IDS on April 16, 2010, 91 days after filing a response to a Notice of Non-Compliant Amendment on January 15, 2010.

Applicant argues the 91-day reduction in patent term adjustment is improper based on an assertion the IDS was filed in a manner which excludes it from counting as delay "under 37 C.F.R 1.704, paragraph 11."

Applicant appears to misunderstand the Office's basis for entry of the 91-day reduction in patent term adjustment.

Pursuant to 37 C.F.R. § 1.704(c)(8), circumstances that will result in a reduction in the period of adjustment include:

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

37 C.F.R. § 1.704(d) states,

> A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

The 91-day reduction in patent term adjustment was entered pursuant to 37 C.F.R. § 1.704(c)(8). The record fails to indicate the IDS was expressly requested examiner and the IDS was not accompanied by a statement under 37 C.F.R. § 1.704(d). Therefore, the Office's entry of a 91-day reduction in patent term adjustment for the IDS filed April 16, 2010, 91 days was proper.

Conclusion

Applicant has failed to establish the Office acted improperly when the Office entered:

1. A 15-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8),

2. A 29-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b),
3. A 59-day reduction in patent term adjustment under 37 C.F.R. § 1.704(b), and
4. A 91-day reduction in patent term adjustment under 37 C.F.R. § 1.704(c)(8).

As of the mailing of the notice of allowance, the total period of Office delay (363 days) was less than the total period of Applicant Delay (364 days). The Office does not set forth negative balances of patent term adjustment when notifying applicants of the Office's calculation of the initial patent term adjustment. Therefore, the initial patent term adjustment of 0 days mailed with the notice of allowance was proper.

Submission of the $200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged. No additional fee is required.

Applicants is reminded any Office delays pursuant to 37 C.F.R. §§ 1.702(a)(4) and 1.702(b), and any Applicant delays under 37 C.F.R. § 1.704(c)(10), will be calculated at the time of the issuance of the patent and Applicant will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

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MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA VA 223

MAILED
AUG 26 2011
OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,399,775 | : ON PETITION |
| Yasukouchi et al. | : UNDER 37 CFR 1.183 |
| Issue Date: 07/15/2008 | : and |
| Application No. 10/500156 | : ON REQUEST FOR |
| Filing or 371(c) Date: 06/25/2004 | : RECONSIDERATION OF |
| Attorney Docket No. 254534US0PCT | : PATENT TERM ADJUSTMENT |

This is a decision on the "Petition Under 37 C.F.R. § 1.183 and on Petition Under 37 C.F.R. § 1.705(d) and Request for Reconsideration of Patent Term Adjustment," filed February 2, 2009, requesting suspension of the time limit for consideration of an application for patent term adjustment ("PTA"). The response is properly treated as a petition under 37 CFR 1.183.

This petition is hereby **dismissed**.

Your petition for recalculation/reconsideration of the USPTO's PTA determination for U.S. Patent No. 7,399,775 is dismissed as untimely. On February 1, 2010, the USPTO published a Federal Register notice that, *inter alia*, announced a limited waiver of the two-month deadline for filing a petition for reconsideration of a PTA determination under 37 CFR sec. 1.705(d). *See Interim Procedure for Patentees to Request a Recalculation of the Patent Term Adjustment to Comply with the Federal Circuit Decision in Wyeth v. Kappos Regarding Overlapping Delay Provisions of 35 U.S.C. sec. 154(b)(2)(A)*, 75 *Fed. Reg.* 5043 (Feb. 1, 2010) (notice).

Specifically, patent owners were permitted to request recalculation of a patent's PTA in view of the Federal Circuit decision *Wyeth v. Kappos*, 591 F.3d 1364 (Fed. Cir. 2010) up to 180 days after the grant of the patent. The USPTO determined not to accept any requests for PTA recalculation initially filed more than 180 days after patent grant, however, in view of the statutory judicial-review provisions of 35 U.S.C. sec. 154(b)(4), which require that any civil action to challenge the USPTO's PTA determination be brought within 180 days of patent grant. The USPTO believes that the statutory 180-day period for seeking court review of the USPTO's PTA determinations, particularly in view of the six-year statute of limitations that otherwise is applicable for actions under the Administrative Procedure Act, indicates a congressional intent

that PTA issues be resolved shortly after a patent issues. The USPTO does not consider it likely that Congress created a scheme under which the time period to seek initial USPTO review of a PTA determination extends beyond the time period provided for a dissatisfied patentee to seek judicial review of the USPTO's PTA determination. Thus, the USPTO believes that the 180-day period in 35 U.S.C. sec. 154(b)(4) represents the outer limit on the USPTO's ability to consider a patentee's initial request for PTA determination {to conclude its PTA determination}."

The present petition under 37 CFR 1.183 is requesting suspension of the time limit for consideration of an application for patent term adjustment under 37 CFR 1.183 is **dismissed**.

The balance of the fee for the petition under 37 CFR 1.183, $270.00, has been charged to petitioner's deposit account as authorized in the petition.

This patent file is being referred to the Files Repository.

Telephone inquiries specific to 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

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/500,296 | 06/28/2004 | Yuji Yamazaki | 081356-0218 | 7715 |

7590 03/03/2011
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| EXAMINER |
|---|
| SKELDING, ZACHARY S |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1644 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 03/03/2011 | PAPER |

# ACKNOWLEDGEMENT OF REQUEST

*Notice of Allowance/Allowability Mailed*

The request to print a color drawing reference as the first paragraph in the portion of the specification containing a brief description of the drawings as required by 37 CFR 1.84 and MPEP § 608.02 has been received by the United States Patent and Trademark Office and will be entered into the specification.

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



FORM PTOM327-5 (Rev. 02/08)

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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www.uspto.gov

March 3, 2011

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

| | | |
|---|---|---|
| In re Application of | : | |
| Yamazaki, Yuji et al | : | **DECISION ON PETITION** |
| Application No. 10/500,296 | : | |
| Filed: 06/28/2004 | : | ***ACCEPTANCE OF COLOR*** |
| Attorney Docket No. 081356-0218 | : | ***DRAWINGS*** |

This is a decision on the Petition to Accept Color Drawings under 37 C.F.R 1.84 (a) (2), received in the United States Patent and Trademark Office (USPTO) June 28, 2004.

The petition is **GRANTED**.

A grantable petition under 37 C.F.R. 1.84(a) (2) must be accompanied by the following.

1. The fee set forth under 37 C.F.R. 1.17(h),
2. Three (3) sets of the color drawings in question, or (1) set if filed via EFS, and
3. The specification contains appropriate language referring to the color drawings as the first paragraph in that portion of the specification relating to the brief description of the drawings.

The petition was accompanied by all of the required fees and drawings. The specification contains the appropriate language. Therefore, the petition is GRANTED.

Telephone inquires relating to this decision may be directed to the undersigned in the Office of Data Management at 571-272-4200.

/Diane Terry/
Quality Control Specialist
Office of Data Management
Publications Branch

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

**WILLIAM D. BUNCH**
**W. R. GRACE & CO.-CONN.**
**7500 GRACE DRIVE, PATENT DEPARTMENT**
**COLUMBIA, MD 21044-4098**

**MAILED**

DEC 03 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| **Hans G. FRITZ**, et *al.* | : | |
| Application No. 10/500,349 | : | DECISION ON PETITION |
| Filed: November 18, 2005 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. **W9543-01** | : | |

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

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed March 6, 2009, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on May 7, 2009. *See* MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an appeal brief and fee of $540, (2) the petition fee of 1620; and (3) an adequate statement of unintentional delay.

A review of the file record indicated that petition fee of $1620 has been submitted twice. Therefore, the fee of $1620 submitted concurrently with this petition is being refunded to petitioner's deposit account no. 07-1770.

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253.

This application is being referred to Technology Center AU 1794 for appropriate action by the Examiner in the normal course of business on the reply received.

Thurman K. Page
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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WILLIAM D. BUNCH
W. R. GRACE & CO.-CONN.
PATENT DEPARTMENT
7500 GRACE DRIVE
COLUMBIA MD 21044-4098

MAILED
SEP 01 2011
OFFICE OF PETITIONS

In re Application of
Hans G. Fritz et al.
Application No. 10/500,349
Filed: November 18, 2005
Attorney Docket No: **W9543-01**

ON PETITION

This is a decision on the petition to withdraw the holding of abandonment, filed August 22, 2011, under 37 CFR 1.181, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.

The petition is **GRANTED**.

The above-identified application became abandoned as a result of petitioner's failure to file a proper appeal brief within the time period provided in 37 CFR 1.192(a). A Notice of Appeal was filed March 6, 2009. In response to an appeal brief filed May 20, 2010, a Notification of Non-Compliance with 37 CFR 1.192 ( c) was mailed on January 28, 2011. No response having been filed, this application became abandoned March 1, 2011. Accordingly, a Notice of Abandonment was mailed August 15, 2011. Petitioner asserts that the Notification of Non-Compliance with 37 CFR 1.192 ( c) was never received.

The file record discloses that the Notification of Non-Compliance with 37 CFR 1.192 ( c) was mailed to the address of record which is the same address previously used on all correspondences from the USPTO up to the date the Notification of Non-Compliance with 37 CFR 1.192 ( c) was mailed. Petitioner has provided a copy of the docket to show that the Notification of Non-Compliance with 37 CFR 1.192 ( c) mailed January 28, 2011 was not received. Petitioner also explains that after searching the file and docket records, where receipt of the Notification of Non-Compliance with 37 CFR 1.192 ( c) would have been indicated if it had been received, it was concluded that no correspondence was received for this matter from the USPTO.

In that the statement from the petitioner and the exhibit from the docket record for the instant matter show no entry indicating receipt of the Notification of Non-Compliance with 37 CFR 1.192 ( c) mailed January 28, 2011, it is apparent that it was not received.

The evidence submitted corroborates non-receipt of the Notification of Non-Compliance with 37 CFR 1.192 ( c).

In view of the facts set forth in the petition, it is concluded that the Notification of Non-Compliance with 37 CFR 1.192 ( c) was never received at the address of record. Accordingly, the holding of abandonment is withdrawn and no petition fee is due.

This matter is being referred to Technology Center 1788 for a re-mailing of the Notification of Non-Compliance with 37 CFR 1.192 ( c) and for a restarting of the period for response.

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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Paper No.

BARNES & THORNBURG LLP
11 SOUTH MERIDIAN
INDIANAPOLIS IN 46204

MAILED

MAR 02 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Badylak et al. | : | |
| Application No. 10/500,511 | : | ON APPLICATION FOR |
| Filed: June 30, 2004 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. | : | |
| 3220-72178 | : | |

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(d), filed on December 21, 2010, which is treated as an application for patent term adjustment under 37 CFR 1.705(b). Applicants request that the determination of patent term adjustment be revised from 0 days to 300 days, in part, on the basis that the Office will take in excess of three years to issue this patent.

The request is **DISMISSED**.

To the extent the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As

such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued. Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

To the extent that the instant application for patent term adjustment requests reconsideration of the PTA at the time of

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[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

the mailing of the Notice of Allowance, the request is **DISMISSED.**

On October 15, 2010, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date was 0 days (302 days of PTO delay and 313 days of applicant delay).

The instant application for patent term adjustment was timely filed.[2]

Applicants assert that the delay determination under 37 CFR 1.702(a)(1) should be should be 314 days rather than 302 days. Applicants assert that the application was filed on June 30, 2004, and that the first Office action mailed on July 10, 2006, fourteen months and 314 days after the day after the date the application was filed.

Applicants' argument has been considered, but is not persuasive. Pursuant to 37 CFR 1.703(a)(1), the period of adjustment under § 1.702(a)(1) is the number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

At the outset, the subject application is an application filed under 35 U.S.C. 371, not an application filed under § 111(a). The application fulfilled the requirements of 35 U.S.C. 371 on July 11, 2004. The Office action mailed on July 10, 2006, was mailed fourteen months and 302 days after the day after the date the requirements of 35 U.S.C. 371 were completed. Accordingly, the 302 day period of adjustment for Office delay pursuant to 37 CFR 1.702(a)(1) is correct and will not be removed.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is 0 days (302 days of Office delay and 313 days of applicant delay).

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[2] PALM Records indicate that the issue fee was paid on December 21, 2010.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.
The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to 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
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**MARK P STONE**
**4TH FLOOR**
**25 THIRD STREET**
**STAMFORD CT 06905**

**MAILED**
FEB 23 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No: 7,237,303 | : | |
| Issued: July 3, 2007 | : | |
| Application No. 10/500,612 | : | NOTICE |
| Filed: June 29, 2004 | : | |
| Attorney Docket No. HT-116 | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed January 5, 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
Petitions Examiner
Office of Petitions

cc: DENISE E. BOYLIN
DENNEMEYER & CO LTD
REGENT HOUSE HEATON LANE
STOCKPORT CHESHIRE
ENGLAND SK4 1BB

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**MARK P. STONE**
**400 COLUMBUS AVENUE**
**VALHALLA NY 10595**

**MAILED**
MAY 24 2011
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,237,303 | : | |
| Issued: July 3, 2007 | : | |
| Application No. 10/500,612 | : | ON PETITION |
| Filed: June 29, 2004 | : | |
| Attorney Docket No. HT-116 | : | |

This is a notice regarding your renewed request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed May 2, 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.

Additionally, the Change of Correspondence Address is hereby accepted.

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

/Joan Olszewski/
Joan Olszewski
Petitions Examiner
Office of Petitions

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**FOLEY HOAG, LLP (w/GPT)**
**Patent Group**
**155 Seaport Boulevard**
**Boston, MA 02110-2600**

MAILED

DEC 28 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Wenbin Dang, et al. | : | |
| Application No. 10/500,795 | : | DECISION ON PETITION |
| Filed: December 3, 2004 | : | TO WITHDRAW |
| Attorney Docket No. GPT-030.01 | : | 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 19, 2010.

The request is **APPROVED**.

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

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

All future communications from the Office will be directed to the assignee of the entire interest at the first copied address below until otherwise properly notified by the applicant.

There is an outstanding Office action mailed August 10, 2010 that requires a reply from the applicant.

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

/Terri Johnson/
Terri Johnson
Petitions Examiner
Office of Petitions

cc: **Eisai Inc.**
**Attn: Aaron L. Schwartz**
**4 Corporate Drive**
**Andover, MA 01810-2441**

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NUMBER | FILING OR 371(C) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 10/500,795 | 12/03/2004 | Wenbin Dang | GPT-030.01 |

**CONFIRMATION NO. 8669**

**POWER OF ATTORNEY NOTICE**

29755
FOLEY HOAG, LLP (w/GPT)
PATENT GROUP
155 SEAPORT BOULEVARD
BOSTON, MA 02110-2600

*OC000000045082457*

Date Mailed: 12/21/2010

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 11/19/2010.

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

/tsjohnson/

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

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AUG 17 2010

OFFICE OF PETITIONS

KLARQUIST SPARKMAN, LLP
121 S.W. SALMON STREET
SUITE 1600
PORTLAND OR 97204

| | | |
|---|---|---|
| In re Patent of | : | DECISION ON REQUEST |
| Chang | : | FOR |
| Patent No. 7,662,394 | : | RECONSIDERATION OF |
| Issue Date: February 16, 2010 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/500,796 | : | and |
| Filed: July 6, 2004 | : | NOTICE OF INTENT TO ISSUE |
| Atty Docket No. 6395-64909-02 | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on May 7, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be recalculated.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent be recalculated is **GRANTED.**

The calculation of delay pursuant to 37 CFR 1.702(b) is based on a national stage commencement date of October 6, 2003. As the expiration of the 30-month period pursuant to 35 U.S.C. 371(b) fell on a Saturday, the period expired on the subsequent business day. *See* PCT Rule 80.5. Accordingly, the commencement date is Monday, October 6, 2003. As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on October 7, 2006 and ends on June 25, 2008, the day before a RCE was filed, and is 628 days. *See* 35 U.S.C. 154(b)(1)(B)(i). There is a 112 day overlap between the A delay and B delay periods, beginning on October 7, 2006 and ending on January 26, 2007. As such, the patent term adjustment is **868 days** (508 A delay + 628 B delay - 112 overlap - 156 Applicant delay).

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

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The petition fee of $200.00 is being charged to deposit account no. 02-4550.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **eight hundred sixty-eight (868)** days.

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,662,394 B2

DATED : **February 16, 2010** **DRAFT**

INVENTOR(S) : Chang

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 352 days

Delete the phrase "by 352 days" and insert – by 868 days--

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/500,851 | 07/16/2004 | Susumu Senshu | 255147US6PCT | 2817 |

22850 7590 02/15/2011
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.
1940 DUKE STREET
ALEXANDRIA, VA 22314

| EXAMINER |
|---|
| POLTORAK, PIOTR |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2434 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 02/15/2011 | 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):

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Bradley Lytle
Oblon, Spivak, McClelland Maier & Neustadt, LLP
1940 Duke Street
Alexandria VA 22314

In re Application of:
Senshu
Application No. 10/50,0851
Filed: July 16, 2004
For: Recording System and Method, Recording Apparatus and Method, Input Device and Method, Playback System and Method, Playback Apparatus and Method, Recording Medium and Program

**DECISION ON PETITION UNDER 37 C.F.R. § 1.181**

This is a decision on the petition filed January 11, 2011 under 37 CFR § 1.181 to have the examiner consider a reference on the Information Disclosure Statement s(IDS) filed on July 14, 2004 that was not previously considered.

A review of the record reveals that the examiner has now considered all of the references and returned an initialed signed copy of the July 14, 2004, 1449 on January 21, 2011 to petitioner.

As petitioner's relief has already occurred, the petition is **DISMISSED AS MOOT.**

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3612.

/Tod Swann/
Tod Swann
Workgroup Quality Assurance Specialist
Technology Center 2400

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

MAILED

SEP 02 2010

OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent of Op Den Camp et al. | : DECISION ON REQUEST FOR |
| Patent No. 7,622,284 | : RECONSIDERATION OF |
| Issue Date: November 24, 2009 | : PATENT TERM ADJUSTMENT AND |
| Application No. 10/500,872 | : NOTICE OF INTENT TO ISSUE |
| Filed: December 6, 2004 | : CERTIFICATE OF CORRECTION |
| Docket No. OP DEN CAMP-1 | : |

This is a decision on the petition filed on January 22, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by five hundred sixty-four (564) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by five hundred sixty-four (564) is **GRANTED to the extent indicated herein**.

With respect to patentees' argument that the Office miscalculated the period of delay under 37 CFR 1.703(a)(1), this argument will not be addressed because it was untimely raised.

37 CFR 1.705(d), provides that:

> If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. *Any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section shall be dismissed as untimely as to those issues.* (*emphasis* added).

If applicants desired to dispute the adjustment pertaining to 37 CFR 1.703(a)(1), applicants should have filed a petition under 37 CFR 1.705(b) after the mailing of the Notice of Allowance.

The adjustment pertaining to 37 CFR 1.703(a)(1) can not be addressed in a petition under 37 CFR 1.705(d).

With respect to the B period of delay: In an international application, the B period of delay is based on the failure of the Office to issue a patent within three years after the national stage commences under 35 U.S.C. 371(b) or (f). *See* 1.702(b). The national stage commenced in this application on July 23, 2004. Unless a Request for Continued Examination ("RCE") is filed, the period of B Delay ends of the date the patent issues. In this case, a RCE was filed on March 31, 2008. Per 35 U.S.C. 154(b)(1)(B)(i), B Delay does not include "any time consumed by continued examination of the application requested by the applicant under section 132(b)."

The period of B Delay in this case is 251 days, not 252 days as asserted by patentees, beginning on July 24, 2007, the day after the date three years after the commencement date, and ending on March 30, 2008, the day before the date the RCE was filed. *See* 1.703(b).

Therefore, correct patent term adjustment is 427 days, which is the sum of 429 days of delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") and 251 days of B Delay, reduced by 253 days for patentees' delay.

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

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **four hundred twenty-seven (427)** days.

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,622,284 B2

DATED : **November 24, 2009** **DRAFT**

INVENTOR(S) : Op Den Camp et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 176 days

Delete the phrase "by 176 days" and insert – by 427 days--

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : March 15, 2010

**TO SPE OF** : ART UNIT 2167
**SUBJECT** : Request for Certificate of Correction for Appl. No /10/501494 patent 7676507

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:** _____

Attorney Docket No. 15675P538

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | |
|---|---|
| In re the Patent Application of: | |
| **Enrico Maim** | Patent No.: **7,676,507** |
| Serial No. 10/501,494 | Issue Date: **March 9, 2010** |
| Filed: March 18, 2005 | |
| For: **METHODS AND SYSTEMS FOR SEARCHING AND ASSOCIATING INFORMATION RESOURCES SUCH AS WEB PAGES** | |

**REQUEST FOR CERTIFICATION OF CORRECTION**

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

Enclosed is a Certificate of Correction for the above-referenced patent. Claims 7 and 10 are amended. These amendments were made in a Rule 312 Amendment filed on December 28, 2009. The patentee received a response to Rule 312 Communication mailed February 2, 2010, stating that the Amendment filed on December 28, 2009 was disapproved because the amendment was filed after the payment of the issue fee. However, since the Rule 312 Amendment was filed with the payment of the issue fee on December 28, 2009, the refusal to enter the amendment was in error.

Issuance of a Certificate of Correction is respectfully requested. As the error was made by the Patent Office, no official fee should be due. In the event that it is determined official fees are due, those fees should be charged to Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 3/10/2010 By: _____
Eric S. Hyman, Reg. No. 30,139

1279 Oakmead Parkway
Sunnyvale, California 94085-4040
Telephone (310) 207-3800
Facsimile (408) 720-8383

**CERTIFICATE OF TRANSMISSION**
I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.

Suzanne Johnston 3/10/10
Date

(Also Form PTO-1050)

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

PATENT NO. : 7,676,507

APPLICATION NO.: 10/501,494

DATED : March 9, 2010

INVENTOR(S) : Enrico Maim

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

In claim 7: delete "claim 3" and replace with "claim 1".

In claim 7: delete "resources belong" and replace with "resource belongs".

In claim 7: insert "relevant" before the term "browsing".

In claim 10: delete the second instance of "other" in line 33 and replace with "second".

MAILING ADDRESS OF SENDER (Please do not use customer number below):

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
1279 Oakmead Parkway
Sunnyvale, CA 94085
Telephone: (310) 207-3800

Based on PTO/SB/44 (04-05) as modified by Blakely, Solokoff, Taylor & Zafman (wlr) 11/30/2005.
SEND TO: Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Docket No. 15675P538

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
MAR 28 2011
OFFICE OF PETITIONS

CHOATE, HALL & STEWART LLP
TWO INTERNATIONAL PLACE
BOSTON MA 02110

| | | |
|---|---|---|
| In re Patent No. of Papisov | : | DECISION ON REQUEST |
| Patent No. 7,838,619 | : | FOR RECONSIDERATION OF |
| Issue Date: November 23, 2010 | : | PATENT TERM ADJUSTMENT |
| Application No. 10/501,565 | : | and |
| Filed: July 14, 2004 | : | NOTICE OF INTENT TO ISSUE |
| Attorney Docket No. 04924790037 | : | CERTIFICATE OF CORRECTION |
| (MGH1979USNTALUS) | : | |

This is a decision on the "Application for Patent Term Adjustment Determination Under 35 U.S.C. § 154(b) and 37 C.F.R. § 1.705(d)," filed January 18, 2011. Patentee requests that the patent term adjustment indicated in the patent be corrected from six hundred sixty-four (664) days to one thousand fifty-six (1056) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted to one thousand fifty-six (1056) days is **granted to the extent indicated herein.**

On November 23, 2010, the above-identified application matured into U.S. Patent No. 7,838,619. The instant request for reconsideration filed July 16, 2010 was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 664 days.

Patentee discloses the Office erred in assessing a 28 day adjustment for the mailing of a Notice of Allowance on May 13, 2009, after a reply was filed on February 10, 2009. Patentee asserts the Office miscalculated the delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay") by using December 14, 2008 as the end date of the 3 year calculation. Patentee discloses an additional reduction of 17 days pursuant to 37 CFR 1.704(b) for the filing of a reply on February 10, 2009. Patentee disputes a reduction, pursuant to 37 CFR 1.704(c)(10), of seventy-one (71) days due to

a "miscellaneous incoming letter" being filed on September 14, 2010.

In sum, patentee's calculation of patent term adjustment is 534 days of delay under 35 U.S.C. § 154(b)(1)(A) ("A Delay") + 885 days of B Delay - 346 days overlapping period between A Delay and B Delay - 17 days Applicant Delay.

The Office concurs that the 28 day period of adjustment in connection with the mailing of the May 13, 2009 Notice of Allowance was made in error. Applicant filed a response after non-final on February 10, 2009. On May 13, 2009, the Office mailed a Notice of Allowance. The mailing of the Notice of Allowance occurred within 4 months of the filing of applicant' February 10, 2009 reply. Therefore, no delay is warranted pursuant to 37 CFR 1.702(a)(2). Accordingly the 28 day period of adjustment is being removed.

In calculating the period of delay under 35 U.S.C. § 154(b)(1)(B) ("B Delay"), patentee indicates the period of delay ended on December 15, 2009, the date of the filing of a Request for Continued Examination ("RCE"). Unless a RCE is filed, the period of B Delay ends of the date the patent issues. In this case, a RCE was filed December 15, 2009. Per 35 U.S.C. § 154(b)(1)(B)(i), B Delay does not include "any time consumed by continued examination of the application requested by the applicant under section 132(b)." The maximum period of B Delay in this case is 884 days, which is the number of days beginning on July 15, 2007, the day after the date three years after commencement, and ending on December 14, 2009, the day before the date the RCE was filed. Subtracting the 346 day overlapping period between the A Delay and B Delay periods (beginning July 15, 2007 and ending June 24, 2008), the B Delay period is 538 (884 - 346) days, not 539 as patentee asserts.

Patentee discloses a 17 day reduction in connection with the filing of a reply on February 10, 2009 to a non-final Office action, mailed October 24, 2008. The Office concurs. Pursuant to 37 CFR 1.704(b), the period of adjustment of the term of the patent should have been reduced by 17 days, counting the number of days in the period beginning on the day after the date that is three months after the mailing date of the non-final Office action, January 25, 2009, and ending on the date the reply was filed, February 10, 2009. Accordingly, a period of reduction of 17 days will be entered.

Patentee disputes a reduction, pursuant to 37 CFR 1.704(c)(10), of seventy-one (71) days due to a "miscellaneous incoming letter" being filed on September 14, 2010. A review of the application record supports a conclusion that applicant did **not** file a miscellaneous incoming letter in this application on September 14, 2010. Applicant filed a completed issue fee transmittal (PTOL-85(b)) and the balance due on the issue fee. It is agreed that applicant did not fail to engage in reasonable efforts to conclude prosecution of the application by filing those items. Accordingly, the period of reduction of 71 days will be removed.

A review of the PTA calculations for this application reveals additional errors.

> 37 CFR 1.704(c)(10) provides that:
>
> Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:
>
> (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;
>
> or
>
> (ii) Four months;

On May 13, 2009, the Office mailed a Notice of Allowance. On August 13, 2009, applicant filed a Rule 312 amendment and the issue fee. On October 8, 2009, applicant filed another Rule 312 amendment correcting errors in the August 13, 2009 Rule 312 amendment. On October 21, 2009, the Office mailed a response to the Rule 312 amendment. The period of reduction pursuant to 37 CFR 1.704(c)(10) is properly calculated as seventy (70) days, counting the number of days in the period beginning on August 13, 2009, the date the first Rule 312 amendment was filed, and ending on October 21, 2009, the date the Office mailed a response to the Rule 312 amendment(s). Accordingly, a 70 day period of reduction is being entered.

On December 15, 2009, applicant filed a petition to withdraw from issue, a RCE, and an Information Disclosure Statement

("IDS"). On December 17, 2009, the Office mailed a decision granting the petition to withdraw from issue. Pursuant to 37 CFR 1.704(c)(10), the 3 day period of reduction begins on December 15, 2009, the date the petition to withdraw from issue was filed, and ends on December 17, 2009, the date the decision granting the petition was mailed. Accordingly a 3 day period of reduction is being entered.

On January 11, 2010, the Office mailed a non-final Office action that addressed the RCE and IDS, both filed on December 15, 2009. Pursuant to 37 CFR 1.704(c)(10), the period of reduction begins on December 15, 2009, the date the RCE and IDS were filed, and ends on January 11, 2010, the date the Office mailed an Office action in response. However, a portion of this period overlaps with the 3 day period of reduction assessed for the filing of the December 15, 2009 petition to withdraw from issue. Accordingly, the reduction is 25 days, beginning on December 18, 2009, the first day after the petition to withdraw from issue was granted, and ending on January 11, 2010, the date the Office mailed an Office action that addressed the December 15, 2009 RCE and IDS. A 25 day period of reduction is being entered.

In light thereof, the correct patent term adjustment is nine hundred fifty-seven (957) days, which is 534 days of A Delay + 884 days of maximum B Delay - 346 days overlapping period between A Delay and B Delay - 115 (17 + 70 + 25 + 3) days of Applicant delay.

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

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

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

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted **by nine hundred fifty-seven (957)** days.

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,838,619 B2

DATED : **November 23, 2010** **DRAFT**

INVENTOR(S) : Papisov

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 664 days

Delete the phrase "by 664 days" and insert – by 957 days--

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**

OCT 27 2010

OFFICE OF PETITIONS

**CAESAR, RIVISE, BERNSTEIN,**
**COHEN & POKOTILOW, LTD.**
**11TH FLOOR, SEVEN PENN CENTER**
**1635 MARKET STREET**
**PHILADEPHIA PA 19103-2212**

| | | |
|---|---|---|
| In re Application of | : | |
| Heiko ZIMMERMANN, et al | : | |
| Application No. 10/501,703 | : | DECISION ON PETITION |
| Filed: November 22, 2004 | : | |
| Attorney Docket No. B1180/20133 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 1, 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 Restriction Requirement, mailed April 6, 2007, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 7, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an election, (2) the petition fee of $810; and (3) the required statement of unintentional delay.

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

date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

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

This application is being referred to Technology Center AU 1651 for appropriate action by the Examiner in the normal course of business on the reply received October 1, 2010.

/DCG/
Diane C. 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
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**IP GROUP OF DLA PIPER LLP (US)**
**ONE LIBERTY PLACE**
**1650 MARKET ST, SUITE 4900**
**PHILADELPHIA PA 19103**

MAILED
NOV 18 2010
OFFICE OF PETITIONS

In re Application:
Daniel Lecomte
Application No. 10/501,858
Filed: October 25, 2004
Attorney Docket No. LMC-04-1175

ON PETITION

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed December 16, 2009.

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

Joan Olszewski
Petitions Examiner
Office of Petitions

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O BOX 1450
ALEXANDRIA, VA 22313-1450
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Raymond J Lillie Carella Byrne
Bain Gilfillan Cecchi Stewart & Olstein
5 Becker Farm Road
Roseland NJ 07068

MAILED

NOV 24 2010

PCT LEGAL ADMINISTRATION

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| HEENEY et al | : | |
| Application No.: 10/502,031 | : | |
| PCT No.: PCT/GB03/00342 | : | |
| Int. Filing Date: 28 January 2003 | : | PETITION UNDER |
| Priority Date: 28 January 2002 | : | |
| Attorney's Docket No.: 430500-11 | : | |
| For: TREATMENT OF MS WITH GOAT SERUM | : | 37 CFR 1.47(a) & 1.137(b) |

This is in response to the "RENEWED PETITION UNDER 37 CFR 1.137(b) and 37 CFR 1.47(a)" filed on 27 September 2010. The petition fee of $200.00 has now been charged to Deposit Account No.: 03-0678.

## BACKGROUND

In a decision from this Office on 22 July 2008, the initial petition under 37 CFR 1.47(a) and 37 CFR 1.137(b) was dismissed. The decision stated that item (2) under 37 CFR 1.47(a) and item (2) under 37 CFR 1.137(b) had not been satisfied.

On 27 September 2010, petitioner submitted a "Renewed Petition Under 37 CFR 1.47(a) and 37 CFR 1.137(b)" requesting reconsideration of the Office's decision of 22 July 2010 with respect to accepting the above application without the signature of Jonathan Heeney. A declaration by patent attorney Gareth Williams has been submitted.

## DISCUSSION

### 37 CFR 1.47(a):

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

The renewed petition of 27 September 2010 has satisfied item (2) under 37 CFR 1.47(a) and item 2 under 37 CFR 1.137(b). Thus satisfying all the requirements under 37 CFR 1.47(a) and 37 CFR 1.137(b).

Regarding item (1), petitioner has now completely paid the petition fee of $200 under 37 CFR 1.17(g) because only $130.00 has been submitted.

Regarding item (2), petitioner has now satisfied it, a declaration by Gareth Williams, who has first-hand knowledge of the facts, has provided a statement outlining the steps he took to mail the application papers (PCT/GB03/00342) to the non-signing inventor Jonathan HEENEY on August 17, 2010 and it was received on 20 August 2010 and by signed upon receipt (Annex II). However, Mr. Heeney has not returned the required papers signed.

Consequently, at this time it can be concluded that Mr. Heeney has refused to sign the required documents.

Consequently, the petition does satisfy all the items under 37 CFR 1.47(a).

**DECISION**

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

**37 CFR 1.137(b):**

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

Petitioner has now satisfied item (1) under 37 CFR 1.137(b).

Applicants have provided: (1) the proper reply that is a properly executed declaration.

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

**DECISION**

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

**CONCLUSION**

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

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

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371

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

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

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

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

Jonathan Heeney
Vrijburgstraat 25, Voorburg, 2275BX
Netherlands

MAILED
NOV 24 2010
PCT LEGAL ADMINISTRATION

In re Application of
HEENEY et al
PCT No.: PCT/GB03/00342
Application No.: 10/502,031
Int. Filing Date: 28 January 2003
Priority Date: 28 January 2002
Attorney's Docket No.: 430500-11
For: TREATMENT OF MS WITH GOAT SERUM

Dear: Mr. Heeney,

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

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

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

Raymond J Lillie Carella Byrne
Bain Gilfillan Cecchi Stewart & Olstein
5 Becker Farm Road
Roseland NJ 07068

**DATE** : 8/18/11

**TO SPE OF** : ART UNIT: 2881

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/502,104 Patent No. 7,847,~~867~~ 267

**CofC mailroom date**

8/10/11

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,*
**Certificates of Correction Branch**

*LIE*

**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.

**X Approved** **All** changes apply.

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

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

**Comments:** OK

approved

/Phillip A Johnston/Primary Examiner, Art Unit 2881

**For Robert Kim**

**SPE** **Art Unit 2881**

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William S Frommer
Frommer Lawrence & Haug
745 Fifth Avenue
New York, NY 10151

Mail Date: 08/02/2010

| | | |
|---|---|---|
| **Applicant** | : Hiroaki Ogawa | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7653541 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/502,169 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/20/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **1135** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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LEWIS AND ROCA LLP
1663 Hwy 395, Suite 201
Minden NV 89423

**MAILED**

FEB 28 2011

**OFFICE OF PETITIONS**

In re Patent No. 7,243,950 :
Issue Date: July 17, 2007 :
Application No. 10/502,329 : NOTICE
Filed: April 19, 2005 :
Attorney Docket No. **KOOT-001** :

This is a notice regarding your request filed January 17, 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 **NOT ACCEPTED**.

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) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Dennemey & Co. LTD
Regent House Heaton Lane
Stockport Cheshire
England SK4 1BB

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LEWIS AND ROCA LLP
1663 Hwy 395, Suite 201
Minden NV 89423

**MAILED**

SEP 28 2011

OFFICE OF PETITIONS

In re Patent No. 7,243,950 :
Issue Date: July 17, 2007 :
Application No. 10/502,329 :
Filed: April 19, 2005 :
Attorney Docket No. **KOOT-001** :

NOTICE

This is a notice regarding your request filed July 22, 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**.

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) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

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VEREENIGDE
Attn: Foreign Patents
JOHAN DE WITTLAAN7
DEN HAAG 2517 JR NL NETHERLANDS

**MAILED**

OCT 20 2011

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,243,950 | : | |
| Issue Date: July 17, 2007 | : | |
| Application No. 10/502,329 | : | NOTICE |
| Filed: April 19, 2005 | : | |
| Attorney Docket No. **KOOT-001** | : | |

This is a response to the communication filed October 11, 2011, correcting the decision of September 28, 2011, regarding your request filed on July 22, 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**.

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) 272-4584.

JoAnne Burke
Petitions Examiner
Office of Petitions

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08 SEP 2010

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www.uspto.gov

David A. Jackson
KLAUBER & JACKSON
411 Hackensack Avenue
4th Floor
Hackensack, NJ 07601

| | |
|---|---|
| In re Application of:<br>KLEINBERG, David, et al.<br>U.S. Application No.: 10/502,364<br>PCT No.: PCT/US03/01886<br>International Filing Date: 22 January 2003<br>Priority Date: 22 January 2002<br>Attorney's Docket No.: 1049-1-029 PCT/US<br>For: METHODS FOR THERAPEUTIC TREATMENT OF BENIGN PROSTATIC HYPERTROPHY (BPH) | DECISION<br>(37 CFR 1.181 and 1.42) |

This decision is issued in response to applicants' "Request To Withdraw An Erroneous Holding Of Abandonment Based On Failure To Respond To Decision On Petition" filed 15 June 2007, treated herein as a petition under 37 CFR 1.181 to withdraw the holding of abandonment and a renewed submission under 37 CFR 1.42. No petition fee is required.

## BACKGROUND

The procedural background for the present application was set forth in the decision mailed on 20 January 2006. The decision dismissed without prejudice applicants' request for status under 37 CFR 1.42 with respect to deceased inventor Sergio VIDAL based on applicants' failure to submit an acceptable declaration executed on behalf of the deceased inventor by his legal representative. The decision provided applicants with an extendable two-month response period.

On 29 May 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Abandonment" (Form PCT/DO/EO/909) stating that the application was abandoned for failure to file a timely response to the decision mailed 20 January 2006.

On 15 June 2007, applicants filed the "Request To Withdraw An Erroneous Holding Of Abandonment Based On Failure To Respond To Decision On Petition" considered herein.

## DISCUSSION

### 1. Petition To Withdraw Holding Of Abandonment (37 CFR 1.181)

The present petition asserts that applicants filed a timely response to the previous decision on 01 June 2006 and that the holding of abandonment was therefore inappropriate. The petition includes a copy of the materials filed by applicant in response to the previous decision (including the declaration executed on behalf of the deceased inventor), as well as a copy of a return postcard that itemizes these materials and bears a USPTO receipt stamp dated 01 June 2006. In addition, USPTO records confirm receipt on 01 June 2006 of the $510 extension fee included with such response.

Based on the statements in the present petition, the attached return postcard, and USPTO records regarding payment of the extension fee, it is concluded that the extension fee payment and the response materials accompanying the present petition, including the executed declaration, were originally filed herein on 01 June 2006. In view of the payment of the three-month extension fee, the 01 June 2006 submission is considered a timely response to the decision mailed on 20 January 2006.

The holding of abandonment, based as it was on applicants' purported failure to file a timely response to the previous decision, is appropriately withdrawn, as requested in the present petition.

### 2. Renewed Submission Under 37 CFR 1.42

The declaration included in applicants' 01 June 2006 filing is executed on behalf of the deceased inventor by his legal representative, and includes the required residence, mailing address, and citizenship for the legal representative, as well as the citizenship of the deceased inventor. This declaration may be accepted on behalf of the deceased inventor under 37 CFR 1.42 and 1.497. It is noted that applicants had previously submitted an acceptable declaration executed by the surviving inventors of record and the surcharge for filing the declaration later than thirty months after the priority date.

## CONCLUSION

The petition to withdraw the holding of abandonment under 37 CFR 1.181 is **GRANTED**.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 29 May 2007 is hereby **VACATED**.

The declaration executed on behalf of the deceased inventor accompanying the present petition is treated as having been originally filed herein on 01 June 2006 as a timely response to the decision mailed 20 January 2006.

The renewed request for status under 37 CFR 1.42 with respect to deceased inventor Sergio VIDAL is **GRANTED**.

This application is being referred to the National Stage Processing Branch of the Office of PCT operations for further processing in accordance with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) is 01 June 2006.

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

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WILSON, SONSINI, GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO CA 94304-1050

**MAILED**

APR 07 2011

**OFFICE OF PETITIONS**

In re Application of :
Chen, et al. :
Application No.: 10/502,420 : ON PETITION
Filing Date: August 26, 2005 :
Attorney Docket No. **27763-705.831** :

This is a decision on the petition under 37 CFR 1.47 filed March 7, 2011, which will be treated as a petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131.

The petition is **granted**.

The record reflects that the joint inventors named in subject application executed the declaration required by 37 CFR 1.63, and that the executed declaration was filed on August 26, 2005. Petitioner now files the instant petition under 37 CFR 1.47(a) because inventors Cho, Holley, Stewart, and Patel have either constructively refused to sign the declaration under 37 CFR 1.131 or cannot be located to execute the declaration under 37 CFR 1.131. Petitioner requests that the declaration under 37 CFR 1.131 be accepted without the signatures of inventors Cho, Holley, Stewart, and Patel.

It is noted that the provisions of 37 CFR 1.47 only apply to the execution of the original oath or declaration under 37 CFR 1.63. A petition under 37 CFR 1.47 is not appropriate in this case because the joint inventors executed the original declaration. Relief can be granted, pursuant to 37 CFR 1.183, by the waiver or suspension of the requirements of 37 CFR 1.131 as to inventors Cho, Holley, Stewart, and Patel.

37 CFR 1.183 permits, in an extraordinary situation, waiver of a rule which is not a requirement of the statute, where justice requires such waiver, and applicant has requested a waiver of the requirement that the 37 CFR 1.131(b)(1) declaration be signed by all the joint inventors.

The instant petition is accompanied by an appropriate showing that inventors Cho, Holley, Stewart, and Patel have constructively refused to execute the declaration under 37 CFR 1.131 or cannot be located to do the same. Accordingly, the declaration of March 7, 2011, signed by inventors Schneider, Felciano, Richards, Selvarajan, and Cehn, will be accepted as though it was signed all joint inventors as required by 37 CFR 1.131.

The fee for the petition under 37 CFR 1.183 is $400.00 as per 37 CFR 1.183 and 1.17(f). The amount of $130.00 paid March 7, 2011, is noted. Deposit account 23-2415 will be charged an additional $270.00, accordingly.

The application file will be forwarded to Technology Center 2100, GAU 1631 for further processing.

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

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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MCCARTER & ENGLISH, LLP
BOSTON
265 Franklin Street
Boston MA 02110

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| | | |
|---|---|---|
| In re Application of | : | |
| KORSUNSKY, ALEXANDER M. | : | APPLICATION FOR PATENT |
| Application No. 10/502,432 | : | TERM ADJUSTMENT |
| Filed: July 25, 2005 | : | |
| Attorney Docket No. ISI-003US | : | |

This is a decision on the "REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(B)" filed May 5, 2010. Applicants submit that the correct patent term adjustment to be indicated on the patent is a minimum of nine hundred eighteen (918) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants seek this correction partly on the basis that the Office will take in excess of three years to issue this patent.

The request for reconsideration of the patent term adjustment is **GRANTED to the extent indicated herein.**

The Office has updated the PALM and PAIR screens to reflect that the corrected patent term adjustment determination at the time of the mailing of the notice of allowance is **zero (0) days**. A copy of the updated PAIR screen, showing the corrected determination, is enclosed.

Initially, applicants disclose that they should have been assessed a period of delay of 504 day pursuant to 37 CFR 1.704(c)(3) for the abandonment of the application. The Office concurs with applicants.

37 CFR 1.704(c)(3) states:

> Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:
>
> (i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or
>
> (ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed[.]

In this instance, a non-final Office action was mailed on July 24, 2007, which set a three-month shortened statutory period for reply. Applicants did not file a timely and proper reply to the non-final Office action. Thus, the application became abandoned on October 25, 2007. On December 17, 2008, applicants filed a petition under 37 CFR 1.137(b) to revive the application. A decision granting the petition to revive was mailed on March 11, 2009. Accordingly, the period of adjustment should be reduced by an additional 504 days, the number of days beginning on the date of abandonment, October 25, 2007, and ending on the lesser period of the date of mailing of the decision reviving the application, March 11, 2009. See 37 CFR 1.704(c)(3)(i). A period of reduction of 504 days will be entered.

As to applicants' request for reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined.

Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.
Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.[1]

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within two months

---

[1] For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

In view of the additional period of reduction pursuant to 37 CFR 1.704(c)(3), the patent term adjustment determination at the time of the mailing of the notice of allowance should be zero (0) days (322 days of Office delay - 504 days of applicant delay).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of updated PAIR screen

## Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/502,432

| | | | |
|---|---|---|---|
| Filing or 371(c) Date: | 07-25-2005 | Overlapping Days Between {A and B} or {A and C}: | 0 |
| Issue Date of Patent: | - | Non-Overlapping USPTO Delays: | 322 |
| A Delays: | 322 | PTO Manual Adjustments: | -504 |
| B Delays: | 0 | Applicant Delays: | 0 |
| C Delays: | 0 | Total PTA Adjustments: | 0 |

**Patent Term Adjustment History** **Explanation Of Calculations**

| Number | Date | Contents Description | PTO (Days) | APPL (Days) | Start |
|---|---|---|---|---|---|
| 75 | 10-20-2010 | Adjustment of PTA Calculation by PTO | | 504 | 0 |
| 61 | 02-05-2010 | Mail Notice of Allowance | | | 0 |
| 60 | 02-02-2010 | Notice of Allowance Data Verification Completed | | | 0 |
| 59 | 01-30-2010 | Document Verification | | | 0 |
| 58 | 02-01-2010 | Examiner's Amendment Communication | | | 0 |
| 57 | 01-27-2010 | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 56 | 02-01-2010 | Notice of Allowability | | | 0 |
| 55 | 01-07-2010 | Date Forwarded to Examiner | | | 0 |
| 54 | 12-09-2009 | Response after Non-Final Action | | | 0 |
| 53 | 09-09-2009 | Mail Non-Final Rejection | | | 0 |
| 52 | 09-08-2009 | Non-Final Rejection | | | 0 |
| 51 | 08-11-2009 | Date Forwarded to Examiner | | | 0 |
| 50 | 08-07-2009 | Amendment after Final Rejection | | | 0 |
| 49 | 05-07-2009 | Mail Final Rejection (PTOL - 326) | 20 | | 46 |
| 48 | 05-07-2009 | Final Rejection | | | 0 |
| 47 | 04-16-2009 | Date Forwarded to Examiner | | | 0 |
| 46 | 12-17-2008 | Response after Non-Final Action | | | 0 |
| 45 | 03-11-2009 | Mail Notice of Rescinded Abandonment | | | 0 |

| | | | | |
|---|---|---|---|---|
| 44 | 04-16-2009 | Notice of Rescinded Abandonment in TCs | | 0 |
| 38 | 03-11-2009 | Mail-Petition to Revive Application - Granted | | 0 |
| 37 | 03-11-2009 | Petition to Revive Application - Granted | | 0 |
| 36 | 12-17-2008 | Petition Entered | | 0 |
| 35 | 02-25-2008 | Mail Abandonment for Failure to Respond to Office Action | | 0 |
| 34 | 02-19-2008 | Aband. for Failure to Respond to O. A. | | 0 |
| 33 | 07-24-2007 | Mail Non-Final Rejection | 302 | 12 |
| 32 | 07-23-2007 | Non-Final Rejection | | 0 |
| 25 | 06-19-2007 | Case Docketed to Examiner in GAU | | 0 |
| 23 | 04-17-2006 | Cleared by OIPE CSR | | 0 |
| 21 | 11-17-2005 | IFW TSS Processing by Tech Center Complete | | 0 |
| 19 | 07-25-2005 | Reference capture on IDS | | 0 |
| 12 | 07-25-2005 | 371 Completion Date | | 0 |
| 11 | 08-30-2005 | Application Dispatched from OIPE | | 0 |
| 10 | 08-30-2005 | Notice of DO/EO Acceptance Mailed | | 0 |
| 9 | 07-25-2005 | Additional Application Filing Fees | | 0 |
| 7 | 07-25-2005 | A statement by one or more inventors satisfying the requirement under 35 USC 115, Oath of the Applic | | 0 |
| 6 | 08-18-2005 | Mail-Petition Decision - Granted | | 0 |
| 5 | 07-25-2005 | Petition Entered | | 0 |

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/502,489 | 07/26/2004 | Alexandra M.P. Santana Sorensen | 10-129 | 8112 |

20306 7590 01/05/2012
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

| EXAMINER |
|---|
| HIBBERT, CATHERINE S |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1636 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 01/05/2012 | 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.

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JAN 0 5 2012

Emily Miao
MCDONNELL BOEHNEN HULBERT & BERGHOFF PPL
300 SOUTH WACKER DRIVE
CHICAGO, IL 60606

| | |
|---|---|
| In re Application of | : |
| Sorensen et al | : |
| Serial No.:10/502,489 | : Decision on Petition |
| Filed: 26 July 2004 | : |
| Attorney Docket No.: 10-129 | : |

This letter is in response to the Petition dated 26 April 2011 filed under 37 CFR 1.144 requesting reconsideration of the restriction requirement dated 9 October 2007.

**BACKGROUND**

This application was filed as a national stage in compliance with 35 U.S.C. 371 and as such is entitled for consideration under PCT unity of invention rules.

On 9 October 2007, the examiner determined that unity of invention was lacking and divided claims into 37 groups. Claim 131 was identified as a linking claim for Groups I-XXXV.

On 10 December 2007, applicants elected Group III, claims 134-135, along with linking claim 131, with traverse.

The examiner considered the traversal and made the requirement final on 4 April 2008. Claims 131 and 134-135 were examined on the merits and the remainder of the claim withdrawn from consideration.

Following several rounds of prosecution, in which claims 131, 134 and 135 were rejected on the merits and many other claims were withdrawn from examination, applicants filed a request for continued examination on 26 April 2011, along with this petition for reconsideration of the lack of unity determination.

**DISCUSSION**

The application, file history and petition have been considered carefully.

The petition requests reconsideration of the restriction requirement.

In the most recent Office action on the merits, mailed 26 October 2010, claims 131, 134, and 135 were examined on the merits. Claims 132, 133 ,136, 140, 150, 152-154, 157-160, 162-163, 167-170, 172, 174, 177-178, 180-190, 192-195, 197, 199, 201, 203-205, 207-210 and 212-219 were withdrawn from consideration as being directed to non-elected inventions. Claim 131 was rejected on the grounds of provisional double patenting over copending application 10/470,062 and separately over copending application 10/523,007. Claims 131 and 134-135 were rejected under 35 U.S.C. 112, 2nd paragraph for indefiniteness. Claims 131 and 134-135 were rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Delcardayre and further in view of Minshull.

The PCT International Search and Preliminary Examination Guidelines, paragraph 20.09, provides for re-evaluation of any unity of invention determination following amendment of the claims. Accordingly, this petition decision will be determined in view of the claims as currently amended.

The current claim set comprises three independent claims which are related as

A method of making a composition comprising a producer cell (Claim 131, which was indicated as linking Groups I-XXV)
The producer cell product (Claim 212, placed in Group XXXVI and withdrawn from examination) and
A method of using the composition comprising the producer cell (Claims 218, which was placed in Group XXXVII and withdrawn from examination.)

PCT Rule 13.2 permits restriction in this situation if the prior art anticipates or renders obvious that shared technical feature. The Office action of 26 October 2011 contains a rejection of Claims 131 and 134-135 under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Delcardayre and further in view of Minshull.

Maintaining the lack of unity determination between the product, process of making and process of using the product is consistent with Example 1 of the International Search and Examination Guidelines published in 2004.

Claim 1: A method of manufacturing chemical substance X.
Claim 2: Substance X.
Claim 3: The (method of) use of substance X as an insecticide.

Unity exists between claims 1, 2 and 3. The special technical feature common to all the claims is substance X. However, if substance X is known in the art, unity would be lacking because there would not be a special technical feature common to all the claims.

For this reason, in view of the outstanding prior art rejection, the lack of unity determination between the product and the process inventions is warranted.

Turning now to consider the lack of unity determination made between Groups I-XXXV, the examiner has divided dependent process claims 132-210 into 35 groups, based upon limitations recited in the individual dependent claims.

MPEP 806.05 cautions that where "two or more related inventions are claimed, the principal question to be determined in connection with a requirement to restrict or a rejection on the ground of double patenting is whether or not the inventions as claimed are distinct. If they are distinct, restriction may be proper. If they are not distinct, restriction is never proper. If nondistinct inventions are claimed in separate applications or patents, double patenting must be held, except where the additional applications were filed consonant with a requirement to restrict."

MPEP 804.01 cautions that a heavy burden has been imposed on the Office "to guard against erroneous requirements for restrictions where the claims define essentially the same invention in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention."

Here, counter to MPEP 804.01 and 806.05, in many instances, patentably indistinct claims have been placed in different groups for examination. For example, claim 133, which requires the use of more than one parameter, has been placed in Group II while Claim 134, which then specifies that the more than one parameter is related to activity against a pharmaceutical target, has been placed in Group III.

133. (Withdrawn) The method according to claim 131, wherein step c) comprises selecting cells meeting a predetermined selection criterion of more than one parameter.

134. (Previously presented) The method according to claim 131, wherein at least one parameter is a parameter related to activity against a pharmacological target.

Group II, claim(s) 133, drawn to the method according to claim 131, wherein step c) comprises selecting cells meeting a predetermined selection criterion of more than one parameter.

Group III, claim(s) 134-135, drawn to the method according to claim 131, wherein at least one parameter is a parameter related to activity against a pharmacological target.

Division between the generic claim 133 (placed in Group II) and the specific claim of 134 (placed in Group III) is not warranted because it may result in the issuance of two patents containing patentably indistinct subject matter which would not be bound by terminal disclaimers.

For another example, claim 152, which requires that the stringency of the selection criteria is increased for at least some of the repeats has been placed in Group VII, while claim 153, which

requires that the type of selection criteria is changed for at least some of the repeats, has been placed in Group VIII.

152. (Withdrawn) The method according to claim 131, wherein the stringency of the selection criteria/criterion is increased for at least some of the repeats.

153. (Withdrawn) The method according to claim 131, wherein the type of selection criteria/criterion is changed for at least some of the repeats.

Group VII, claim(s) 152, drawn to the method according to claim 131, wherein the stringency of the selection criteria/criterion is increased for at least some of the repeats.

Group VIII, claim(s) 153, drawn to the method according to claim 131, wherein the type of selection criteria/criterion is changed for at least some of the repeats.

Division between claim 152 (placed in Group VII) and claim of 153 (placed in Group VIII) is not warranted because both claims read upon the embodiment where both the stringency of the selection criteria is increased for at least some of the repeats and the type of selection criteria is changed for at least some of the repeats. Division between claims 152 and 153 may result in the issuance of two patents containing patentably indistinct subject matter which would not be bound terminal disclaimers.

As a third example, both claims 157 and 158 read upon selection criteria of survival, superior growth, deviating morphology, stickiness, spectral properties and (modulation of) enzyme activity yet this subject matter was placed into both Group X and XI.

Group X, claim(s) 157, drawn to the method according to claim 131, wherein at least one selection criterion is selection on the basis of survival, superior growth, deviating morphology, stickiness, spectral properties, (modulation of) enzyme activity.

Group XI, claim(s) 158, drawn to the method according to claim 131, wherein at least one selection criterion is selected from at least one physical criterion, such as temperature, osmolarity, light, and electricity, leading to cells being selected on the basis of survival, superior growth, deviating morphology, stickiness, spectral properties, (modulation of) enzyme activity, activation of a receptor, prevention of an activating molecule binding to a receptor.

Although this application has been filed in compliance with 35 U.S.C. 371 and is subject to review under unity of invention, in the Office action dated 4 April 2008, the examiner maintained the unity of invention requirement by stating that that it would present a serious burden to examine the claims together. Even if this were the correct rationale for evaluation, the rationale would not be persuasive because, in some instances, the groupings divide claims that could easily be examined together. For example, the examiner has restricted between (and then withdrawn from examination) claim 194 and claim 195.

194. (Withdrawn) The method according to claim 131, wherein the producer cell comprises a prokaryotic cell selected from the group comprising bacteria.

195. (Withdrawn) The method according to claim 131, wherein the producer cell comprises a eukaryotic cell selected from the group consisting of yeasts; filamentous ascomycetes; plant cells and mammalian host cells.

A review of the prior art rejection shows that on page four, the "Minshull" reference, which was applied as prior art, teaches recipient cells including bacterial cells, yeast cells, fungal cells, plant cells and animal cells. This teaching pertains to both of withdrawn claims 194 and 195 and also demonstrates that it would not present a serious burden to have examined these dependent claims with independent claim 131, which is generic to any type of producer cell.

WO 01/73000 PCT/US01/09203

some cases, multiple conjoint polynucleotide segments are introduced into cells in a combinatorial fashion. Combinations can include different combinations of "supersets" or combinations of subsets of the same "superset" on different episomes. In some cases, the recombinant concatamers are integrated into a chromosome or into the DNA of an intracellular organelle such as a chloroplast or mitochondria. Recipient cells include bacterial cells, yeast cells, fungal cells, plant cells and animal cells.

ISPE Guidelines state in Paragraph 10.04.

> "Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor persisted in on the basis of a narrow, literal or academic approach. There should be a broad, practical consideration of the degree of interdependence of the alternatives presented, in relation to the state of the art as revealed by the international search or, in accordance with Article 33(6), by any additional document considered to be relevant. If the common matter of the independent claims is well known and the remaining subject matter of each claim differs from that of the others without there being any unifying novel inventive concept common to all, then clearly there is lack of unity of invention. If, on the other hand, there is a single general inventive concept that appears novel and involves inventive step, then objection of lack of unity does not arise. For determining the action to be taken by the examiner between these two extremes, rigid rules cannot be given and each case is considered on its merits, the benefit of any doubt being given to the applicant."

In this instance, given the many overlaps in scope between separately grouped dependent claims, and demonstrated lack of serious burden, the benefit of doubt is given to applicant and the division of Groups I-XXXV is unwarranted.

**DECISION**

The petition under 37 CFR 1.144 filed 26 April 2011 is **GRANTED-IN-PART**.

The restriction requirement between Groups I-XXXV has been withdrawn.

In view of the outstanding prior art rejection, the restriction requirement has been maintained between the product of claims 212-217 (Group XXXVI), the method of claims 218-219 (Group XXXVII and the method of making the product (Groups I-XXXV, hereby rejoined for examination).

**The application will be returned to the examiner for consideration of the papers filed 26 April 2011 and for preparation of an Office action consistent with this decision.**

**Any requests for reconsideration of this decision must be filed under 37 CFR 1.181 within two (2) months of the mailing date of this letter.**

Should there be any questions regarding this decision, please contact Quality Assurance Specialist Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-0512 or by Official Fax at 571-273-8300.

Jacqueline Stone
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/502,686 | 07/27/2004 | Kenji Senda | MAT-8581US | 7584 |

23122 7590 12/10/2010
RATNERPRESTIA
P.O. BOX 980
VALLEY FORGE, PA 19482

| EXAMINER |
|---|
| THOMAS, BRADLEY H |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2835 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 12/10/2010 | PAPER |

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

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

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P.O. BOX 980
VALLEY FORGE, PA 19482

| | | |
|---|---|---|
| In re Application of:<br>Kenji Senda et al.<br>Serial No.: 10/502,686<br>Filed: July 27, 2004<br>Attorney Docket No.: MAT-8581US | :<br>:<br>:<br>:<br>: | DECISION *SUA SPONTE*<br>WITHDRAWING HOLDING<br>OF ABANDONMENT |

This is a decision, *sua sponte*, withdrawing the holding of abandonment of the above-identified application.

A decision on appeal by the Board of Patent Appeals and Interferences (BPAI) was mailed on August 25, 2010, affirming the final rejections by the examiner of all pending claims in the application. A decision denying a Request for Rehearing filed October 25, 2010 was issued on November 12, 2010. A Notice of Abandonment was mailed on November 17, 2010.

Although no petition or request to withdraw the holding of abandonment in this application has been filed, the Notice of Abandonment is hereby vacated, the holding of abandonment withdrawn and the application restored to pending status in view of the fact that petitioner has two months from the date of the BPAI decision on the Request for Rehearing to seek review of the decision by the court or to commence a civil action.

Any inquiry regarding this decision should be directed to Hien H. Phan, Quality Assurance Specialist, at (571) 272-1606.

John W. Cabeca, TC Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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) |
|---|---|---|---|---|
| 7,140,699 | 2006-11-28 | 10/502,687 | 2004-07-27 | PC10351US |

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

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 | /Glenn M. Massina/ | Date (YYYY-MM-DD) | 2011-02-09 |
| Name | Glenn M. Massina | Registration Number | 40081 |

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. 7140699
Issue Date: November 28,2006
Application No. 10502687
Filed: July 27,2004
Attorney Docket No. PC10351US

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

This is a decision on the electronic petition, filed February 9,2011 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 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 9,2011 . 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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SEP 02 2011

OFFICE OF PETITIONS

In re Application
Brian Whittle et al.
Application No. 10/502,822
Filed: March 2, 2005
Attorney Docket No.
H0664.70025US00

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)filed August 31, 2011. Applicant requests that the determination of patent term adjustment be corrected from 162 to 415 days. Applicant requests this correction in part on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).[1]

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the patent term adjustment relating to those provisions until the patent has issued.

[1]Reconsidered in light of the Court of Appeals for the Federal Circuit's decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.[2]

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within two months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3212.

/Patricia Faison-Ball/

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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[2] For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

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MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C
ONE FINANCIAL CENTER
BOSTON MA 02111

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AUG 27 2010

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| | | |
|---|---|---|
| In re Application of | : | |
| Coleman et al. | : | |
| Application No. 10/502837 | : | DECISION ON APPLICATION |
| Filing or 371(c) Date: 07/28/2004 | : | FOR PATENT TERM ADJUSTMENT |
| Attorney Docket Number: | : | |
| 21426-017 NATL | : | |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(B)," filed March 16, 2010. Applicants request recalculation of the patent term adjustment to 762 days, not 1177 days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant requests this correction based upon (1) an assertion that the Office erred in failing to calculate delays of 349 days and 66 days.

The Application for Patent Term Adjustment Including Request for Reconsideration of Patent Term Adjustment ("PTA") under 37 CFR 1.705(b), as it relates to the assertion that the Office erred in failing to calculate delays of 184 days is **GRANTED**.

On December 16, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is eleven hundred seventy-seven (1177) days.

On March 16, 2010, applicant timely submitted the instant application for patent term adjustment[1]. Applicants request that the Determination of Patent Term Adjustment be corrected from eleven hundred seventy-seven (1177) days, as indicated on the Determination of PTA mailed December 16, 2009, to an adjustment of 762 days. Applicants aver that the Office may have erred in failing to calculate delays of 349 days and 66 days.

As to the assertion that the Office erred in failing to calculate a delay of 349 days, the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) mailed September 1, 2009 indicates a patent term of eleven hundred seventy-seven (1177) days. The instant request for

[1] PALM records show that the Issue Fee payment was received in the Office on March 16, 2010.

reconsideration of patent term adjustment indicates that the Office may have erred in failing to calculate an adjustment 349 days in connection with Applicants failure to file a complete and proper reply to a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US), on or before Decemmer 15, 2003.

Office records reveal that the application is a National Stage entry of International Application No. PCT/US2002/19402, and claims a priority date from Provisional Application No. 60/298440, filed June 15, 2001. Pursuant to 35 U.S.C. § 154(b)(1)(B) and 37 CFR 1.702(b), the filing date used to calculate the patent term adjustment in this instance is December 15, 2003 (30 months from the earliest priority date claimed)[2].

Office records reveal further that the application became abandoned on December 16, 2003, for failing to a complete and proper reply to a Notification of Missing Requirements Under 35 U.S.C. 371. A petition to revive the application was filed on July 28, 2004, and granted in a Decision mailed April 21, 2005. Office records confirm that no notice of Abandonment was mailed. Pursuant to 37 CFR 1.704(c)(3), a reduction of 349 days, beginning on the date of abandonment, December 16, 2003, and ending on the (ii) the date that is four months after the date the grantable petition to revive was filed, November 28, 2004, is appropriate.

As to the assertion that the Office erred in failing to calculate a delay of 66 days, Office records confirm that Applicants filed a reply to a non-final Office action on September 18, 2009, including a Terminal Disclaimer. The Terminal Disclaimer was disapproved. Applicants filed a corrected Terminal Disclaimer on November 23, 2009. The reduction commenced September 19, 2009, the day after the date that the response to the non-final Office action was filed, and ending on the date corrected Terminal Disclaimer was filed, November 23, 2009. As such, pursuant to 37 CFR 1.704(c)(7), the application is properly assessed a reduction of 66 days.

In view thereof, as of the time of allowance, the application is entitled to an overall patent term adjustment of seven hundred sixty-two days (adjustments totaling 1268 days less reductions totaling 506 days).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent, including any request as it relates to the Office's failure to issue the patent within 3 years of the filing date, must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing

[2] The commencement date may be earlier than 30 months where (1) an applicant expressly requested early commencement, and completed all requirements under 35 U.S.C. 371(c), or (2) Demand was timely filed requesting a change in commencement from 20 to 30 months. Neither is applicable here.

the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.

Anthony Knight
Director
Office of Petitions

Enclosure: Copy of Adjustment PAIR Calculations

Day : Thursday
Date: 8/26/2010

# PALM INTRANET

Time: 13:06:35

| PTA Calculations for Application: 10/502837 | | | |
|---|---|---|---|
| Application Filing Date: | 07/28/2004 | PTO Delay (PTO): | 1268 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 91 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 762 |
| PTO Delay Adjustment: | -415 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 72 | 08/26/2010 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 415 | |
| 53 | 12/16/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 52 | 12/13/2009 | ISSUE REVISION COMPLETED | | | |
| 51 | 12/13/2009 | DOCUMENT VERIFICATION | | | |
| 50 | 12/07/2009 | ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING | | | |
| 49 | 12/02/2009 | ISSUE REVISION COMPLETED | | | |
| 48 | 12/02/2009 | DOCUMENT VERIFICATION | | | |
| 47 | 11/25/2009 | ISSUE REVISION COMPLETED | | | |
| 46 | 11/25/2009 | DOCUMENT VERIFICATION | | | |
| 45 | 11/25/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 44 | 11/25/2009 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 43 | 11/23/2009 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 42 | 11/23/2009 | NOTICE OF ALLOWABILITY | | | |
| 39 | 09/18/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 38 | 09/18/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 37 | 08/13/2009 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 36 | 09/28/2009 | PARALEGAL TD NOT ACCEPTED | | | |
| 35 | 09/18/2009 | TERMINAL DISCLAIMER FILED | | | |
| 34 | 09/28/2009 | TERMINAL DISCLAIMER FEE PAID | | | |
| 33 | 08/13/2009 | REFERENCE CAPTURE ON IDS | | | |
| 32 | 08/13/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 31 | 09/18/2009 | NEW OR ADDITIONAL DRAWING FILED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 30 | 09/20/2009 | DATE FORWARDED TO EXAMINER | | | |
| 29 | 09/18/2009 | RESPONSE AFTER NON-FINAL ACTION | | 91 | 21 |
| 27 | 09/18/2009 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 26 | 09/18/2009 | REFERENCE CAPTURE ON IDS | | | |
| 25 | 09/18/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 24 | 09/18/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 23 | 09/18/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 22 | 08/13/2009 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 21 | 03/19/2009 | MAIL NON-FINAL REJECTION | 1268 | | 6 |
| 20 | 03/16/2009 | NON-FINAL REJECTION | | | |
| 19 | 10/06/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 18 | 01/05/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 17 | 10/17/2007 | WITHDRAW FLAGGED FOR 5/25 | | | |
| 16 | 10/15/2007 | FLAGGED FOR 5/25 | | | |
| 14 | 11/15/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 13 | 07/13/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 12 | 07/13/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 11 | 07/28/2004 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | | |
| 10 | 07/13/2005 | CLEARED BY OIPE CSR | | | |
| 9 | 07/13/2005 | CLEARED BY OIPE CSR | | | |
| 8 | 07/13/2005 | CLEARED BY OIPE CSR | | | |
| 7 | 07/13/2005 | CLEARED BY OIPE CSR | | | |
| 6 | 07/28/2004 | 371 COMPLETION DATE | | | |
| 5 | 07/06/2005 | APPLICATION DISPATCHED FROM OIPE | | | |
| 4 | 07/06/2005 | NOTICE OF DO/EO ACCEPTANCE MAILED | | | |
| 3 | 04/21/2005 | MAIL-PETITION TO REVIVE APPLICATION - GRANTED | | | |
| 2 | 07/28/2004 | PETITION ENTERED | | | |
| 1 | 07/28/2004 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** [ ] Search

## EXPLANATION OF PTA CALCULATION

## EXPLANATION OF PTE CALCULATION

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to OASIS | Home page

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
JUL 29 2011
OFFICE OF PETITIONS

GREENLEE SULLIVAN P.C.
4875 PEARL EAST CIRCLE
SUITE 200
BOULDER, CO 80301

| | | |
|---|---|---|
| In re Patent No. 7,339,521 | : | |
| Issue Date: March 4, 2008 | : | |
| Application No. 10/502,842 | : | NOTICE |
| Filed: January 18, 2005 | : | |
| Attorney Docket No.: 17-02 | : | |

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

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

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

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

Inquiries related to this communication should be directed to the undersigned at (571) 272-3204.

/SDB/

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

| Issue Classification | Application/Control No. | Applicant(s)/Patent under Reexamination | |
|---|---|---|---|
| | 10/502,849 | ALDERBORN ET AL. | |
| | Examiner | Art Unit | |
| | FRANK LU | 1634 | |

# ISSUE CLASSIFICATION

| ORIGINAL | | | | | | CROSS REFERENCE(S) | | | | | | |
|---|---|---|---|---|---|---|---|---|---|---|---|---|
| CLASS | | | | SUBCLASS | CLASS | SUBCLASS (ONE SUBCLASS PER BLOCK) | | | | | | |
| 435 | | | | 287.1 | 435 | 283.1 | 287.2 | | | | | |
| INTERNATIONAL CLASSIFICATION | | | | | 422 | 68.1 | | | | | | |
| C | 1 | 2 | M | 1/34 | | | | | | | | |
| C | 1 | 2 | M | 3/00 | | | | | | | | |
| C | 1 | 2 | M | 1/00 | | | | | | | | |
| G | 0 | 1 | N | 15/06 | | | | | | | | |
| G | 0 | 1 | N | 33/00 | | | | | | | | |

| | | |
|---|---|---|
| (Assistant Examiner) (Date) | | Total Claims Allowed: 10 |
| (Legal Instruments Examiner) (Date) | /Frank W Lu/ 10/20/2011 (Primary Examiner) (Date) | O.G. Print Claim(s): 1 — O.G. Print Fig.: 1b |

☐ Claims renumbered in the same order as presented by applicant ☐ CPA ☐ T.D. ☐ R.1.47

| Final | Original | Final | Original | Final | Original | Final | Original | Final | Original | Final | Original | Final | Original |
|---|---|---|---|---|---|---|---|---|---|---|---|---|---|
| | 1 | | 31 | | 61 | | 91 | | 121 | | 151 | | 181 |
| | 2 | | 32 | | 62 | | 92 | | 122 | | 152 | | 182 |
| | 3 | | 33 | | 63 | | 93 | | 123 | | 153 | | 183 |
| | 4 | | 34 | | 64 | | 94 | | 124 | | 154 | | 184 |
| | 5 | | 35 | | 65 | | 95 | | 125 | | 155 | | 185 |
| | 6 | | 36 | | 66 | | 96 | | 126 | | 156 | | 186 |
| | 7 | | 37 | | 67 | | 97 | | 127 | | 157 | | 187 |
| | 8 | | 38 | | 68 | | 98 | | 128 | | 158 | | 188 |
| 1 | 9 | | 39 | | 69 | | 99 | | 129 | | 159 | | 189 |
| | 10 | | 40 | | 70 | | 100 | | 130 | | 160 | | 190 |
| | 11 | | 41 | | 71 | | 101 | | 131 | | 161 | | 191 |
| 8 | 12 | | 42 | | 72 | | 102 | | 132 | | 162 | | 192 |
| 9 | 13 | | 43 | | 73 | | 103 | | 133 | | 163 | | 193 |
| 2 | 14 | | 44 | | 74 | | 104 | | 134 | | 164 | | 194 |
| 4 | 15 | | 45 | | 75 | | 105 | | 135 | | 165 | | 195 |
| 5 | 16 | | 46 | | 76 | | 106 | | 136 | | 166 | | 196 |
| 6 | 17 | | 47 | | 77 | | 107 | | 137 | | 167 | | 197 |
| | 18 | | 48 | | 78 | | 108 | | 138 | | 168 | | 198 |
| | 19 | | 49 | | 79 | | 109 | | 139 | | 169 | | 199 |
| | 20 | | 50 | | 80 | | 110 | | 140 | | 170 | | 200 |
| | 21 | | 51 | | 81 | | 111 | | 141 | | 171 | | 201 |
| 7 | 22 | | 52 | | 82 | | 112 | | 142 | | 172 | | 202 |
| 10 | 23 | | 53 | | 83 | | 113 | | 143 | | 173 | | 203 |
| 3 | 24 | | 54 | | 84 | | 114 | | 144 | | 174 | | 204 |
| | 25 | | 55 | | 85 | | 115 | | 145 | | 175 | | 205 |
| | 26 | | 56 | | 86 | | 116 | | 146 | | 176 | | 206 |
| | 27 | | 57 | | 87 | | 117 | | 147 | | 177 | | 207 |
| | 28 | | 58 | | 88 | | 118 | | 148 | | 178 | | 208 |
| | 29 | | 59 | | 89 | | 119 | | 149 | | 179 | | 209 |
| | 30 | | 60 | | 90 | | 120 | | 150 | | 180 | | 210 |

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10-29-10

TO SPE OF : ART UNIT 1741

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/502,865 Patent No.: 7704351

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

**FOR IFW FILES:** Check Inventors

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**

**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. |

SPE _____ ART UNIT 1741

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 : December 14, 2010

Patent No. :7820197
Ser. No. :10502951
Inventor(s) : Yasuhiro TSUJI et al
Issued :October 26, 2010
Title :PERCUTANEOUS PREPARATIONS

**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<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Service Window<br>Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (703) 872-9306<br>ATTN: Office of Petitions |
| Electronic Filing | uspto.gov/ebc/index.html<br>(must be registered as an e-filer to submit responses)<br>Support 1-866-217-9197 571-272-4100 |

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.

For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) 756-1580 or (703) 756- 1541

Carey, Rodriquez, Greenberg & Paul, LLP
950 Peninsula Corporate Circle, Ste 2022
Boca Raton, FL 33487

/arg

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 : December 14, 2010

Patent No. :7820197
Ser. No. :10502951
Inventor(s) : Yasuhiro TSUJI et al
Issued :October 26, 2010
Title :PERCUTANEOUS PREPARATIONS

**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<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Service Window<br>Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (703) 872-9306<br>ATTN: Office of Petitions |
| Electronic Filing | uspto.gov/ebc/index.html<br>(must be registered as an e-filer to submit responses)<br>Support 1-866-217-9197 571-272-4100 |

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.

For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) 756-1580 or (703) 756-1541

Carey, Rodriquez, Greenberg & Paul, LLP
950 Peninsula Corporate Circle, Ste 2022
Boca Raton, FL 33487

/arg

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

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

MAILED
APR 25 2011
OFFICE OF PETITIONS

In re Patent No. 7,820,197 :
Issue Date: October 26, 2010 :
Application No. 10/502,951 : DECISION ON PETITION
Filed: July 29, 2004 :
Attorney Docket No. 07580.0004 :

This is a decision on the Petition Under 37 C.F.R. §1.183 For Correction Of Assignee and Request For Certificate Of Correction, filed December 2, 2010, which is being treated as Petition Under 37 CFR §3.81(b), to identify the correct assignee's name. A completed Certificate of Correction Form was submitted with Petition.

The petition under 37 CFR §3.81(b) is **GRANTED**.

Petitioner urges that the present Petition was submitted to correct the assignee's name on the previously submitted PTOL 85B and such error was inadvertent. Accordingly, petitioner requests that a Certificate of Correction (PTO/SB/44) be issued to correct assignee's name to the Title Page of the Letters Patent.

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

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

The requisite $100.00 fee (Fee Code 1811), as set forth under 37 CFR 1.20(a), and the requisite $130.00 processing fee (Fee Code 1464), as set forth under 37 CFR 1.17(i), have been submitted. Further, Office assignment records are consistent with the requested correction. Accordingly, since the Petition complies with the provisions of 37 CFR 3.81(b), it is appropriate for the Office to issue a Certificate of Correction in accordance with the content of the Form submitted with Petition.

Inquiries related this communication should be directed to the undersigned at (571)272-3213.

Any questions concerning the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (703)756-1814.

This matter is being referred to the Certificates of Correction Branch for processing of a Certificate of Correction in U.S. Patent No. 7,820,197.

Cheryl Gibson Baylor

Cheryl Gibson-Baylor
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

KING & SPALDING
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036-4003

**MAILED**

DEC 07 2010

**OFFICE OF PETITIONS**

In re Patent No. 7,767,659 :
Issue Date: August 3, 2010 :
Application No. 10/503,106 : ON PETITION
Filed: June 8, 2005 :
Attorney Docket Number: 13566.105052 :

This is a decision on the petition, filed November 18, 2010, requesting the issuance of a duplicate Letters Patent for the above-identified application.

The petition is **GRANTED**.

Petitioner states that the original Letters Patent was never received.

The required showing to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication (in this case, the original Letters Patent) was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Letters Patent was not received. A copy of the docket record where the non-received Letters Patent would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. *See* MPEP § 711.03(c) and 1156 Official Gazette 53 (November 16, 1993).

The petition is accompanied by the evidence required to establish non-receipt of the original Letters patent. Accordingly, the Office of Data Management is directed to issue a duplicate Letters Patent.

Telephone inquiries concerning this decision may be directed to the undersigned Senior Petitions Attorney at (571) 272-3212. Inquiries regarding the issuance of a duplicate Letters Patent may be directed to the Office of Data Management at (703) 308-9250.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

cc: Ollie Person (Fax – (571) 270-9764)
Kimberly Terrell (Fax – (571) 270-9958)

**UNITED STATES DEPARTMENT OF COMMERCE**
**Patent and Trademark Office**
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, VA 22313-1450

Patent No.: 7767659 B2
Application No.: 10/503106
Issued : 08/03/2010
Atty Docket No.: **13566.105052**

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 Rule1.323.

Respecting the alleged error changing inventors' name, "Alberto Rodriguez" to "Roberto Rodriguez". The inventor name is printed in accordance with the Declaration submitted at the time of filing the application. Therefore, no correction is in order here under Rule, 1.323.

However, your attention is directed to C.F.R. 1.324, wherein a request is being made to change, add or delete inventor(s) names, after issuance of the patent.

In view of the foregoing, your request in this matter is hereby denied.
A certificate of correction will be issued to correct the remaining errors in your request.

A petition under C.F.R. 1.324 should include:

A. the processing fee set forth in 37 CFR 1.20(b) (currently $130);
B. a statement from each person being added as an inventor that the inventorship occurred without any deceptive intention on his or her part, a statement from the current inventors agreeing to the change of inventorship of stating that they have no disagreement in regard to the requested change, and a statement from all assignees of the current inventors agreeing to the change of inventorship in the patent.

Further correspondence concerning this matter should be filed and directed to Supervisory Patent Examiner of Technology Center 1624 at the U.S. Patent and Trademark Office.

Tasneem Siddiqui
For Mary F. Diggs
Decisions & Certificates of Correction Branch
703-756-1593 or 703-756-1814
Date: 05/03/2011

Address: Kenneth H. Sonnenfeld
KING & SPALDING, LLP
1185 Avenue of the Americas
New York, NY 10036

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 05/4/11

**TO SPE OF** : ART UNIT 1622

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 10/503,106 Patent No.: 7767659

**CofC mailroom date:** 04/29/11

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**

**Tasneem Siddiqui**
**Certificates of Correction Branch**
**703-756-1593 or 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. |
| X **Approved in Part** | Specify below which changes **do not** apply. |
| ☐ **Denied** | State the reasons for denial below. |

**Comments:** Change of inventorship is not supported by the Oath (6/8/05) or the ADS (9/23/05). There is nothing of record indicating that a correction was sought during prosecution and that such a change corresponds to the same person.

/Andrew D. Kosar/ _____ 1622
**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

MAILED

OCT 29 2010

OFFICE OF PETITIONS

NOVARTIS VACCINES AND DIAGNOSTICS INC.
INTELLECTUAL PROPERTY- X100B
P.O. BOX 8097
Emeryville CA 94662-8097

| | | |
|---|---|---|
| In re Patent No. 7,754,228 | : | DECISION ON REQUEST |
| Novartis, et al. | : | FOR |
| Issue Date: July 13, 2010 | : | RECONSIDERATION OF |
| Application No. 10/503,135 | : | PATENT TERM ADJUSTMENT |
| Filed: August 11, 2004 | : | and |
| Atty Docket No. **PAT051214-US-PCT** | : | NOTICE OF INTENT TO ISSUE |
| | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on September 13, 2010, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by four one thousand, one hundred and seventy-eight (1,178) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by one thousand, one hundred and seventy-seven (1,177) days is **GRANTED to the extent indicated herein.**[1]

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or

---

[1] [1] It is noted that patentees assert that only 37 days of reduction to the patent term adjustment should be entered for the filing of the amendment under 37 CFR 1.312, however, the period of reduction to the patent term adjustment under 37 CFR 1.704(c)(10) begins on, and includes, the date the amendment under 37 CFR 1.312 was filed and ends on, and includes, the mailing date of the response to the amendment under 37 CFR 1.312. "When a period is indicated (in 37 CFR 1.703 or 1.704) as 'beginning' on a particular day, that day is included in the period, in that such day is 'day one' of the period and not 'day zero.'" MPEP 2731. "For example, a period beginning on April 1 and ending on April 10 is ten (and not nine) days in length." Id. Thus, in this instance, the period of reduction to the patent term adjustment is 38 days.

patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The fee required under 37 CFR 1.18(e)was received. No additional fees are due.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application is being forwarded to the Certificates of Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand, one hundred and seventy-seven (1,177)** days.

Telephone inquiries specific to this matter should be directed to the undersigned, at (571) 272-3222.

/Kenya A. McLaughlin/

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

**DRAFT COPY**

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,754,228 B2

DATED : Jul. 13, 2010

INVENTOR(S) : Bensi et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (1041) days

Delete the phrase "by 1041 days" and insert – by 1177 days--

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PO BOX 1022
MINNEAPOLIS MN 55440-1022

**MAILED**

DEC 30 2011

**OFFICE OF PETITIONS**

In re Application
Daniel Chrichton
Application No. 10/503,418
Filed: December 30, 2004
Attorney Docket No. **12587-0265US1 /**

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) filed December 21, 2011. Applicant requests that the determination of patent term adjustment be corrected from 684 days to 643 days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

On October 27, 2011, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 684 days. The instant application for patent term adjustment was timely filed before payment of the issue fee.

Applicants dispute the reduction of 1 day for the response filed April 29, 2009. "The USPTO mailed a Final rejection to the applicants on December 29, 2008, setting a shortened statutory period of three months to reply. The three month response date fell on Sunday, March 29, 2009, which was a weekend day. The applicants filed a response to the non-final office action on March 30,2009, the next business day".

In Arqule v. Kappos, _ F.Supp.2d _ (D.D.C. 2011), the District Court of the District of Columbia ruled that the 35 U.S.C. § 21 (b) "weekend add holiday" exception applies to "any action" including the § 154(b)(2)(C) Accordingly, because March 29, 2009 was a Sunday, the time period to calculate Applicant delay commenced on March 30, 2009, rather than March 29, 2009. Therefore, a delay of 1 day was accrued, corresponding to the time period between March 29, 2009 (three months after the mailing date of the Office Action, in accordance with 37 CFR §1.704(b)) and March 30, 2009. Applicants respectfully request the Office to remove the 1 day of Applicant delay..

Applicants also disclose that the patent term adjustment indicated on the front of the patent is also incorrect because "a Notice of Non-Compliant Amendment was mailed by the PTO on August 4, 2010, subsequent to a response filed on July 13, 2010. Applicant

filed a response to the Notice of Non-Compliant Amendment on August 24, 2010. Applicant was accorded 0 days delay for a non-compliant response. In good faith and candor, Applicant submits that the non-compliant response should have been accorded a total Applicant Delay of 42 days for delay from July 14, 2010, to August 24, 2010. See 37 C.F.R. § 1.704(c)(7)."

Petitioner's argument is persuasive. A period of 42 additional days should have been deducted for Applicant Delay.

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 260 days (i.e., the sum of 68 days, 30 days, 43 days, 77 days and 42 days).

The determination of Patent Term Adjustment at the time of the mailing of the notice of allowance should therefore have been 643 days (903 days of Office delay reduced by 260 days of applicant delay) rather than 684 days.

Receipt of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The Office of Data Management has been advised of this decision. The application is, thereby, forwarded to the Office of Data Management for issuance of the application. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

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

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PALM Screen

# Patent Term Adjustments

PTA/PTE Information | Patent Term Adjustment | Patent Term Extension

Application Number*: 10503418 Search | Explanation of PTA Calculation | Explanation of PTE Calculation

## PTA Calculations for Application: 10503418

| | | | |
|---|---|---|---|
| Application Filing Date | 12/30/2004 | OverLapping Days Between (A and B) or (A and C) | 0 |
| Issue Date of Patent | | Non-Overlapping USPTO Delays: | 903 |
| A Delays | 903 | PTO Manual Adjustment | -41 |
| B Delays | 0 | Applicant Delay (APPL) | 219 |
| C Delays | 0 | Total PTA (days) | 643 |

* - Sorted Column

## File Contents History

| Action Number | Action Recorded Date | Action Due Date | Action Code | Action Description | Duration PTO | Duration APPL | Parent Action Number |
|---|---|---|---|---|---|---|---|
| 126 | 12/28/2011 | | P028 | Adjustment of PTA Calculation by PTO | | 42 | 0 |
| 125 | 12/28/2011 | | P028 | Adjustment of PTA Calculation by PTO | | 30 | 0 |
| 124 | 12/28/2011 | | P028 | Adjustment of PTA Calculation by PTO | 31 | | 0 |
| 106 | 10/27/2011 | | MN/=. | Mail Notice of Allowance | | | 0 |
| 105 | 10/24/2011 | | OAR | Office Action Review | | | 0 |
| 104 | 10/24/2011 | | OAR | Office Action Review | | | 0 |
| 103 | 10/24/2011 | | IREV | Issue Revision Completed | | | 0 |
| 102 | 10/24/2011 | | N/=. | Notice of Allowance Data Verification Completed | | | 0 |
| 101 | 10/24/2011 | | DVER | Document Verification | | | 0 |
| 100 | 10/20/2011 | | EX.R | Reasons for Allowance | | | 0 |
| 99 | 10/20/2011 | | CNTA | Allowability Notice | | | 0 |
| 95 | 08/18/2011 | | MEXIA | Mail Applicant Initiated Interview Summary | | | 0 |
| 93 | 08/11/2011 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 92 | 08/10/2011 | | A... | Response after Non-Final Action | | | 0 |
| 94 | 08/04/2011 | | OAR | Office Action Review | | | 0 |
| 91 | 08/04/2011 | | EXIA | Interview Summary- Applicant Initiated | | | 0 |
| 90 | 05/12/2011 | | ELC_RVW | Electronic Review | | | 0 |
| 89 | 05/12/2011 | | EML_NTF | Email Notification | | | 0 |
| 88 | 05/12/2011 | 12/24/2010 | MCTNF | Mail Non-Final Rejection | 139 | | 83 |
| 87 | 05/09/2011 | | CTNF | Non-Final Rejection | | | 0 |
| 83 | 08/24/2010 | | A... | Response after Non-Final Action | | | 0 |
| 80 | 08/04/2010 | | ELC_RVW | Electronic Review | | | 0 |
| 79 | 08/04/2010 | | EML_NTF | Email Notification | | | 0 |
| 78 | 08/04/2010 | | MCPA-AMD | Mail Notice of Informal or Non-Responsive RCE Amendment | | | 0 |
| 77 | 08/02/2010 | | CPA-AMD | RCE Amendment Informal or Non-Responsive | | | 0 |
| 76 | 07/20/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 73 | 07/20/2010 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 75 | 07/13/2010 | | AMPR | RCE- AF Processed | | | 0 |
| 74 | 07/13/2010 | 04/27/2010 | RCEX | Request for Continued Examination (RCE) | | 77 | 58 |
| 72 | 07/13/2010 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 71 | 07/13/2010 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 70 | 07/01/2010 | | EML_NTR | Email Notification | | | 0 |
| 69 | 07/01/2010 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 68 | 06/29/2010 | | CTAV | Advisory Action (PTOL-303) | | | 0 |
| 67 | 06/22/2010 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 66 | 05/26/2010 | | A.NE | Amendment after Final Rejection | | | 0 |
| 65 | 05/26/2010 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 64 | 05/26/2010 | | EML_NTR | Email Notification | | | 0 |
| 63 | 05/26/2010 | | PA.. | Change in Power of Attorney (May Include Associate POA) | | | 0 |
| 62 | 05/25/2010 | | EML_NTR | Email Notification | | | 0 |
| 61 | 05/25/2010 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 60 | 05/12/2010 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 59 | 05/11/2010 | | C.AD | Correspondence Address Change | | | 0 |
| 58 | 01/27/2010 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 57 | 01/26/2010 | | CTFR | Final Rejection | | | 0 |
| 52 | 11/17/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 51 | 11/12/2009 | 09/30/2009 | A... | Response after Non-Final Action | | 43 | 46 |
| 50 | 11/12/2009 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 49 | 10/23/2009 | | MEXIN | Mail Examiner Interview Summary (PTOL - 413) | | | 0 |
| 48 | 10/20/2009 | | EXIN | Examiner Interview Summary Record (PTOL - 413) | | | 0 |
| 46 | 06/30/2009 | | MCTNF | Mail Non-Final Rejection | | | 0 |
| 45 | 06/28/2009 | | CTNF | Non-Final Rejection | | | 0 |
| 40 | 05/04/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 38 | 05/04/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 36 | 05/04/2009 | | ABN9 | Disposal for a RCE / CPA / R129 | | | 0 |
| 39 | 04/29/2009 | | AMPR | RCE- AF Processed | | | 0 |

| | | | | | | | |
|---|---|---|---|---|---|---|---|
| 37 | 04/29/2009 | 03/29/2009 | RCEX | Request for Continued Examination (RCE) | | 31 | 29 |
| 35 | 04/29/2009 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 34 | 04/29/2009 | | BRCE | Workflow - Request for RCE - Begin | | | 0 |
| 33 | 04/14/2009 | | MCTAV | Mail Advisory Action (PTOL - 303) | | | 0 |
| 32 | 04/13/2009 | | CTAV | Advisory Action (PTOL-303) | | | 0 |
| 31 | 04/11/2009 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 30 | 04/01/2009 | | A.NE | Amendment after Final Rejection | | | 0 |
| 29 | 12/29/2008 | | MCTFR | Mail Final Rejection (PTOL - 326) | | | 0 |
| 28 | 12/22/2008 | | CTFR | Final Rejection | | | 0 |
| 22 | 12/02/2008 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 21 | 10/08/2008 | | FWDX | Date Forwarded to Examiner | | | 0 |
| 20 | 09/08/2008 | 07/02/2008 | A... | Response after Non-Final Action | | 68 | 18 |
| 19 | 09/08/2008 | | XT/G | Request for Extension of Time - Granted | | | 0 |
| 18 | 04/02/2008 | 02/28/2006 | MCTNF | Mail Non-Final Rejection | 764 | | 4 |
| 17 | 03/31/2008 | | CTNF | Non-Final Rejection | | | 0 |
| 15 | 10/24/2007 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 14 | 10/17/2007 | | W525 | Withdraw Flagged for 5/25 | | | 0 |
| 13 | 10/16/2007 | | F525 | Flagged for 5/25 | | | 0 |
| 27 | 06/30/2006 | | IDSC | Information Disclosure Statement considered | | | 0 |
| 12 | 06/30/2006 | | RCAP | Reference capture on IDS | | | 0 |
| 11.7 | 06/30/2006 | | M844 | Information Disclosure Statement (IDS) Filed | | | 0 |
| 11 | 06/30/2006 | | WIDS | Information Disclosure Statement (IDS) Filed | | | 0 |
| 10 | 06/09/2006 | | TSSCOMP | IFW TSS Processing by Tech Center Complete | | | 0 |
| 6 | 06/09/2006 | | DOCK | Case Docketed to Examiner in GAU | | | 0 |
| 5 | 03/31/2005 | | L194 | Cleared by OIPE CSR | | | 0 |
| 3 | 03/23/2005 | | OIPE | Application Dispatched from OIPE | | | 0 |
| 2 | 03/23/2005 | | M903 | Notice of DO/EO Acceptance Mailed | | | 0 |
| 9 | 12/30/2004 | | C602 | Oath or Declaration Filed (Including Supplemental) | | | 0 |
| 4 | 12/30/2004 | | 371COMP | 371 Completion Date | | | 0 |
| 0.5 | 02/04/2003 | | NEFILE | International Filing date | | | 0 |

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SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER CO 80202

MAILED
DEC 14 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Chilton, et al. | : | |
| Application No. 10/503,552 | : | ON PETITION |
| Filed: July 30, 2004 | : | |
| Attorney Docket No. 5224-19-PUS | : | |

This is a decision on the petition to revive under 37 CFR 1.137(b), filed December 2, 2011.

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

The above application became abandoned for failure to timely file a reply in response to the non-final Office action, mailed October 25, 2010. This Office action set a shortened statutory period for reply of three months. No reply having been received, the application became abandoned on January 26, 2011. The Office mailed a Notice of Abandonment on May 23, 2011.

With the instant petition, petitioner has made the proper statement of unintentional delay, paid the petition fee, and submitted the required reply in the form of an Amendment.

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 application is being forwarded to Group Art Unit 1627 for consideration of the Amendment, filed December 2, 2011.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

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GUSHARAN CHANA
KENWOOD 57, BRACEBRIDGE ROAD
SUTTON COLDFIELD B7426L GB UNITED KINGDOM

MAILED

SEP 20 2010

OFFICE OF PETITIONS

In re Application
Gursharan Singh Chana
Application No. 10/503,788
Filed: January 21, 2005
Attorney Docket No.
BARK0010UPCT-US

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is a decision on the 37 CFR 1.705 APPLICATION FOR PATENT TERM ADJUSTMENT filed June 4, 2010. Applicant requests that the initial determination of Patent Term Adjustment of 562 days be corrected to 1099 days, in part on the basis that the Office will take in excess of three years to issue this patent and is being considered in light of the court decision in *Wyeth v. Kappos*, 2009-1120 (Fed. Cir. 1-7-2010).

To the extent that this application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

With respect to the over 3 year calculation, rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the

issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.

To the extent that applicant otherwise requests correction of the patent term adjustment at the time of the mailing of the Notice of Allowance, the application for patent term adjustment is **DISMISSED**.

On April 5, 2010, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is five hundred sixty-two (562) days which included 636 days accorded for Examination delay reduced by 74 days for Applicant delay.

It is noted that applicants have miscalculated the period of reduction pursuant to 37 CFR 1.704(b) for applicant delay in filing a reply to the non-final Office action mailed July 9, 2008. The number of days in the period beginning on October 10, 2008, the day after the date three months after the mailing date of the non-final Office action, and ending on November 24, 2008, the date applicant filed a response is 46 days, not 45 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance remains as five hundred sixty-two (636 days attributable to examination delay minus 46 + 28 days applicant delay) days.

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

The application is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).
Telephone inquiries specific to this matter should be directed to Patricia Faison-Ball, Senior Petitions Attorney, at (571) 272-3212.

Anthony Knight
Director
Office of Petitions

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

MAILED
OCT 24 2011
OFFICE OF PETITIONS

In re Patent No. 7,381,205 :
Issue Date: June 3, 2008 :
Application No. 10/503,825 : NOTICE
Filed: August 5, 2004 :
Attorney Docket No. 07-2312

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

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

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

Inquiries related to this communication should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

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| | |
|---|---|
| In re Patent No. 7,993,192 | : DECISION ON REQUEST FOR |
| Issued: August 9, 2011 | : RECONSIDERATION OF |
| Application No. 10/504,313 | : PATENT TERM ADJUSTMENT |
| Filed: March 16, 2005 | : and |
| Attorney Docket No. 04-641 | : NOTICE OF INTENT TO ISSUE |
| | : CERTIFICATE OF CORRECTION |

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)" filed August 22, 2011. Applicant requests that the determination of patent term adjustment be corrected from 1120 days to 1184 days.

The application for patent term adjustment-post grant is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **one thousand one hundred eighty-four (1184) days**.

On August 9, 2011, the above-identified application matured into U.S. Patent No. 7,993,192 with a revised patent term adjustment of 1120 days. On August 22, 2011, patentees timely submitted this application for patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 1184 days.

The Office initially determined a patent term adjustment of one thousand one hundred twenty (1120) days which included thirty-one (31) days of applicant delay. However, after the issuance of the patent, additional delays were recorded that revised the Patent Term Adjustment. Pursuant to 37 C.F.R. § 1.704(c)(10), a period of reduction totaling 64 days was entered for applicant filing papers after the mailing of the notice of allowance.

Patentee disputes the reduction of 64 days due to the submission on June 7, 2011 of a "MISCELLANEOUS INCOMING LETTER" after the March 31, 2011 mailing of the Notice of Allowance.

37 CFR § 1.704(c)(10) provides that:

> Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:
> (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;
> or
> (ii) Four months;

As stated in MPEP 2732:

> 37 CFR 1.704(c)(10) establishes submission of an amendment under 37 CFR 1.312 or other paper after a notice of allowance has been given or mailed as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. The submission of amendments (or other papers) after an application is allowed may cause substantial interference with the patent issue process.
>
> Certain papers filed after allowance are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See *Clarification of 37 CFR 1.704(c)(10) – Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed*, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001). The submission of the following papers after a "Notice of Allowance" is not considered a failure to engage in reasonable efforts to conclude processing or examination of an application: (1) Fee(s) Transmittal (PTOL-85B); (2) Power of Attorney; (3) Power to Inspect; (4) Change of Address; (5) Change of Status (small/not small entity status); (6) a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability;" and (7) letters related to government interests (e.g., those between NASA and the Office). Papers that will be considered a failure to engage in reasonable efforts to conclude processing or examination of an application include: (1) a request for a refund; (2) a status letter; (3) amendments under 37 CFR 1.312; (4) late priority claims; (5) a certified copy of a priority document; (6) drawings; (7) letters related to biologic deposits; and (8) oaths or declarations.

A review of the application record reveals that the reduction was for a Miscellaneous Incoming Letter filed June 7, 2011, after the mailing of the Notice of Allowance, however the record supports a conclusion that no such Miscellaneous Incoming Letter was filed on June 7, 2011 and therefore that the entry of 64 days for applicant delay is erroneous.

In view thereof, the patent term adjustment indicated in the patent should have been one thousand one hundred eighty-four (1184) days.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. See 35 U.S.C. § 254 and 37 CFR § 1.322. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand one hundred eighty-four (1184) days**.

Telephone inquiries specific to this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,993,192 B2

DATED : August 9, 2011

INVENTOR(S) : Martin Moshal

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (1120) days

Delete the phrase "by 1120 days" and insert – by 1184 days--

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

BERESKIN AND PARR LLP/S.E.N.C.R.L., s.r.l.
40 KING STREET WEST
BOX 401
TORONTO ON M5H 3Y2 CA CANADA

MAILED

AUG 30 2010

OFFICE OF PETITIONS

In re Patent No. 7,632,495 :
Issue Date: December 15, 2009 :
Application No. 10/504,328 : DECISION ON PETITION
Filed: March 11, 2005 :
Attorney Docket No. **9579-92** :

This is a decision on the renewed petition filed August 17, 2010, requesting issuance of a duplicate Letters Patent for the above-identified patent that is being considered under 37 CFR 1.182.

The petition under 37 CFR 1.182 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.

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

Any questions concerning this matter may be directed to the undersigned at (571) 272-4584. Any questions concerning issuance of the duplicate Letters Patent should be directed to Niomi Farmer at (703)756-1556.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Niomi Farmer, P/ODM, Randolph Square Building, 9th Floor, 09/D30-B
FAX No. (571) 270-9753

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : November 15, 2010

TO SPE OF : ART UNIT 1788 - SPE

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/504,600 Patent No.: 7,709,071 B2

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

**FOR IFW FILES:**

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

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

**FOR PAPER FILES:**

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

**Certificates of Correction Branch (CofC)**
**Randolph Square Building**
**2800 South Randolph Street**
**Arlington, VA 22206**

**Antonio Johnson**

**Should the PCT Publication No. and Date be changed as requested by applicant?**
**See COCIN dated 10-26-2010**

**Certificates of Correction Branch**
**(571)272-0483**

**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:** _____

_____

_____

Carrie Shosho **SPE** _____ **Art Unit** 1788

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/25/2011

TO SPE OF : ART UNIT 1726 Ryan Patrick (Spe)

SUBJECT : Request for Certificate of Correction for Appl. No.: 10/504624 Patent No.: 7736772

CofC mailroom date: 3/16/2011

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**

Certificates of Correction Branch
703-756-1571 _____

**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

1726
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

**MARTIN D. MOYNIHAN**
**PRTSI, INC.**
**P.O. BOX 16446**
**ARLINGTON VA 22215**

**MAILED**
**AUG 26 2011**
**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,331,725 | : | |
| Issue Date: February 19, 2008 | : | |
| Application No. 10/504,852 | : | NOTICE |
| Filed: August 27, 2004 | : | |
| Attorney Docket No. 28441 | : | |

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

**PEARL COHEN ZEDEK LATZER, LLP**
**1500 BROADWAY**
**12TH FLOOR**
**NEW YORK NY 10036**

MAILED
JUN 07 2011
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Eitan Zait et al. | : | |
| Application No. 10/504,866 | : | NOTICE |
| Patent No. 7,459,242 | : | |
| Filed: August 17, 2004 | : | |
| Attorney Docket No. **P-7100-US** | | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed May 09, 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) 272-2783.

/Tredelle D. Jackson/
Paralegal Specialist
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

**MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C.**
**ONE FINANCIAL CENTER**
**BOSTON MA 02111**

MAILED
AUG 16 2010
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Yoni Iger | : | |
| Application No. 10/505,017 | : | DECISION ON PETITION |
| Filed: August 18, 2004 | : | |
| Attorney Docket No. IGER-MA-2003 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 21, 2010, to revive the above-identified application.

The petition is **GRANTED**.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply received May 21, 2010, is accepted as having been unintentionally delayed.

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

This application is being referred to Technology Center AU 3737 for appropriate action by the Examiner in the normal course of business on the reply received May 21, 2010.

/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
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**NXP, B.V.**
**NXP INTELLECTUAL PROPERTY**
**& LICENSING**
**M/S41-SJ**
**1109 MCKAY DRIVE**
**SAN JOSE CA 95131**

**MAILED**

FEB 02 2011

**OFFICE OF PETITIONS**

In re Application of :
ZINKE, et al :
Application No. 10/505,187 : DECISION ON PETITION
Filed: August 18, 2004 :
Docket No. DE02 0037 US :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 5, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, April 20, 2007, which set a shortened statutory period for reply of **three (3) months.** No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on July 21, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1540; and (3) an adequate statement of unintentional delay.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Since the statement appearing in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the required statement. Petitioner must notify the Office if this is **not** a correct reading of the statement appearing in the petition.

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

This application is being referred to Technology Center AU 2182 for appropriate action by the Examiner in the normal course of business.

/Diane C. Goodwyn/
Diane C. 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

Date : 10/14/2010
Patent No. : 7,772,459 B2
Serial No. : 10/505,191
Inventor(s) : Erickson
Issued : August 10, 2010
Title : **TRANSGENIC PRODUCTION IN SALIVA**
Docket No. : **AIB-09206**

Re: Request for Reconsideration

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of 37 CFR 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 Fee(s) Transmittal Form PTOL-85B. After payment of the issue fee, correction of assignment data submitted on the PTOL-85B can only be done by Certificate of Correction under 37 CFR 1.323, with a request under 37 CFR 3.81(b).

A request for a patent to be corrected to state the name of the assignee must:

A. state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;
B. include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); and
C. include the processing fee set forth in 37 CFR 1.17(i).

If the request is granted, Certificates of Correction Branch will be notified that a Certificate of Correction may be issued.
See Manual of Patent Examining Procedure, Section 1481.01 (Rev. 3) (Oct. 2005).

*Applicant has not included items A and or C above, accordingly, the request for Certificate of Correction to add or change the assignee data is dismissed.*

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

number:

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

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

By fax: 571-273-8300
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 noted in your request.

**Ernest C. White, *LIE***
**ernest.white@uspto.gov**
**(571) 272-3385**
For Mary F. Diggs (703) 756-1580
Decisions & Certificates
of Correction Branch

Peter G Carroll
Medlen & Carroll
101 Howard Street
Suite 350
San Francisco CA 94105

ecw

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

FEB 14 2011

OFFICE OF PETITIONS

**Peter G Carroll**
**Medlen & Carroll**
**101 Howard Street**
**Suite 350**
**San Francisco CA 94105**

| | | |
|---|---|---|
| Patent No. 7,772,459 | : | |
| Issue Date: August 10, 2010 | : | |
| Application No. 10/505,191 | : | ON PETITION |
| Filed: August 19, 2004 | : | |
| Attorney Docket No. AIB-09206 | : | |

This is a decision on the petition filed October 25, 2010, under 37 CFR 3.81(b) to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **GRANTED**.

The patent file is being forwarded to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this decision may be directed to the Kimberly Inabinet at (571) 272-4618. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (703) 756-1814.

/Carl Friedman/
Carl Friedman
Petitions Examiner
Office of Petitions

**Doc Code: PET.PTA.RCAL**
**Document Description: Request for Recalculation in view of Wyeth**

PTO/SB/131 (02-10)
Approved for use through 02/28/2011. OMB 0651-0020
U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH**

| | |
|---|---|
| Attorney Docket Number: Q82801 | |
| Application Number: 10/505,214 | Filing Date (or 371(b) or (f) Date): October 26, 2004 |
| Patent Number: 7,664,029 | Issue Date: February 16, 2010 |
| First Named Inventor: Martin Vegoureux | |
| Title: METHOD OF DETERMINING A SPECTRAL ROUTE FOR A GIVEN CONNECTION IN AN OPTICAL TELECOMMUNICATIONS NETWORK | |

PATENTEE HEREBY REQUESTS RECALCULATION OF THE PATENT TERM ADJUSTMENT (PTA) UNDER 35 USC 154(b) INDICATED ON THE ABOVE-IDENTIFIED PATENT. THE PATENTEE'S SOLE BASIS FOR REQUESTING THE RECALCULATION IS THE USPTO'S PRE-*WYETH* INTERPRETATION OF 35 U.S.C. 154(b)(2)(A).

Note: This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A). See Instruction Sheet on page 2 for more information.

Patentees are reminded that to preserve the right to review in the United States District Court for the District of Columbia of the USPTO's patent term adjustment determination, a patentee must ensure that he or she also takes the steps required under 35 U.S.C. 154(b)(3) and (b)(4) and 37 CFR 1.705 in a timely manner.

**Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

| | |
|---|---|
| Signature /DJCushing/ | Date August 16, 2010 |
| Name (Print/Typed) David J. Cushing | Registration Number 28,703 |

***Note**: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required in accordance with 37 CFR 1.33 and 11.18. Please see 37 CFR 1.4(d) for the form of the signature. If necessary, submit multiple forms for more than one signature, see below**.*

☐ *Total of _____ forms are submitted.

The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 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: 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.*

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.

# Instruction Sheet for: REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT IN VIEW OF *WYETH**

(Not to be Submitted to the USPTO)

**This form is only for requesting a recalculation of PTA for patents issued before March 2, 2010, if the sole basis for requesting the recalculation is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A).**

**This form must be filed within 180 days of the day the patent was granted,** with the following exception:

> Patentees who received a decision from the USPTO under the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A) may file a request for reconsideration of that decision if such a request for reconsideration is filed within **two months** of the date of the decision (37 CFR 1.181(f)). If the patentee's sole basis for requesting reconsideration of the decision is the USPTO's pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A), the request for reconsideration need only state that reconsideration is being requested in view of Wyeth (this form may be used for this purpose if it is filed within **two months** of the date of the decision from the USPTO).

**Do not use this form if the application has been allowed, but not yet issued as a patent.**

1. **For patents issued before March 2, 2010:** A request for reconsideration under 37 CFR 1.705(d) and the fee set forth in 37 CFR 1.18(e) are not required, provided that the patentee's sole basis for requesting recalculation of the PTA in the patent is the USPTO's pre-*Wyeth* interpretation of 35 U.S.C. 154(b)(2)(A) and this form is filed within 180 days of the day the patent was granted.

2. **For patents issued on or after March 2, 2010 (do not use this form):** Patentees seeking a revised PTA in a patent issued on or after March 2, 2010, must file a request for reconsideration under 37 CFR 1.705(d) that complies with the requirements of 37 CFR 1.705(b)(1) and (b)(2) within two months of the day the patent issued.

For more information, see "Notice Concerning Calculation of the Patent Term Adjustment With Respect to the Overlapping Delay Provision of 35 U.S.C. 154(b)(2)(A)" available on the USPTO Web site at http://www.uspto.gov/patents/law/notices/2010.jsp.

**Wyeth v. Kappos*, No. 2009-1120 (Fed. Cir., Jan. 7, 2010).

# 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

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

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

Mail Date: 08/20/2010

| | | |
|---|---|---|
| **Applicant** | : Martin Vigoureux | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7664029 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 10/505,214 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 10/26/2004 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

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

The patent term adjustment has been determined to be **902** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

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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Stephen M Haracz
Bryan Cave
1290 Avenue of the Americas
New York NY 10104-3300

MAILED

MAR 07 2011

OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 7,794,719 | : |
| Bardroff et al. | : |
| Issue Date: September 14, 2010 | : DECISION ON REQUEST FOR |
| Application No. 10/505,313 | : RECONSIDERATION OF |
| Filed: March 7, 2005 | : PATENT TERM ADJUSTMENT |
| Attorney Docket No. F2842 US S3 | : AND NOTICE OF INTENT |
| (C018016/0180 | : TO ISSUE CERTIFICATE OF |
| Title: ANTI-AMYLOID BETA | : CORRECTION |
| ANTIBODIES | : |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R § 1.705(d) filed November 12, 2010 and PETITION UNDER 37 C.F.R. §1.181 (a)(3) TO INVOKE THE SUPERVISORY AUTHORITY OF THE DIRECTOR," filed August 20, 2010. Applicants request reconsideration of the petition decision mailed June 22, 2010 and submit that the correct patent term adjustment to be indicated on the patent is one thousand four hundred twelve (1,412) days, not one thousand sixteen (1,016) days as calculated by the Office.

The request for review of the patent term adjustment is **GRANTED** to the extent indicated.

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

Patentees dispute the 198 day reduction. Patentees contend that the July 2, 2008 response to the January 28, 2008 Office action did have an omission. Further Patentees contend that the supplemental response submitted on July 28, 2008 also did not contain an omission. Thus, the 198 day reduction is not warranted.

Patentees contend that the reduction 198 days should be removed because neither reply included an omission. Instead applicants contend that the responses were clarifying amendments and not required based upon an omission.

Patentees also dispute the 90 day reduction. Patentees contend the July 27, 2007 response was compliant and the Notice of Non Compliant Amendment mailed on October 17, 2007 was improper.

The reduction of 90 days pursuant to 37 CFR 1.704(c)(7) is required. In response to the Restriction Requirement mailed on June 5, 2007, applicants submitted a non-compliant response on July 27, 2007. A Notice of Non-Compliant Amendment was mailed on October 18, 2007. A response to the Notice was submitted on October 25, 2007.

The reduction of 90 days for the delay from the filing of the initial response on July 28, 2007, to the filing of the response on October 25, 2007, is warranted.

The Office has reconsidered patentees' argument but does not find it persuasive. Applicants essentially seek to reopen prosecution after prosecution has closed. To the extent petitioner believed that the Notices of Non-Compliant amendment were mailed in error, applicants recourse was to file a petition seeking review of the Notice and or the Office actions pursuant to 37 CFR 1.181 (a)(3). Nor is the Office convinced that the final Office action acknowledges that the replies did not contain an omission. As such, the 198 day reduction for the submission of the supplemental replies on July 28, 2008 and January 16, 2009 is warranted. Further, the Office is not convinced that the Non-Compliant Amendment was mailed in error. As such the 198 and 90 day reductions will remain.

Patentees also contend that the 120 day reduction for the submission of the amendment after the notice of allowance on October 16, 2009 should be removed because the documents were submitted in support of the patent term adjustment petition.

A review of the record confirms that the documents submitted on October 16, 2009 were in support of the request for patent term adjustment. As such the 120 day reduction will be removed.

As such the total number of days of patentees' delay is 379 days (90 + 19 + 65 + 198 + 5 + 2).

The present petition under 37 CFR 1.181 is granted to the extent that the decision of June 22, 2010 has been reconsidered; however, the petition requesting removal of the 90 and 198 day reduction is **DISMISSED**. The request for removal of the 120 days is **GRANTED**.

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. Brennan 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.

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

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application is being forwarded to the Certificate of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **one thousand one hundred thirty-six (1,136)** days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant, at (571) 272-3215.

Anthony Knight
Director
Office of Petitions

Cc: Jack Brennan
FISH & RICHARDSON P.C. (NY)
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,794,719 B2

DATED : September 14, 2010 **DRAFT**

INVENTOR(S) : Bardroff et al.

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 1016 days

Delete the phrase "by 1016 days" and insert – by 1,136 days--

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MAR 12 2012
OFFICE OF PETITIONS

Andrew R. Kopsidas
FISH & RICHARDSON P.C.
1425 K Street, N.W.
Washington, D.C. 20005

In re Patent No. 7,794,719
Bardoff et al.
Issue Date: September 14, 2010
Application No. 10/505,313
Filed: March 7, 2005
Attorney Docket No. F2482 US S3
Title: Anti-Amyloid Beta Anti-Bodies

: DECISION UPON REMAND AND
: RECONSIDERATION OF
: PATENT TERM ADJUSTMENT
: AND NOTICE OF INTENT
: TO ISSUE CERTIFICATE OF
: CORRECTION

This is a decision following remand from the United States District Court for the District of Columbia in *Hoffman LaRoche v. Kappos*, Civ. Action No. 11-0516, regarding the patent term adjustment indicated on the above-identified patent. The Court remanded this matter to the U.S. Patent and Trademark Office ("USPTO") for recalculation of the patent term adjustment (hereinafter referred to as "PTA").

**Relevant Procedural History**

On November 12, 2010, patentee timely filed an Application for Patent Term Adjustment under 37 CFR 1.705(d) requesting correction of the Director's calculation of applicant delay pursuant to 35 U.S.C. 154(b)(2)(C). Specifically, patentee contested the Director's calculation of applicant delay in three separate instances. On March 7, 2011, the Office granted-in-part patentee's Application for PTA. The Office granted the removal of one period of applicant delay amounting to 120 days. The Office did not grant the removal of the remaining 90 day and 198 day periods of applicant delay. On March 10, 2011, patentee filed a civil action pursuant to 35 U.S.C. 154(b)(4)(A). Subsequently, on April 7 2011, patentee filed a Response to the Office's March 7, 2011 Decision on Request for Reconsideration of PTA.

**Patentee's Arguments**

Patentee contests the calculation of applicant delay that was assessed by the Office. Patentee does not contest the reduction of 10 + 19 + 65 + 5 + 2 + 2 = 103 days of applicant delay under the various provisions of 37 CFR 1.704(c). Patentee specifically contests the following three reductions of applicant delay: (1) the reduction of 198 days pursuant to 37 CFR 1.704(c)(7); (2) the reduction of 120 days pursuant to 37 CFR 1.704(c)(10); and (3) the reduction of 90 days pursuant to 37 CFR 1.704(c)(7).

As for the 90 day reduction (June 28, 2007 thru October 25, 2007) that was assessed based on a Notice of Non-Compliant Amendment in response to a restriction/election requirement, patentee asserts that the determination of non-compliant response was improper. Patentee asserts that the use of the status identifier "withdrawn" as it related to the non-elected claims was proper and, accordingly, the determination that the response to election requirement was an omission was incorrect. Patentee notes that the fact that the patentee obviated the non-compliant determination by "cancelling" claims does not take away from the fact that the initial reply was compliant.

As for the 120 day reduction that was assessed based on the October 16, 2010 filing, patentee asserts that the Office has already acknowledged in the March 7, 2011 Decision on Request for Reconsideration that this reduction was improper in light of the incorrect paper entry into the Office records. Patentee reasserts that the document submitted to the Office on October 16, 2010, was not an amendment pursuant to 37 CFR 1.312 but actually an application for PTA pursuant to 37 CFR 1.705(b). Accordingly, patentee contends that the errant entry of the document led to an improper applicant delay assessment by the Office.

As for the 198 day reduction (July 3, 2008 thru January 16, 2009), patentee asserts that the Office erred in assessing this reduction because none of the reply filed on July 3, 2009 and the reply filed on July 28, 20008 were non-compliant and accordingly, the Office assessment of an applicant delay was in error. Patentee asserts that the delay should have been for two days from the date that the January 15, 2009 (day after date which is three months from the date which non-responsive was mailed) until January 16, 2009 (date of which response was mailed).

**Overall PTA Calculation**

**Formula:**

"A" delay + "B" delay + "C" delay - Overlap - applicant delay = X

| **Patentee's Calculations:** | **USPTO's Calculation:** |
|---|---|
| a) 590 + 1121 + 0 - 196 - 103 = 1412 | 590 + 1121 + 0 - 196 - 129 = 1386 |

**Decision**

Upon remand, the Office finds that the correct amount of PTA at the time of the issuance of the patent is **THIRTEEN HUNDRED AND EIGHTY SIX (1386)** days of PTA.

The Office finds that based upon the specific facts of the application, patentee and the Office are in agreement in determining that the amounts of "A" delay (590 days), "B" delay (1121 days), and Overlap (196 days), as determined by the Office.

As for the amount of applicant delay, the Office finds that the proper amount of applicant delay is 129 days. The Office has reviewed patentee's arguments as to applicant delay and finds some of the arguments persuasive and other arguments non-persuasive.

Specifically, the Office finds that the arguments as to assessment of 120 days of applicant delay under 37 CFR 1.704(c)(10) persuasive. The Office acknowledges that it improperly entered the document filed October 16, 2010, as an "Amendment after Notice of Allowance" rather than a request for reconsideration of PTA under 37 CFR 1.705. As noted in 37 CFR 1.704(e), the request for reconsideration of PTA is not a reduction under 37 CFR 1.704(c)(10). Accordingly, the reduction of 120 days of applicant delay is in error. Prior to this decision, as noted in the decision by the Office of Petitions on March 7, 2011, the Office acknowledged that no applicant delay should have been assessed for the October 16, 2010 filing.

In addition, the Office finds that the reduction of 90 days of applicant delay under 37 CFR 1.704(c)(7) is in error and will be removed. Specifically, the Office notes that the alleged omission was that in response to the restriction/election requirement some of the claims used the status identifier "withdrawn" which was deemed to be a non-compliant response to the restriction requirement. However, upon review of the MPEP, it is noted that the Manual of Patent Examination Policy (MPEP) asserts that for any amendment filed in response to a restriction or election of species requirement, claims not elected must use the status identifier "withdrawn." See MPEP 714(II)(c)(A). Accordingly, use of the "withdrawn" status identifier was not improper.

In addition, the Office finds that the calculation of a reduction of 198 days pursuant to 37 CFR 1.704(c)(7) is in error. The Office finds that the correct amount of applicant delay is 26 days, beginning on July 3, 2008 (day after responsive filing on July 2, 2008) and ending on July 28, 2008 (date of submission by patentee correcting the omission in the July 2, 2008 response). The office reaffirms that the response filed on July 2, 2008 was not compliant. On July 2, 2008, patentee amended the written description and the claims to recite the antibody comprising sequences selected from the group consisting of three complimentary determining regions (CDR) comprising sequences selected from the group consisting of sequences related to the elected MSR-7 antibody species as well as CDR relating to non-elected MSR-3 and MSR-8 species. In an interview on July 9, 2008, the examiner informed patentee's representatives that it was unclear how the amendment filed on July 2, 2008, read on the MSR-7 invention. On July, 28, 2008, patentee submitted an additional set of amendments that omitted all references to MSR-3 or MSR-8 and thus only recited subject matter relating to the elected MSR-7. The Office finds that it was not until the July 28 amendment, that the claims finally were limited to sequences for solely the MSR-7 species. Patentee concedes that the confusion was due to the fact that six SEQ ID Nos. recited in claim 1 for the six CDR's of MSR-7 were different from the sequences noted by the examiner because the sequence listings included redundant ID Nos. for the same CDR regions. See patentee's January 16, 2009 Response.

As for patentee's argument that the response filed on July 28, 2008 was expressly requested by the examiner and therefore should not be deemed a failure to engage in reasonable efforts to conclude prosecution of the application, the argument is not persuasive because the rule involved is 37 CFR 1.704(c) (7) not (c)(8). The reduction under 37 CFR 1.704(c)(7) unlike (c)(8) does not provide an exception for amendments/replies submitted at the request of the examiner. Accordingly, the Office finds that the omission did occur with the July 2, 2008 amendment; however, the patentee corrected the omission on July 28, 2008. Thus, the reduction for the period between July 29, 2008 and January 16, 2009 will be removed under 37 CFR 1.704(c)(7). As noted in patentee's April 7, 2011 Response, a two day reduction for replying after the date that is three months from the date on which the October 14, 2008 Notice on Non-Responsive Amendment was mailed is also properly assessed.

Accordingly, the Office finds that the correct amount of applicant delay is (10 + 19 + 65 + 5 + 2 + 2 + 26) = 129 days.

**Conclusion**

Patentee is entitled to PTA of **THIRTEEN HUNDRED AND EIGHTY SIX (1386)** days. Using the formula "A" delay + "B" delay + "C" delay - Overlap - applicant delay = X, the amount of PTA is calculated as following: 590 + 1121 + 0 - 196 - 129 = 1386 days.

Telephone inquiries specific to this matter should be directed to Senior Legal Advisor, Kery A. Fries at (571) 272-7757.

/Kery A. Fries/

Kery A. Fries
Senior Legal Advisor Attorney
Office of Patent Legal Administration
Office of Associate Commissioner
For Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/505,356 | 08/19/2004 | Gerald J Julien | ICE US1 | 5987 |

7590 07/18/2011

J. Michael Neary
53939 Pine Grove Road
LaPine, OR 97739

| EXAMINER |
|---|
| WALTERS, JOHN DANIEL |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3618 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 07/18/2011 | 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.

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JUL 1 8 2011

J. Michael Neary
53939 Pine Grove Road
LaPine OR 97739

| | | |
|---|---|---|
| In re Application of Gerald Julien | : | DECISION ON PETITION |
| Appl. No. 10/505,356 | : | TO WITHDRAW FINALITY |
| Filed: August 19, 2004 | : | OF OFFICE ACTION |
| For: NITINOL ICE BLADES | : | UNDER 37 CFR 1.181 |

This is a decision on applicant's petition under 37 CFR 1.181 filed on January 20, 2011 to request a response to applicant's Request for Clarification filed on November 8, 2010.

The petition is **DISMISSED AS MOOT.**

Applicant argues in the final Office action mailed on October 21, 2010, the examiner failed to explain why the subject matter of claim 21 would have been obvious to a person of ordinary skill in the art when the teachings in the Abkowitz reference expressly contradict the subject matter of claim 21.

A review of the record reveals that a non-final Office action was mailed on May 27, 2010 rejecting the claims 1-4 and 13-20 on 103(a) over applicant's disclosure in view of Abkowitz et al. (U.S. patent 6,318,738), and allowing claims 6-12. Applicant filed an amendment on August 26, 2010 to add a new claim 21. A final Office action was mailed on October 21, 2010 in which the examiner rejected claims 1-4 and 13-21 on 103(a) over applicant's disclosure in view of Abkowitz et al. and Julien (WO9729892), and maintained that claims 6-12 are allowable. Applicant filed a notice of appeal and a petition on January 20, 2011. Subsequently, applicant filed an appeal brief on March 21, 2011. Thereafter, a notice of allowance was mailed on June 20, 2011.

Since all of the pending claims 1-4, and 6-20 have been allowed, the issue raised by applicant in the January 20, 2011 petition is moot.

Any questions regarding this decision should be directed to Quality Assurance Specialist Lanna Mai at 571-272-6867.

David L. Talbott, Director
Technology Center 3600
571-272-5150

lm:7/13/11
LM

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**BIOGEN IDEC / FINNEGAN HENDERSON, LLP**
**901 NEW YORK AVENUE, NW**
**WASHINGTON DC 20001-4413**

**MAILED**

SEP 14 2010

**OFFICE OF PETITIONS**

| | | |
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| In re Application of | : | ON PETITION |
| Kalled et al. | : | |
| Application No. 10/505,376 | : | |
| Filed: July 1, 2005 | : | |
| Attorney Docket No. 08201.0028-00000 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed August 24, 2010, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely reply to the non-final Office action mailed January 23, 2009. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on April 24, 2009. A Notice of Abandonment was mailed August 24, 2009.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:
(1) the required reply,[1]
(2) the petition fee,
(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
(4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information.[2]

---

[1] In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

[2] See MPEP 711.03(c)(III)(C) and (D).

The instant petition lacks item(s) (3). Petitioner states, "On instructions from Biogen in-house counsel dated July 8, 2009, no response to this office action was filed."

Where the applicant deliberately permits an application to become abandoned, the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

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) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

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**901 NEW YORK AVENUE, NW**
**WASHINGTON DC 20001-4413**

**MAILED**

MAR 01 2011

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| In re Application of | : | |
| Kalled et al. | : | |
| Application No. 10/505,376 | : | ON PETITION |
| Filed: July 1, 2005 | : | |
| Attorney Docket No. 08201.0028-00000 | : | |

This is a decision on the renewed petition under 37 C.F.R. § 1.137(b), filed January 13, 2011, to revive the above-identified application.

The petition is **GRANTED**.

The petition now satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application, (2) the petition fee of $1620.00, and (3) a proper statement of unintentional delay.

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of continuing application No. 12/862,448, filed August 24, 2010.

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). Accordingly, since the $1110.00 extension of time fee submitted with the original petition on August 24, 2010 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account as authorized.

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

Liana Walsh
Petitions Examiner
Office of Petitions

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**Norikazu Sato**
**2-46-8, Unoki, Ootaku**
**Tokyo 146-0-091 JP JAPAN**

**MAILED**

APR 10 2012

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Norikazu Sato et al. | : | |
| Application No. 10/505,408 | : | DECISION ON PETITION |
| Filed: October 16, 2006 | : | |
| Attorney Docket No. | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 23, 2012, to revive the above-identified application.

The petition is **DISMISSED**.

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

This application became abandoned for failure to properly submit the issue and publication fees on or before February 16, 2010, as required by the Notice of Allowance and Fee(s) Due, mailed November 16, 2009. Accordingly, the date of abandonment of this application is February 17, 2010. A Notice of Abandonment was mailed on February 26, 2010.

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

As to item (1) the Notice of Allowance Fee Transmittal – Part B submitted on January 4, 2010, was not properly signed. The form should be signed by both inventors.

As to item (3), the statement of unintentional delay cannot be accepted, until the petition under 37 CFR 1.137(b) is signed by both inventors of this application.

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 EFS Web

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

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/505,440 | 08/24/2004 | Eberhard Ammermann | 3165-107 | 2309 |

6449 7590 12/07/2011
ROTHWELL, FIGG, ERNST & MANBECK, P.C.
1425 K STREET, N.W.
SUITE 800
WASHINGTON, DC 20005

| EXAMINER |
|---|
| PURDY, KYLE A |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1611 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 12/07/2011 | 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

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United States Patent and Trademark Office
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DEC - 7 2011

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

| | |
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| In re Application of: | : |
| Ammermann et al. | : |
| Serial No.: 10/505,440 | : SUSPENSION OF ACTION |
| Filed: August 24, 2004 | : |
| Attorney Docket No.: **3165-107** | : |

This is in reply to the petition under 37 CFR 1.103(c) to suspend action in this application at applicants' request for a three month period of time, filed November 14, 2011.

BACKGROUND

Applicants state that "Pursuant to 37 C.F.R. § 1.103(c), and in conjunction with the Request for Continued Examination and Amendment filed herewith, applicants petition for a suspension of action by the Office for a period of three months."

DISCUSSION

**§ 1.103 Suspension of action by the Office.**

(c) *Limited suspension of action after a request for continued application (RCE) under § 1.114.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph after the filing of a request for continued examination in compliance with § 1.114 for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for continued examination under § 1.114, specify the period of suspension, and include the processing fee set forth in § 1.17(i).

DECISION

In view of the above, the petition for suspension of action is **GRANTED** for three months as of November 14, 2011.

Should there be any questions with respect to this action, please contact the examiner or Marianne Seidel, by mail addressed to: Director, Technology Center 1600, P. O. BOX 1450, ALEXANDRIA, VA 22313-1450,.or by telephone at 571-272-0519 or by facsimile transmission at Office general facsimile number, 571-273-8300.

/MC Seidel/
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